PRODUCT-BY-PROCESS CLAIMS OF PATENTS ARE LIMITED TO PRODUCTS MADE BY THE RECITED PROCESS


The *Abbott* case clarifies conflicting prior panel decisions and establishes that product-by-process claim language will not allow a claimed product to escape the process limitations used to describe it.

**Conflicting Federal Circuit Case Law**


In *Scripps*, the Federal Circuit addressed the interpretation and scope of claims exemplified by a product-by-process claim to a highly purified concentrated blood clotting factor. The court reasoned that “[s]ince claims must be construed the same way for validity and for infringement, the correct reading of product-by-process claims is that they are not limited to product prepared by the process set forth in the claims.”² Thus, the court determined that the defendant infringed the asserted claims even though its product was made by a different process than that recited in the claims.

The *Atlantic Thermoplastics* court considered the scope of product-by-process claims to molded shoe innersoles. Here, the allegedly infringing innersoles were also made by a process different than that recited in the claims, but the court construed the claims as limited by the recited process. The court explained that the *Scripps* court had “ruled without reference to the Supreme Court’s previous cases involving product claims with process limitations” and that it “would have reached a different conclusion if it had considered controlling precedent.”³ Further, the

¹ *Abbott*, at 26-27.
² *Scripps*, 927 F.2d at 1583.
³ *Atlantic Thermoplastics*, 970 F.2d at 839, fn. 2.
court found that not limiting product-by-process claims to the recited process would unacceptably “require this court to disregard several other mainstay patent doctrines” including the rules that: (1) “infringement requires the presence of every claim limitation or its equivalent”; (2) “infringement analysis compares the accused product with the patent claims, not an embodiment of the claims”; and (3) “infringement analysis proceeds with reference to the patent claims.”

The Abbott Opinion

The court acted sua sponte in Abbott “to clarify en banc the scope of product-by-process claims.” Ruling that product-by-process claims are not infringed by products made by processes not meeting claimed process limitations, the court explained that “this decision merely restates the rule that the defining limitations of a claim -- in this case process terms -- are also the terms that show infringement.” Thus, inventors who choose to claim products in terms of the process by which they are made are on notice that this definition “also governs the enforcement of the bounds of the patent right.”

The majority overruled Scripps to the extent that it “is inconsistent with this rule.” The court based its adoption in Abbott of “the rule in Atlantic Thermoplastics” on Supreme Court and other precedent. The court noted that it did not “question at all” the legitimacy of the claim form, but rather decided only the proper scope of such claims for infringement purposes. The inventor employing such claims “will not be denied protection.” However, the court refused to “simply ignore as verbiage the only definition supplied by the inventor.” The court also ruled that the use of the phrase “obtainable by” in Abbott’s patent did not provide a “free pass” from the product-by-process rule. The court noted that a contrary result would provide a “windfall” to inventors at the expense of future innovation and proper notice to the public of the scope of the claimed invention.

---

4 Id. at 846.
6 Id. at 28.
7 Id. at 30.
8 Id. at 27.
9 See id. at 21.
10 Id. at 28.
11 Id. at 30.
12 Id.
13 Id. at 36.
Willkie Farr & Gallagher LLP successfully represented Teva Pharmaceuticals USA, Inc. in Abbott. For further information regarding this memorandum or intellectual property issues generally, please contact Thomas J. Meloro (212-728-8248, tmeloro@willkie.com), or the attorney with whom you regularly work.

Willkie Farr & Gallagher LLP is headquartered at 787 Seventh Avenue, New York, NY 10019-6099. Our telephone number is (212) 728-8000 and our facsimile number is (212) 728-8111. Our website is located at www.willkie.com.

May 29, 2009

Copyright © 2009 by Willkie Farr & Gallagher LLP.

All Rights Reserved. This memorandum may not be reproduced or disseminated in any form without the express permission of Willkie Farr & Gallagher LLP. This memorandum is provided for news and information purposes only and does not constitute legal advice or an invitation to an attorney-client relationship. While every effort has been made to ensure the accuracy of the information contained herein, Willkie Farr & Gallagher LLP does not guarantee such accuracy and cannot be held liable for any errors in or any reliance upon this information. Under New York’s Code of Professional Responsibility, this material may constitute attorney advertising. Prior results do not guarantee a similar outcome.