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Federal Circuit Patent Bulletin: *Scientific Plastic Prods., Inc. v. Biotage AB*

September 10, 2014

"[W]hen the problem an invention is designed to solve is not unique to the specific field of the invention, it is not improper for the trier of fact to consider whether a person of ordinary skill would consult a different art in order to solve the problem."

On September 10, 2014, in *Scientific Plastic Prods., Inc. v. Biotage AB*, the U.S. Court of Appeals for the Federal Circuit (Newman,* Moore, Wallach) affirmed the Patent Trial and Appeal Board's decision upholding the patent examiner's rejection during inter partes reexamination of the claims of U.S. Patents No. 7,138,061, No. 7,381,327, and No. 7,410,571, which related to a resealable cartridge for low pressure liquid chromatography (LPLC), for obviousness. The Federal Circuit stated:

Criteria for determining whether prior art is analogous may be summarized as "(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." The question here is whether [the prior art references] King or Strassheimer meets the second criterion. . . . "A reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection." The pertinence of the reference as a source of solution to the inventor's problem must be recognizable with the foresight of a person of ordinary skill, not with the hindsight of the inventor's successful achievement.

The Board found that the central purpose of the SPP inventors was to form "an LPLC cartridge that 'would allow a user to easily vary and access the cartridge's contents without destroying its ability to be sealed and function under LPLC pressures.'" The Board concluded that a person of ordinary skill seeking such a cartridge would reasonably look to sealing arrangements for other pressurized systems. Thus the Board held that replacement of the sealing arrangement of [the prior art reference] Yamada with the sealing arrangement of

King or Strassheimer was an obvious solution to the problem of providing a resealable cartridge that achieves a fluid tight seal at elevated pressures. . . . The Board observed that when the problem an invention is designed to solve is not unique to the specific field of the invention, it is not improper for the trier of fact to consider whether a person of ordinary skill would consult a different art in order to solve the problem. . . .

Here, the King and Strassheimer references address the problem of providing a fluid tight seal at elevated pressures, between a container and a resealable cap. This is sufficiently close to the problem addressed by the claimed invention; substantial evidence supports the Board's finding that King and Strassheimer are available as prior art. The question remains as to whether combining the cartridge of Yamada with the pressure-resistant cap of King or Strassheimer would have been obvious to a person of ordinary skill in the field of liquid chromatography devices. [T]he Board concluded that the "known problem of leakage in threaded connections of plastic LPLC cartridges under pressure identified in the[patents] provides a reason for one of ordinary skill in the art to have turned to King or Strassheimer to improve the sealing arrangement set forth in Yamada." The Board cited a statement in the SPP patents that explained that because prior art LPLC cartridges "leak at the seams[,] [t]hreaded connections are thus not used to form the body of [LPLC cartridges] when the body is made out of polymers." The Board noted SPP's argument that Yamada, a polymer cartridge with threaded connections, does not explicitly disclose a leakage problem. However, the Board found that "by providing for the presence of an O-ring, Yamada implicitly acknowledges that there is a potential leakage issue between the cap and column body of the plastic cartridge." . . . We conclude that the Board did not err in holding that it would have been obvious for a person of ordinary skill in the field of the invention to modify the chromatography cartridge of Yamada with the resealable threaded cap of King or Strassheimer. This applies to the three patents whose reexamination decisions are here appealed.