



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

Rosco, Inc.
v.
Mirror Lite Co.

Nos. 01-1271,
-1302
Federal Circuit
Sept. 24, 2002

“Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”

On September 24, 2002, the Federal Circuit, *inter alia*, reversed and remanded the district court’s judgment following a bench trial that U.S. Patent No. 5,589,984 was invalid under 35 U.S.C. §§ 102(e) and 102(g). The patented technology related to school bus mirrors. The Federal Circuit stated:

The district court found that the ‘357 patent inherently disclosed the invention of the ‘984 patent under 35 U.S.C. § 102(e), such that one skilled in the art would read the ‘357 patent as disclosing a mirror with varying radius of curvature: “the ‘357 Patent shows a mirror with a varying radius of curvature based on the inherent nature of such a characteristic.” The district court concluded that “one skilled in the art could produce the results claimed in the ‘984 Patent simply by practicing the ‘357 Patent, i.e., the result flows naturally from the express disclosures of the ‘357 Patent whether or not others are aware of it.” . . .

We disagree. Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” [T]he question is not whether the manufacture of the mirror using this process inherently results in a varying radius of curvature along the major axis, but whether one skilled in the art would read the ‘357 patent as inherently disclosing the invention of the ‘984 patent, that is, whether one skilled in the art would read the ‘357 patent as showing a mirror of varying radius of curvature along the major axis. There is no evidence in the record to support a finding that one skilled in the art would so read the ‘357 patent. . . . We accordingly reverse the district court’s conclusion that the ‘984 patent is invalid under section 102(e).

The district court also found claims 1-3 and 6-8 of the ‘984 patent invalid under section 102(g) in view of Rosco’s pre-1992 products, finding that Rosco made the invention of the ‘984 patent before the ‘984 critical date. . . . Prior invention by another invalidates a claimed invention under section 102(g)(2) if the prior inventor either reduced the invention to practice first, or conceived of the invention first and subsequently reduced the invention to practice. However, “[i]t is well-settled that conception and reduction to practice cannot be established nunc pro tunc. There must be contemporaneous recognition and appreciation of the invention” The question is whether Rosco actually recognized and appreciated a mirror with varying radius of curvature along the major axis of the lens. Though the issue is disputed, particularly with regard to trial exhibit 110, we may assume for present purposes that the earlier Rosco product did in fact have a varying radius of curvature along the major axis of the lens. But there is no evidence that this feature of the invention was recognized and appreciated. . . . We therefore reverse the district court’s conclusion that the ‘984 patent is invalid under section 102(g).