



1 October 2004

# TECHNOLOGY LAW UPDATE

*A report of the latest Federal Circuit updates brought to you by Preston Gates.*

## Astrazeneca AB v. Mut. Pharm. Co.

No. 04-1100 (Fed. Cir. Sept. 30, 2004)

***“Where the general summary or description of the invention describes a feature of the invention [and] criticizes other products [that] lack that same feature, this operates as a clear disavowal of these other products (and processes using these products).”***

On September 30, 2004, the Federal Circuit affirmed-in-part, reversed-in-part, and remanded the district court’s summary judgment of infringement and invalidity with respect to U.S. Patent No. 4,803,081, which related to extended-release felodipine. The Federal Circuit stated:

Language in some of our recent cases suggests that the intrinsic record, except for the claims, should be consulted only after the ordinary and customary meaning of claim terms to persons skilled in the pertinent art is determined. The language in these cases emphasizes the use of technical and general-usage dictionaries in determining the ordinary meaning. Under this approach, where the ordinary meaning of a claim is evident, the inventor’s written description of the invention, for example, is relevant only insofar as it provides clear lexicography or disavowal of the ordinary meaning. Against this backdrop, the question becomes whether the intrinsic evidence takes priority in our construction of the claim term “solubilizer,” or if instead the ordinary meaning of the term, as determined from sources such as treatises and dictionaries, controls our construction in the absence of intrinsic evidence of clear lexicography or disavowal. Given that the parties agree that the extrinsic meaning of solubilizer is broad, Astrazeneca unsurprisingly urges the latter approach to claim construction.

We need not decide which approach is proper as a matter of law, as even under Astrazeneca’s preferred methodology, the district court’s claim construction must be reversed. The intrinsic evidence, we hold, clearly binds Astrazeneca to a narrower definition of “solubilizer” than the extrinsic evidence would support. [W]e hold the specification clearly disavows nonsurfactant solubilizers. The inventors’ lexicography alone works an implicit disavowal of nonsurfactant solubilizers, but the rest of the specification goes further. . . . Astrazeneca contends that these statements in the specification simply address the features of preferred embodiments. Astrazeneca seems to suggest that clear disavowal requires an “expression of manifest exclusion or restriction” in the form of “my invention does not include \_\_\_\_.” But again, such rigid formalism is not required: Where the general summary or description of the invention describes a feature of the invention (here, micelles formed by the solubilizer) and criticizes other products (here, other solubilizers, including co-solvents) that lack that same feature, this operates as a clear disavowal of these other products (and processes using these products). [W]hile it is of course improper to limit the claims to the particular preferred embodiments described in the specification, the patentee’s choice of preferred embodiments can shed light on the intended scope of the claims.

Although the specification, by itself, compels the above claim construction, we briefly discuss additional confirmation for this construction: the patent applicants’ remarks during the prosecution history of the ’081 patent. [T]he reference to the “definition” in the specification [provided] that “[t]he solubilizers suitable for the preparations according to the invention are semi-solid or liquid non-ionic surface active agents.” The applicants’ characterization of this sentence in the specification as a “definition” confirms that the applicants acted as their own lexicographers to redefine “solubilizer” differently from its ordinary meaning. [T]he applicants highlighted the second component of the composition taught by the Kawata patent as the only component that “could be a ‘nonionic solubilizer.’”