



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***EMI Group N.  
Am., Inc.  
v.  
Cypress  
Semiconductor  
Corp.***

No. 00-1508  
Federal Circuit  
Sept. 21, 2001

*“[T]he  
discovery of a  
previously  
unappreciated  
property of a  
prior art  
composition, or  
of a scientific  
explanation for  
the prior art’s  
functioning,  
does not  
render the old  
composition  
patentably new  
to the  
discoverer.”*

On September 21, 2001, the Federal Circuit reversed the district court’s partial judgment as a matter of law that U.S. Patents No. 4,826,785 and No. 4,935,801 are not invalid as anticipated or obvious. The patented technology related to metallic fuses for semiconductor chips. The Federal Circuit noted:

In granting JMOL, the district court concluded: “The pertinent inquiry was whether the prior art inherently discloses the claimed fuse-removal mechanism, not whether the fuse-removal mechanism is an inherent characteristic of the claimed structure.” . . . . “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”

This requirement, that a person of ordinary skill in the art must recognize that the missing descriptive matter is necessarily present in the reference, may be sensible for claims that recite limitations of structure, compositions of matter, and method steps which could be inherently found in the prior art. Such recognition by one of ordinary skill may be important for establishing that the descriptive matter would inherently exist for every combination of a claim’s limitation. Theoretical mechanisms or rules of natural law that are recited in a claim, that themselves are not patentable, however, do not need to be recognized by one of ordinary skill in the art for a finding of inherency. A person of ordinary skill does not need to recognize that a method or structure behaves according to a law of nature in order to fully and effectively practice the method or structure.

A hypothetical example clarifies this principle. Humans lit fires for thousands of years before realizing that oxygen is necessary to create and maintain a flame. The first person to discover the necessity of oxygen certainly could not have obtained a valid patent claim for “a method of making a fire by lighting a flame in the presence of oxygen.” Even if prior art on lighting fires did not disclose the importance of oxygen and one of ordinary skill in the art did not know about the importance of oxygen, understanding this law of nature would not give the discoverer a right to exclude others from practicing the prior art of making fires.

Similarly, in the present case the prior art does not need to inherently disclose the claimed theoretical vapor-induced fuse explosion mechanism. Nor does one of skill in the art need to understand the severing mechanism. Recitation of a law of nature does not distinguish a claim from prior art. . . .

This court’s holding does not foreclose an inventor from claiming an invention in terms of a structure that achieves a specific claimed result. In this case, however, the claim merely explains the operation of the claimed structure, rather than defining the claimed structure in terms of the result it achieves. Moreover, in explaining the operation, the claim merely recited a purported law of nature.