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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

THE SCRIPPS RESEARCH  
INSTITUTE,  
  
Plaintiff,  
  
v.  
  
ILLUMINA, INC.,  
  
Defendant.

Case No.: 16-CV-661 JLS (BGS)  
  
**ORDER ON CLAIM  
CONSTRUCTION**  
  
(ECF Nos. 54, 55)

In March 2016, Plaintiff The Scripps Research Institute brought suit against Defendant Illumina, Inc. alleging infringement of U.S. Patent No. 6,060,596 (“the ’596 patent”), entitled “Encoded Combinatorial Chemical Libraries.” Presently before the Court is claim construction. The Court held a claim construction hearing on January 30, 2018.

The ’596 patent generally relates to a library of bifunctional molecules, each molecule having a chemical polymer and an identifier oligonucleotide sequence that defines the structure of the chemical polymer. *See* U.S. Patent No. 6,060,596 (filed May 9, 2000.) The libraries are used in the manufacture of DNA microarrays. (ECF No. 55,

1 at 5.)<sup>1</sup> Each DNA bead in a microarray contains many copies of specific DNA sequences  
2 (known as “probes,” “oligonucleotides,” or “oglios.”) (*Id.* at 5–6.) These probes “can be  
3 used to bind to and detect a complementary DNA or RNA sample.” (*Id.* at 6.) Scripps  
4 asserts claims 1, 3, 10, and 16, and the Parties dispute six terms within claim 1. Defendant  
5 filed a claim construction brief, (“Def. CC Brief,” ECF No. 54), as did Plaintiff, (“Pl. CC  
6 Brief,” ECF No. 55). Both Parties also filed a response, (“Def. Response,” ECF No. 56;  
7 “Pl. Response,” ECF No. 57).

### 8 LEGAL STANDARD

9 “A determination of infringement involves a two-step analysis. ‘First, the claim  
10 must be properly construed to determine its scope and meaning. Second, the claim as  
11 properly construed must be compared to the accused device or process.’” *Omega Eng’g,*  
12 *Inc. v. Raytek Corp.*, 334 F.3d 1314, 1320 (Fed. Cir. 2003) (quoting *Carroll Touch, Inc. v.*  
13 *Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1576 (Fed. Cir. 1993)).

14 The first step, commonly known as claim construction, is presently before the Court.  
15 Claim construction is a matter of law for the Court’s determination. *Markman v. Westview*  
16 *Instruments, Inc.*, 517 U.S. 370, 388 (1996) (“[J]udges, not juries, are the better suited to  
17 find the acquired meaning of patent terms.”).

18 Words of a claim are “generally given their ordinary and customary meaning.”  
19 *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). “[T]he  
20 ordinary and customary meaning of a claim term is the meaning that the term would have  
21 to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the  
22 effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303,  
23 1313 (Fed. Cir. 2005) (en banc). Because the inquiry into the meaning of claim terms is  
24 an objective one, “a court looks to those sources available to the public that show what a  
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27 <sup>1</sup> Pin citations to docketed material refer to the CM/ECF numbers electronically stamped at the top of each page.

1 person of skill in the art would have understood disputed claim language to mean.”  
2 *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed.  
3 Cir. 2004). “Those sources include the words of the claims themselves, the remainder of  
4 the specification, the prosecution history, and extrinsic evidence concerning relevant  
5 scientific principles, the meaning of technical terms, and the state of the art.”<sup>2</sup> *Id.* (citing  
6 *Vitronics*, 90 F.3d at 1582–83).

7 Claim construction begins with an analysis of the words of the claims themselves.  
8 *See Scanner Techs. Corp. v. ICOS Vision Sys. Corp.*, 365 F.3d 1299, 1303 (Fed. Cir. 2004)  
9 (holding that claim construction “begins and ends” with a claim’s actual words). “In some  
10 cases, the ordinary meaning of claim language as understood by a person of skill in the art  
11 may be readily apparent even to lay judges, and claim construction in such cases involves  
12 little more than the application of the widely accepted meaning of commonly understood  
13 words.” *Phillips*, 415 F.3d at 1314. However, the meaning of a claim term as understood  
14 by ordinarily skilled artisans often is not immediately apparent. *Id.* In those situations, the  
15 court looks to “sources available to the public that show what a person of skill in the art  
16 would have understood disputed claim language to mean.” *Id.* Or, when a patentee  
17 “chooses to be his own lexicographer and use terms in a manner other than their ordinary  
18 meaning,” the court can use the patentee’s meaning “as long as the special definition of the  
19 term is clearly stated in the patent specification or file history.” *Vitronics*, 90 F.3d at 1582.

20 In examining the claims themselves, “the context in which a term is used can be  
21 highly instructive.” *Phillips*, 415 F.3d at 1314. Moreover, “[o]ther claims of the patent in  
22 question, both asserted and unasserted can . . . be valuable sources of enlightenment as to  
23 the meaning of a claim term.” *Id.* (citing *Vitronics*, 90 F.3d at 1582). “Because claim  
24 terms are normally used consistently throughout the patent, the usage of a term in one claim  
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27 <sup>2</sup> The first three sources are considered “intrinsic evidence” of claim meaning. *See generally Phillips*, 415 F.3d at 1314–17.

1 can often illuminate the meaning of the same term in other claims.” *Id.* Conversely, under  
2 the doctrine of claim differentiation, “different words or phrases used in separate claims  
3 are presumed to indicate that the claims have different meanings and scope.” *Andersen*  
4 *Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1369 (Fed. Cir. 2007) (quoting *Karlin*  
5 *Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971–72 (Fed. Cir. 1999)).

6 “Importantly, the person of ordinary skill in the art is deemed to read the claim term  
7 not only in the context of the particular claim in which the disputed term appears, but in  
8 the context of the entire patent, including the specification.” *Phillips*, 415 F.3d at 1313.  
9 “The specification acts as a dictionary when it expressly defines terms used in the claims  
10 or when it defines them by implication.” *Vitronics*, 90 F.3d at 1582. “In addition to  
11 providing contemporaneous technological context for defining claim terms, the patent  
12 applicant may also define a claim term in the specification ‘in a manner inconsistent with  
13 its ordinary meaning.’” *Metabolite Labs., Inc. v. Lab. Corp. of Am.*, 370 F.3d 1354, 1360  
14 (Fed. Cir. 2004). “Usually, [the specification] is dispositive; it is the single best guide to  
15 the meaning of a disputed term.” *Vitronics*, 90 F.3d at 1582; *accord Phillips*, 415 F.3d at  
16 1317 (“It is . . . entirely appropriate for a court, when conducting claim construction, to  
17 rely heavily on the written description for guidance as to the meaning of the claims.”).

18 Patent claims should ordinarily be construed to encompass the preferred  
19 embodiments described in the specification, for “[a] claim construction that excludes a  
20 preferred embodiment . . . ‘is rarely, if ever, correct.’” *SanDisk Corp. v. Memorex Prods.,*  
21 *Inc.*, 415 F.3d 1278, 1285 (Fed. Cir. 2005) (quoting *Vitronics*, 90 F.3d at 1583). However,  
22 a court should not import limitations from the specification into the claims, *Phillips*, 415  
23 F.3d at 1323 (“[A]lthough the specification often describes very specific embodiments of  
24 the invention, we have repeatedly warned against confining the claims to those  
25 embodiments.”), absent a specific reference in the claims themselves, *Reinshaw PLC v.*  
26 *Marposs Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (“[A] party wishing to  
27 use statements in the written description to confine or otherwise affect a patent’s scope

1 must, at the very least, point to a term or terms in the claim with which to draw in those  
2 statements.”).

3 The patent’s prosecution history, if in evidence, may also shed light on claim  
4 construction. *Vitronics*, 90 F.3d at 1582. “This history contains the complete record of all  
5 proceedings before the Patent and Trademark Office [(“PTO”)], including any express  
6 representations made by the applicant regarding scope of the claims.” *Id.* “Like the  
7 specification, the prosecution history provides evidence of how the PTO and the inventor  
8 understood the patent.” *Phillips*, 415 F.3d at 1317. Although the prosecution history  
9 “often lacks the clarity of the specification,” it is nevertheless useful to show “how the  
10 inventor understood the invention and whether the inventor limited the invention in the  
11 course of prosecution, making the claim scope narrower than it would otherwise be.” *Id.*

12 “In most situations, an analysis of the intrinsic evidence alone will resolve any  
13 ambiguity in a disputed claim term. In such circumstances, it is improper to rely on  
14 extrinsic evidence.” *Vitronics*, 90 F.3d at 1583. Thus, expert testimony on the proper  
15 construction of disputed claim terms “may only be relied upon if the patent documents,  
16 taken as a whole, are insufficient to enable the court to construe disputed claim terms.” *Id.*  
17 at 1585.

18 However, *Vitronics* does not state a rule of admissibility, nor does it “prohibit courts  
19 from examining extrinsic evidence, even where the patent document is itself clear.” *Pitney*  
20 *Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999). As the Federal  
21 Circuit has made clear:

22 [B]ecause extrinsic evidence can help educate the court regarding the field of  
23 the invention and can help the court determine what a person of ordinary skill  
24 in the art would understand claim terms to mean, it is permissible for the  
district court in its sound discretion to admit and use such evidence.

25 *Phillips*, 415 F.3d at 1319; accord *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 716  
26 (Fed. Cir. 1998) (“[T]rial courts generally can hear expert testimony for background and  
27 education on the technology implicated by the presented claim construction issues, and

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