

## Fed. Circ. Backs J&J Unit's Win In Glucose Test Strip IP Suit

By Tiffany Hu

*Law360* (November 22, 2019, 7:30 PM EST) -- The Federal Circuit affirmed Friday that a Johnson & Johnson subsidiary's blood-glucose test strips did not infringe two patents owned by a medical device maker, siding with a lower court that said the device maker had narrowed the claims that could have covered J&J's test strips during prosecution of its own patent.

In a precedential opinion, a three-judge panel upheld a Nevada federal judge's decision last October that J&J's LifeScan Inc. unit, which makes OneTouch Ultra glucose monitors, did not infringe on Pharma Tech Solutions Inc.'s patented glucose test strips.

The judge had found that LifeScan's test strips do not compare glucose concentrations as Pharma Tech's did, and instead used a method that Pharma Tech already excluded during patent prosecution after an examiner had originally rejected its broader claims.

When a patent applicant narrows a claim during prosecution, it is presumed that the "territory between the original claim and the amended claim" is disclaimed as well, the judge had noted.

On appeal, Pharma Tech contended that the lower court erred in finding that the company was barred from making infringement allegations based on the prosecution history of one of the patents. The company's reason for making the change was only "tangentially related" to the equivalent method, it argued. But the panel was unpersuaded.

"We hold that amendment-based and argument-based prosecution history estoppel bar Pharma Tech's infringement claims under the doctrine of equivalents," the panel wrote. "Pharma Tech's asserted equivalent is within the territory that the inventors surrendered during prosecution of the ... patent."

Counsel for both parties did not immediately respond to requests for comment Friday.

Pharma Tech, which is a subsidiary of Decision Diagnostics Corp., sued LifeScan in March 2016, accusing it of infringing two related patents covering Pharma Tech's test strips, which are sold as GenStrip. The GenStrip can be used with LifeScan's OneTouch Ultra monitors and was at one point the only third-party strip approved for use by the U.S. Food and Drug Administration, according to the judge.

LifeScan had contended that Pharma Tech was barred from making infringement allegations based on the prosecution history of one of the patents. When a patent applicant narrows a claim during

prosecution, it is presumed that the “territory between the original claim and the amended claim” is disclaimed as well, the judge said.

Pharma Tech had responded that it had not surrendered claims that did not include concentration comparisons and that the comparison of concentrations was merely "tangential" to the actual reason behind the change, which it said was to “require a linear comparison of multiple measurements.”

But the judge in October 2018 was unpersuaded by Pharma Tech’s arguments, finding that its reliance on the comparison of concentrations in order to differentiate itself with prior art made it “at minimum, a significant aspect” of its amended claim.

Pharma Tech lodged its appeal in the Federal Circuit that December.

U.S. Circuit Judges Kimberly A. Moore, Jimmie V. Reyna and Kara F. Stoll sat on the panel for the Federal Circuit.

The patents-in-suit are U.S. Patent Nos. 6,153,069 and 6,413,411.

Pharma Tech is represented by John Shaeffer, Jeffrey H. Grant and William A. Rudy of Fox Rothschild LLP.

LifeScan is represented by Eugene Gelernter and Gregory Diskant of Patterson Belknap Webb & Tyler LLP, and Charles Hoffman and Sean R. Marshall of Hoffmann Marshall Strong LLP.

The case is Pharma Tech Solutions Inc. et al. v. LifeScan Inc. et al., case number 19-1163, in the U.S. Court of Appeals for the Federal Circuit.

--Editing by Gemma Horowitz.