

## FEDERAL CIRCUIT PATENT LAW CASE UPDATE

SmithKline Beecham Corp. v. Apotex Corp., 04-1522 (Fed. Cir. Feb. 24, 2006) (Dyk, J.)

The court affirmed the summary judgment that SmithKline's product-by-process patent claiming paroxetine, used in the brand label Paxil<sup>®</sup>, was anticipated by SmithKline's earlier patent to the compound paroxetine. Judge Newman dissented, arguing that the majority misunderstood the law for product-by-process claims.

SmithKline owns U.S. Pat. No. 6,113,944, claiming the product paroxetine by its process of manufacture. SmithKline also owned an earlier product patent for paroxetine, U.S. Pat. No. 4,721,723. The district court found that the '723 patent anticipated the '944 patent. The court agreed.

[O]nce a product is fully disclosed in the art, future claims to that same product are precluded, even if that product is claimed as made by a new process. . . .

This court has previously considered the scope of product-by-process claims. In [Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991)], we held that the product-by-process claims at issue were not limited by the process steps within those claims. . . .

Some commentators, like the district court here, have perceived a conflict between Scripps, where the court construed the product-by-process claims without reference to the process steps, and [Atlantic Thermoplastics Co., Inc. v. Faytex Corp., 970 F.2d 834 (Fed. Cir. 1992)], where the court read the process steps as claim limitations. We need not address this controversy here. The issue here does not turn on how broadly or narrowly we construe the '944 patent's claims, for it is undisputed that the product that is the subject of the patent's claims is paroxetine. Rather the issue is whether the '723 patent anticipated the '944 product-by-process patent, when the '723 patent broadly claimed

paroxetine without regard to the process by which it was made.

The court noted the dissent in Atlantic Thermoplastics, and discussed a variety of case law supporting Scripps.

The court held SmithKline's other argument waived.

SmithKline failed to include in the Argument section of its opening brief an argument that, contrary to the district court's finding, the product claimed in the '944 patent is itself different from that disclosed in the '723 patent.

Judge Newman dissented.

The law of "anticipation" does not change in the special situation where claims contain both product and process limitations. The panel majority perpetuates a confusing misunderstanding of precedent governing product-by-process claims, ignoring the opportunity and need for clarification.

In this case the district court found "anticipation" based on a claim construction that erased critical limitations of the claim. . . .

The fundamentals of claim analysis require that all of the claim limitations limit the claim.

