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Markush Claims Need Not Always Be Closed, Depending on the Wording of the Claim

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The patentee asserted infringement of a patent for a drug formulation used to treat kidney disease (among other things). The patent included "Markush" claims, which are a particular type of claim that lists alternative elements (a "Markush group") from which a selection can be made, typically in the form: "a material selected from the group consisting of A, B, and C." The asserted claims recited, in relevant part, "[a] pharmaceutical composition ***comprising . . . at least one*** binder selected from the group consisting of [A, B, and C]."

The district court interpreted the "binder" Markush group as being "closed" due to the transitional phrase "consisting of," meaning that use of unlisted "binders" precluded infringement even if a listed "binder" was used. Because the defendant's formulation included unlisted "binders," the district court granted summary judgment of non-infringement.

The Federal Circuit reversed, stating that these Markush claims were "critically different" from those previously addressed by the court. First, unlike typical Markush claims, these claims recited "**at least one** binder selected from the group consisting of," which did not "indicate that the only binders . . . in the claimed formulation are those listed." Second, the transitional phrase "comprising" in the preamble suggested that the claim "is best construed not to foreclose such additional binders." Thus, there was "no language . . . indicating that every binder . . . must be within the Markush groups," as long as "at least one" of the listed "binders" was included.

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