



08.07.15

DISTRICT COURT CASES

Humanized Antibody Not Found to Infringe Under DOE

A district court judge granted UCB, Inc.'s (plaintiff) motion for summary judgment that its Cimzia® product, a humanized monoclonal antibody approved for the treatment of rheumatoid arthritis, psoriatic arthritis, active ankylosing spondylitis, and Crohn's disease, does not infringe a patent owned by Yeda Research and Development Co. (defendant). In its motion, plaintiff argued that the term "monoclonal antibody", which was used in the asserted claims, does not include humanized antibodies like Cimzia® because the technology to make humanized antibodies did not exist when the asserted patent was filed. In response, defendant argued that the plain meaning of "monoclonal antibody" is broad enough to include humanized antibodies. In granting plaintiff's motion, the court first found that Cimzia® does not literally infringe the asserted claims because the term "monoclonal antibody" is limited to an antibody made through hybridoma and did not extend to chimeric or humanized monoclonal antibodies. In reaching this conclusion, the court explained that "[i]f the embodiment disclosed in the specification is the only embodiment which could have been understood to fall within the claim terms at the time of filing, then interpreting the claims to be coextensive with that single embodiment is simply giving the claims their correct meaning. In other words, [defendant's] argument that the claims cannot be limited only to disclosed embodiments fails when no other embodiments existed at the time of filing."

The court also rejected defendant's argument that Cimzia® infringes under the doctrine of equivalents (DOE) because a humanized antibody is equivalent to an antibody made via hybridoma. In rejecting that argument, the court noted that during prosecution the defendant cancelled claims directed to humanized or chimeric antibodies and, therefore, were estopped from trying to re-capture that subject matter. The court explained that "[w]hen the USPTO rejected [defendant's] efforts to claim chimeric and humanized antibodies and [defendant] acquiesced to those rejections, [defendant's] competitors and interested members of the public were entitled to rely on [defendant's] actions. Having conceded the correctness of the rejections made by the USPTO, [defendant] cannot now complain that it is estopped from re-capturing that subject matter as an equivalent."

UCB, Inc. v. Yeda Research and Development Co. Ltd., 1-14-cv-01038, E.D. Va. (Brinkema).

- Author: [Matthew G. Hartman](#)

PATENT TRIAL AND APPEAL BOARD

PTAB Determines Indemnification Settlement and "Legal Advice" Insufficient To Show Privity Between Petitioner and Third Party

A Patent Trial and Appeal Board (PTAB) panel has determined a patent owner provided insufficient evidence to show a petition for *inter partes* review was barred under the time bar due to privity in 35 U.S.C. § 315(b). The panel framed its privity analysis by looking at whether the petitioner controlled or could have controlled the third party's conduct in related four-year old district court litigation. The panel was not persuaded by evidence of a settlement based on the parties' indemnification agreement related to the district court litigation, or by evidence of a series of communications between the parties' lawyers discussing the litigation.

First, the panel assessed the petitioner's and third party's conduct related to the indemnification agreement. That agreement gave the petitioner the ability to control district court litigation against the third party, following prompt notice by the third party of an infringement suit filed against it. However, the panel found the evidence did "not demonstrate sufficiently that [the third [party] made claims under the Agreements that would have triggered [the petitioner's] right to exercise control over the 2011 district court proceeding." Instead, the panel found the parties

had merely settled the indemnification claims.

Next, the panel turned to the communications between the petitioner and third party. The patent owner adduced evidence of more than forty emails and documents sent between the parties' counsel concerning the district court litigation, and a privilege log in which the "third party's in-house counsel was referred to as "co-counsel." The patent owner argued this evidence showed the petitioner's "constant involvement and control" of the litigation. Again, the panel was unpersuaded. Instead, the panel found the "communications between [the petitioner's] in-house counsel and [a third party's] counsel, even if characterized as 'legal advice,' [did] not establish that [the petitioner] controlled [the third party's] participation in the 2011 district court proceedings."

Arris Grp., Inc. v. C-Cation Techs., LLC, IPR2015-00635, Paper 19 (PTAB Dec. 31, 2015) [Pettigrew (opinion), Benoit, Quinn].

- Author: [Jonathan Underwood](#)

CONTACT INFORMATION

If you have any questions regarding this issue of *IP Newsflash*, please contact—

Todd Eric Landis

tlandis@akingump.com

214.969.2787

Michael Simons

msimons@akingump.com

512.499.6253

www.akingump.com



© 2015 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. IRS Circular 230 Notice Requirement: This communication is not given in the form of a covered opinion, within the meaning of Circular 230 issued by the United States Secretary of the Treasury. Thus, we are required to inform you that you cannot rely upon any tax advice contained in this communication for the purpose of avoiding United States federal tax penalties. In addition, any tax advice contained in this communication may not be used to promote, market or recommend a transaction to another party. Lawyers in the London office provide legal services through Akin Gump LLP, practicing under the name Akin Gump Strauss Hauer & Feld. Akin Gump LLP is a New York limited liability partnership and is authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG.

[Update](#) your preferences | [Subscribe](#) to our mailing lists | [Forward](#) to a friend | [Opt out](#) of our mailing lists | [View](#) mailing addresses