

WBIP, LLC v. KOHLER CO., Appeal No. 2015-1038, -1044 (Fed. Cir. July 19, 2016). Before Moore, O'Malley, and Chen. Appealed from D. Mass. (Judge Gorton).

Background:

WBIP and Kohler are competitors that both manufacture and sell marine generators ("gen-sets"). WBIP owns patents directed to marine engine exhaust systems that reduce the amount of carbon monoxide released in the exhaust. In 2011, WBIP sued Kohler for infringement, alleging that Kohler's low-carbon monoxide gen-sets infringed WBIP's patents. A jury ruled in favor of WBIP and found that Kohler infringed the asserted claims.

Kohler moved for judgment as a matter of law, alleging that the claims of WBIP's patents were invalid as being obvious over U.S. Patent No. 5,832,896 ("Phipps"). Kohler argued and WBIP did not dispute that Phipps disclosed all the features of the claimed invention except for the known elements of a catalyst and a coolant injector.

Kohler argued that combining Phipps with the known coolant elements, which are necessary for marine engines, would produce the claimed invention. Kohler presented evidence that a skilled artisan would have been motivated to add the known coolant elements to Phipps to produce the claimed invention.

WBIP argued that one of ordinary skill in the art would not have been motivated to convert Phipps into a marine engine. At trial, WBIP's expert testified that Phipps was "totally reverse" to a marine engine so that a skilled artisan would not have started with Phipps to produce WBIP's invention. WBIP also presented evidence of a nexus between the claimed invention and objective evidence of non-obviousness, including a long-felt need for the reduced amounts of carbon monoxide, industry praise, industry skepticism, copying by Kohler, and commercial success.

The district court held that Kohler infringed WBIP's patents and that Kohler failed to prove that the asserted claims were invalid for obviousness. Kohler appealed.

Issue/Holding:

Did the district court err in finding that WBIP's asserted claims would not have been obvious in view of Phipps? No, affirmed.

Discussion:

The Federal Circuit reviewed the *Graham* factors using the objective evidence presented by both parties and found no error in the district court's determination that Kohler failed to prove by clear and convincing evidence that the asserted claims were obvious in view of Phipps. The Federal Circuit ruled that WBIP's evidence of secondary considerations including long-felt need, industry praise, industry skepticism, copying, and commercial success provided a presumption of non-obviousness.