UNITED STATES DISTRICT COURT

DISTRICT OF MAINE

JEWISH HOSPITAL OF ST. LOUIS,	)	
	)	
PLAINTIFF	)	
	)	
v.	)	**Civil No. 95-290-P-H**
	)	
IDEXX LABORATORIES,	)	
	)	
DEFENDANT	)	

ORDER ON DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT (Docket Item 81)

LAWYERING PRACTICES

Originally IDEXX filed a 40-page legal memorandum in support of its motion for summary judgment on this issue. On July 22, 1996, I expressed my unhappiness that 208 pages of argument, not including exhibits, declarations, etc., were filed by the parties on summary judgment issues and struck IDEXX's filing, but permitted it to make a new filing of 20 pages in accordance with Local Rule 19(f). IDEXX then filed a new memorandum within the page limit, but altered its argument to expand its motion to all of the patent claims instead of only Claims 1-6 and 13 as originally argued. Although Jewish Hospital has properly objected to this expansion as being beyond the scope of what I permitted in my procedural orders of last summer, I conclude that it is simpler to deal with the argument as filed. I conclude, however, that IDEXX has attempted to avoid my strictures in that

and a number of other ways, including an unreasonably small font in its reply memorandum (Docket Item 163) and in the Appendices it has filed to its memorandum on the filing date and in its decision to file still another motion for summary judgment (characterized as a cross-motion). Undeterred by my bluntly expressed concern about the blizzard of paper the parties have filed in this case, IDEXX has also moved for permission to file more on matters already excessively briefed. So as to maintain a focus on the merits, I granted IDEXX's motion (Docket Item 143) to file a reply to Jewish Hospital's opposition to IDEXX's motion for summary judgment of noninfringement. The filing, however, was a clear waste of attorney time and client money, like IDEXX's recently denied motion for reconsideration of my treatment of large/small entity status (Docket Item 165). I reserve the right to impose sanctions, should they become necessary, for the litigating practices I and Magistrate Judge Cohen have noted. I **ORDER** that IDEXX's lead counsel certify to the court within thirty (30) days that these comments, together with Judge Cohen's Order of October 20 and October 30, 1996, have been drawn specifically to the attention of IDEXX's senior management.

MERITS

The first element of IDEXX's argument on its motion for summary judgment derives from Claim No. 1 of the patent. Claim No. 1 begins as follows (I have underlined the language at issue):

> WHAT IS CLAIMED IS:
>
> 1. Circulating parasite antigens of *Dirofilaria immitis* essentially purified and isolated from *Dirofilaria immitis* adult worms or infected dog serum <u>treated with trichloroacetic acid and heat</u>, said antigens characterized as follows: [there follow ten characteristics, including:]

(c) not being destroyed by trichloroacetic acid extraction or by perchloric acid extraction;

(d) not being destroyed by heat treatment at approximately 100° C for 30 minutes . . . .

IDEXX claims that by virtue of the underlined phrase, Claim No. 1 "is a product claim which contains a process limitation." Mem. of Points and Authorities in Supp. of [Def.'s] Mot. for Summ. J. of Noninfringement [Docket Item 82], at 1. In other words, according to IDEXX, the patent does not claim antigens identified by the ten characteristics, two of which deal with trichloroacetic acid and heat,[1] but claims only antigens that had first been isolated by treatment with trichloroacetic acid and heat. IDEXX goes on to argue that none of its products, components or assays use the trichloroacetic acid and heat process to produce antigens. As a result, according to IDEXX, it cannot be guilty of infringement.

The underlined language from which IDEXX derives its argument appears in that portion of the claim that patent practitioners call the "preamble." See 2 Donald S. Chisum, Patents § 8.06[1][b], at 8-99 (1996) (defining the preamble as "an introductory phrase that may summarize the invention, its relation to prior art, or its intended use or properties"). The Federal Circuit has instructed trial judges that "no 'litmus test' exists as to what effect should be accorded to words contained in a preamble" and that "review of a patent in its entirety should be made to determine whether the inventors intended such language to represent an additional . . . limitation or mere introductory language." In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). In fact, according to

[1] The two characteristics (c) and (d) do relate to tricholoroacetic acid and heat, but they are listed as characteristics, not as the process limitation that IDEXX seeks to extract from the preamble language. Since the list of descriptors are introduced in the "transition" as "characterized by," caselaw teaches that they do not "close a claim to its recited elements and nothing further." Mannesmann Demag Corp. v. Engineered Metal Prod. Co., 605 F. Supp. 1362, 1379 (D. Del. 1985), aff'd, 793 F.2d 1279 (Fed. Cir. 1986).

the Federal Circuit, "[g]enerally . . . the preamble does not limit the claims." DeGeorge v. Bernier, 768 F.2d 1318, 1322 n.3 (Fed. Cir. 1985). The Federal Circuit has also quoted approvingly from a 1980 Court of Claims case stating that where the "effect of the preamble words is 'at best ambiguous . . . a compelling reason must exist before the language can be given weight.'" Id. (quoting Arshal v. United States, 621 F.2d 421, 431 (Ct. Cl. 1980)).

I have searched the patent in its entirety as well as the entire prosecution history in vain for any suggestion that the method of isolating the antigen characteristics is critical to the patent. Instead, I find that the overall thrust of the patent claim (and, for that matter, the prosecution history) is that the antigens themselves are what count, not the means by which the antigens were purified and isolated. The whole point of the patent claim so far as the antigens are concerned is the identification of *Dirofilaria immitis* antigens.[2] Overall, the applicant's purpose was to characterize the antigens so that they could be distinguished from other antigens and thereby be detected in infected dogs.

IDEXX argues that all the other claims of the patent are subject to the process limitation because all the patent's antibodies and assays relate to the antigens claimed in Claim No. 1. Since I have rejected IDEXX's argument that the antigens are limited by the process of their detection, the rest of IDEXX's arguments on this score fall as well.

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[2] From the outset, in the very first filing of December 1, 1983, Dr. Weil stated: "I have identified two circulating parasite antigens of *Dirofilaria immitis* present in the serum of *D. immitis* infected dogs and characterized the antigens to the extent necessary to distinguish these antigens from other antigens, such as the circulating onchocerciasis antigen described by Ouassi et al. and Des Moutis et al., supra, and thereby render it possible to detect these specific antigens in the blood or bodily fluids of *D. immitis* infected animals." P. 9, lines 11-19. Indeed, the original claim was for "[c]irculating parasite antigens of *Dirofilaria immitis* characterized as follows [with a listing of characteristics]." The patent examiner objected that "parasite antigens are products of nature" and that the claim would have to "indicate human intervention" in their isolation. Action of November 8, 1984 ¶ 4. For further discussion as to why the inventor's isolation of the antigens was significant, see Remarks in Amendment A dated July 8, 1987, at 3.

Accordingly, IDEXX's motion for summary judgment of noninfringement (Docket Item 81) is **DENIED** as to all the claims.

SO ORDERED.

DATED THIS 18TH DAY OF DECEMBER, 1996.

D. BROCK HORNBY
UNITED STATES CHIEF DISTRICT JUDGE