

Disclaiming a Patent's Claims Prior to Final Judgment Can Moot a Case or Controversy and Eliminate Subject Matter Jurisdiction

AUGUST 15, 2019

Sanofi-Aventis U.S., LLC v. Fresenius Kabi USA, LLC (Fed. Cir. Aug. 14, 2019)

In an Abbreviated New Drug Application (ANDA) suit, a patentee asserted claims from a method-of-treatment patent. While the ANDA suit proceeded, the Patent Trial and Appeal Board (PTAB) invalidated certain asserted claims for obviousness. The patentee moved to amend the claims before the PTAB, but facing a likely denial of its motion, it later filed a statutory disclaimer of the claims. The motion to amend was in fact denied and separately appealed. After the disclaimer and the denial of the motion to amend in the PTAB, the district court entered judgment of invalidity.

The Federal Circuit vacated the invalidity judgment because no Article III case or controversy existed at the time of the judgment. Article III requires a case or controversy that is “real and substantial” and “admits of specific relief through a decree of a conclusive character, as distinguished from an opinion advising what the law would be upon a hypothetical state of facts.” And this controversy “must be extant at all stages of review, not merely at the time the complaint is filed.” Because the effect of the patentee’s disclaimer was “as though the disclaimed claim(s) had ‘never existed,’” no controversy existed after the disclaimer. The accused infringer argued that the judgment should remain because of possible issue preclusion if the patentee were able to amend the claims and assert them against the accused infringer. The Federal Circuit disagreed, finding the possibility of amendment “speculative” given the PTAB’s denial of the motion to amend, and finding that the accused infringer had failed to explain how vacatur would affect any potential issue-preclusion argument.

[A copy of the opinion can be found here.](#)

1 Min Read

Authors

[David Enzminger](#)

[Ivan Poullaos](#)

[Mike Rueckheim](#)

[Danielle Williams](#)

Related Locations

Charlotte

Chicago

Los Angeles

Silicon Valley

Related Topics

Patent Trial and Appeal Board (PTAB)

ANDA

Article III

Related Capabilities

Intellectual Property

Patent Litigation

Related Regions

North America

Related Professionals



David Enzminger



Ivan Poullaos



Mike Rueckheim



Danielle Williams