

SCIENTIFIC PLASTIC PRODS., INC. v. BIOTAGE AB, Appeals Nos. 2013-1219, -1220, -1221 (Fed. Cir. Sept. 10, 2014). Before Newman, Moore, Wallach. Appealed from Patent Trial and Appeal Board.

### Background:

Scientific Plastic Products (SPP) sued Biotage for infringement of three patents directed to resealable cartridges for low pressure liquid chromatography (LPLC). Biotage requested *inter partes* reexamination, and the infringement lawsuit was stayed.

During reexamination of the patents, the Examiner rejected all claims as having been obvious over two combinations of references. The primary reference taught an LPLC cartridge that included all features of the claimed cartridges other than the abutting inclined portions for forming a fluid-tight seal. The secondary references each taught resealable beverage containers having this sealing mechanism. The Examiner concluded that it would have been obvious for one of ordinary skill in the art to have used the sealing technology of either secondary reference in the LPLC cartridge of the primary reference to prevent leakage.

On appeal, PTAB affirmed the rejections and canceled all the claims. SPP appealed PTAB's decision.

### Issues/Holdings:

(1) Did PTAB err in concluding that the secondary references were analogous art? No, affirmed.

(2) Did PTAB err in holding that it would have been obvious to combine the teachings of the applied references? No, affirmed.

### Discussion:

The Federal Circuit acknowledged that the beverage container prior art was not from the same field of endeavor, and thus only constitutes analogous art if "reasonably pertinent to the particular problem with which the inventor is involved." The court rejected SPP's arguments that the particular problem is LPLC-specific, and characterized the secondary references as broadly addressing the problem of providing a fluid-tight seal between a container body and a resealable cap at elevated pressures. Because the problem addressed by the inventor was not LPLC-specific, the Federal Circuit determined that one of ordinary skill in the art would have looked to other pressurized systems, and specifically the secondary references, because they address a "sufficiently close" problem. Thus, the court held that these references are analogous art.

The Federal Circuit also held that one of ordinary skill in the art would have combined the prior art LPLC cartridge with the pressure-resistant beverage container caps to improve leakage issues with the prior art's cartridge because such leakage issues were a well-known problem. As evidence, the court relied on the identification of these issues in the patents at issue, and the primary reference's implicit acknowledgment of this problem through the use of an O-ring seal. The court therefore affirmed PTAB's holding that the claims would have been obvious over the applied art.

In dissent, Judge Moore argued that the majority had not resolved the issue of who was the person of ordinary skill in the art, had relied on the applicant's disclosure to establish the necessary motivation to combine the references, and ignored that the prior art cartridge does not in fact have a leakage problem. Judge Moore thus characterized the majority's opinion as "[h]indsight, hindsight, hindsight."