

NOVEMBER 10, 2006

Abbott Labs. v. Baxter Pharm. Prods., Inc.

Nos. 06-1021, -1022, -1034, Federal Circuit (Bryson, Archer, Gajarsa)

The general principle that a newly-discovered property of the prior art cannot support a patent on that same art is not avoided if the patentee explicitly claims that property. “[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.”

On November 9, 2006, the Federal Circuit reversed the district court’s judgment that U.S. Patent No. 5,990,176, which related to the fast-acting inhalation anesthetic sevoflurane, was valid. The Federal Circuit stated:

The parties do not dispute that the ‘211 patent predates the ‘176 patent for the purposes of 35 U.S.C. § 102, and the facts about what the ‘211 patent teaches are in relevant part undisputed. It discloses a technique for purifying sevoflurane for “use[] as a pharmaceutical and particularly as an inhalation anesthetic,” which involves the addition of water. [T]he result will be sevoflurane that is saturated with water, unable to absorb any more moisture. Saturation implies that the sevoflurane contains an amount of water sufficient to prevent it from degrading due to Lewis acids.

At the time, however, knowledge of the beneficial nature of a water-sevoflurane mix was wholly lacking in the art.... Thus, the ‘211 patent discloses a particular composition and claims a process for making that composition, but does not teach the advantageous feature of that composition whose discovery led to the patent in suit.

Our cases have consistently held that a reference may anticipate even when the relevant properties of the thing disclosed were not appreciated at the time....



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Abbott’s objection here is merely that at the time of the ‘211 patent, nobody knew that the water-saturated sevoflurane that patent disclosed had the property of resisting the Lewis acid degradation reaction. [T]hat lack of knowledge is wholly irrelevant to the question of whether the ‘176 patent claims something “new” over the disclosure of the ‘211 patent; the claimed property of resistance to degradation is found inherently in the disclosure. Since the ‘211 patent discloses sevoflurane saturated with water – i.e., unable to absorb any additional water to further protect it from the degradation reaction – it anticipates the claims of the ‘176 patent. This is true under any definition of the term “prevent degradation” that the claims might reasonably bear, so we need not construe that phrase with numerical exactitude in order to reach our decision.

The district court nonetheless found the patent valid due to the purpose-based distinction ... applicable only to process claims.... All of the steps of the ‘176 patent are thus disclosed in the ‘211 patent in furtherance of the same purpose: the delivery of safe, effective sevoflurane anesthetic. All that is contributed by the method claims of the ‘176 patent is the recognition of a new property of the prior art process. We hold today ... that “the claimed process here is not directed to a new use; it is the same use.”

For more information on these issues or other intellectual property law matters, please contact **Lawrence M. Sung, Ph.D.** at lsung@nixonpeabody.com or 202-585-8221.

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