

Perspectives on the Law: Intellectual Property

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Should evidence developed after a patent is granted be used to determine whether the invention was obvious at the time the patent application was filed? The Court of Appeals for the Federal Circuit addressed this issue in a recent decision and held that such later developed evidence is permissible. Obviousness is the legal test that determines whether the invention would have been obvious to a skilled artisan at the time of invention. If so, the invention is not patentable - the claims are invalid. The District Court held that the patent was invalid due to obviousness, but refused to consider evidence of unexpected benefits because this evidence was developed *after* the patent had issued. The Federal Circuit reversed, reasoning that the full scope of a patent could not always be understood at the time of filing. The Court of Appeals said "[i]t is not improper to obtain additional support consistent with the patented invention, to respond to attacks on validity." *Knoll Pharm. Co., Inc. v. Teva Pharm. USA, Inc.*, __ F.3d __, 03-1300 (Fed. Cir. May 19, 2004).

Obviousness was also at issue in a recent patent infringement case heard by Judge Montgomery. The Court held the patent claims invalid due to obviousness where the inventive contribution, if any, over the prior art was minimal. The patent was for a vitamin supplement formula combining folic acid and vitamin B₁₂, but excluding antioxidants that would reduce the efficacy of the formulation. Similar combinations had already been disclosed in two prior art references: a U.S. patent and a European patent— both being effective combinations. Neither reference specifically excluded antioxidants, however, from the formulation. In fact, the U.S. patent made no mention of antioxidants and the European patent suggested that antioxidants were "optional." The Court, in finding the exclusion of antioxidants obvious, reasoned that antioxidants were unnecessary for full efficacy of the formulation. *Upsher-Smith Laboratories, Inc. v. Pan American Laboratories, Inc.*, Civ. No. 01-352 (D. Minn. Apr. 26, 2004).

Judge Frank's recent decision in a patent claim construction proceeding illustrates the importance of understanding the ordinary and customary meaning of terms used in patents. The patent in this case was for a portable machine that stored and automatically dispensed specific amounts of agricultural chemicals, such as fertilizer. The parties disputed several terms in the claims, including the term "density." Although the ordinary and customary meaning of density is "a value that represents the mass of the particulate material per unit volume," the patentee argued that the term should be defined as a calibration factor used to control the amount of chemical dispensed by the machine. This definition was not expressly used in the patent claims or specification, however, and the term had not been defined during prosecution of the patent before the Patent Office. Accordingly, the Court gave "density" its ordinary and customary meaning, because the patentee had not rebutted the presumption that patent claim terms receive their ordinary and customary meaning. *Rosen's, Inc. v. Van Diest Supply Co.*, Civ. No. 03-3206 (D. Minn. Mar. 30, 2004).