



Federal Circuit Takes Intervening Rights Case En Banc: *Marine Polymer v. Hemcon*

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On Friday, January 20, 2012, the Federal Circuit issued an [order](#) indicating that it will rehear the case of *Marine Polymer v. Hemcon*, No. 2010-1548, *en banc*. The earlier appellate decision deals with intervening rights, and held that a narrowing of claim terms through arguments made by the patentee during reexamination does give rise to intervening rights, even if the claim terms are not actually amended. Intervening rights are provided for in [35 USC §§ 252](#) (reissue) and [307\(b\)](#) (reexamination). The doctrine provides protection for an accused infringer who has engaged in activity that falls within the scope of the new or amended claim, but did so prior to the grant of the new or amended claim by reissue or reexamination. The accused infringer can thus continue to practice the invention after the reissue or reexamination without committing infringement.

The question in *Marine Polymer* was whether the narrowing of a claim term *by patentee argument only*, without any actual amendment to the claim term or issuance of a new claim, has the same effect. In its earlier decision, the Federal Circuit agreed that it did, in an opinion authored by Judge Dyk and joined by Senior Judge Gajarsa. Judge Lourie dissented, relying on the language in the statute that intervening rights apply to “amended or new claims.”

With the rise in popularity over the past few years of accused infringers initiating reexamination proceedings when faced with allegations of infringement, intervening rights have become increasingly important. Most claims that emerge from a reexamination are amended in some way, and intervening rights can provide a successful defense when the reexam does not result in cancellation.

Interestingly, the court did not adopt its usual practice of issuing a set of particular questions for the parties to address, or inviting briefs *amicus curiae*; rather, the court indicated that the case will be decided on the basis of the briefs previously submitted.

Notable non-practicing entity Intellectual Ventures filed an amicus brief in support of rehearing *en banc*.

Dennis Crouch at [Patently-O](#) has a good discussion of the earlier decision [here](#).

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