

In re Skvorecz*
and
Amgen Inc. v. F. Hoffman-LaRoche Ltd.**

Susan Perng Pan
December 9, 2009



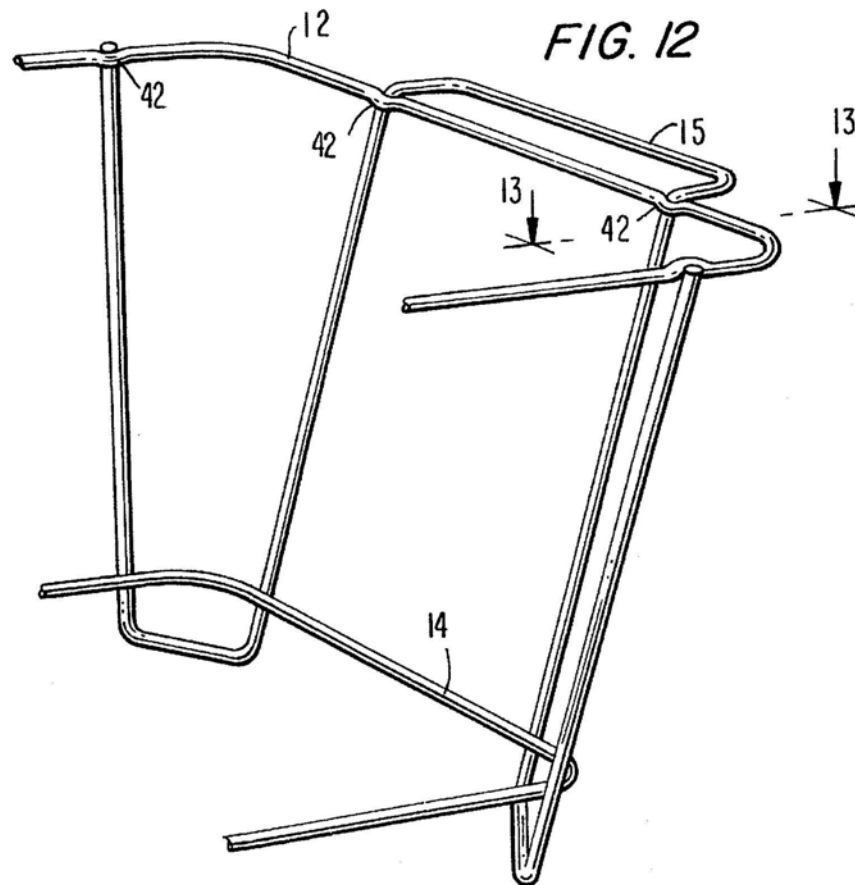
*92 USPQ2d 1020
**92 USPQ2d 1289

In re Skvorecz

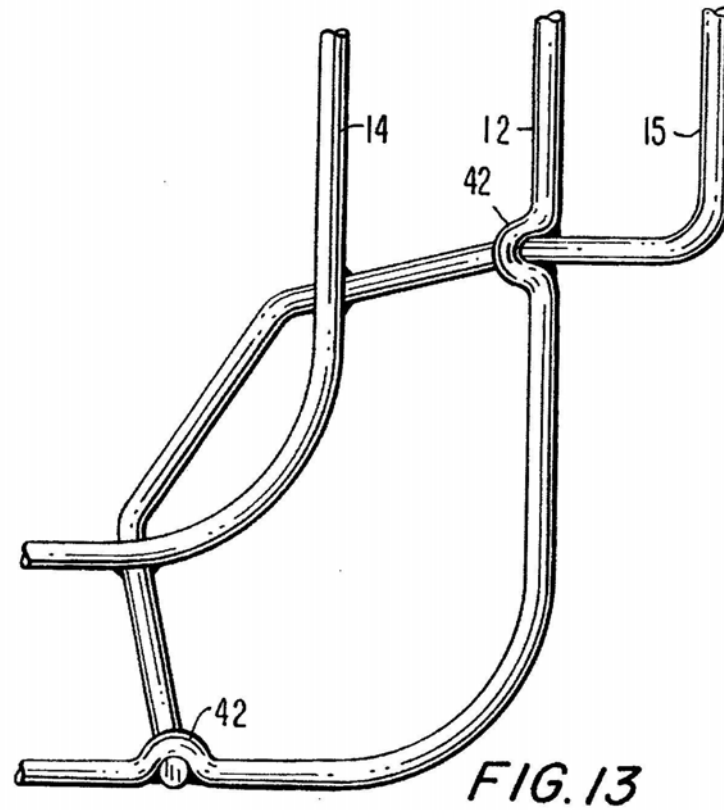
- Introductory word "comprising" does not render a claim anticipated by a device that contains less (rather than more) than what is claimed
- Drawings can serve as the basis for written description support, according to what would be understood by one skilled in the art



U.S. Patent 5,996,948



U.S. Patent 5,996,948



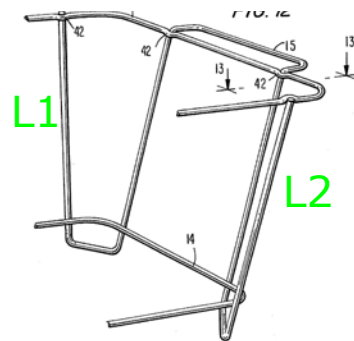
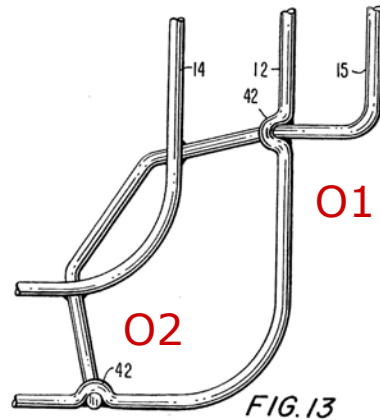


U.S. Patent 5,996,948

1. A wire chafing stand comprising a first rim of wire steel which forms a closed geometrical configuration circumscribing a first surface area, and having at least two wire legs with each wire leg having two upright sections interconnected to one another in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90 degrees with respect to a horizontal plane through said base support and being affixed to the first rim adjacent one end thereof and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said first rim for laterally displacing each wire leg relative to said first rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging.



Claim language



A wire chafing stand comprising a first rim of wire steel which forms a closed geometrical configuration circumscribing a first surface area, and having at **least two wire legs** with each wire leg having two upright sections interconnected to one another in a configuration forming a base support..... and further comprising a **plurality of offsets** located either in said upright sections of said wire legs or in said first rim **for laterally displacing each wire leg** relative to

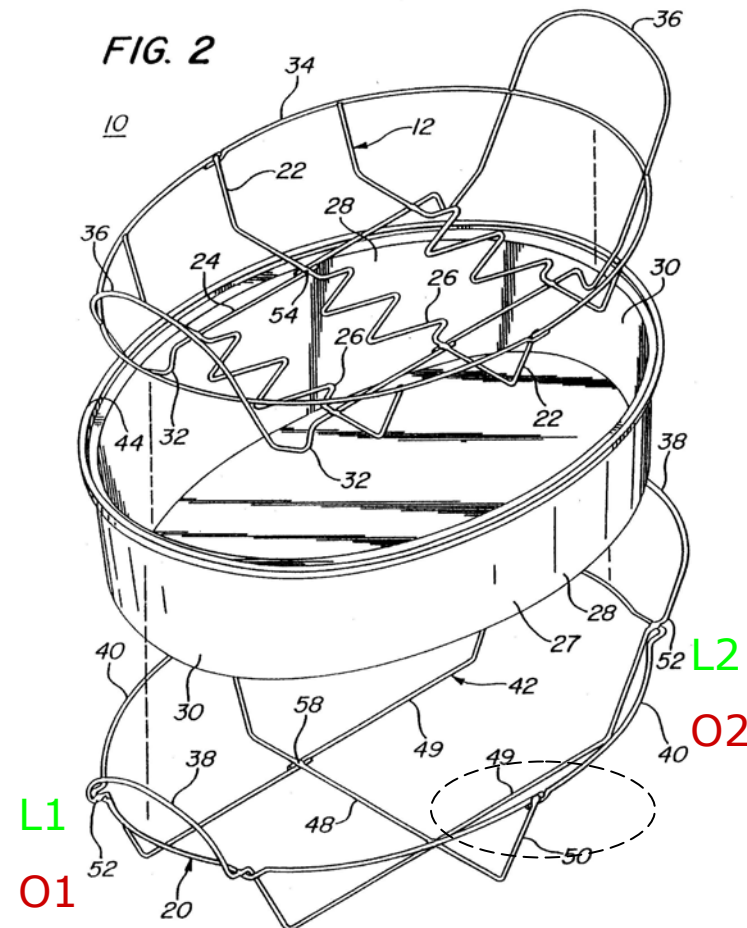


Claim language in comparison to Prior Art

Prior Art "leg" 48 has no offset.

Therefore, each leg does not include an offset for displacing the leg relative to the rim.

Claim is not anticipated



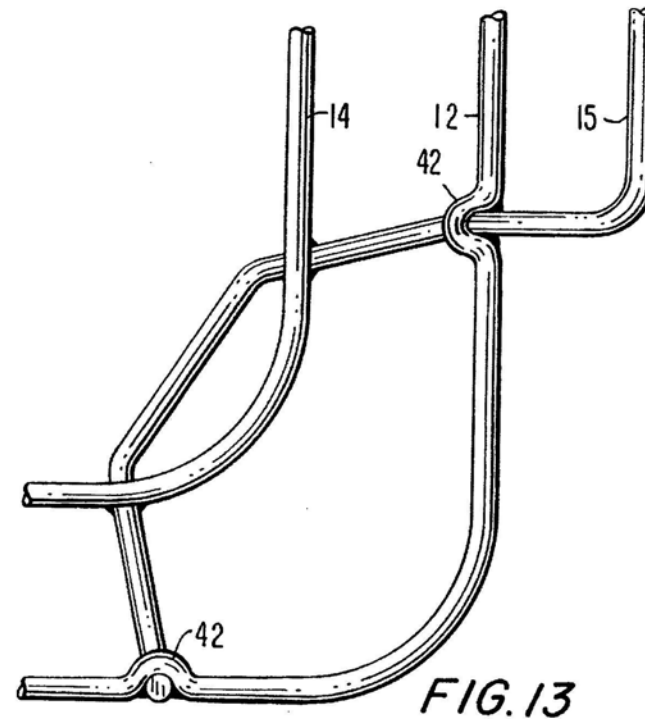
U.S. Patent 5,996,948

The signal "comprising" does not render a claim anticipated by a device that contains less (rather than more) than what is claimed. Here the examination expedient of "broadest reasonable interpretation" was incorrectly applied to interpret "comprising" to mean that not all the Skvorecz wire legs need have offsets, despite the claims that state that "each wire leg" has an offset. The Buff device does not have an offset located in each wire that serves as a leg to support the device. In the Buff structure both the transverse wire 48 and the longitudinal wire 49 provide the bottom support analogous to wire legs, and it is undisputed that wire segment 48 does not have an offset. Anticipation cannot be found, as a matter of law, if any claimed element or limitation is not present in the reference. The "anticipation" rejection is reversed.



Section 112 issues

5. A wire chafing stand as defined in claim 1 wherein said plurality of offsets are welded to said wire legs at the* separation of the upright sections into segments.



*Examiner can suggest correction on antecedence



Amgen v. Hoffmann-LaRoche

- ☐ Claims of Continuation applications may be rejected on basis of obviousness type double-patenting over related parent applications
- ☐ Prior product claim alone cannot render method claim invalid based on obviousness type double-patenting
- ☐ Old product is not patentable, even if made by new process

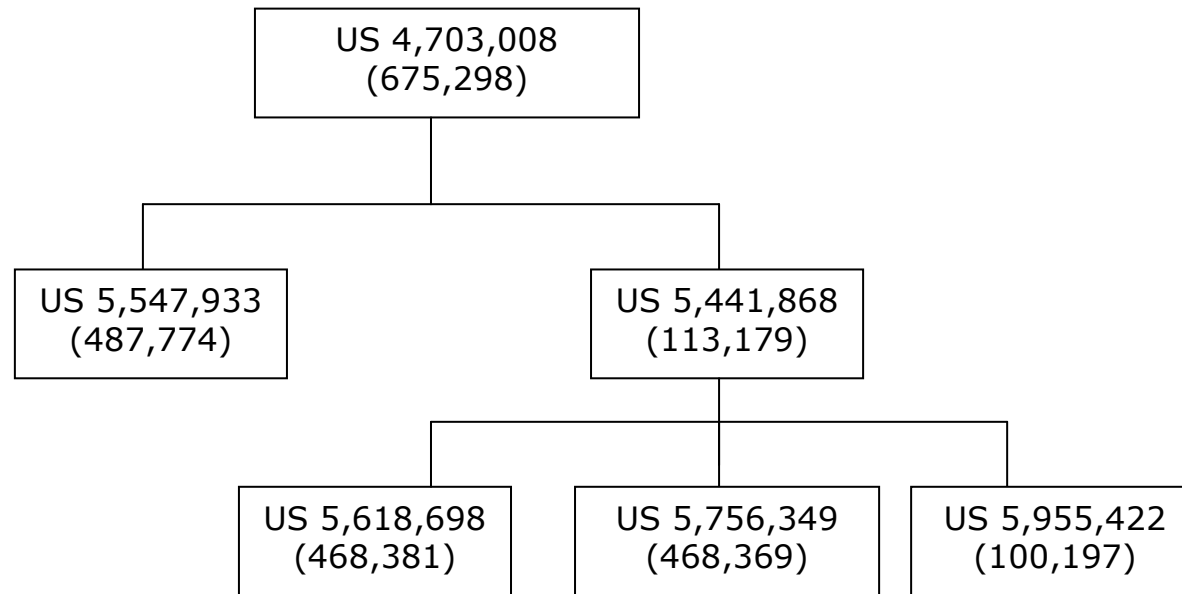


Amgen v. Hoffmann-LaRoche

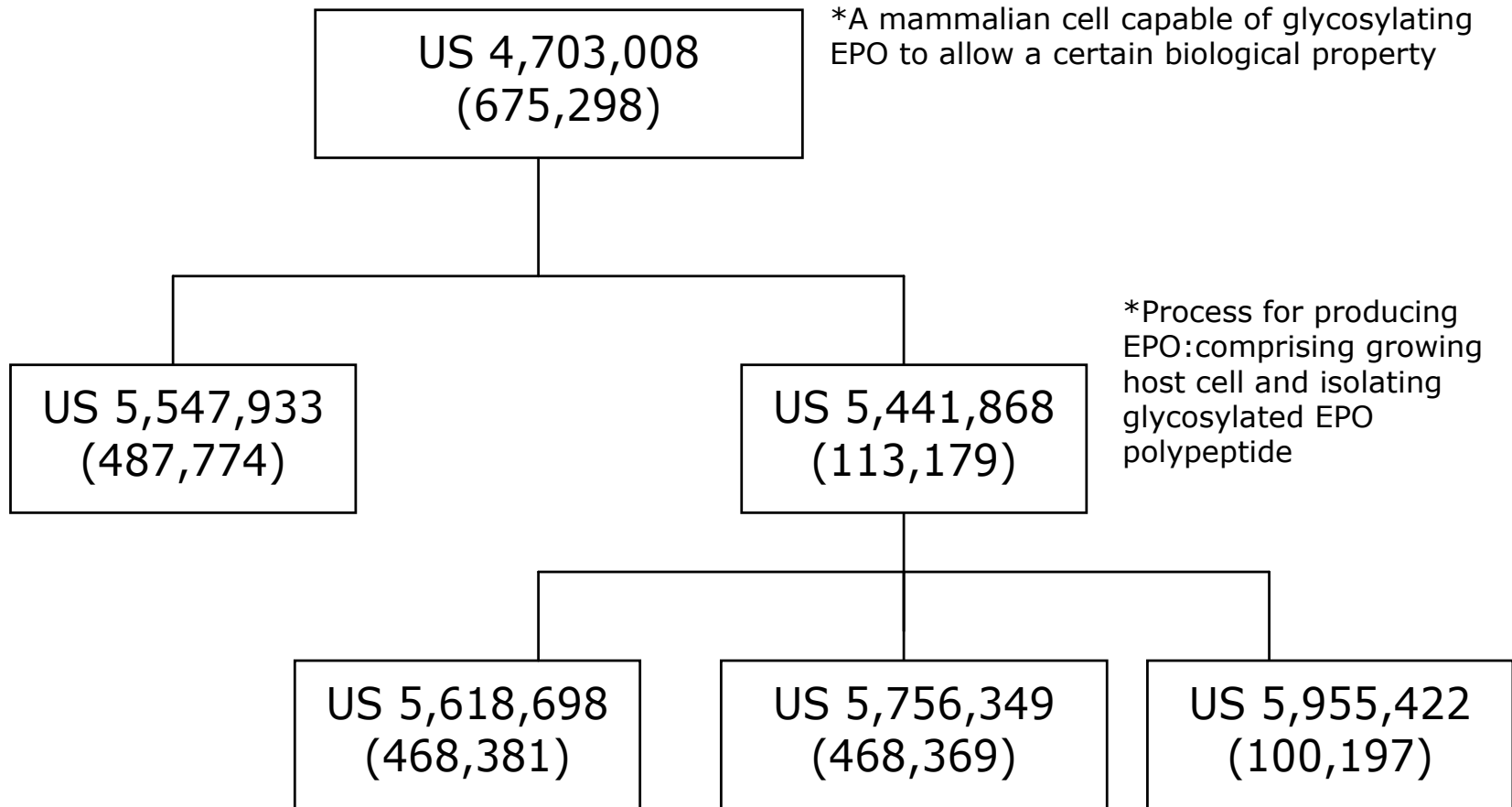
- ☐ For product-by-process claims, that which anticipates if earlier does not necessarily infringe if later.
- ☐ Product in prior art patent may be made by different process and anticipate claim
- ☐ Accused product may not infringe if the process by which the product is made is different from the claim



Amgen – Relationship of Patents



Amgen – Relationship of Patents



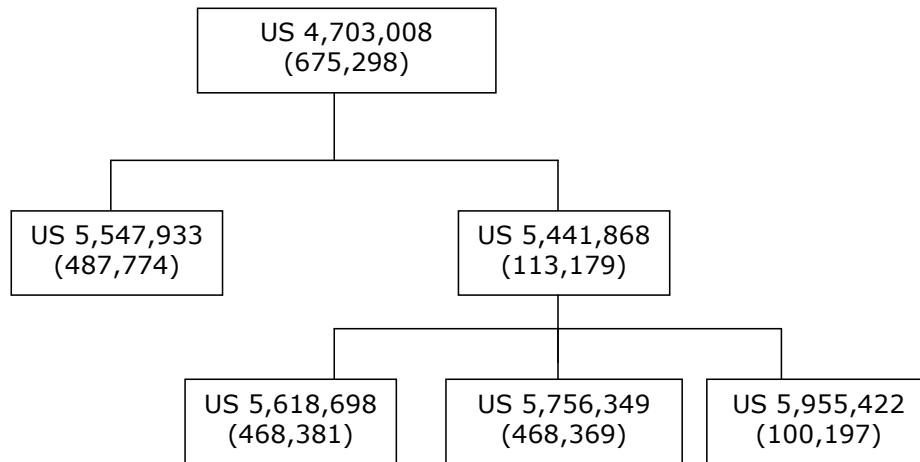
*A mammalian cell capable of glycosylating EPO to allow a certain biological property

*Process for producing EPO: comprising growing host cell and isolating glycosylated EPO polypeptide

*Process comprising: growing vertebrate cells including amplified DNA coding and isolating glycosylated EPO



Amgen – Relationship of Patents



'422: claim 1: A pharmaceutical composition comprising a therapeutically effective amount of human EPO... wherein said EPO is purified from mammalian cells grown in culture

'933: claim 3: A non-naturally occurring glycoprotein product of the expression in a mammalian host cell of exogenous DNA sequence comprising DNA encoding human EPO

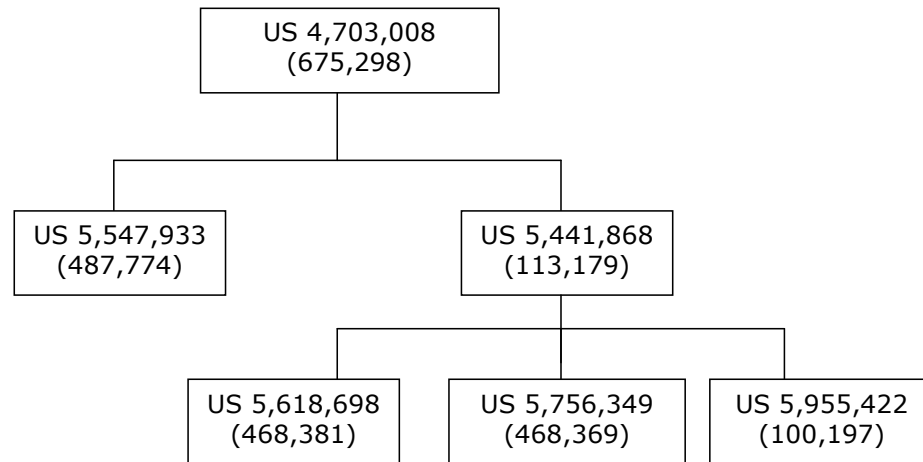


Differences between Prior Art and '422 and '933 patent claims

- ☐ Purported invalidating art disclosed EPO purified from urine
- ☐ Court determined that purified EPO form did not include originating source material from mammalian cells grown in culture
- ☐ Court determined that recombinant EPO was different in characteristic than purified EPO (.e.g. molecular weight)



Amgen – Relationship of Patents



'422: claim 1: A pharmaceutical composition comprising a therapeutically effective amount of human EPO... wherein said EPO is purified from mammalian cells grown in culture

'933: claim 3: A non-naturally occurring glycoprotein product of the expression in a mammalian host cell of exogenous DNA sequence comprising DNA encoding human EPO

'698 and '868 patents include methods for manufacturing the compositions of '933 and '422 patents



Infringement of process claims by importation of products

- 35 U.S.C. 271(g) Whoever without authority imports into the U.S. or offers to sell, sells or uses within the U.S. shall be liable as an infringer, if the importation, offer to sell, sale or use of the product occurs during the term of such process patent... A product which is made by a patented process will... not be considered so made if after ... it is materially changed by a subsequent process



Infringement

- Accused EPO met purity and source requirements of the composition claims ('422 and '933)
 - The additional reaction of the EPO with a PEG molecule does not obviate the infringement of the EPO claims
 - Likewise the additional reaction with PEG molecule is not a sufficient material change that would obviate infringement of the method claims '868 and '698 patents under 271(g)



Questions?

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Thank you.

