UCB, INC. v. YEDA RESEARCH AND DEVELOPMENT CO., LTD., Appeal No. 2015-1957 (Fed. Cir. September 8, 2016). Before Newman, Lourie and Chen. Appealed from E.D. Va. (Judge Brinkema).

Background:

Yeda owns a patent directed to a monoclonal antibody that binds a defined human cytotoxin. UCB filed suit against Yeda in order to obtain a declaration that UCB's Cimzia brand antibody did not infringe Yeda's patent. Yeda counterclaimed for infringement.

A *Markman* hearing was conducted to determine whether the claimed monoclonal antibody covers chimeric or humanized antibodies, when the patent specification discloses only mouse monoclonal antibodies. Yeda argued that because chimeric monoclonal antibodies were known at the priority date of Yeda's patent, the claims should be construed to cover chimeric antibodies and human antibodies. However, UCB argued that the prosecution history excludes chimeric and humanized antibodies from the scope of Yeda's patent claims.

Specifically, during prosecution, Yeda presented new independent claims that were not limited to mouse monoclonal antibodies, and new dependent claims that covered chimeric and humanized antibodies. The Examiner rejected the new dependent claims for reciting new matter because chimeric and humanized antibodies were not supported in the specification. Yeda then cancelled all the claims that recited chimeric and humanized antibodies to obtain an allowance.

Based on the prosecution history, the district court held that the scope of the claimed monoclonal antibody excludes chimeric and humanized antibodies. The district court subsequently granted summary judgment of non-infringement, which Yeda appealed.

Issue/Holding:

Did the district court err in excluding chimeric and humanized antibodies from the scope of Yeda's patent claims? No, affirmed.

Discussion:

Before the Federal Circuit, Yeda argued that the patent claims do not recite any specific monoclonal antibody or species of chimera, and thus the scope of the patent claims should not be limited to only mouse monoclonal antibodies. Yeda argued that every embodiment need not be specifically described and claimed to be within the scope of a generic term in a claim.

The Federal Circuit agreed that generic terms in claims are construed in light of that which is already known at the time of invention. However, the Federal Circuit found that the content of the specification, as well as actions and arguments raised during prosecution, must also be considered in determining the scope of a generic term in a claim. The Federal Circuit also found that a patent applicant cannot later obtain a claim scope that was requested during prosecution, rejected by the Examiner, and then withdrawn by the applicant. Thus, the Federal Circuit held that Yeda was estopped from including chimeric and humanized antibodies in the scope of its patent claims.