



UNITED STATES PATENT AND TRADEMARK OFFICE

Inherency

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Inherency

- **The rule that anticipation can be inferred despite a missing element in a prior-art reference if the missing element is either necessarily present in or a natural result of the product or process and a person of ordinary skill in the art would know it (Black's Law Dictionary, 8th Ed. 2004)**
- **Can also be asserted by applicant when amending the specification and/or the claims or when asserting priority to demonstrate support and avoid new matter**



Inherency

- **Structure**
- **Use**
- **Advantage or Property**



Inherency

- **Inherent feature need not have been recognized in the prior art**

Atlas Powder v. IRECO, 190 F.3d 1342, 51 USPQ2d 1943 (Fed. Cir. 1999)



Inherency

- **Inherency cannot be established by probabilities or possibilities**
- **The mere fact that a certain thing may result from a given set of circumstances is not sufficient**

**In re Oelrich, 666 F.2d 578, 212 USPQ 323
(CCPA 1981)**



In re Runion, 989 F.2d 1201 (Fed. Cir. 1993) (Nonprecedential)

- **Claim:**
 - **A bird feeder with pan for holding the food with one vertical surface having an abrasive means for abrading beaks of birds as they feed**
- **Prior art:**
 - **A baking pan for baking bread within which vegetable grit was coated on all of the surfaces to ensure easy removal of the bread by tilting or overturning the pan**



In re Runion, 989 F.2d 1201 (Fed. Cir. 1993) (Nonprecedential)

- **Board found that the grit coating of the bread pan performed the function of the claim, i.e. abrading bird beaks**
- **Court disagreed, determining that a surface described as “rough” or “pebbled” need not necessarily be “abrasive”**
- **The explanation of the character of the bread pan coating was not consistent with the explanation of the abrasive means in the specification**



Inherency

- **Structure**
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Chen v. Bouchard, 347 F.3d 1299, 68 USPQ2d 1705 (Fed. Cir. 2003)

- **In parent application, Chen claims 7-substituted fluorotaxols and discloses a process to produce mixture of fluorotaxols**
- **Application is allowed but Chen petitions to withdraw from issue due to error and then files a CIP with new claims and new drawings to 7,8-cyclopropataxol**



Chen v. Bouchard, 347 F.3d 1299, 68 USPQ2d 1705 (Fed. Cir. 2003)

- **Interference is instituted between Chen and Bouchard over claims to the 7,8-cyclopropataxols in the CIP**
- **Chen attempted to rely on filing date of parent application to establish earlier conception and reduction to practice**
- **Board denied benefit claim and found Chen to be the junior party, due to lack of adequate written description of the count in the parent**



Chen v. Bouchard, 347 F.3d 1299, 68 USPQ2d 1705 (Fed. Cir. 2003)

- **Chen appealed and argued inherency to support claim for benefit**
- **Chen asserted that since disclosed methods invariably produced the cyclopropataxols, the products inherently had the structures in the counts**
- **Chen argued that it should not matter what the inventors initially believed was the result of the disclosed method or when the error was discovered**



Chen v. Bouchard, 347 F.3d 1299, 68 USPQ2d 1705 (Fed. Cir. 2003)

- **Bouchard argued that Chen never described any compounds of the counts**
- **Bouchard pointed to the NMR and mass spec data in the parent application which corresponded only to the erroneously-identified compounds**



Chen v. Bouchard, 347 F.3d 1299, 68 USPQ2d 1705 (Fed. Cir. 2003)

- **Court agreed with Bouchard**
- **Court affirmed the Board's holding that the subject matter of the count was not adequately described in Chen's earlier application**
- **Court distinguished cases relied upon by Chen**



Chen v. Bouchard, 347 F.3d 1299, 68 USPQ2d 1705 (Fed. Cir. 2003)

- **Cases relied upon by Chen**
 - **In re Nathan, 328 F.2d 1005, 140 USPQ 601 (CCPA 1964)**
 - **In re Magerlein, 346 F.2d 609, 145 USPQ 683 (CCPA 1965)**
 - **Spero v. Ringold, 377 F.2d 652, 153 USPQ 726 (CCPA 1967)**
 - **Regents of the University of New Mexico v. Knight, 321 F.3d 1111, 66 USPQ2d 1001 (Fed. Cir. 2003)**



Schering Corp. v. Geneva Pharmaceuticals, 339 F.3d 1373, 67 USPQ2d 1664 (Fed. Cir. 2003)

- **Claim recited descarboethoxyloratidine (DCL)**
- **DCL is a metabolite formed in the body after administration of loratidine**
- **DCL is also an antihistimine that does not make the user sleepy**
- **Infringement proceeding between patent holder and generic manufacturers**
- **Invalidity based on anticipatory prior art was alleged and summary judgment was granted in favor of generic manufacturers by the district court**



Schering Corp. v. Geneva Pharmaceuticals, 339 F.3d 1373, 67 USPQ2d 1664 (Fed. Cir. 2003)

- **Claim to compound was construed by the district court to cover compound in all forms, wherever found**
- **Prior patent disclosed administration of loratidine to patients**
- **Prior patent did not explicitly disclose DCL and did not expressly refer to metabolites of loratidine**



Schering Corp. v. Geneva Pharmaceuticals, 339 F.3d 1373, 67 USPQ2d 1664 (Fed. Cir. 2003)

- **Evidence showed that DCL is an inevitable consequence of loratidine administration**
- **Court held that prior art administration of loratidine to patients inherently anticipated claims to the DCL compound**
- **Court points out that patent protection is available to metabolites of known drugs but cautions proper claiming**



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Ex parte Novitski, 26 USPQ2d 1389 (BPAI 1993)

- Claim for protecting a plant from pathogenic nematodes comprised step of inoculating the plant with nematode-inhibiting strain of *Pseudomonas cepacia*
- Prior art disclosed inoculating plants with *P. cepacia* type Wisconsin 526 to inhibit fungal pathogens
- *P. cepacia* type Wisconsin 526 inhibited nematodes



Mehl/Biophile International Corp. v Milgraum, 192 F.3d 1362, 52 USPQ2d 1303 (Fed. Cir. 1999)

- **Claim recited laser hair removal requiring vertical alignment of the laser light applicator over a hair follicle and applying a pulse of laser energy of a wavelength that is readily absorbed by the melanin of the papilla and has a dose of sufficient energy for sufficient duration to damage the papilla such that hair regrowth is prevented and scarring of the surrounding skin is avoided**
- **Prior art relied upon for anticipation was a manual for laser use for tattoo removal and a research paper discussing effects of laser energy on melanosomes in guinea pig skin**



Mehl/Biophile International Corp. v Milgraum, 192 F.3d 1362, 52 USPQ2d 1303 (Fed. Cir. 1999)

- **Court found vertical alignment was not inherent in the laser manual – the manual did not discuss hair follicles and only teaches “aiming” the laser at skin pigmented by a tattoo and the court found no necessary relationship between the location of the tattoo and the hair follicle opening**
- **Court found vertical alignment was inherent in research article because the article specifically mentioned disruption of hair follicles and stated that the laser was held in contact with the animals’ skin**



Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 77 USPQ2d 1321 (Fed. Cir. 2005)

- **Infringement proceeding where defendant alleged invalidity based on anticipation by inherency**
- **Claims recited methods of treating sunburned skin**
- **Prior patent disclosed the same composition as suitable for general topical application to the skin or hair**
- **District court found that the prior composition would have inherently functioned in the treatment of sunburned skin when topically applied to the skin**



Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 77 USPQ2d 1321 (Fed. Cir. 2005)

- **Federal Circuit disagreed, concluding that sunburned skin is not analogous to all skin surfaces**
- **Since claim required treatment of sunburned skin, the issue was not whether the prior art's composition would have inherently treat sunburned skin if applied (it would), but whether the prior art disclosed the application of the composition to sunburned skin (it did not)**



Inherency

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In re Cruciferous Sprout Litigation, 301 F.3d 1343, 64 USPQ2d 1202 (Fed. Cir. 2002)

- **Claim recited method of preparing a food product rich in glucosinolates and rich in high Phase 2 enzyme-inducing potential comprising germinating cruciferous seeds and harvesting sprouts to form a food product**
- **Prior art taught germinating broccoli seeds, harvesting the sprouts and selling them as a food product**
- **District court found inherent anticipation of the claim**



In re Cruciferous Sprout Litigation, 301 F.3d 1343, 64 USPQ2d 1202 (Fed. Cir. 2002)

- **Plaintiff contended that the district court failed to treat the preamble (“rich in glucosinolates” and “high Phase 2 enzyme-inducing potential”) as a limitation**
- **Plaintiff also contended that the second phrase should be limited to require “at least 200,000 units per gram fresh weight of Phase 2 enzyme-inducing potential” to meet the limitation of “high” enzyme-inducing potential**



In re Cruciferous Sprout Litigation, 301 F.3d 1343, 64 USPQ2d 1202 (Fed. Cir. 2002)

- **Federal Circuit found that the phrases were limitations of the claim**
- **However, the court also held that Plaintiff's proposed claim construction of those terms was improperly limiting in view of the record**
- **As a result, the court found that the broccoli sprouts of the prior art inherently had the claimed property and therefore inherently anticipated the claims**



Highlights and Guidance

- **The Examiner must provide rationale or evidence to support a conclusion of inherency**
- **Once the Examiner presents a *prima facie* case to support a conclusion of inherency, the burden shifts to the Applicant to show that there is no inherency**



Highlights and Guidance

- **Structural inherency is more easily asserted if corroborating evidence is present in the specification**
- **Claims to compounds may not be patentable if the compounds existed in the prior art regardless of whether they were identified or recognized, but methods of use and pharmaceutical compositions for that use may be more successful**



Highlights and Guidance

- **Claims to products, compositions or articles of manufacture that are claimed functionally may not be patentable if the evidence indicates that a prior art product, composition or article of manufacture that meets all structural limitations is suitable for or capable of performing the claimed function**



Highlights and Guidance

- **Recognition of a new use or inherent property of a prior art compound, product, composition or article of manufacture may not be patentable in claims directed to compound, product, composition or article of manufacture, but may be more successful in method claims**



MPEP Citations

- **2112 – Requirements of rejections based on inherency**
 - **2112.01 – Composition, product and apparatus claims**
 - **2112.02 – Process claims**
- **2131.01 – Multiple references may be used in a 102 rejection to support the primary reference to show inherency – supportive reference(s) may be post-filing**



Thank You!

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