

Monsanto Co. v. Syngenta Seeds, Inc.

No. 06-1472, Federal Circuit (Rader,* Gajarsa, O'Malley)

[I]nfringement of a multi-step method claim cannot lie by the performance of a single step after issuance of the patent when the initial steps were performed prior to issuance.

On October 4, 2007, the Federal Circuit affirmed the district court's summary judgment that Syngenta did not infringe U.S. Patents No. 5,538,880 and No. 6,013,863, which related to transgenic corn resistant to the nonselective herbicide glyphosate, and that certain claims of U.S. Patent No. 4,940,835 were invalid under 35 U.S.C. § 112 for lack of enablement. The Federal Circuit stated:

Claim 4 expressly recites the process of claim 1 and specifically requires a fertile transgenic plant obtained by the performance of the steps in claim 1. Further, it includes the additional step of obtaining progeny. Claim 4 thus incorporates the format specified by the statute for dependent claims. Contrary to Monsanto's argument, claim 4 clearly references another claim, not simply a starting material. The claim might have used express language to clarify that it only invoked the product of the process in claim 1 as a starting material, but did not do so. Instead, the claim language reads claim 1 into claim 4. . . . Although in a somewhat unusual format, claim 4 is dependent from claim 1 because it only stands if all three steps recited in claim 1 have been performed. In other words, the additional fourth step of obtaining progeny depends on the performance of the process comprising the three steps recited in claim 1 for obtaining a fertile transgenic plant. . . .

According to § 112, ¶ 4, claims in dependent form include all the limitations of the claim incorporated by reference into the dependent claim. On appeal, Monsanto concedes that Syngenta has not infringed independent claim 1 of either Lundquist patent. . . . Monsanto contends that, even if the asserted claims of the Lundquist patents are dependent claims, Syngenta should still be liable for infringing them, because each limitation of the independent claims of the Lundquist patents have been performed (albeit by Monsanto's own subsidiary Dekalb). Alternatively, Monsanto contends that, even if the asserted claims of the Lundquist patents are dependent claims, Syngenta should still be liable for infringing them, because Syngenta infringes any "four-step" claimed process by completing the last step of "obtaining progeny" during the patent term (albeit with the first three steps occurring before the patents issued).

[O]ne may infringe an independent claim and not infringe a claim dependent on that claim. The reverse is not true. One who does not infringe an independent claim cannot infringe a claim dependent on (and thus containing all the limitations of) that claim. [This] rule typically applies in cases where the accused

product or process lacks a single limitation from the independent claim. The rule does not change, however, where all of the steps of the independent claim are missing. In the present case, no one performed the three-step process of the independent claim “during the patent term,” as required by § 271(a). Indeed, Monsanto itself (through Dekalb) practiced the three-step process before the ‘863 and ‘880 patents issued. [I]nfringement under § 271(a) requires use “without authority . . . during the patent term.” . . . Thus, this court finds no error in the district court ruling as to the claim of infringement under § 271(a).

Further, this court reaches the same result with respect to Monsanto’s claim of infringement under § 271(g). Infringement is not possible under § 271(g) when the three first steps of the claimed process are performed before the issuance of the patent. [Section] 271(g) “requires that the patent be issued and in force at the time that the process is practiced and the product is made.” “Because domestic entities do not infringe a process patent if they practice the process before the beginning of the patent term, even if they sell the products of the process during the term of the patent, parallel treatment of overseas entities indicates that the statute does not reach pre-issuance use of the later-patented process.” [A] method or process claim is directly infringed only when the process is performed. [I]nfringement of a multi-step method claim cannot lie by the performance of a single step after issuance of the patent when the initial steps were performed prior to issuance. Therefore, this court affirms the district court’s judgment that Syngenta’s products do not infringe claims 4-9 of the ‘880 patent and claims 5-6 of the ‘863 patent. Syngenta cannot be liable under § 271(a) or (g).

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