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Federal Circuit Patent Bulletin: *UCB, Inc. v. Yeda Research & Dev. Co.*

September 8, 2016

"Although each claim in a patent warrants independent consideration in light of its particular facts and history, the general rule is that a patent applicant cannot later obtain scope that was requested during prosecution, rejected by the Examiner, and then withdrawn by the applicant."

On September 8, 2016, in *UCB, Inc. v. Yeda Research & Dev. Co.*, the U.S. Court of Appeals for the Federal Circuit (Newman,* Lourie, Chen) affirmed the district court's summary judgment that UCB's Cimzia® product did not infringe U.S. Patent No. 6,090,923, which related to a monoclonal antibody that binds a defined human cytotoxin. The Federal Circuit stated:

The question is whether the monoclonal antibody of claim 1 includes chimeric or humanized antibodies, when the patent specification describes only murine (mouse) monoclonal antibodies. Yeda argues that since chimeric monoclonal antibodies were known at the time the '923 priority application was filed in 1984, the claims should be construed to cover such chimeric antibodies, as well as humanized antibodies. UCB responds that the prosecution history prohibits coverage of chimeric and humanized antibodies, and that claim 1 cannot be construed to cover those types of antibodies. . . .

The district court construed "monoclonal antibody," as used in the '923 patent specification and claims, to mean "a homogenous population of a single type of antibody produced via hybridoma and not including chimeric or humanized antibodies." We agree that the prosecution history requires this construction, for the scope now sought by Yeda was requested of the Examiner, and refused on the ground of new matter. Yeda argues that present claim 1 was never

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rejected on this ground; Yeda states that only the specific species claims were deemed by the Examiner to contain new matter.

The district court held that all the claims, correctly construed, exclude chimeric or humanized antibodies, the court stating that "[e]xamination of the prosecution history reveals that for the first ten years of prosecution, neither Yeda nor the examiner understood the term 'monoclonal antibodies' to include chimeric or humanized antibodies. Like the evidence in the specification, the prosecution history weighs towards a construction of 'monoclonal antibodies' which does not include chimeric or humanized antibodies." On this ground, the court found non-infringement. . . .

Yeda points out that claim 1 does not mention any particular monoclonal antibody or species of chimera, and should not be limited to the examples in the specification. Yeda states that every embodiment need not be specifically described and claimed to be within the scope of a generic term in a claim. Yeda is correct in that generic terms in claims are construed in light of that which is already known. However, the content of the specification and actions and arguments during prosecution must also be considered, in defining the scope of a generic term in a claim.

During prosecution, Yeda submitted new claims specific to "rat, hamster and human antibodies and chimeras thereof" as well as claims specifically encompassing "chimeras of" mouse monoclonal antibodies and "nonmurine" monoclonal antibodies. Yeda argued that its invention is not limited to murine antibodies to human cytotoxin, and "should encompass chimeric monoclonal antibodies produced by a genetically engineered cell line." The Examiner rejected the proposed claims on the ground of new matter not supported in the specification. Yeda then withdrew the proposed specific claims, and the application was passed to issuance. The district court held that Yeda cannot now obtain a claim construction that recovers claim scope that was yielded in order to obtain issuance of the patent, and construed the claims as excluding chimeric and humanized antibodies. . . .

The district court concluded that "the extrinsic evidence relied upon by Yeda's experts does not support the conclusion that the understanding of 'monoclonal antibodies' in 1984 included either chimeric or humanized antibodies." The district court found that "for the first ten years of prosecution, neither Yeda nor the examiner understood the term 'monoclonal antibodies' to include chimeric or humanized antibodies." The district court held that Yeda's unsuccessful attempt to claim chimeras in the pending application, with acquiescence in the examiner's rejection on the ground of new matter not supported by the specification, prohibited now obtaining a claim construction that chimeric antibodies, or equivalents thereof, are described in the specification and included in the claims.

Yeda argues that absent a narrowing amendment to the proposed claim that is now claim 1, there can be no prosecution estoppel to the scope of claim 1, merely because some proposed different claims were rejected by the examiner and then dropped by the applicant. That is not a correct general principle. Although each claim in a patent warrants independent consideration in light of its particular facts and history, the general rule is that a patent applicant cannot later obtain scope that was requested during prosecution, rejected by the Examiner, and then withdrawn by the applicant. Such estoppel was reasonably applied to claim 1 by the

district court, although claim 1 had not been amended.