TECHNOLOGY LAW UPDATE

Iron Grip Barbell Co. v. USA Sports, Inc.

No. 04-1149
Federal Circuit
Dec. 14, 2004

Not every competing product that arguably falls within the scope of a patent is evidence of copying [as a secondary consideration]. Otherwise every infringement suit would automatically confirm the nonobviousness of the patent. Rather, copying requires the replication of a specific product.

On December 14, 2004, the Federal Circuit affirmed the district court's summary judgment that U.S. Patent No. 6,436,015, which relates to weight plates used with fitness equipment, is invalid as obvious. The Federal Circuit stated:

> [The obviousness inquiry] requires us to examine (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the objective evidence of nonobviousness. . . . The key feature of the '015 patent, the fact that there are three elongated handles, falls within a range disclosed by the prior art. Where the "prior art . . . discloses a range encompassing a somewhat narrower claimed range," the narrower range may be obvious. "[W]hen the difference between the claimed invention and the prior art is the range or value of a particular variable," then a patent should not issue if "the difference in range or value is minor." [B]ecause an invention falls within a range disclosed by the prior art does not necessarily make it per se obvious. Both the genus and species may be patentable. [W]here there is a range disclosed in the prior art, and the claimed invention falls within that range, there is a presumption of obviousness. But the presumption will be rebutted if it can be shown: (1) That the prior art taught away from the claimed invention; or (2) that there are new and unexpected results relative to the prior art.
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> There is, to be sure, one distinguishing feature of these range cases. Each involved a range disclosed within a single patent, while here the range is disclosed in multiple prior art patents. But, under the circumstances of this case, that is a distinction without a difference. The prior art suggested that a larger number of elongated grips in exercise weights was beneficial, thus plainly suggesting that one skilled in the art look to the range appearing in the prior art. [Because the patentee] has not shown that the prior art taught away from the invention or new and unexpected results from a three elongated grip weight plate as compared to those in the prior art, we conclude that the claims are obvious absent substantial evidence of pertinent secondary factors supporting patentability.
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> [I]n "determining the question of obviousness, inquiry should always be made into whatever objective evidence of nonobviousness there may be." . . . Iron Grip has not made a showing of commercial success. [A] "nexus must be established between the merits of the claimed invention and evidence of commercial success before that evidence may become relevant to the issue of obviousness." Ordinarily, this nexus may be inferred when "the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent." [C]opying by a competitor may be a relevant consideration in the secondary factor analysis. Not every competing product that arguably falls within the scope of a patent is evidence of copying. Otherwise every infringement suit would automatically confirm the nonobviousness of the patent. Rather, copying requires the replication of a specific product. This may be demonstrated either through internal documents, direct evidence such as disassembling a patented prototype, photographing its features, and using the photograph as a blueprint to build a virtually identical replica, or access to, and substantial similarity to, the patented product (as opposed to the patent).

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