

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

BAYER HEALTHCARE LLC,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 03-189-GMS
)	
ABBOTT LABORATORIES,)	
)	
Defendant.)	

MEMORANDUM

I. INTRODUCTION

On February 11, 2003, Bayer Healthcare LLC (“Bayer”) filed a complaint against Abbott Laboratories (“Abbot”) alleging infringement of several of Bayer’s patents, including U.S. Patent No. 6,074,615 (“the ‘615 patent”), U.S. Patent No. 6,436,349 (“the ‘349 patent”), and U.S. Patent No. 6,498,037 (“the ‘037 patent”). (D.I. 1.) On August 28, 2003, Bayer filed a supplemental complaint against Abbott alleging infringement of U.S. Patent No. 6,555,062 (“the ‘062 patent”). (D.I. 28.) On July 12, 2004, the court granted a request by Abbott for leave to amend its answer to Bayer’s supplemental complaint to include an inequitable conduct defense. (D.I. 158.) On September 9, 2004, the court granted Bayer’s request for leave to file a motion for summary judgment on Abbott’s inequitable conduct defense. (D.I. 180.) Presently before the court is that motion. (D.I. 186.) For the following reasons, the court will grant Bayer’s motion.

II. JURISDICTION

The court has jurisdiction over this matter pursuant to 28 U.S.C. § 1331 (1993).

III. STANDARD OF REVIEW

Summary judgment is appropriate when there are no genuine issues of material fact. *See* Fed. R. Civ. P 56(c). A fact is material if it might affect the outcome of the case, and an issue is genuine if the evidence is such that a reasonable fact finder could return a verdict in favor of the nonmovant. *See In re Headquarters Dodge, Inc.*, 13 F.3d 674, 679 (3d Cir. 1993) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). When deciding a motion for summary judgment, the court must evaluate the evidence in the light most favorable to the nonmoving party and draw all reasonable inferences in that party's favor. *See Pacitti v. Macy's*, 193 F.3d 766, 772 (3d Cir. 1999). The nonmoving party, however, must demonstrate the existence of a material fact supplying sufficient evidence – not mere allegations – for a reasonable jury to find for the nonmovant. *See Olson v. General Elec. Aerospace*, 101 F.3d 947, 951 (3d Cir. 1996) (citation omitted). To raise a genuine issue of material fact, the nonmovant “need not match, item for item, each piece of evidence proffered by the movant but simply must exceed the ‘mere scintilla’ [of evidence] standard.” *Petruzzi's IGA Supermarkets, Inc. v Darling-Delaware Co.*, 998 F.2d 1224, 1230 (3d Cir. 1993) (citations omitted). The nonmovant's evidence, however, must be sufficient for a reasonable jury to find in favor of the party, given the applicable burden of proof. *See Anderson*, 477 U.S. at 249-50.

IV. DISCUSSION

Abbott contends that “Bayer and its attorneys made a series of knowingly false and misleading statements and omissions to the PTO [United States Patent and Trademark Office]” during the prosecution of patent application 09/655,128 (“the ‘128 application”), which ultimately

issued as the '349 patent. (D.I. 201 at 4.) For the purpose of this motion, the facts are viewed in the light most favorable to Abbott. Thus, the court assumes as true all factual assertions made by Abbott in its brief.

A. The Single Tray Limitation

Abbott's first contention is that the attorneys responsible for prosecuting the '349 patent intentionally misled the examiner by mischaracterizing the substance of pending claims 8 and 14. (Id. at 4-7.) During prosecution the examiner communicated to Bayer that pending claim 6, which contained an element referred to as the "single tray limitation," was allowable. (D.I. 202 Ex. 2 at eight.) Subsequently, Bayer proposed additional claim 15. (Id. Ex. 3.) However, the examiner rejected the amendment because it did not include the single tray limitation. (Id. Ex. 4.) This, Abbott contends, put Bayer on notice that the single tray limitation was crucial to patentability. (D.I. 201 at 5-6.) Nevertheless, Bayer represented to the examiner that pending claims 8 and 14 had "limitations similar to the gear structure recited in claim[] 6" (D.I. 202 Ex. 2 at 8-9), even though neither claim contained the single tray limitation. In addition, Abbott points to Bayer's characterization of the amendments of claims 8 and 14 to the examiner as "selective inclusion of the specific structural elements relating to a ring gear and satellite gears," without stating that the single tray limitation had been removed. (Id. Ex. 6 at 4.)

In order to defeat Bayer's motion, Abbott must present evidence from which a reasonable finder of fact could infer both prongs of inequitable conduct. Specifically, "the proponent of the inequitable conduct must first establish by clear and convincing evidence that there was a material misrepresentation or omission of information, and then establish a threshold level of intent on the part of the applicant." *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1481 (Fed. Cir. 1986). However, in cases where all the pertinent information was available to the examiner, the defendant's

inequitable conduct defense may fail as a matter of law for lack of materiality.

This is not a bright-line rule because sometimes the information in front of the examiner is voluminous, *see, e.g., Mechanical Plastic Corp. v. Rawplug Co.*, 14 U.S.P.Q.2d 1058 (S.D.N.Y. Dec. 7, 1989), or difficult to comprehend, *see, e.g., Semiconductor Energy Lab. Co. v. Samsung Elecs. Co.*, 204 F.3d 1368, 1377-78 (Fed. Cir. 2000) (partial Japanese translation). But other times the information in front of the examiner is far more accessible, precluding a finding of materiality. *See, e.g., Fiskars, Inc. v. Hunt Mfg. Co.*, 221 F.3d 1318, 1326-28 (Fed. Cir. 2000) (pamphlet describing prior art submitted to examiner, but not explained by applicant); *Akzo*, 808 F.2d at 1482 (prior art patents in front of examiner, but arguably mischaracterized by applicant); *Genzyme Corp. v. Transkaryotic Therapies, Inc.*, No. C.A. 00-677, 2004 WL 2239248, at *2 (D. Del. Sept. 27, 2004) (prior art article in front of examiner, but arguably mischaracterized by applicant). Therefore, although the court's judgment should not be a proxy for that of the jury, the court is obliged to be vigilant in its effort to prevent certain defenses from proceeding beyond summary judgment. This is particularly true with regard to the defense of inequitable conduct. *Cf. Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 939 (Fed. Cir. 1990) ("Given the ease with which a relatively routine act of patent prosecution can be portrayed as intended to mislead or deceive, clear and convincing evidence of conduct sufficient to support an inference of culpable intent is required.").

In this case, the substance of pending claims 8 and 14 was directly before the examiner. It is difficult to imagine a situation where the information is more accessible. Were courts such as this one to hold that applicants could not rely on the examiner to read and understand all of the pending claims, the patent system would become unworkable. Thus, the court does not believe Bayer's

mischaracterizations, if any, were material.¹ As such, the court also declines to address the issue of intent with regard to the single tray limitation.

B. The Missing Motor

Abbott's second contention is that Bayer's attorneys misled the examiner in connection with the submission of new claim 14 to the '128 application. (D.I. 201 at 7-8.) According to Abbott, new claim 14 only provided for a single motor, whereas no previous pending claim provided for a single motor. (Id.) Nevertheless, Bayer represented to the patent office that new claim 14 "contains no new matter." (D.I. 202 Ex. 9 at 7.) Abbott further contends that the patent specification contains no description as to how the invention could function properly with only one motor, as set forth in new claim 14. (D.I. 201 at 8.)

Again, since the text of new claim 14 was accessible to the examiner, the court does not believe any deception that might be inferred from Bayer's statements to the examiner were material.

C. The Japanese Patent Office

Abbott's final contention is that Bayer failed in its duty to disclose to the examiner that the same invention it was prosecuting in the Japanese Patent Office also required the single tray limitation. According to Abbott, this failure is evidence of Bayer's intent to deceive the examiner. However, since the court finds Bayer's alleged mischaracterization of pending claims 8 and 14 was not material, Abbott's defense fails regardless of Bayer's intentions.

¹Abbott may be correct that a Petition to Make Special creates a heightened duty of candor (D.I. 201 at 14-15), however the court is not convinced that the duty is so heightened by such a petition that the applicant can no longer rely on the examiner to read and understand the pending claims.

V. CONCLUSION

For the aforementioned reasons, the court does not find a genuine issue of material fact, the resolution of which would permit a reasonable jury to find in Abbott's favor. Therefore, Bayer's Motion for Summary Judgment of No Inequitable Conduct, Fraud, or Unclean Hands will be granted.

Dated: December 10, 2004

Gregory M. Sleet
UNITED STATES DISTRICT JUDGE

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

BAYER HEALTHCARE LLC,)
)
 Plaintiff,)
)
 v.) C.A. No. 03-189-GMS
)
 ABBOTT LABORATORIES,)
)
 Defendant.)

ORDER

IT IS HEREBY ORDERED that Bayer Healthcare, LLC's Motion for Summary Judgment of No Inequitable Conduct, Fraud, or Unclean Hands be GRANTED.

Dated: December 10, 2004

Gregory M. Sleet
UNITED STATES DISTRICT JUDGE