

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

THE REGENTS OF THE UNIVERSITY
OF CALIFORNIA; and BECTON,
DICKINSON and COMPANY,

Plaintiffs,

v.

AFFYMETRIX, INC.; and LIFE
TECHNOLOGIES CORP.,

Defendants.

Case No.: 17-cv-01394-H-NLS

**CLAIM CONSTRUCTION ORDER
FOR THE '799 PATENT, THE '673
PATENT, AND THE '113 PATENT**

In the present action, Plaintiffs the Regents of the University of California, Becton, Dickinson and Company, Sirigen, Inc., and Sirigen II Limited assert claims of patent infringement against Defendants Affymetrix, Inc. and Life Technologies Corp., alleging infringement of U.S. Patent No. 9,085,799, U.S. Patent No. 8,110,673, and U.S. Patent No. 8,835,113.¹ (Doc. No. 101, FAC ¶¶ 52-81.) On January 26, 2018, the parties filed their joint claim construction prehearing statement, chart, and worksheet, identifying the

¹ In this action, Plaintiffs also assert claims of patent infringement against Defendants for infringement of U.S. Patent No. 9,547,008, U.S. Patent No. 9,139,869, U.S. Patent No. 8,575,303, and U.S. Patent No. 8,455,613. (Doc. No. 101, FAC ¶¶ 82-115.) The Court will hold a separate claim construction hearing on those four patents at a later time.

disputed claim terms from the '799 patent, the '673 patent, and the '113 patent. (Doc. No. 97.) On February 23, 2018, the parties each filed an opening claim construction brief. (Doc. Nos. 111, 113.) On March 9, 2018, Plaintiffs filed their responsive claim construction brief. (Doc. No. 123.) On March 13, 2018, Defendants filed their corrected responsive claim construction brief. (Doc. No. 128.) On March 21, 2018, the Court issued a tentative claim construction order. (Doc. No. 132.)

The Court held a claim construction hearing on March 23, 2018. Donald R. Ware, Barbara Fiacco, and Jesse Hindman appeared for Plaintiffs. Douglas E. Lumish, Roger J. Chin, and Brent T. Watson appeared for Defendants. After considering the parties' briefs, the parties' arguments at the hearing, and all relevant information, the Court construes the disputed terms from the '799 patent, the '673 patent, and the '113 patent.

Background

On July 10, 2017, Plaintiffs Regents and Becton, Dickinson filed a complaint for patent infringement against Defendants Affymetrix and Life Technologies, alleging infringement of the '799 patent, the '673 patent, and the '113 patent. (Doc. No. 1, Compl.) On September 8, 2017, Defendants filed an answer to Plaintiffs' complaint. (Doc. No. 37.)

On October 6, 2017, the Court issued a scheduling order. (Doc. No. 55.) On November 20, 2017, the Court denied Plaintiff Becton, Dickinson's motion for a preliminary injunction without prejudice. (Doc No. 69.) On November 30, 2017, the Court issued an amended scheduling order. (Doc. No. 76.)

On February 7, 2018, the Court granted the parties' joint motion for leave for Plaintiffs to file a first amended complaint and to modify the scheduling order. (Doc. No. 100.) On February 9, 2018, Plaintiffs filed an amended complaint: (1) adding Sirigen and Sirigen II as additional Plaintiffs and adding claims that Defendants' products infringe four Sirigen patents: U.S. Patent No. 9,547,008, U.S. Patent No. 9,139,869, U.S. Patent No. 8,575,303, and U.S. Patent No. 8,455,613; (2) adding infringement allegations against additional accused products; and (3) adding allegations of induced infringement against Defendants. (Doc. No. 101, FAC.) On February 23, 2018, the Court issued a second

amended scheduling order. (Doc. No. 105.) By the present claim construction briefs, the parties request that the Court construe disputed claim terms from the '799 patent, the '673 patent, and the '113 patent. (Doc. Nos. 111, 113.)

Discussion

I. Legal Standards for Claim Construction

Claim construction is an issue of law for the court to decide. Teva Pharm. USA, Inc. v. Sandoz, Inc., 135 S. Ct. 831, 838 (2015); Markman v. Westview Instr., Inc., 517 U.S. 370, 372 (1996). Although claim construction is ultimately a question of law, “subsidiary factfinding is sometimes necessary.” Teva, 135 S. Ct. at 838.

“The purpose of claim construction is to ‘determin[e] the meaning and scope of the patent claims asserted to be infringed.’” O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co., 521 F.3d 1351, 1360 (Fed. Cir. 2008). “It is a ‘bedrock principle’ of patent law that the ‘claims of a patent define the invention to which the patentee is entitled the right to exclude.’” Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc).

Claim terms “‘are generally given their ordinary and customary meaning[,]’” which “is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” Id. at 1312–13. “In some cases, the ordinary meaning of claim language as understood by a [PHOSITA] may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words.” Id. at 1314. “However, in many cases, the meaning of a claim term as understood by persons of skill in the art is not readily apparent.” O2 Micro, 521 F.3d at 1360. If the meaning of the term is not readily apparent, the court must look to “those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean,” including intrinsic and extrinsic evidence. See Phillips, 415 F.3d at 1314. A court should begin with the intrinsic record, which consists of the language of the claims, the patent specification, and, if in evidence, the prosecution history of the asserted patent. Id.; see also Vederi, LLC v. Google, Inc., 744 F.3d 1376, 1382 (Fed. Cir. 2014) (“In construing claims, this court relies

primarily on the claim language, the specification, and the prosecution history.”).

In determining the proper construction of a claim, a court should first look to the language of the claims. See Vitronics, 90 F.3d at 1582; see also Comark Commc’ns v. Harris Corp., 156 F.3d 1182, 1186 (Fed. Cir. 1998) (“The appropriate starting point . . . is always with the language of the asserted claim itself.”). The context in which a disputed term is used in the asserted claims may provide substantial guidance as to the meaning of the term. See Phillips, 415 F.3d at 1314. In addition, the context in which the disputed term is used in other claims, both asserted and unasserted, may provide guidance because “the usage of a term in one claim can often illuminate the meaning of the same term in other claims.” Id. Furthermore, a disputed term should be construed “consistently with its appearance in other places in the same claim or in other claims of the same patent.” Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342 (Fed. Cir. 2001); accord Microprocessor Enhancement Corp. v. Texas Instruments Inc., 520 F.3d 1367, 1375 (Fed. Cir. 2008); see also Paragon Sols., LLC v. Timex Corp., 566 F.3d 1075, 1087 (Fed. Cir. 2009) (“We apply a presumption that the same terms appearing in different portions of the claims should be given the same meaning.” (internal quotation marks omitted)). Moreover, “[a] claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.” Vederi, 744 F.3d 1383.

A court must also read claims “in view of the specification, of which they are a part.” Markman, 52 F.3d at 979; see 35 U.S.C. § 112(b) (“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”). “‘Apart from the claim language itself, the specification is the single best guide to the meaning of a claim term.’” Vederi, 744 F.3d at 1382. For example, “a claim construction that excludes [a] preferred embodiment [described in the specification] ‘is rarely, if ever, correct and would require highly persuasive evidentiary support.’” Adams Respiratory Therapeutics, Inc. v. Perrigo Co., 616 F.3d 1283, 1290 (Fed. Cir. 2010).

But “[t]he written description part of the specification does not delimit the right to

exclude. That is the function and purpose of claims.” Markman v. Westview Instruments, Inc., 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). “[A] claim construction must not import limitations from the specification into the claims.” Douglas Dynamics, LLC v. Buyers Products Co., 717 F.3d 1336, 1342 (Fed. Cir. 2013). Therefore, “it is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.” Dealertrack, Inc. v. Huber, 674 F.3d 1315, 1327 (Fed. Cir. 2012); see also Kara Tech. Inc. v. Stamps.com Inc., 582 F.3d 1341, 1348 (Fed. Cir. 2009) (“The patentee is entitled to the full scope of his claims, and we will not limit him to his preferred embodiment or import a limitation from the specification into the claims.”).

In most situations, analysis of the intrinsic evidence will resolve claim construction disputes. See Vitronics, 90 F.3d at 1583; Teva, 135 S. Ct. at 841. However, “[w]here the intrinsic record is ambiguous, and when necessary,” district courts may “rely on extrinsic evidence, which ‘consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.’” Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc., 711 F.3d 1348, 1360 (Fed. Cir. 2013) (quoting Phillips, 415 F.3d at 1317). A court must evaluate all extrinsic evidence in light of the intrinsic evidence. Phillips, 415 F.3d at 1319. “Extrinsic evidence may not be used ‘to contradict claim meaning that is unambiguous in light of the intrinsic evidence.’” Summit 6, LLC v. Samsung Elecs. Co., 802 F.3d 1283, 1290 (Fed. Cir. 2015); see also Bell Atl. Network Servs., Inc. v. Covad Commc’ns Grp., Inc., 262 F.3d 1258, 1269 (Fed. Cir. 2001) (“[E]xtrinsic evidence . . . may not be used to vary, contradict, expand, or limit the claim language from how it is defined, even by implication, in the specification or file history.”); Vederi, 744 F.3d at 1382 (“[E]xtrinsic evidence may be less reliable than the intrinsic evidence.”). In cases where subsidiary facts contained in the extrinsic evidence “are in dispute, courts will need to make subsidiary factual findings about that extrinsic evidence.” Teva, 135 S. Ct. at 841.

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