

DECEMBER 29, 2006

Ventana Med. Sys., Inc. v. BioGenex Labs., Inc.

No. 06-1074, Federal Circuit (Lourie, Dyk, Prost)

As with statements made by the inventor during the prosecution of an ancestor application, statements made during the continued prosecution of a sibling application may “inform the meaning of the claim language by demonstrating how the inventor understood the invention.”

On December 29, 2006, the Federal Circuit vacated and remanded the district court’s judgment that BioGenex did not infringe U.S. Patent No. 6,352,861, which related to automated methods and apparatuses for immunostaining microscope slides. The Federal Circuit stated:

Claim terms “are generally given their ordinary and customary meaning.” And “the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art.” . . . Ventana argues that there is nothing in the record to suggest that a person of ordinary skill in the art would interpret the disclosure and claims of the ‘861 patent to mean that the term “dispensing” is limited to “direct dispensing.” We agree.

To start with, claims 1 and 5 do not contain any language that could be read to limit the term “dispensing” to require “direct dispensing.” Although “direct dispensing” is one type of dispensing, BioGenex does not appear to dispute that other types of dispensing, such as “sip and spit” dispensing, also fall within the ordinary meaning of “dispensing.” . . . Instead, BioGenex argues that the patent’s specification compels a narrow construction of “dispensing.” . . . We decline to interpret these general statements by the inventors to effect a complete surrender from the claims of the ‘861 patent of all types of dispensing except “direct dispensing.” [I]f BioGenex’s argument were correct, the inventors have also disavowed coverage of “direct dispensing,” which is the type of dispensing employed by the patent’s preferred embodiment. For this reason, BioGenex’s argument cannot be correct.



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[T]his is not a case in which the inventor's distinguishing the invention over the prior art in the specification results in a disavowal of coverage by the inventor of features in the prior art. [I]n certain cases, "the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor." In such cases, this court interprets the claim more narrowly than it otherwise would to give effect to the inventor's intent to disavow a broader claim scope. . . . BioGenex points to only general statements by the inventors indicating that the invention is intended to improve upon prior art automated staining methods. [G]eneral statements, without more, will not be interpreted to disclaim every feature of every prior art device . . .

"[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." Accordingly, we examine the patent's prosecution history, when placed in evidence, to determine whether the inventor disclaimed a particular interpretation of a claim term during the prosecution of the patent in suit or during the prosecution of an ancestor application. But the doctrine of prosecution disclaimer generally does not apply when the claim term in the descendant patent uses different language.

In this case, the allegedly disclaiming statements were made with respect to claim language that expressly required reagent in the reagent container to be "dispensable directly to a sample." . . . Because claims 1 and 5 of the '861 patent use different claim language—that is, they do not require that reagent be "dispensable directly to a sample"—the alleged disclaimer of "sip and spit" dispensing during the prosecution of the '052 application does not apply to the asserted claims of the '861 patent. . . .

We have held that statements made by the inventor during continued prosecution of a related patent application can, in some circumstances, be relevant to claim construction. As with statements made by the inventor during the prosecution of an ancestor application, statements made during the continued prosecution of a sibling application may "inform the meaning of the claim language by demonstrating how the inventor understood the invention."

For more information on these issues or other intellectual property law matters, please contact **Lawrence M. Sung, Ph.D.** at lsung@nixonpeabody.com or 202-585-8221.

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