

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

BAYER AG and)
BAYER CORPORATION,)
)
Plaintiffs,)
)
v.) Civil Action No. 01-148-SLR
)
HOUSEY PHARMACEUTICALS, INC.,)
)
Defendant.)

MEMORANDUM ORDER

At Wilmington this 12th day of November, 2002, having heard oral argument and having reviewed papers submitted in connection therewith;

IT IS ORDERED that the disputed claim language in United States Patent Nos. 4,980,281; 5,266,464; 5,688,655 and 5,877,007, as identified by the above referenced parties, shall be construed as follows, consistent with the tenets of claim construction set forth by the United States Court of Appeals for the Federal Circuit:

A. "A Method of Determining"

The parties agree that, in science, rarely is anything 100% certain. Consistent with this understanding, the patent specification, and the prosecution history,¹ "determining" shall

¹The patentee's 37 C.F.R. § 1.132 declaration states that "the predictive ability of the claimed cell-based system is far higher than that for more traditional cell-free systems." (D.I. 276, Ex. B)

be construed to mean "ascertaining with a high degree of probability that an unknown or suspected substance is an activator or inhibitor of a target protein."

B. "Inhibitor or Activator of a Protein"

The claim language, the specification, and the prosecution history contain no language limiting an activator or inhibitor to substances that directly bind to the target protein. As such, the court rejects the patentee's attempt to read such a limitation into the claims.² Thus, the term "inhibitor or activator" shall be construed to mean "a substance that has a greater effect on the phenotype of cells that express the protein of interest at a higher level than on the phenotype of cells that express the protein of interest at a lower level or not at all." ('281 patent, col. 3, ll. 5-10; col. 4, ll. 48-50)

C. "Phenotypic Characteristic"

The term "phenotypic characteristic" shall be construed to mean "an observable trait of a cell, and does not include characteristics of a temporary or transient nature, such as, for example, the levels or concentrations of ions or other chemical substances." The patent specification states "[t]he phenotypic

²The patentee has argued that the term should be construed to mean "substances the directly interact, i.e., bind to, the target protein." The court, however, finds no intrinsic evidence to support the direct interaction (binding) limitation. The extrinsic evidence (expert reports) submitted by the patentee are merely conclusory.

characteristic is preferably a 'cultural' or 'morphological' characteristic of the cell." ('281 patent, col. 4, ll. 54-55)
Cultural or morphological changes are stable, non-transient traits.

D. "Phenotypic Response" or "Responsive Change in a Phenotypic Characteristic"

The term "phenotypic response" or "responsive change in a phenotypic characteristic" shall be construed to mean "the characteristic which is changing and which the person skilled in the art is measuring, which is reflective of the activation or inhibition of the protein of interest."³

E. "Evokes," "Exhibits," and "Induces"

The terms "evokes," "exhibits," and "induces" shall be construed to mean "the phenotypic change in the cell that overproduces the protein of interest is observable prior to the addition of the test substance to that cell." ('464 patent, col. 7, ll. 7-15)

³The court rejects plaintiffs' attempt to add language regarding reporter genes to the claim construction. Although the "responsive change" must be reflective of the activation or inhibition of the protein of interest, there is no limitation as to how the "responsive change" may be measured. ('655 patent, claim 1)

Sue L. Robinson
United States District Judge