

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

OXFORD GENE TECHNOLOGY LIMITED,)
)
 Plaintiff,)
)
 v.) Civil Action No. 02-1695-KAJ
)
 MERGEN LTD., et al.,)
)
 Defendants.)

ORDER

Presently before me is a motion (D.I. 262; the “Motion”) filed by Mergen Limited (“Mergen”) seeking reconsideration of my November 19, 2004 Order granting Oxford Gene Technology Limited’s (“OGT”) Motion for Partial Summary Judgment of Infringement (D.I. 179). At the pre-trial conference on January 4, 2005, I denied Mergen’s Motion on all but one issue, and reserved ruling on that issue until after further consideration of the arguments presented in the parties’ briefing and during the pre-trial conference. The only remaining issue from Mergen’s Motion is whether Mergen practices all of the elements of claim 10 of the ‘270 patent, including the last element, “observing the differences between the patterns of hybridisation.” (‘270 patent, col. 16, ll. 64-65.) Mergen admits that, under the court’s claim construction ruling, it does practice all of the elements of claim 10 with regard to some of its products (Transcript at 17:11-19, Pre-Trial Conf., Jan. 4, 2005; D.I. 262 at 7), but it also argues that it does not and cannot do so with the majority of its product line because it performs its analyses using *two* distinct supports rather than using a single support, as required by the claim

construction ruling. (D.I. 262 at 6-7.) For the reasons that follow, I deny Mergen's Motion.

In its Motion, Mergen argues that it does not infringe claim 10 when it uses two supports in its analyses because, in order to infringe, all of the elements of claim 10 must be performed on a single support. (See D.I. 262 at 7.) Mergen asserts that the "vast majority of the time ... [it] use[s] two distinct arrays located on two supports" and therefore does not practice each and every element of claim 10. (D.I. 262 at 7.)

Mergen bases this argument on my construction of the claim term "an array of oligonucleotides," which I said means "two or more oligonucleotide sequences located at different regions on a *single* support." (*Id.* at 6-7 (emphasis added in original).)

Essentially, Mergen's argument is that "about 90 percent" of the time, it uses two supports in its analyses, and in so doing, it does not practice the last limitation of claim 10, namely "observing the differences between the patterns of hybridisation," on any one support, but rather that it observes "the differences between the patterns of hybridisation" across two supports. (*Id.*; Transcript at 17:16, Pre-Trial Conf., Jan. 4, 2005.)

In the Memorandum Opinion and Order dated November 19, 2004, I concluded, *inter alia*, that Mergen practices each and every limitation of claim 10 and granted summary judgment for OGT on the issue of literal infringement. (D.I. 245 at 32-33.) That ruling was based on my Memorandum Opinion and Order on September 29, 2004 (D.I. 237; D.I. 238), in which, as earlier noted, I construed "an array of oligonucleotides" to mean "two or more oligonucleotide sequences located at different regions on a *single* support." (D.I. 237 at 2; D.I. 238 at 27 (emphasis added).) OGT's proposed claim

construction was nearly identical to the construction I gave the claim language. OGT had proposed the following construction: “a set of two or more oligonucleotide sequences located at different regions on a *single* support.” (D.I. 174 at 20; D.I. 173 at 3 (emphasis added).) Nonetheless, in its Opposition to Mergen’s Motion, OGT argues that “there is no restriction in claim 10 against using more than one such ‘array’” and cited *Altiris, Inc. v. Symatec Corp.*, 218 F.3d 1363, 1373-74 (Fed. Cir. 2003) for the proposition that the article “an” in patent claims means “one or more.” (D.I. 263 at 10.)

There is no dispute that in open-ended claims, such as claim 10, “a” or “an” generally means “one or more.” *Altiris*, 218 F.3d at 1373 (citing *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000)). However, the Federal Circuit’s claim construction rulings in cases standing for that proposition were based on a finding that the patentee did not evince a clear intent to limit the article to mean “one and only one.” See *KCJ*, 223 F.3d at 1356; see *Altiris*, 218 F.3d at 1373. Here, that is not the case. OGT expressly requested and advocated the claim construction limiting the method of claim 10 to the observation of differences between hybridization patterns on a “single” support. (D.I. 174 at 20; D.I. 173 at 3.) At the pre-trial conference, I specifically asked counsel for OGT whether they were arguing for a different claim construction than that which they had originally sought, and counsel responded they were not. (Transcript at 19:25-20:2, Pre-Trial Conf., Jan. 4, 2005.) Instead, OGT’s argument was that “there is no requirement in the comparison aspect that requires the comparison to be made within or among locations on that same support.” (*Id.* at 19:1-3.)

Claim 10 states in its entirety:

A method of comparing polynucleotide sequences, which method comprises:

applying the polynucleotides to an array of oligonucleotides under hybridizing conditions, wherein the oligonucleotides have different predetermined sequences and are attached at different known locations on an impermeable surface of a support, and observing the differences between the patterns of hybridisation.

(‘270 patent, col. 16, ll. 57-65.) Because the differences referred to in the last step of the claim are to be found within “an array of oligonucleotides,” and because “an array of oligonucleotides” means “two or more oligonucleotide sequences located at different regions on a *single* support” (D.I. 237 at 2; D.I. 238 at 27 (emphasis added)), literal infringement will occur only when all of the elements of the method in claim 10 are performed on a single support.

The question then becomes whether Mergen practices the last element of claim 10 even when it uses two distinct supports in its analyses. In other words, is it the case that, even when using two supports (e.g., microscope slides) to conduct an analysis because one is interested in the differences between two separate arrays, one nevertheless also looks for differences that exist on each of the arrays? If that is the case, then there is still literal infringement, regardless of whether one takes the further step of observing differences between the arrays on the separate supports. If Mergen observes “the differences between the patterns of hybridisation” on one support then it practices all of the elements of claim 10 and literally infringes. If, on the other hand, Mergen observes “the differences between the patterns of hybridisation” *only* by comparing the results of two distinct supports and it makes no observation of

hybridization differences on any one support, then it does not practice this limitation as I have construed it, and therefore does not literally infringe claim 10.

This same issue was raised by OGT during the summary judgment briefing. OGT asserted that the record is undisputed in showing that, even in undertaking an analysis using two slides, Mergen practices all of the limitations of claim 10 on each individual slide because, at a minimum, they observe differences in the pattern of hybridization on a single slide by seeing the difference between a control spot on each slide and the rest of the spots on the slide.¹ (D.I. 180 at 17-18.) Mergen did not address that specific argument or advance evidence in response to it to raise a genuine issue of material fact. OGT's evidence and argument in this regard are persuasive and dispositive of this issue.

Accordingly, IT IS HEREBY ORDERED that Mergen's Motion for Reconsideration (D.I. 262) is DENIED.²

Kent A. Jordan
UNITED STATES DISTRICT JUDGE

January 7, 2005
Wilmington, Delaware

¹ Even if one were to assume that every spot on a single slide was indistinguishable from every other spot except the control, there would still be a difference "between the patterns of hybridisation" ('270 patent, col. 16, ll. 64-65) on the slide in the sense that the control would stand out distinctly from the rest of the spots.

² At this juncture, the foregoing discussion may be academic because the practical effect of my previous ruling that Mergen infringes claim 9 of the '270 patent may well be that Mergen will be liable for damages with respect to all of its products, if the claim is not proven invalid.