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7 **UNITED STATES DISTRICT COURT FOR THE**
8 **WESTERN DISTRICT OF WASHINGTON**
9 **AT SEATTLE**

10 **WASHINGTON RESEARCH**
11 **FOUNDATION; and GENENTECH,**
12 **INC.,**

13 **Plaintiffs,**

14 **v.**

15 **SANOFI; SANOFI-AVENTIS U.S. LLC,**

16 **Defendants.**

Civil Action No. 2:15-cv-1143-BJR

ORDER GRANTING
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT

17 Plaintiffs and Counterclaim Defendants Washington Research Foundation (“WRF”) and
18 Genentech, Inc. (“Genentech”) allege that Defendants and Counterclaimants Sanofi and sanofi-
19 aventis U.S. LLC (collectively “Sanofi”) have infringed claim 38 of U.S. Patent No. 5,919,651
20 (“the ‘651 patent”). Sanofi moves this Court for summary judgment, arguing that pursuant to
21 35 U.S.C. § 112(d), claim 38 depends from claim 34; and, since Defendants, Plaintiffs agree,
22 cannot be found to have infringed claim 34, they cannot be found to have infringed claim 38 as
23 a matter of law. Plaintiff opposes the motion, arguing that claim 38 is an independent claim;
24 and, therefore, that Defendants need not have infringed claim 34 in order for the Court to find
25 that they have infringed claim 38. Having reviewed the parties’ briefs together with all relevant
materials, the Court grants summary judgment.

I. BACKGROUND

A. Procedural History

Plaintiffs initiated this lawsuit on July 17, 2015, alleging that Defendants had infringed one or more of the claims of the ‘651 patent in violation of 35 U.S.C. § 271. Doc. 1.¹ The ‘651 patent, entitled “Expression of Polypeptides in Yeast,” contains 38 claims relating to recombinant DNA technology for genetically engineering yeast cells to produce useful proteins (“polypeptides”) that are ordinarily exogenous to, and not normally made by, yeast cells. ‘651 patent, Doc. 69-1, col.1 ll.19-22, col.4 ll.-20.

In January 2017, the parties completed claim construction briefing in anticipation of a March 31, 2017 *Markman* hearing. Docs. 50, 52-57. In February 2017, however, the parties filed a stipulation and covenant not to sue, narrowing the case to a single disputed claim. Doc. 59. Specifically, Defendants represented that their allegedly-infringing product—the protein rasburicase, which Defendants sell in the United States under the trade name Elitek—has always been manufactured outside of the United States; that the yeast strain used to manufacture rasburicase was transformed in 1991, eight years before the ‘651 patent issued; and that the strain of transformed yeast cells and the DNA vector used to manufacture rasburicase has never resided in the United States. *Id.* at 2. In reliance on Defendants’ representations, Plaintiffs agreed, in relevant part, to not assert any claims or causes of action alleging that Defendants have directly or indirectly infringed any of the ‘651 patent’s claims with the exception of claim 38. *Id.*² At the parties’ request, the Court vacated all previously-set dates, and issued a briefing

¹ In August 2016, the Court dismissed for lack of personal jurisdiction former Defendant Sanofi-Synthelabo LLC. Doc. 44.

² Specifically, Plaintiffs agreed “to provide a covenant not to sue, and not to assert any claims or causes of action alleging that Defendants have directly or indirectly infringed any of claims 1-5, 9-10, 12-15, 17-19, 23-30, 34-35, or 37 of the ‘651 patent by making, using, offering for sale, selling, and/or importing [r]asburicase.” Doc. 59 at 2.

1 schedule for the instant motion for summary judgment of noninfringement with respect to claim
2 38. Doc. 60.

3 **B. The Asserted Claim**

4 The '651 patent was issued on July 6, 1999. '651 patent, Doc. 69-1. The patent is directed
5 to methods of producing useful proteins in yeast cells using recombinant DNA technology. *Id.* at
6 col.1 ll.19-22, col.4 ll.-20.³ According to the patent's specification, recombinant DNA technology
7 allows for the microbial production of proteins that can be used in the preparation of vaccines,
8 immune modulators, and antibodies for diagnostic and drug-targeting applications. *Id.* at col. 1
9 ll.41-47. Defendants' accused product, Elitek (rasburicase), was approved by the FDA in July
10 2002 as a treatment to reduce uric acid in patients receiving chemotherapy. Doc. 65 at 12.
11 According to Defendants, rasburicase is made in yeast cells that have been transformed with a
12 DNA vector containing the rasburicase gene. Doc. 65 at 12.

14 Plaintiffs allege that Defendants have infringed claim 38. Claim 38 recites as follows:

15 A process of producing a polypeptide comprising culturing the yeast strain of claim
16 34, and recovering said polypeptide.

17 *Id.* at col.18 ll.24-26. Claim 34 recites as follows:

18 A yeast strain capable of expressing a polypeptide ordinarily exogenous to yeast
19 produced by a process comprising transforming said yeast strain with a DNA
20 transfer vector comprising [certain structural features].

22 ³ Recombinant DNA technology refers generally to the process of taking a piece of one strand of DNA and
23 combining it with another strand of DNA, which is then able to create a new strand of DNA. *See id.* at col.1 ll.33-67.
24 The '651 patent's specification explains that plasmid, a non-chromosomal loop of double-stranded DNA, is encoded
25 to contain one or more characteristics and to reproduce in "daughter cells." *Id.* Plasmids can be "cleaved," with
each piece recognizing a different site on the plasmid DNA. *Id.* at col. 1 ll. 58-61. Thereafter, genes or gene
fragments can be inserted into the plasmid at the cleavage site. *Id.* at col.1 ll. 61-64. The DNA recombination is
performed outside of the cell, and the resulting recombinant plasmid is introduced into the cell by a process known
as "transformation." *Id.* at col. 1 ll.64-66. These plasmids are referred to as "DNA transfer vectors." *Id.* at col. 2
ll.36-39. The transfer vectors contain "a structural gene intended for expression" and a "promoter and associated
controls" such that the cells can actually produce the desired characteristic. *Id.* at col. 2 ll.36-46.

1 *Id.* at col.17 ll.19-col. 18 ll.10.

2 Defendants have moved for summary judgment, arguing that pursuant to 35 U.S.C.
3 § 112(d), claim 38 is dependent upon claim 34. A party who “does not infringe an independent
4 claim cannot infringe a claim dependent on (and thus containing all the limitations of) that claim.”
5 *Wahpeton Canvas Co., Inc. v. Frontier, Inc.*, 870 F.2d 1546, 1552 (Fed. Cir. 1989). There is no
6 contention that Defendants have infringed claim 34; thus, Defendants argue, they cannot be found
7 to have infringed claim 38 as a matter of law. Plaintiffs oppose the motion, arguing that claim 38
8 is an independent claim; and, therefore, that the Court does not need to find that Defendants have
9 infringed claim 34 in order for the Court to find that Defendants have infringed claim 38.
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11 **II. LEGAL STANDARDS**

12 **A. Summary Judgment**

13 Summary judgment is proper “if the movant shows that there is no genuine dispute as to
14 any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a).
15 The moving party bears the initial burden of demonstrating the absence of a genuine issue of
16 material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). In deciding a summary judgment
17 motion, the court must view the evidence in the light most favorable to the non-moving party and
18 draw all justifiable inferences in its favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255
19 (1986).
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21 **B. Infringement**

22 An infringement analysis generally involves two steps. *Markman v. Westview Instruments,*
23 *Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996). Courts first
24 determine “the meaning and scope of the patent claims asserted to be infringed,” and then
25 “compar[e] the properly construed claims to the device accused of infringing.” *Id.* In this matter,

1 The parties vigorously dispute, however, whether, according to § 112(d), claim 38 specifies
2 a further limitation of the subject matter of claim 34, *i.e.*, the yeast strain recited in claim 34.
3 Defendants maintain that it does. Specifically, Defendants contend that claim 38’s steps of
4 “culturing” the yeast strain and “producing” and “recovering” the polypeptide further limit the
5 yeast strain, which, in claim 34, is only “capable” of producing a polypeptide. Doc. 65 at 24-25.
6 Defendants assert that the yeast strain of claim 34 is a “condition precedent” to claim 38: “Without
7 the transformed yeast strain of claim 34, the additional process steps of claim 38 would be
8 meaningless (if not impossible)[.]” *Id.* Plaintiffs, in their opposition, maintain that claim 38 does
9 not further limit claim 34. Doc. 68. Specifically, Plaintiffs contend, claim 38 does not further limit
10 or otherwise define “either (i) the yeast strain made by claim 34 or (ii) the process of making the
11 yeast strain recited in claim 34;” thus, Plaintiffs argue, claim 38 is not dependent upon claim 34.
12 Doc. 76 at 4. Defendants, in response, argue that Plaintiffs’ “narrow reading of § 112(d)” is
13 unsupported by the relevant case law. Doc. 70 at 9, 14; Doc. 65 at 19-24. The Court agrees and
14 finds that *Monsanto Co. v. Syngenta Seeds, Inc.*, 503 F.3d 1352 (Fed. Cir. 2007), is especially
15 instructive. Before examining the relevant jurisprudence, the Court examines the claims of the
16 ‘651 patent. *See Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

19 **A. The ‘651 Patent’s Claims**

20 The parties compare the wording of claim 38 to that of other claims of the ‘651 patent. *See*
21 Doc. 68 at 4-6; Doc. 70 at 12; Doc. 76 at 7-8; *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1313
22 (Fed. Cir. 2005) (en banc) (claims must be viewed “in the context of the entire patent”). In so
23 doing, Plaintiffs maintain that claim 38 is drafted similarly to the undisputedly independent claims
24 (claims 1, 12, 19, and 34), and differently from the undisputedly dependent claims (claims 3, 13,
25 and 30, for example). Doc. 68 at 4-6. Plaintiffs would thus have the Court believe that claim 38 is

1 anomalous among the patent’s claims that reference another claim. It is not. Instead, claim 38 is
 2 nearly identical to claims 10 and 28; and claim 38 fits within the overall drafting of the claims.
 3 ‘651 patent, Doc. 69-1, col. 15 ll.18-col.18 ll.11.⁴ Further, claim 38 is not drafted similarly to the
 4 undisputedly independent claims. *See id.*⁵

5 Plaintiffs are correct that claim 38 does not follow the format of claims 35-37, which are
 6 undisputedly dependent upon claim 34, and which follow the typical dependent format by
 7 beginning: “The yeast strain of claim 34, wherein...[.]” However, a claim’s status as dependent
 8 or independent is determined by “the substance of the claim in light of the language of § 112[(d)],
 9 and not on the form alone.” *Monsanto*, 503 F.3d at 1357-58 (citing Manual of Patent Examining
 10 Procedure § 608.01(m), (n); and 37 C.F.R. § 1.75)).

12 **B. Claim 38’s Substance in Light of the Language of § 112(d)—Relevant Case Law**

13 In deciding the same issue, the Federal Circuit in *Monsanto* was confronted with a claim
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15 ⁴ The nearly identical claims recite as follows:

<p>Claim 10: A process of producing a polypeptide comprising culturing a yeast strain transformed by the process of claim 1, and recovering said polypeptide.</p>	<p>Claim 28: A process of producing a polypeptide comprising transforming a yeast strain with the DNA expression vector of claim 12, culturing the transformed yeast strain, and recovering said polypeptide.</p>	<p>Claim 38 [at issue here]: A process of producing a polypeptide comprising culturing the yeast strain of claim 34, and recovering said polypeptide.</p>
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19 The claims of the ‘651 patent were drafted in the following manner: (i) an independent claim (1; 12; 29; 34, respectively); (ii) a number of referencing claims that are follow the typical dependent format (2-9, 11; 13-27; 30-33, respectively); (iii) a claim that begins with the phrase, “a process of producing a polypeptide comprising...” (10; 28; 38, respectively). *Cf. CLS Bank Int’l v. Alice Corp. Pty.*, 717 F.3d 1269, 1327 (Fed. Cir. 2013), *aff’d*, 134 S. Ct. 2347 (2014) (Moore, J., dissenting in part) (citing *O’Reilly v. Morse*, 56 U.S. 62 (1853)) (in drafting claims, “it is customary to start with broad claims and then draft claims of progressively narrower scope”).

21 ⁵ The undisputedly independent claims recite as follows:

<p>Claim 1: A process of forming a transformant of a yeast strain capable of expressing a polypeptide ordinarily exogenous to yeast, comprising transforming said yeast strain with a DNA transfer vector that comprises [certain structural features].</p>	<p>Claim 12: A DNA expression vector, capable in a transformant strain of yeast of expressing a polypeptide ordinarily exogenous to yeast, said vector comprising [certain structural features].</p>	<p>Claim 29: A yeast strain comprising a gene encoding a polypeptide ordinarily exogenous to yeast under the control of a yeast promoter [with certain structural features].</p>	<p>Claim 34: A yeast strain capable of expressing a polypeptide ordinarily exogenous to yeast produced by a process comprising transforming said yeast strain with a DNA transfer vector comprising [certain structural features].</p>
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1 that was drafted in a similar, “unusual format.” *See id.* at 1358. In relevant part, Plaintiffs
2 Monsanto and Dekalb alleged that Defendants had used a patented seed acquired from Plaintiffs’
3 licensees “to produce further progeny containing” the trait that the seed was genetically-engineered
4 to contain. 503 F.3d at 1355. The relevant claim at issue, claim 4, recites as follows:

5 A process comprising obtaining progeny from a fertile transgenic plant obtained by
6 the process of claim 1 which comprise said DNA.

7 *Id.* at 1355. The parties agreed that claim 1 was an independent process claim that recites “a three-
8 step process for generating an original [] fertile transgenic plant containing DNA that provides
9 herbicide resistance.” *Id.* at 1357. Specifically, claim 1 recites as follows:

10 A process for producing a fertile transgenic...plant comprising [three enumerated
11 steps].

12 The parties further agreed that Defendants had not performed the three steps recited in claim 1;
13 and, therefore, that Defendants had not infringed claim 1. *Id.* at 1359. In fact, it was Plaintiffs who
14 had performed the three steps listed in claim 1, and Plaintiffs had done so before the relevant patent
15 issued. *Id.* at 1355. In construing the claim terms, the district court found that claim 4 was
16 dependent upon claim 1. *Id.* at 1357. Specifically, the district court construed claim 4 as “further
17 adding a fourth step of obtaining progeny from” the plant produced by the process of claim 1. *Id.*
18 On appeal, Plaintiffs argued that claim 4 was, “by itself a single-step process ([the] process of
19 obtaining progeny),” and that claim 4’s reference to claim 1 referred only “to the novel starting
20 material (a fertile transgenic plant previously obtained using the claim 1 process) of the new
21 process in claim 4.” *Id.* In support of their argument, Plaintiffs asserted that the format of claim 4
22 differed from that of the customary dependent format. *Id.*
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25 The Federal Circuit agreed that claim 4 was drafted “in a somewhat unusual format.” *Id.*
at 1358. Nevertheless, “claim 4 is dependent from claim 1,” the Circuit found, “because it only

1 stands if all three steps recited in claim 1 have been performed. In other words, the additional
2 fourth step of obtaining progeny *depends* on the performance of the process comprising the three
3 steps recited in claim 1 for obtaining a fertile transgenic plant.” *Id.* (emphasis in original). Thus,
4 the Circuit found, “claim 4 clearly references another claim, not simply a starting material.” *Id.* at
5 1358. Citing 35 U.S.C. § 112(d), the Circuit reasoned that claim 4 “expressly recites the process
6 of claim 1 and specifically requires” the product “obtained by the performance of the steps in claim
7 1.” *Id.* Further, the Circuit explained, claim 4 “includes the additional step of obtaining progeny.”
8 *Id.* This additional step, the Circuit found, constituted a limitation upon the subject matter of claim
9 1. *Id.*

11 In the instant case, Plaintiffs attempt to distinguish *Monsanto* by asserting that in
12 *Monsanto*, both claims were process claims, while here, claims 38 and 34 are of “different statutory
13 classes:” Claim 34 is a product-by-process claim and claim 38 is a process claim. Doc. 68 at 7, 12-
14 13, 18, 20-23; Doc. 76 at 5-6 (citing *Amgen v. Hospira*, 232 F. Supp. 3d 621, 627 (D. Del. 2017)).
15 In *Monsanto*, Plaintiff contends, the Circuit interpreted claim 4 as a fourth step “in one continual
16 process” that begins in claim 1, “rather than a separate process that used the starting material
17 obtained from claim 1.” *Id.* at 21 (citing 503 F.3d at 1358). Here, Plaintiffs contend, claim 38
18 “merely references ‘the yeast strain of claim 34’ as the starting material to use in the method of
19 claim 38[.]” Doc. 68 at 12.

21 However, the *Monsanto* Court addressed this argument and found it “irrelevant.” 503 F.3d
22 at 1358. On appeal, Plaintiffs contended that “claim 4 is claiming a process using the starting
23 material of a product [that] has been made by the process” of the three steps recited in claim 1. 503
24 F.3d at 1358. Even if the inverse were true (and claim 4 was a product-by-process claim), the
25 Circuit explained, what is dispositive is that Defendants “would still have to perform the steps of

1 the process of claim 1 to infringe the product-by-process claim, *i.e.* claim 4 would only have
2 meaning according to the incorporation of the limitations of claim 1.” *Id.* Given that claim 1 only
3 claims the process of making the plant, claim 4, which claims the process of obtaining progeny
4 from that plant, also requires, of course, the actual plant. Thus, for Plaintiffs here, the statutory
5 class distinction is, at best, one without a difference; and, at worst, it makes claim 38’s dependency
6 on claim 34 all the more apparent because claim 38 has meaning *solely* according to the
7 incorporation of claim 34. *Cf. id.* at 1357 (noting that claim 4 “might have used express language
8 to clarify that it only invoked the product of the process in claim 1 as a starting material, but did
9 not do so.”).⁶

11 Plaintiffs additionally, or alternatively, contend that claim 38 should be interpreted to
12 reference the yeast strain of claim 34 “as a shorthand for the product ‘to use in’ the separate method
13 of claim 38, ‘not to further define’ that yeast strain.” *Id.* at 22 (quoting *Ex Parte Gillis*, 2013 WL
14 860588, at *2 (PTAB Mar. 4, 2013)). Plaintiffs assert that claim 38’s steps “do not relate to the
15 *creation* of the yeast strain, and instead relate to the *production of a polypeptide.*” *Id.* at 18
16 (emphasis in original). Claim 38 “recites steps to be performed on the yeast strain of claim 34, but
17 not steps that further limit that yeast strain beyond the properties set forth in claim 34 itself.” *Id.*

19 Plaintiffs’ interpretation of § 112(d)’s “further limit” language is not in accordance with
20 binding precedent. As explained above, claim 4 in *Monsanto* did not “further define” the process
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23 ⁶ Thus, Plaintiffs’ reliance on *Amgen Inc. v. Hospira, Inc.*, 232 F. Supp. 3d 621 (D. Del. 2017), is mistaken. In relevant
24 part, at issue in *Hospira* was whether claim 27 depended from claim 1. *Id.* at 627. Claim 27 recited: “A method for
25 obtaining an erythropoietin composition having [certain characteristics] comprising preparing a mixture of two or
more erythropoietin isoforms of claim 1.” Claim 1 recited: “A isolated biologically active erythropoietin isoform
having [certain characteristics].” In finding claim 27 independent, the Court noted that “claim 27 is a method claim,
while claim 1 is a composition claim,” and that “the prosecution history tends to show that claim 27 was treated as an
independent claim during prosecution.” *Id.* Here, however, as described *infra*, the prosecution history tends to show
that claim 38 was treated as dependent. Further, claim 38 does not “prepare a mixture” of the yeast strain of claim 34;
instead, it cultures the yeast strain to produce the polypeptide and recovers the polypeptide.

1 of creating the transgenic plant recited in claim 1, nor the resulting transgenic plant. 503 F.3d at
2 1354-1358. Similarly, the Circuit in *Amgen v. Hoffman-La Roche Ltd*, 580 F.3d 1340, 1383-84
3 (Fed. Cir. 2009), noted that a nearly-identical claim, claim 7, depends from its referent claims,
4 claims 1 through 6. For ease of reference, the Court has reproduced the claims below:

Claim 38 [at issue here] A process of producing a polypeptide comprising culturing the yeast strain of claim 34, and recovering said polypeptide.	Claim 7 in <i>Amgen</i> A process for producing erythropoietin comprising the step of culturing, under suitable nutrient conditions, vertebrate cells according to claim 1, 2, 3, 4, 5, or 6.	Claim 4 in <i>Monsanto</i> A process comprising obtaining progeny from a fertile transgenic plant obtained by the process of claim 1 which comprise said DNA.
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10 As in *Amgen*, claim 38 cultures the product-subject matter of the referent claim (by growing it in
11 a nutrient-rich environment), thereby transforming that product from one *capable* of producing a
12 desired trait into a product that actually produces the desired trait. *See* 580 F.3d at 1383-84. As in
13 *Monsanto*, claim 38 actually recovers what the referent claim is only capable of producing. *See*
14 *Monsanto*, 503 F.3d at 1354-1358. Thus, claim 38 only stands if all of the steps of claim 34 have
15 been performed. *See id.* Accordingly, the Court finds that claim 38 is dependent upon claim 34
16 pursuant to 35 U.S.C. § 112(d). *See id.*; *Hoffman-La Roche*, 580 F.3d at 1383-84; *see also*
17 *Spectrum Pharmaceuticals, Inc. v. Sandoz Inc.*, 2013 WL 6865692, at *21-22 (D. Nev. Dec. 31,
18 2013) (finding that despite claims having been written in “unusual format,” referencing claims
19 were dependent upon their respective referent claims where the composition in each referencing
20 claim “can be created only after the composition covered by [the referent claim] is first created”)
21 (citing *Monsanto*, 503 F.3d at 1357); *Maury Microwave, Inc. v. Focus Microwaves, Inc.*, 2012 WL
22 9161988, at *32-33 (C. D. Cal. July 30, 2012) (finding referencing claims dependent upon referent
23 claims where the steps of the referent claims had to be performed before the step in the referencing
24 claim could begin); *accord I Energy Solutions, Inc. v. Nicholas Holiday*, 2014 WL 12589113, at
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1 *4 (C.D. Cal. July 9, 2014) (dependent claims are those that are “limited by another claim”).⁷

2 **C. Treatment of Claim 38 During the ‘651 Patent’s Prosecution History**

3 The Court’s finding that claim 38 is a dependent claim is further reinforced by the patent’s
4 prosecution history. Specifically, WRF’s statements concerning—and the Examiner’s treatment
5 of—claim 38 during the ‘651 patent’s prosecution history support the finding that claim 38 is a
6 dependent claim. Doc. 65 at 9-11, 12, 19, 25-27.

7 1. Fee Determination and the Examiner’s Index of Claims

8 As Defendants point out, for fee determination purposes, WRF twice informed the Patent
9 and Trademark Office (“PTO”) that of the patent’s 38 claims, only four of were independent. *Id.*
10 at 10-11 (citing Doc. 69-1 at 41, 66, Amendment Transmittal Letters for Application Serial No.
11 08/465,927, dated Oct. 10, 1997 and July 6, 1998, respectively). There is “no real dispute,”
12 Defendants contend, that these four claims correspond to Plaintiffs’ cancelled claims 16, 27, 44,
13 and 49, which themselves correspond to issued claims 1, 12, 29, and 34, respectively, because
14 these are the only four claims that do not reference another claim. *Id.* Plaintiffs, in their opposition,
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18 ⁷ The additional cases on which Plaintiffs rely do not convince the Court otherwise. In *Ex Parte Eisenhardt*, 2013
19 WL 4575055, at *3 (PTAB Aug. 27, 2013), in relevant part, the Patent Trial and Appeal Board (“PTAB”), examined
20 claim 18. Claim 18 is directed to: “A data storage unit for a system according to claim 1.” *Id.* Claim 1, in turn, recited:
21 “A system for measuring a [certain] concentration in a body fluid sample, comprising [certain characteristics].” *Id.* at
22 *1. The Board found that claim 18’s reference to claim 1, “merely describes the intended use of the claimed data
23 storage unit.” *Id.* at *3. The system recited in claim 1, the Board found, was not further “defined” or “required” by
24 claim 18. *Id.* Here, however, claim 38 specifically requires the product claimed by claim 34 (the yeast strain), and
25 further defines the yeast strain by culturing it to produce polypeptide, and then recovering the polypeptide.

Moreover, *Eisenhardt*—and Plaintiffs—rely in part on *Ex Parte Gillis*, 2013 WL 860588, at *2-*4 (PTAB
Mar. 4, 2013), which is not in accordance with *Monsanto*, 503 F.3d at 1354-58. In *Ex Parte Gillis*, the Examiner had
rejected claim 8 for “failing to include all the limitations of the claims upon which it depends[, claims 1, 2, 3, and 4]
and for failing to further limit the subject matter of [these] claims[.]” 2013 WL 860588, at *2. Claim 8 recites: “A
method of treating an airway using an implant system as defined in claim 1, 2, 3, 4.” *Id.* In refusing to sustain the
Examiner’s rejection, the PTAB stated that:

Claim 8 recites a statutory class (‘A method’), a preamble (‘...treating an airway’), and at least one
step (‘using...’). Claim 8 refers to claims 1-4 as shorthand for the structure to use in the method,
not to further define the structure claims. Such are clues that a claim is independent.

In light of *Monsanto*, this Court disagrees. See *Monsanto*, 508 F.3d at 1354-58.

1 do not address these transmittal letters. *See* Doc. 68 at 23-26 (addressing fee determination issues
2 as they relate to the Examiner only); Doc. 70 at 8 (same).

3 The Court takes note of the fact that the Examiner, in accordance with the Manual of Patent
4 Examining Procedure (“MPEP”) in effect at the time, was required to designate independent
5 claims “in the Index of Claims by encircling the claim number in red ink.” Doc. 64 at 253, MPEP
6 § 719.04 (6th ed., Jul. 1997); *see Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120
7 F.3d 1253, 1257 (Fed. Cir. 1997) (the MPEP “is well known to those registered to practice in the
8 PTO and reflects the presumptions under which the PTO operates”). When examining the ‘651
9 patent, the Examiner only circled issued claims 1, 12, 29, and 34—the only four claims that do not
10 reference another claim—and did not ever circle claim 38 over the course of the prosecution
11 history. Doc. 64 at 44, Index of Claim for Application Serial No. 08/465,927, initially dated Jul.
12 18, 1995; *see* MPEP § 719.04 (6th ed., Jul. 1997) (directing that the Index of Claims “be kept up
13 to date so as to be a reliable index of all claims standing in a case, and of the amendment in which
14 the claims are to be found”). Plaintiffs correctly point out that Examiners initially consider
15 dependent any claim that references another claim, and that the Examiner did not “affirmatively
16 analyze” whether claim 38 was dependent upon claim 34. Doc. 68 at 24-25 (citing MPEP §
17 608.01(n)). However, had the Examiner, at any point during the prosecution history, considered
18 claim 38 to be an improper dependent claim, *i.e.*, an independent claim, he was obligated to object
19 to the claim and require cancellation or Plaintiffs’ rewriting. MPEP § 608.01(n). The Examiner
20 did not do so.
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23 The Court finds that the Examiner’s actions (and lack thereof), when combined with
24 Plaintiffs’ transmittal letters, support the finding that claim 38 is a dependent claim. *See Spectrum*
25 *Pharmaceuticals, Inc. v. Sandoz Inc.*, 2013 WL 6865692, at *22 (D. Nev. Dec. 31, 2013)

1 (prosecution history supported finding that claims 13 and 14 were dependent where the patent
2 application “expressly provides for fourteen total claims of which only three are independent
3 claims” and “[n]either party disputes that these three independent claims consist of claim 1, claim
4 5, and claim 10”); *Novartis Pharmaceuticals Corp. v. Actavis, Inc.*, 2013 WL 6142747 (D. Del.
5 Nov. 21, 2013) (during prosecution history, “the fact that Plaintiffs did not consider the claims at
6 issue as independent when making payment to the PTO is at least *some* evidence suggesting that
7 Plaintiffs themselves recognized that the claims are dependent claims”) (emphasis in original);
8 *Maury Microwave, Inc. v. Focus Microwaves, Inc.*, 2012 WL 9161988 (C.D. Cal. Jul. 30, 2012)
9 (prosecution history supported finding that two claims were dependent where applicants “changed
10 what were independent claims into dependent claims,” and examiner recorded the number of
11 independent claims as falling from “four to one”).

13 2. WRF’s Statements Concerning Related Patents

14 Defendants assert that WRF informed the PTO that then-pending claim 38 “‘generally
15 corresponded’ to” claim 31 of a related patent (“the ‘676 patent”). Doc. 65 at 11, 27 (quoting Doc.
16 64 at 28-33, Amendment A and Response to Paper No. 7 for Application Serial No. 08/465,927).
17 WRF, Defendants continue, identified claim 31 as a “‘dependent’ claim.” Doc. 65 at 12 (quoting
18 Doc. 64 at 87-88, Supplemental Amendment for Application Serial No. 08/474,333). Further,
19 Defendants assert, claim 31 of the ‘676 patent and claim 38 at issue here are “virtually identical.”
20 Doc. 65 at 11. Plaintiffs, in their opposition, argue that the Court should “give little weight to this
21 one isolated statement concerning a different patent.” Doc. 68 at 26. Moreover, Plaintiffs assert,
22 at another point during prosecution, WRF referred to a different, ultimately-cancelled claim that
23 was “similar to issued claim 38 in both form and substance,” and which WRF stated was an
24 “independent claim.” *Id.* at 25-26 (citing Doc. 69-1, Ex. 5, comparing claim 38 to cancelled claim
25

56). Defendants, in response, contend that WRF’s asserted statement concerning cancelled claim 56 was not made during the prosecution of the ‘651 patent; instead, it was made “in an abandoned patent application that was five applications up the chain from the prosecution of the ‘651 patent, and more than four years before the filing of the ‘651 patent.” Doc. 70 at 15 (citing Doc.69-1, Ex. 5, WRF’s Mar. 29, 1991 Amendment to App. No. 07/349,918, filed May 9, 1989).

The parties’ asserted claims, as compared to the claim at issue here, recite as follows:

Claim 38 of the ‘651 patent [at issue here]	Claim 31 of the ‘676 patent [Defendants’ comparison]	Cancelled claim 65 [Plaintiffs’ comparison]
A process of producing a polypeptide comprising culturing the yeast strain of claim 34, and recovering said polypeptide.	A method of producing a biocompetent polypeptide ordinarily exogenous to yeast comprising culturing a yeast strain of claim 28 and recovering said polypeptide.	A method of producing a biocompetent polypeptide ordinarily exogenous to yeast, by culturing a yeast strain transformed by the process of claim 13.

Plaintiffs do not provide authority for their simultaneous contentions that the Court should afford “little weight” to the fact that during the prosecution history of the patent at issue, WRF considered claim 31 a dependent claim, but afford at least some weight to the fact that during the prosecution of an abandoned patent, WRF considered cancelled claim 56 independent. In any event, claim 56 is materially different from claim 38 and claim 31: it does not contain the phrase, “and recovering said polypeptide.” *See Monsanto Co. v. Syngenta Seeds, Inc.* 503 F.3d 1352, 1358 (Fed. Cir. 2007) (referencing claim’s process of “obtaining progeny” from a plant whose creation process is recited in referent claim, constituted limitation of the referent claim). Thus, the prosecution history is not, as Plaintiffs maintain, “ambiguous” because it is not necessarily contradictory to consider cancelled claim 56 independent while considering claims 38 and 31 dependent. *Cf. Abbott Labs v. Sandoz, Inc.* 566 F.3d 1282, 1289 (Fed. Cir. 2009) (“[O]wing in part to the inherent ambiguities of prosecution history, the doctrine of prosecution disclaimer only

1 applies to unambiguous disavowals”); *Monsanto*, 503 F.3d at 1358 (prosecution history provided
2 “additional insight” into whether claim was dependent where applicant amended original claim
3 after prosecution closed and “carefully explained that its amendments ‘do not introduce new
4 matter.’”).

5 IV. CONCLUSION

6 “It is axiomatic that dependent claims cannot be found infringed unless the claims from
7 which they depend have been found to have been infringed[.]” *Wahpeton Canvas Co., Inc. v.*
8 *Frontier, Inc.*, 870 F.2d 1546, 1552 (Fed. Cir. 1989). Here, there is no dispute that Defendants’
9 rasburicase does not infringe claim 34 according to 35 U.S.C. § 271. The Court having found
10 claim 38 to be a dependent claim, Defendants cannot, therefore, be found to have infringed claim
11 38 as a matter of law. *See id.*; *Wahpeton* 870 F.2d at 1552. Accordingly, Defendants motion for
12 summary judgment is HEREBY GRANTED with respect to claim 38 of the ‘651 patent.
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14 Dated this 2nd day of February, 2018.
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20 BARBARA J. ROTHSTEIN
21 UNITED STATES DISTRICT JUDGE
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