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# TECHNOLOGY LAW UPDATE

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## Medichem, S.A. v. Rolabo, S.L.

Nos. 02-1461, -1480 (Fed. Cir. Dec. 23, 2003).

***“[I]n order to provoke an interference in district court under § 291, the interfering patents must have the same or substantially the same subject matter in similar form as that required by the PTO pursuant to 35 U.S.C. § 135.”***

On December 23, 2003, the Federal Circuit, *inter alia*, vacated and remanded the district court’s judgment following a bench trial that no interference-in-fact under 35 U.S.C. § 291 existed between the claimed inventions of Medichem’s U.S. Patent No. 6,084,100 and Rolabo’s U.S. Patent No. 6,093,827, which both related to the antihistamine loratidine. The Federal Circuit stated:

By PTO regulation, [the] underlying questions to the interference-in-fact inquiry are those of anticipation and obviousness under 35 U.S.C. §§ 102-103. Following from the two-way test, the standards of review for an interference-in-fact should mirror the standards of review employed in anticipation and obviousness inquiries. “[I]n order to provoke an interference in district court under § 291, the interfering patents must have the same or substantially the same subject matter in similar form as that required by the PTO pursuant to 35 U.S.C. § 135.” A district court “has no jurisdiction under § 291 unless interference is established.” Thus, the first step in any interference proceeding under § 291 is the evaluation of whether an interference-in-fact exists under the two-way test. Though PTO regulations do not bind a district court, a district court defines “the same or substantially the same subject matter” in the same manner as would the PTO under its own regulations—by using the two-way test.

According to the regulations outlining interference proceedings in the PTO, “[a]n interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.” The “same patentable invention” is defined by a separate subsection of the same regulation. This is referred to as the “two-way test.”[S]ection 1.601(n) incorporates the standards for both anticipation under § 102 and obviousness under § 103 in determining the existence of an interference, permitting either circumstance to satisfy that leg of the two-way test.

Construed properly, claims 1 and 2 of the ‘100 patent plainly anticipate claims 1 and 17 of the ‘827 patent when the ‘100 patent is the assumed prior art under the two-way test. Rolabo appropriately conceded this point at oral argument. “It is . . . an elementary principle of patent law that when, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is ‘anticipated’ if one of them is in the prior art.” The broader claims of the ‘827 patent permit, but do not require, a tertiary amine. The narrower claims of the ‘100 patent are restricted to processes including a tertiary amine. Since the ‘100 patent teaches a process that falls within the scope of the claims of the ‘827 patent, claims 1 and 2 of the ‘100 patent, when treated as prior art, anticipate claims 1 and 17 of the ‘827 patent. As a result, we reverse the district court’s findings that the first leg of the two-way test was not satisfied. . . .

Since the district court made no findings of fact regarding the second leg of the interference inquiry, it is impossible for this court in the first instance to undertake any review. As the ‘827 patent contains genus claims and the ‘100 patent contains species claims, an arrangement that assumes that the ‘827 patent is prior art does not necessarily anticipate or make obvious the narrower claims of the ‘100 patent. The second leg of the two-way test is satisfied, however, if either condition is met. Anticipation is a question of fact. Although obviousness is a question of law, it is based on underlying factual determinations. Accordingly, we remand this portion of the interference inquiry to the district court to make factual determinations of anticipation and obviousness in the first instance.