

Süd-Chemie, Inc. v. Multisorb Techs., Inc.

No. 08-1247, Fed. Cir. (Rader, Friedman, Bryson*)

[C]onclusory statements in a patent's specification cannot constitute evidence of unexpected results in the absence of factual support.

On January 30, 2009, the Federal Circuit vacated and remanded the district court's summary judgment that U.S. Patent No. 5,743,942, which related to a desiccant container made from a water-vapor-permeable, multilayered packaging material, was invalid as obvious in view of U.S. Patent No. 4,487,791 (Komatsu). The Federal Circuit stated:

[C]laim 1 of the '942 patent requires that the inner surfaces of the microporous and laminate films be "comprised of compatible polymeric materials." The district court concluded that Komatsu teaches the use of compatible films because "[t]he Komatsu patent suggests the employment of the same materials claimed by the '942 patent to be 'compatible polymeric materials.'" [E]ven though the patents disclose the same classes of polymeric materials used to form the packaging material, the containers described in Komatsu and in the '942 patent are different in a way that the '942 patent treats as important to the invention. In essence, the Komatsu container is formed by heat-sealing a microporous layer with a high softening point to an inner laminate layer with a low softening temperature. In contrast, the '942 container is formed by sealing a microporous layer with a low softening point to an inner laminate layer that also has a low softening temperature. The district court looked only to the classes of materials described in the patents and did not examine the softening points of the materials. It therefore failed to recognize that Komatsu discloses the use of incompatible materials where the '942 patent requires compatible materials, and it therefore incorrectly concluded that Komatsu teaches the same container as that claimed in the '942 patent.

Süd-Chemie contends that secondary considerations, including unexpected results, copying, and commercial success indicate that the invention of the '942 patent would not have been obvious to a person of skill in the art. The district court did not explicitly address any of the secondary consideration evidence, other than to state that the '942 patent did not employ elements that worked together in an unexpected manner. As we have repeatedly emphasized, evidence relating to secondary considerations "constitutes independent evidence of nonobviousness" and can be quite instructive in the obviousness inquiry. The district court should therefore attend carefully to any evidence of these secondary considerations of nonobviousness on remand.

Süd-Chemie focuses in particular on the evidence of unexpected results. In that regard, Süd-Chemie argues that a person of skill in the art would not have expected uncoated laminate and microporous films to form stronger bonds than adhesive-coated films. In response to that argument, Multisorb contends that the '942 patent's mere assertion that "[i]t has been surprisingly discovered that

strong, laminated desiccant packaging materials can be produced from uncoated microporous or nonwoven films” is insufficient to establish an unexpected result.

Multisorb is correct that conclusory statements in a patent’s specification cannot constitute evidence of unexpected results in the absence of factual support. However, the ’942 patent provides evidence pertaining to the allegedly unexpected advantages of uncoated over coated films beyond its mere declaration that the results were surprising. Examples 1 and 2 of the ’942 patent describe embodiments of the desiccant container in which uncoated but compatible laminate and microporous films formed seals with an average strength of more than nine pounds per square inch. In contrast, Example 3 shows that coated but incompatible films produced weaker bonds with a seal strength of only 2.77 pounds per square inch. The specification therefore contains specific evidence pertinent to Süd-Chemie’s contention that the use of uncoated films yields advantages over more conventional combinations such as the incompatible surfaces disclosed in the Komatsu patent. The district court should consider that evidence, as well as any contrary evidence offered by Multisorb, as it pertains to the obviousness inquiry. Of course, evidence of unexpected results and other secondary considerations will not necessarily overcome a strong prima facie showing of obviousness, and we make no judgment as to the probative value of Süd-Chemie’s evidence regarding the asserted secondary considerations beyond emphasizing that the district court should take such evidence into account when conducting its obviousness analysis.

[T]he district court erred in certain respects in the course of ruling, on summary judgment, that the ’942 patent was invalid due to obviousness. While, as indicated above, we agree with much of the district court’s treatment of the differences between claim 1 of the ’942 patent and the prior art Komatsu patent, we disagree with the court’s analysis in two important respects: (1) with regard to its conclusion that Komatsu teaches using the same materials on the container’s inner surfaces as those claimed in the ’942 patent; and (2) with regard to its treatment of the evidence set forth in the ’942 specification that the use of compatible materials on the container’s inner surfaces produces results that are significantly better than the conventional sealing methods. Because our resolution of those issues may affect the trial court’s ultimate decision whether summary judgment of obviousness is appropriate in this case, we remand for further proceedings consistent with this opinion.

The previous statements are for information purposes only, and do not constitute legal advice. Questions regarding the matters discussed above, and any requests to be subscribed to the free electronic distribution of this publication, may be directed to Lawrence M. Sung, Ph.D., at +1 202.346.7850 or lsung@dl.com, or to any other Dewey & LeBoeuf LLP attorney with whom you regularly consult.

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