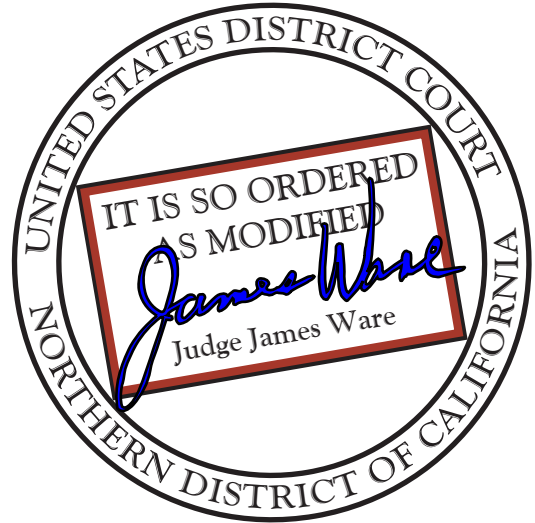


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17 UNITED STATES DISTRICT COURT  
18 NORTHERN DISTRICT OF CALIFORNIA  
19 SAN JOSE DIVISION

21 AGILENT TECHNOLOGIES, INC.

22 Plaintiff,

23 v.

24 AFFYMETRIX, INC.

25 Defendant.

CASE NO. C 06-05958 JW (PVT)

26 **JOINT CASE MANAGEMENT  
STATEMENT AND [PROPOSED]  
ORDER**

27 Date: December 14, 2009  
Time: 10:00 a.m.  
Courtroom: 8, 4<sup>th</sup> Floor  
Judge: Hon. James Ware

1 In its Order of November 3, 2009 (Dkt. 89), the Court continued the Case Management  
 2 Conference until December 14, 2009, in light of the parties' settlement negotiations. In its Order,  
 3 the Court stated that the Joint Case Management Statement shall include the parties' proposed  
 4 schedule on how the case should proceed and an update on the parties' settlement efforts. While  
 5 settlement negotiations are on-going, the parties jointly submit this Case Management Statement and  
 6 Proposed Order.

### 7 **DESCRIPTION OF THE HISTORY OF THE CASE**

8 The present case is a suit under 35 U.S.C. § 146 filed by Plaintiff Agilent Technologies, Inc.  
 9 ("Agilent") against Defendant Affymetrix, Inc. ("Affymetrix") on September 26, 2006. Agilent  
 10 appeals the decision of the United States Patent and Trademark Office ("USPTO") Board of Patent  
 11 Appeals and Interferences ("the Board") in Patent Interference No. 105,285 ("the Interference"),  
 12 entitled "Carol T. Schembri, Junior Party v. Donald M. Bessemer, Virginia W. Goss, and James L.  
 13 Winkler, Senior Party."

14 Agilent is the owner of all right, title, and interest in U.S. Patent No. 6,513,968, which issued  
 15 on February 4, 2003 ("the Schembri patent"). Affymetrix is the owner of U.S. patent application  
 16 number 10/619,224, filed on July 12, 2003, by Besemer, Goss, and Winkler ("the Besemer  
 17 application"). To provoke an interference, Affymetrix copied claims of the Schembri patent into the  
 18 Besemer application. On January 27, 2004, Affymetrix requested a declaration of interference  
 19 between the Schembri patent and the Besemer application. The Interference was declared by the  
 20 USPTO on February 16, 2005.

21 In the Interference, Agilent filed a motion contending that claims 66-70 and 73-78 of the  
 22 Besemer application are unpatentable because they are not supported by an adequate written  
 23 description, as required under 35 U.S.C. § 112, ¶ 1. After briefing and a hearing, the Board denied  
 24 Agilent's motion. It also found that Agilent could not prevail on the question of priority because the  
 25 priority date accorded to Agilent was after that accorded to Affymetrix and Agilent did not assert an  
 26 earlier date of invention. Accordingly, the Board canceled claims 20-26 and 30-35 of the Schembri  
 27 patent. Although Affymetrix filed motions attacking the involved claims of the Schembri patent  
 28 under 35 U.S.C. § 102(b) and 102(e), the Board dismissed those motions as moot.

1 Agilent contended that the Board erroneously determined that claims 66-70 and 73-78 of the  
2 Besemer application were supported by an adequate written description, and that the Board  
3 erroneously canceled claims 20-26 and 30-35 in the Schembri patent as a result. Affymetrix  
4 contended that the Board was correct in its decision.

5 On appeal to this Court, the parties submitted cross-motions for summary judgment on the  
6 written description issue. Following a joint claim construction and summary judgment hearing held  
7 April 25, 2008, the Court construed the Besemer claims in light of the Besemer specification, found  
8 sufficient written description support for the claims, and entered judgment in Affymetrix's favor.

9 Agilent appealed the Court's decision to the Federal Circuit, which reversed. In its decision,  
10 the Federal Circuit held that when a party challenges written description support for an interference  
11 count or a copied claim in an interference, the originating disclosure provides the meaning of the  
12 pertinent claim language. The Federal Circuit therefore construed the Besemer claims in light of the  
13 Schembri patent specification. After construing the key limitations of the claims, the Federal Circuit  
14 held there was no dispute of material fact that the Besemer application does not satisfy the written  
15 description requirement for the claims at issue. Accordingly, the Federal Circuit held the Court  
16 erred in granting Affymetrix's summary judgment motion and reversed this Court's denial of  
17 Agilent's summary judgment motion. Affymetrix filed a petition for rehearing en banc, which the  
18 Federal Circuit denied. The Federal Circuit then issued its mandate on September 25, 2009, and  
19 entered judgment in favor of Agilent.

#### 20 **DISPOSITION OF THE CASE IN LIGHT OF THE REMAND**

21 In its Order, the Court specifically asked the parties to address their respective positions with  
22 respect to how the case should proceed. The parties' positions are below:

##### 23 Agilent's Position:

24 The only issue that the Board substantively decided was whether the Besemer claims have  
25 written description support. The Board did not consider any of Affymetrix's additional motions,  
26 instead dismissing the motions as moot in light of the decision on written description. Accordingly,  
27 on appeal, the only issue that this Court and the Federal Circuit considered was the written  
28 description issue. If Affymetrix asserts that its substantive motions should be considered at all,

Agilent requests that the Court reverse the Board's decision and remand the case to the Board so that the Board may decide how to proceed with the interference in the first instance.

In the alternative, if the Court would find it to be helpful, Agilent proposes that the parties brief the issue of the disposition of the case according to the schedule below.

Affymetrix's Position:

Affymetrix's motions in the Interference challenging the validity of the Schembri patent claims 20-26 and 30-35 remain to be decided in this case. This Court has already ruled in its Order dated September 13, 2007, that "these issues qualify for consideration in this action." Order on Motions Re: Standard of Review, Scope of Review, and Examination of Specifications, Docket No. 47, dated September 13, 2007 at p. 7.

Affymetrix also agrees to brief the issue of the disposition of the case if the Court would find it helpful.

### SCHEDULE

If the Court would find briefing the issue of the disposition of the case helpful, the parties' proposed schedule going forward is set forth below:

| EVENT                                           | DUE DATE                        |
|-------------------------------------------------|---------------------------------|
| Opening brief on the disposition of the case    | January 25, 2010                |
| Responsive brief on the disposition of the case | February 8, 2010                |
| Hearing on the disposition of the case          | <b>March 22, 2010 at 9 a.m.</b> |

Pursuant to General Order No. 45 X.B, the electronic filer of this document attests under penalty of perjury that she has the concurrence of each of the signatories to this Joint Case Management Statement.

1  
2 Dated: December 4, 2009

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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4  
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~~Proposed~~ [PROPOSED] CASE MANAGEMENT ORDER

The Case Management Statement and ~~Proposed~~ Order is hereby adopted by the Court as the Case Management Order for the case and the parties are ordered to comply with this Order.

The Court also sets a Further Case Management Conference following the **March 22, 2010** hearing at 10 a.m. On or before **March 12, 2010**, the parties shall file a Joint Case Management Statement. The Statement shall include an update on the parties' settlement efforts.

Dated: December 8, 2009

  
JAMES WARE  
United States District Judge