

SOFT GEL TECHNOLOGIES, INC., v. JARROW FORMULAS, INC., Appeal Nos. 2016-1814, 2016-1815 and 2017-1051 (Fed. Cir. July 26, 2017). Before Prost, Bryson and Hughes. Appealed from PTAB.

Background:

Jarrow requested *inter partes* reexamination for each of Soft Gel's patents directed to a method for dissolving a coenzyme CoQ10 in a solvent d-limonene. The Board found that the prior art references disclose all elements recited in Soft Gel's patents. The Board also found that one of ordinary skill in the art would have been motivated to combine these references and would have had a reasonable expectation of success in doing so, thereby invalidating the claims of Soft Gel's patents. Soft Gel appealed the Board's factual finding that, *inter alia*, a person of ordinary skill in the art would have had a reasonable expectation of success regarding combining the prior art references to arrive at Soft Gel's invention.

Issue/Holding:

Did the Board err in finding that a person of ordinary skill in the art would have had a reasonable expectation of success in combining the prior art references to arrive at Soft Gel's invention? No, affirmed.

Discussion:

Before the Federal Circuit, Soft Gel argued that the prior art references fail to expressly disclose d-limonene. Instead, one prior art reference discloses dissolving CoQ10 in lemon oil. Based on this omission, Soft Gel argued that a skilled artisan would not have had a reasonable expectation of success in dissolving CoQ10 in d-limonene.

However, the Federal Circuit found that Soft Gel ignored the Board's finding that the main constituent of lemon oil is d-limonene. Further, the Federal Circuit found that: (1) one prior art reference suggests testing the interaction between carvone and CoQ10 as well as testing the interaction between limonene and CoQ10, and (2) another prior art reference teaches that carvone successfully dissolves CoQ10. The Federal Circuit concluded that a person of ordinary skill would reasonably expect that limonene, like carvone, would also successfully dissolve CoQ10.

Soft Gel also argued that the inventor of one prior art reference conducted additional experiments (after the priority dates of Soft Gel's patents), which investigated the use of d-limonene in lemon oil to dissolve CoQ10. Soft Gel maintained that the reason for why this author conducted "follow up" research was because "it must not have been obvious that the lemon oil results in his earlier experiments were attributable to d-limonene."

The Federal Circuit disagreed, and held that Soft Gel's argument applies an incorrect legal standard for obviousness, requiring "absolute predictability" rather than "a reasonable expectation of success." The Federal Circuit acknowledged that the prior art discloses lemon oil, and not specifically d-limonene. But, the Federal Circuit ruled that this does not mean that a skilled artisan would not expect d-limonene, the main constituent of lemon oil, to work. The Federal Circuit concluded that a "supplemental study does not imply lack of awareness of the likely result; rather, studies are frequently conducted to confirm what is suspected to be true."