

ENZO BIOCHEM INC. v. APPLERA CORP., Appeal No. 2014-1321 (Fed. Cir. March 16, 2015). Before Prost, Newman and Linn. Appealed from D. Conn. (Judge Arterton).

Background:

Enzo sued Applera for infringement of claims of a patent relating to DNA sequencing. The claims were directed to a chemical structure and included the feature that "A comprises at least three carbon atoms and represents at least one component of a signaling moiety capable of producing a detectable signal."

The District Court construed the phrase "signaling moiety" as a chemical entity capable of producing a detectable signal, and also construed that "A" can comprise, in some instances, the entire signaling moiety. By extension, the district construed the claim to allow for a direct detection of the signal, without requiring any additional steps to be present. The District Court found direct infringement of the claims and also held the claims not to be invalid for lack of enablement and written description.

Issues/Holdings:

Did the District Court err in its claim construction and in finding infringement of the claims? Yes, reversed on claim construction, vacated the finding of infringement, and remanded.

Discussion:

The Federal Circuit held that the term "at least one component of a signaling moiety" necessarily requires that the signaling moiety is composed of multiple parts. That is, the term "at least one component" provides that there must be additional components that are implicitly necessary in the claim. The Federal Circuit held that the District Court's construction would impermissibly read out the feature "at least one component" and impermissibly broaden the claim.

The Federal Circuit also indicated that "A" could not be the whole signaling moiety, because "A" must be attached directly or through a linkage group that does not substantially interfere with formation of the signaling moiety. Construing "A" to be the entire moiety would also read this feature out of the claim because the moiety would be formed solely by "A."

The Federal Circuit also looked to the specification for guidance, and found that "A" is never alone described to be a signaling moiety, and the specification, if anything, further provided support that the claim should only be construed to cover indirect detection.

Judge Newman dissented, arguing that the majority effectively required the meaning of "at least one component" to require "two or more" components. Judge Newman found that the majority's holding ran contrary to grammatical logic, as well as extrinsic evidence which included an expert explaining how an example in the specification provides for an instance of "direct detection."