

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF WISCONSIN

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INNOGENETICS, N.V.,

Plaintiff,

v.

ABBOTT LABORATORIES,

Defendant.

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ORDER

05-C-0575-C

At the final pretrial conference held on August 17, 2006, I took under advisement the parties' competing motions concerning the construction of claim 1. Defendant seeks an order barring plaintiff from introducing any evidence at trial that the claimed "method of genotyping" in claim 1 requires using multiple probes. It argues that if the court should deny this request, the claim language is necessarily indefinite within the meaning of 35 U.S.C. § 112.

Claim 1 recites:

A method of genotyping HCV present in a biological sample comprising hybridizing nucleic acids in a biological sample with at least one probe and detecting a complex as formed with said probe and said nucleic acids of HCV, using a probe that specifically hybridizes to the domain extending from the nucleotides at positions -291 to -66 of the 5' untranslated region of HCV.

Defendant alleges that when it took second depositions of plaintiff's experts, Howard Worman, M.D., and William Reznikoff, M.D., the two men offered new opinions about the meaning of the language of claim 1. Specifically, they testified that the "method of genotyping" claimed in the '704 patent could not be practiced using only one probe, but required multiple probes. Defendant contends that this testimony "flies in the face of the plain language of the patent claims," Dft.'s Br., dkt. #173, at 4, which in defendant's view, provides that the claimed method of genotyping requires the use of at least *one* probe, suggesting that the method could be practiced with *only* one probe. It alleges that it was surprised by these opinions and that plaintiff's failure to disclose its construction of the method of genotyping warrants an order barring plaintiff from offering any evidence of its allegedly new construction.

Defendant's argument is flawed from the start because it relies on a misreading of claim 1, which does not require "the use of at least one probe" as a *method of genotyping*, but rather recites a method of genotyping comprising the step of hybridizing nucleic acids in a biological sample with at least one probe that specifically hybridizes to the specified domain of the 5' UTR. The genotyping assays described in the patent specification use many probes, only one or a few of which will specifically hybridize in a given assay, depending on whether there are one or more HCV genotypes present in the sample.

When claim 1 is read as it should be to require that at least one probe must specifically hybridize, rather than as saying that the method of genotyping requires the use of at least one probe, it is clear that neither Worman nor Reznikoff “offered a new opinion” about the meaning of claim 1. They read the claim properly: the patented method of genotyping requires more than one probe, *at least one* of which must specifically hybridize to the specified domain. To the extent their answers may have been confusing, the cause was the questions put to them and not their lack of understanding of the claim language.

Defendant’s alternate argument fares no better. Defendant contends that the language of claim 1 is indefinite if read to apply to multiple probes because no person or ordinary skill in the art could understand from reading it how many probes to use to practice the claimed method. Defendant contends that it had no reason to identify this argument until it deposed Worman and Reznikoff, when it realized for the first time that plaintiff was taking the position that the method of genotyping could encompass any number of probes and not just one.

As I have noted, if defendant was surprised at plaintiff’s construction of the method of genotyping, it could only be because it misread the claim language as saying something that it does not. As for its assertion that the patent is indefinite, it has adduced no evidence that a person of ordinary skill in the art could not read the patent’s specification and determine from it how to practice the invention. Without such evidence, its assertion of

indefiniteness requires no further consideration.

I conclude that defendant has failed to show that plaintiff withheld any discoverable information that would require a sanction barring plaintiff from introducing evidence to support its view of the proper construction of “method of genotyping.” Further, defendant has failed to show that it should be entitled to advance a defense of indefiniteness as part of its invalidity case.

Entered this 21st day of August, 2006.

BY THE COURT:  
/s/  
BARBARA B. CRABB  
District Judge