

HOLOGIC, INC. v. SMITH & NEPHEW, INC., Appeal No. 2017-1389
(Fed. Cir. March 14, 2018) (Newman, Stoll, Wallach). Appealed from the U.S. Patent and Trademark Office.

Background:

Hologic initiated an inter partes reexamination of Smith & Nephew's ("S&N") patent asserting that S&N's patent would have been obvious from the PCT application to which S&N's patent claims priority. Hologic asserted that the earlier-filed PCT application does not qualify as a priority document because the PCT application does not support the claimed "light guide." The PCT application disclosed a "fibre optics bundle," which the Examiner in the inter partes reexamination determined did not provide sufficient support for the claim term "light guide." As a result, the Examiner determined the earlier-filed PCT application qualified as prior art for S&N's patent, and rendered the claims obvious.

S&N appealed to the Board and argued that the PCT application reasonably conveys to a skilled artisan that the inventor of S&N's patent had possession of a "first channel having a light guide permanently affixed therein," as recited in the claims of S&N's patent. The Board reversed the Examiner's obviousness rejection by finding that the PCT application provides sufficient written description to support the claimed features of S&N's patent, and thus the PCT application does not qualify as prior art. The Board reasoned that the disclosure of the "fibre optics bundle" of the PCT application in light of the knowledge of a skilled artisan sufficiently describes the claimed "light guide." Hologic appealed.

Issue/Holding:

Did the Board err in finding that the earlier-filed PCT application provided sufficient written description for the claims of S&N's patent? - No, affirmed.

Discussion:

The Federal Circuit held that substantial evidence supports the Board's finding that S&N's patent is entitled to claim priority to the PCT application because the PCT application reasonably conveys to a skilled artisan that the inventor had possession of the claimed "first channel having a light guide permanently affixed therein." The Federal Circuit held that the Board properly relied on the fact that the parties did not dispute that a "fibre optic bundle" is a type of light guide, and that various types of light guides were well-known in the art. The Federal Circuit held that substantial evidence supports the Board's conclusion that a person of ordinary skill, reviewing the figures and specification of the PCT application, would have understood that the inventor had possession of "a light guide permanently affixed" in the first channel.

Hologic argued that the PCT application only discloses a "fibre optics bundle," and does not explicitly describe the location of the "fibre optics bundle" in the first channel. However, the Federal Circuit held that a skilled artisan considering the combination of the disclosure of the specification and the drawings of the PCT application would have understood that the disclosure of the "fibre optics bundle" provides sufficient written description support for the claimed "first channel having a light guide permanently affixed therein."