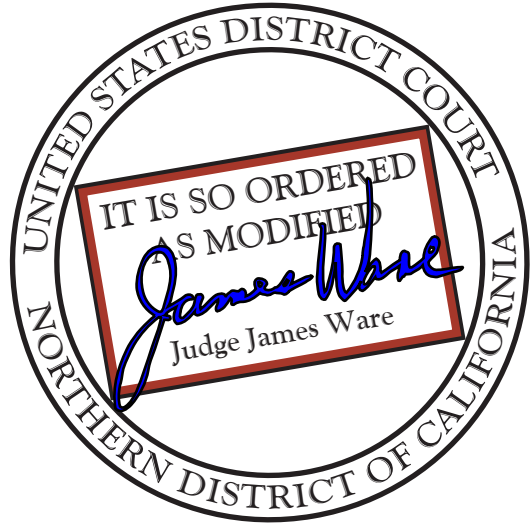


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17 UNITED STATES DISTRICT COURT
 18 NORTHERN DISTRICT OF CALIFORNIA
 19 SAN JOSE DIVISION

21 AGILENT TECHNOLOGIES, INC.
 22 Plaintiff,
 23 v.
 24 AFFYMETRIX, INC.
 25 Defendant.

CASE NO. C 06-05958 JW (PVT)
**JOINT CASE MANAGEMENT
 STATEMENT AND [PROPOSED]
 ORDER**

Date: December 14, 2009
 Time: 10:00 a.m.
 Courtroom: 8, 4th Floor
 Judge: Hon. James Ware

1 In its Order of November 3, 2009 (Dkt. 89), the Court continued the Case Management
2 Conference until December 14, 2009, in light of the parties' settlement negotiations. In its Order,
3 the Court stated that the Joint Case Management Statement shall include the parties' proposed
4 schedule on how the case should proceed and an update on the parties' settlement efforts. While
5 settlement negotiations are on-going, the parties jointly submit this Case Management Statement and
6 Proposed Order.

7 **DESCRIPTION OF THE HISTORY OF THE CASE**

8 The present case is a suit under 35 U.S.C. § 146 filed by Plaintiff Agilent Technologies, Inc.
9 ("Agilent") against Defendant Affymetrix, Inc. ("Affymetrix") on September 26, 2006. Agilent
10 appeals the decision of the United States Patent and Trademark Office ("USPTO") Board of Patent
11 Appeals and Interferences ("the Board") in Patent Interference No. 105,285 ("the Interference"),
12 entitled "Carol T. Schembri, Junior Party v. Donald M. Bessemer, Virginia W. Goss, and James L.
13 Winkler, Senior Party."

14 Agilent is the owner of all right, title, and interest in U.S. Patent No. 6,513,968, which issued
15 on February 4, 2003 ("the Schembri patent"). Affymetrix is the owner of U.S. patent application
16 number 10/619,224, filed on July 12, 2003, by Besemer, Goss, and Winkler ("the Besemer
17 application"). To provoke an interference, Affymetrix copied claims of the Schembri patent into the
18 Besemer application. On January 27, 2004, Affymetrix requested a declaration of interference
19 between the Schembri patent and the Besemer application. The Interference was declared by the
20 USPTO on February 16, 2005.

21 In the Interference, Agilent filed a motion contending that claims 66-70 and 73-78 of the
22 Besemer application are unpatentable because they are not supported by an adequate written
23 description, as required under 35 U.S.C. § 112, ¶ 1. After briefing and a hearing, the Board denied
24 Agilent's motion. It also found that Agilent could not prevail on the question of priority because the
25 priority date accorded to Agilent was after that accorded to Affymetrix and Agilent did not assert an
26 earlier date of invention. Accordingly, the Board canceled claims 20-26 and 30-35 of the Schembri
27 patent. Although Affymetrix filed motions attacking the involved claims of the Schembri patent
28 under 35 U.S.C. § 102(b) and 102(e), the Board dismissed those motions as moot.

1 Agilent contended that the Board erroneously determined that claims 66-70 and 73-78 of the
2 Besemer application were supported by an adequate written description, and that the Board
3 erroneously canceled claims 20-26 and 30-35 in the Schembri patent as a result. Affymetrix
4 contended that the Board was correct in its decision.

5 On appeal to this Court, the parties submitted cross-motions for summary judgment on the
6 written description issue. Following a joint claim construction and summary judgment hearing held
7 April 25, 2008, the Court construed the Besemer claims in light of the Besemer specification, found
8 sufficient written description support for the claims, and entered judgment in Affymetrix's favor.

9 Agilent appealed the Court's decision to the Federal Circuit, which reversed. In its decision,
10 the Federal Circuit held that when a party challenges written description support for an interference
11 count or a copied claim in an interference, the originating disclosure provides the meaning of the
12 pertinent claim language. The Federal Circuit therefore construed the Besemer claims in light of the
13 Schembri patent specification. After construing the key limitations of the claims, the Federal Circuit
14 held there was no dispute of material fact that the Besemer application does not satisfy the written
15 description requirement for the claims at issue. Accordingly, the Federal Circuit held the Court
16 erred in granting Affymetrix's summary judgment motion and reversed this Court's denial of
17 Agilent's summary judgment motion. Affymetrix filed a petition for rehearing en banc, which the
18 Federal Circuit denied. The Federal Circuit then issued its mandate on September 25, 2009, and
19 entered judgment in favor of Agilent.

20 **DISPOSITION OF THE CASE IN LIGHT OF THE REMAND**

21 In its Order, the Court specifically asked the parties to address their respective positions with
22 respect to how the case should proceed. The parties' positions are below:

23 Agilent's Position:

24 The only issue that the Board substantively decided was whether the Besemer claims have
25 written description support. The Board did not consider any of Affymetrix's additional motions,
26 instead dismissing the motions as moot in light of the decision on written description. Accordingly,
27 on appeal, the only issue that this Court and the Federal Circuit considered was the written
28 description issue. If Affymetrix asserts that its substantive motions should be considered at all,

1 Agilent requests that the Court reverse the Board's decision and remand the case to the Board so that
2 the Board may decide how to proceed with the interference in the first instance.

3 In the alternative, if the Court would find it to be helpful, Agilent proposes that the parties
4 brief the issue of the disposition of the case according to the schedule below.

5 Affymetrix's Position:

6 Affymetrix's motions in the Interference challenging the validity of the Schembri patent
7 claims 20-26 and 30-35 remain to be decided in this case. This Court has already ruled in its Order
8 dated September 13, 2007, that "these issues qualify for consideration in this action." Order on
9 Motions Re: Standard of Review, Scope of Review, and Examination of Specifications, Docket No.
10 47, dated September 13, 2007 at p. 7.

11 Affymetrix also agrees to brief the issue of the disposition of the case if the Court would find
12 it helpful.

13 **SCHEDULE**

14 If the Court would find briefing the issue of the disposition of the case helpful, the parties'
15 proposed schedule going forward is set forth below:

16

EVENT	DUE DATE
Opening brief on the disposition of the case	January 25, 2010
Responsive brief on the disposition of the case	February 8, 2010
Hearing on the disposition of the case	March 22, 2010 at 9 a.m.

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24 Pursuant to General Order No. 45 X.B, the electronic filer of this document attests under
25 penalty of perjury that she has the concurrence of each of the signatories to this Joint Case
26 Management Statement.
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Dated: December 4, 2009

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: /s/ Tina E. Hulse
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Dated: December 4, 2009

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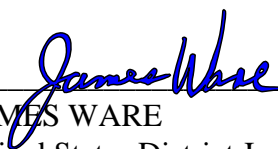
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~~James Ware~~
[PROPOSED] CASE MANAGEMENT ORDER

The Case Management Statement and ~~James Ware~~ Order is hereby adopted by the Court as the Case Management Order for the case and the parties are ordered to comply with this Order.

The Court also sets a Further Case Management Conference following the **March 22, 2010** hearing at 10 a.m. On or before **March 12, 2010**, the parties shall file a Joint Case Management Statement. The Statement shall include an update on the parties' settlement efforts.

Dated: December 8, 2009



JAMES WARE
United States District Judge