

United States District Court,
S.D. New York.

BRISTOL-MYERS SQUIBB COMPANY,
Plaintiff.

v.

**RH'4NE-POULENC RORER, INC., Centre National De La Recherche Scientifique, and Rh'4ne-
Poulenc Rorer, S.A,**
Defendants.

No. 95 Civ. 8833(RPP)

Aug. 3, 2001.

Fitzpatrick, Cella, Harper & Scinto, New York, NY, By: Thomas H. Beck, for Plaintiff.

Clifford Chance Rogers & Wells, New York, NY, By: Philip E. Roux, for Defendants.

Gaynell C. Methvin, Dallas, TX, for Special Master.

ORDER

PATTERSON, J.

The Court has reviewed: (1) the Special Master's Report and Recommendation Concerning Construction of Claims of U.S. Patent No. 34,277 ("the '277 Patent") served on June 1, 2001 (the "Report"); (2) Exhibit A to the Special Master's Report, entitled The Rules of Claim Construction; (3) RPR's Objections to the Special Master's Report; (4) Bristol-Myers Squibb Company's ("Bristol") Response to RPR's Objections; and (5) RPR's Reply to Bristol's Response. FN1

FN1. In addition, the Court attended the *Markman* hearing held March 26 and 27, 2001.

RPR objects to only two of the Special Master's determinations. RPR contends that the Special Master erred by concluding that: (1) claims 1 and 16 must yield taxol in "more than trace amounts"; and (2) "hydroxy-protecting group means any protecting group, or class or category without limitations as to any specific protecting group or class or category," instead of determining that the term "replaced by hydrogen" limits the hydroxy protecting groups encompassed within claims 1 and 16.

With respect to RPR's first objection that the claims 1 and 16 must yield taxol in "more than trace amounts," the Special Master's conclusion is a correct interpretation of the claims in light of the law and the intrinsic evidence. The specification of the patent states "this process may be used to produce taxol in good yield...." U.S. Patent No. 34,277 (issued June 8, 1993) col. 2, ll. 64-65.

With respect to RPR's second objection, in reaching his conclusion, the Special Master expressly relied on the testimony of RPR's expert Dr. Martin given at the *Markman* hearing that claim 1 contained "no restrictions" on the R₂ or R₃ hydroxy-protecting groups (Report at 15), and the "plain and unambiguous language used in the claims and specification" (*id.* at 18). As explained at the *Markman* hearing by Dr. Martin, "replaced by hydrogen" does not limit the hydroxy protecting groups as urged by RPR, but refers to the next step in the claimed method which must be carried out. (Tr. of *Markman* hearing at 33-35; *see also* U.S. Patent No. 34,277 col. 2, ll. 61-63; col. 9, ll. 67-69; col. 10, ll. 14-16; col. 12, ll. 67-68; col. 14, ll. 1-3.) RPR has not met its burden to show that the two determinations in the Report to which RPR objects are clearly erroneous.

The Special Master's Report and Recommendation is detailed, comprehensive and well researched. It correctly interpreted the '277 claims in view of the law and the intrinsic evidence. It is also supported by the extrinsic evidence including the testimony given at the *Markman* hearing. Accordingly, the Report and Recommendation is accepted and is adopted in full.

IT IS SO ORDERED.

S.D.N.Y., 2001.

Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.

Produced by Sans Paper, LLC.