

Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.

No. 08-1333, Fed. Cir. (Lourie,* Clevenger, Linn)

“Under the flexible inquiry set forth [in KSR], the district court [must] take account of ‘the inferences and creative steps,’ or even routine steps, that an inventor would employ and by failing to find a motivation to combine related pieces from the prior art.”

On February 9, 2009, the Federal Circuit, inter alia, reversed the district court’s summary judgment that Limited infringed U.S. Patent No. 6,457,969, which related to a candle tin with a removable cover that also acts as a base for the candle holder, and vacated and remanded the summary judgment that the ‘969 patent was not invalid for obviousness. The Federal Circuit stated:

Obviousness under 35 U.S.C. § 103 is a question of law, with underlying factual considerations regarding (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the art, and (4) any relevant secondary considerations. A claimed invention is invalid for obviousness “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” . . .

The disagreement between the parties—and the sole basis for the district court’s denial of Limited’s motion for summary judgment of obviousness—is whether a motivation to combine the prior art existed. We think there clearly was such a motivation. “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” [I]f a combination of known elements was “obvious to try” to address a recognized problem, the combination may have been obvious under § 103.

Here, it is undisputed that the prior art discloses all the limitations of the claims. Most relevant to our analysis, the Wright patent discloses “protuberances” or “bumps” on the bottom of a candle can, and the Marchi patent discloses a combination cover-stand and includes a figure showing the invention configured with the candle holder resting on top of the stand. . . . It is also undisputed that the problem of scorching caused by the bottoms of hot candle holders was known and had been addressed by others by the time Kholsa began to work on the ‘969 patent. Finally, BASC did not dispute the district court’s adoption of Limited’s argument that because the “technology is simple and easily understandable,” the level of ordinary skill in the art was that of an ordinary layman of average intelligence.

“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” That is clearly the situation here. The combination of putting feet on the bottom of the candle holder and using the cover as a base for the candle holder was a predictable variation. . . . The combination of a cover-stand and feet on the bottom of the candle holder was obvious to try in an effort to minimize scorching, as the combination would further raise the bottom of the candle holder above the supporting surface. The resulting, and desired, decreased heat transfer between the candle holder and the supporting surface from the combination would have been entirely predictable and grounded in common sense.

In addition, the district court erred in finding a requirement in KSR of an explicit motivation to combine. The court faulted Limited for using what the court deemed “conclusory statements in lieu of an explanation of a motivation to combine.” [The court] misconstrued the language that the motivation to combine analysis “should be made explicit.” [T]he analysis that “should be made explicit” refers not to the teachings in the prior art of a motivation to combine, but to the court’s analysis. Here, all the limitations of claims 1 and 5 of the ’969 patent were in the prior art, as was the claimed configuration and a known problem of scorching. KSR thus compels the grant of summary judgment of obviousness. Under the flexible inquiry set forth by the Supreme Court, the district court therefore erred by failing to take account of “the inferences and creative steps,” or even routine steps, that an inventor would employ and by failing to find a motivation to combine related pieces from the prior art.

Finally, BASC asserts that the secondary consideration of commercial success supports the district court’s conclusion of nonobviousness. We disagree. The minimal indications of commercial success argued by BASC do not outweigh the clear indication of obviousness apparent from the prior art. Because BASC alleged infringement of only claims 1 and 5, those are the only claims in issue, and we render no judgment on any other claims. To the extent that the district court declared the patent “valid,” or all the claims of the patent “valid,” we vacate that declaration. Aside from the fact that courts do not declare patents to be valid, and only declare that they have not been proved to be invalid, if such is the case, courts should not adjudicate claims not put in issue by the parties, unless a holding with respect to contested claims necessarily implicates others, a situation that has not been argued to be the case here.

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