



TECHNOLOGY LAW UPDATE

Perricone
v.
Medicis Pharm.
Corp.

Nos. 05-1022, -1023

Federal Circuit
Dec. 20, 2005

"[I]f the prior art necessarily functions in accordance with, or includes, the claims limitations, it anticipates." "Inherency is not necessarily coterminous with knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art."

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On December 20, 2005, the Federal Circuit, inter alia, affirmed-in-part, reversed-in-part and remanded the district court's summary judgment that U.S. Patents No. 5,409,693 and 5,574,063, which related to skin damage protection using a topical application of fat soluble vitamin C forms, were invalid. The Federal Circuit stated:

The district court determined that U.S. Patent No. 4,981,845 (Pereira) anticipates claims 1-4, 7-9, and 13 of the '693 patent, and claims 1-19 of the '063 patent. [T]he district court reasoned that "Pereira will inherently function in [the claimed beneficial manner] when topically applied to the skin." Thus, the district court ultimately based its anticipation analysis on inherency. "In general, a limitation or the entire invention is inherent and in the public domain if it is the 'natural result flowing from' the explicit disclosure of the prior art." In some cases, the inherent property corresponds to a claimed new benefit or characteristic of an invention otherwise in the prior art. In those cases, the new realization alone does not render the old invention patentable. Thus, when considering a prior art method, the anticipation doctrine examines the natural and inherent results in that method without regard to the full recognition of those benefits or characteristics within the art field at the time of the prior art disclosure. . . .

Thus, Dr. Perricone's independent claims recite particular skin benefits together with methods of achieving those benefits (i.e., topically applying a particular compound). If Pereira discloses the very same methods, then the particular benefits must naturally flow from those methods even if not recognized as benefits at the time of Pereira's disclosure. Thus, Pereira anticipates if its disclosure of "topical application" satisfies the application step in Dr. Perricone's various asserted claims. . . .

Claim 1 of the '693 patent recites a new use of the composition disclosed by Pereira, i.e., the treatment of skin sunburn. The district court's inherent anticipation analysis for this claim contains a flaw. The disclosed use of Pereira's lotion, i.e., topical application, does not suggest application of Pereira's lotion to skin sunburn. In other words, the district court's inherency analysis goes astray because it assumes what Pereira neither disclosed nor rendered inherent. Because Pereira does not disclose topical application to skin sunburn, this court reverses the district court's holding that Pereira anticipates claims 1-4 and 7 of the '693 patent.

[T]here is an important distinction between topical application to skin for the purpose of avoiding sunburn, and the much narrower topical application to skin sunburn. [T]he disclosure that a sunburn can be prevented by wearing a hat clearly does not anticipate a claim to the discovery that one can treat an existing sunburn by putting on a hat. . . .

Unlike claim 1, claim 8 of the '693 patent, from which claims 9 and 13 ultimately depend, merely requires application of the composition to exposed skin surfaces. Because all skin surfaces are susceptible to sunburn damage, and because one can only realistically apply a composition to a skin surface when that surface is exposed, Pereira's "topical application" encompasses the application step of claim 8. Thus, the district court correctly determined that Pereira's disclosure of the topical application of the same composition necessarily anticipates claims 8, 9, and 13 of the '693 patent [as well as claims 1-19] of the '063 patent.