

NOVEMBER 16, 2006

## Optivus Tech., Inc. v. Ion Beam Applications S.A.

Nos. 05-1518, -1534, -1575, Federal Circuit (Bryson, Archer, Linn)

***“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”***

On November 16, 2006, the Federal Circuit, *inter alia*, affirmed the district court’s summary judgment that IBA did not infringe U.S. Patents No. 4,870,287 and No. 5,260,581, which are assigned to Loma Linda University Medical Center and are related to the use of proton beams in cancer therapy, because the patents are invalid for obviousness. The Federal Circuit stated:

Loma Linda argues that the district court erred in holding that no issue of fact exists on the obviousness of the ‘287 patent over a neutron therapy facility at the University of Washington and a Conceptual Design Report reference (the “CDR”). Specifically, Loma Linda argues that modifying the University of Washington facility as described by the district court would result in a “death ray” and thus teaches away from an invention designed to treat patients; that there is no evidence supporting the court’s conclusion that a motivation to combine references exists; and that no evidence supports that the CDR was publicly disseminated so as to qualify as prior art....

First, Loma Linda’s argument that the University of Washington facility teaches away from modification is unpersuasive. The University of Washington facility uses neutrons, rather than protons, to treat cancer. The facility directs a proton beam at a beryllium plate to cause nuclear reactions that produce neutrons, which then travel towards the patient. Loma Linda makes much of the fact that the proton beam used in the University of Washington facility is of such high intensity that if it were modified by removing the beryllium plate, it would kill patients rather than cure them. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by



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the applicant.” As the district court noted, “the common denominator among the individuals listed [by the parties as demonstrating ordinary skill] is a working familiarity with particle beam technology, particularly as it applies to cancer treatment.” Clearly, one of ordinary skill in the art would not simply remove the beryllium plate and direct the high intensity proton beam at a patient without further calculation or adjustment. Nothing about the University of Washington facility can be said to discourage a person having ordinary skill in the art from modifying it to enable proton therapy or to lead the skilled artisan in a path divergent from the path taken by Loma Linda.

Second, we decline Loma Linda’s invitation to question the status of the CDR as prior art.... Here, IBA supported its motion for summary judgment of invalidity with evidence sufficient, if unopposed, to establish that the CDR was prior art; the burden of production then shifted to Loma Linda to identify genuine issues that preclude summary judgment. Because Loma Linda’s submissions to the district court failed to identify a genuine issue regarding the publication status of the CDR, we decline to consider the merits of that argument on appeal.

Third, Loma Linda’s argument that there is an issue of fact regarding the motivation to combine is unpersuasive.... Here, there is no question that the CDR establishes that a person having a working familiarity with particle beam technology as it relates to cancer treatment, motivated by the need for more effective and efficient proton therapy facilities, would have been led to combine the University of Washington’s neutron therapy facility with the proton beam therapy design outlined in the CDR. We see no error in the district court’s conclusion that a motivation to combine the two references exists as a matter of law.

Finally, the district court’s application of the law does not warrant reversal. The court analyzed the level of skill in the art, the scope and content of the prior art, the differences between the claimed invention and the prior art, and the alleged secondary considerations of non-obviousness. The court determined that a motivation to combine the prior art references existed, and that the references did not teach away from combination or modification, thereby guarding against a hindsight reconstruction of the invention. As discussed above, the combination of prior art references was proper, and Loma Linda’s opening brief does not contest the district court’s conclusion that the combination reads on every limitation in the ‘287 patent. Accordingly, we affirm the district court’s summary judgment holding the ‘287 patent invalid. Having affirmed the judgment of invalidity, we need not address the judgment of non-infringement.

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

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