



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***LNP Eng'g
Plastics, Inc.***

v.

***Miller Waste
Mills, Inc.***

Nos. 00-1501,
-1563

Federal Circuit
Dec. 21, 2001

"[I]f one of ordinary skill in the art would have been motivated to use the teachings of a prior art process, in its normal disclosed operation, to create a product that a patentee claims in a subsequent patent, then such patent would have been obvious over the former disclosed process."

On December 21, 2001, the Federal Circuit affirmed the district court's judgment, notwithstanding the jury verdict, that the defendant infringed U.S. Patent No. 5,019,450, and that the '450 patent is not invalid for indefiniteness. In addition, the Federal Circuit affirmed the district court's judgment regarding no willful infringement and no inequitable conduct. However, the Federal Circuit reversed the judgment, notwithstanding the jury verdict, that U.S. Patent No. 5,213,889 is not invalid for obviousness. The patented technology related to plastic products produced with long fiber reinforced thermoplastics (LFRTs). With respect to obviousness, the Federal Circuit noted:

The jury indicated on the verdict form that it found claim 1 of the '889 patent obvious in light of . . . the Hattori patent, . . . the Bradt patent, and Fiberfil LFRT pellets made by Polymer Composites, Inc. [T]he district court granted JMOL that claim 1 is not obvious over prior art. . . .

Turning to differences between the prior art and the claimed invention, Hattori, of course, claims a method and the '889 patent claims an LFRT made with pultrusion. On the other hand, the Hattori patent teaches the same melt pultrusion process disclosed in the '889 patent. The Hattori patent specifically instructs one of ordinary skill to adjust melt viscosity and to spread fiber strands during pultrusion as disclosed in the '899 patent to achieve the characteristics in claim 1. Dr. Broutman testified that the melt pultrusion process disclosed in the Bradt and Hattori patents allow the production of LFRT products with the length and dispersal characteristics claimed in the '889 patent.

[P]rior art describing a product is highly relevant to patentability determinations for a process that may be performed using the product. Similarly, prior art describing a process also may be highly relevant to patentability for a product that may be produced using the process. Specifically, if one of ordinary skill in the art would have been motivated to use the teachings of a prior art process, in its normal disclosed operation, to create a product that a patentee claims in a subsequent patent, then such patent would have been obvious over the former disclosed process. This case fits that description. The melt pultrusion process and adjustments taught by Hattori would motivate a person of skill in the art to make the suggested adjustments in order to create an LFRT with the characteristics of claim 1 of the '889 patent.

Moreover, evidence indicated that the Fiberfil product yielded a weight-average filament length of 5.8 mm. The district court discounted this evidence, stating that it does not show that the Hattori patent discloses random dispersion in a molded product. However, as described above, the Hattori patent pultrusion process is the same as that disclosed in the '889 patent and Hattori teaches adjusting the pultrusion process to achieve better wetting of the strand. As explained above, better wetting results in dispersal. Accordingly, the record supplies substantial evidence for a reasonable jury to find that claim 1 of the '889 patent would have been obvious over the Hattori patent alone or in further combination with the Fiberfil LFRT product.