

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ALNYLAM
PHARMACEUTICALS, INC.,

Plaintiff,

v.

MODERNA, INC.,
MODERNATX, INC., and
MODERNA US, INC.,

Defendants.

Civil Action No. 22-335-CFC

ALNYLAM
PHARMACEUTICALS, INC.,

Plaintiff,

v.

PFIZER, INC., PHARMACIA &
UPJOHN CO. LLC, BIONTECH
SE, and BIONTECH
MANUFACTURING GMBH,

Defendants.

Civil Action No. 22-336-CFC

ORDER

Having studied carefully the parties' briefing and based on the clear and unmistakable lexicography of "alkyl" and "branched alkyl" in the #933 patent at 411:53–55 and 412:13–18, I went into today's hearing inclined to construe the

disputed term “R¹³ is a branched C₁₀-C₂₀ alkyl” to mean “R¹³ is a saturated hydrocarbon moiety group with 10 to 20 carbon atoms and in which one carbon atom in the group (1) is bound to at least three other carbon atoms and (2) is not a ring atom of a cyclic group.” After hearing oral argument on the term, I initially adopted this construction. But counsel for the Pfizer defendants asked me to reconsider my decision and to add the words “in the group” after “at least three other carbon atoms” to make clear that the “at least three other carbon atoms” exist within the R¹³ moiety group and do not include carbon atoms from M¹. I ultimately agreed to this modification and adopted Pfizer’s proposed construction.

I was wrong, however, to reconsider my initial construction of “R¹³ is a branched C₁₀-C₂₀ alkyl.” As I explained during the hearing, the lexicography set forth in column 412 is clear and unmistakable: “*Unless otherwise specified, the terms ‘branched alkyl’, ‘branched alkenyl’, and ‘branched alkynyl’ refer to an alkyl, alkenyl, or alkynyl group in which one carbon atom in the group (1) is bound to at least three other carbon atoms and (2) is not a ring atom of a cyclic group.*” #933 patent at 412:14–20 (emphasis added). This definition does not establish clearly and unmistakably that the “at least three other carbon atoms” are “in” the defined branched alkyl. It does establish clearly and unmistakably that *one* of the carbon atoms in the defined branched alkyl is bound to three other carbon atoms.

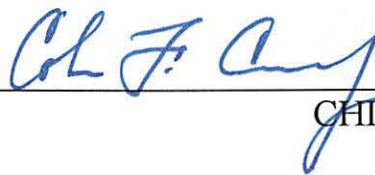
And the fact that the definition expressly requires “one carbon atom” to be “in the group” but is silent as to whether the “at least three other carbon atoms” are “in the group” suggests, if anything, that the “at least three other carbon atoms” need not be in the group.

A court should construe claim terms according to the plain and ordinary meaning that the terms would have to an artisan of ordinary skill when read in the context of the specification and prosecution history. *See Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). “There are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Id.* Such a disavowal must be clear and unmistakable. *See id.* at 1367–68. Any additional limitations that do not appear in the claim generally should not be read into the claim. *See id.* at 1366–67.

I agreed today with Pfizer that claim 1 of the patent treats R¹³ and M¹ as “distinct” chemical groups. But as I have written before in a similar context, “distinct” lends itself to competing interpretations.” *ViiV Healthcare Co. v. Gilead Scis., Inc.*, 437 F. Supp. 3d 395, 402 (D. Del. 2020). And it is not unreasonable to assert, as Alnylam does, that R¹³ and M¹ can be distinct but still

share a carbon atom. Thus, the fact that R¹³ and M¹ are treated as distinct chemical groups in claim 1 does not clearly and unmistakably “specify” that R¹³ is defined “otherwise” than it is in lines 13 through 18 of column 412 of the #933 patent.

NOW THEREFORE, at Wilmington on this Ninth day of August in 2023, **IT IS HEREBY ORDERED** that I will construe “R¹³ is a branched C₁₀-C₂₀ alkyl” to mean “R¹³ is a saturated hydrocarbon moiety group with 10 to 20 carbon atoms and in which one carbon atom in the group (1) is bound to at least three other carbon atoms and (2) is not a ring atom of a cyclic group.”



CHIEF JUDGE