



Courts Must Analyze Claims as a Whole to Determine Whether Independent Claims That Lack Written Description Preclude Assertion of Dependent Claims

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The District Court for the District of New Jersey recently denied a defendant's motion for summary judgment which sought to invalidate a dependent claim on preclusion grounds based on the PTAB's invalidation of the related independent claim for lack of written description. Because the claims were not identical in scope when viewed as a whole, the district court found it could not assume the differences were immaterial. Factual issues, therefore, prevented application of preclusion.

In 2018, the PTAB held, *inter alia*, that independent claim 1 of plaintiff Indivior, Inc.'s patent was anticipated. The PTAB concluded that claim 1 was not entitled to a parent application's priority date because there was no written description support for claim 1's 40-60% polymeric matrix limitation. Thus, the relevant anticipatory reference was prior art to claim 1. In contrast, however, the PTAB concluded that the parent application did provide written description support for claim 8, which depended from claim 1, but claimed a specific value within the range. And because claim 8 was entitled to the benefit of its priority date, it was not anticipated by the asserted reference. The Federal Circuit affirmed.

In the district court litigation, Indivior asserted previously unchallenged claim 6 against defendant Alvogen Pine Brooks LLC. Claim 6 incorporated all limitations from claim 1—including the 40-60% polymeric matrix limitation—but further required a specific ratio between a different component and the polymeric matrix. Alvogen filed a motion for summary judgment, arguing that because claim 6 included the same 40-60% limitation as

claim 1, it must be found to lack sufficient written description based on principles of claim preclusion.

The district court disagreed, reasoning that the written description requirement applies to patent claims in their entirety, not to individual limitations. Claim 6 included a limitation not found in claim 1. That added limitation was not considered in the PTAB's determination, and the district court could not assume at the summary judgment stage that the differences between claim 1 and claim 6 were immaterial. It is not the case that when an independent claim lacks written description support all of its dependent claims necessarily lack written description support. Indeed, the PTAB (affirmed by the Federal Circuit) previously concluded that claim 8, which expressly narrowed claim 1's range to a specific value, was adequately supported.

Thus, the questions of whether claim 6's added ratio limitation necessarily narrowed the polymeric matrix range to less than 40-60% and whether the specification would support any such narrower range were factual questions the court could not resolve at summary judgment.

The district court also found that the differences in the burdens of proof between the PTAB and district courts provide an alternative basis to deny summary judgment on preclusion grounds in this case, but noted that general rule would not apply under Federal Circuit precedent **if** the case involved the **same claims** challenged at the PTAB.

Practice Tip: When faced with a question of issue preclusion, be sure to analyze the claim as a whole to determine whether the identical relevant issue was in fact litigated in a previous case. Be prepared to explain why differences between an asserted claim and a previously invalidated claim are, or are not, material to the validity question at hand.

Indivior Inc. v. Alvogen Pine Brook LLC, No. 17-7106, 18-5285 (D.N.J. June 26, 2023)

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