

Keywords: Obviousness, relevant prior art, references and claims as a whole, properties of compositions

General: If the prior art suggests an inventor's compound or composition per se, that compound or composition would be *prima facie* obvious, regardless of the properties disclosed in the inventor's application.

In re Dillon

16 U.S.P.Q.2d 1897 (Fed. Cir. 1990)

Decided November 9, 1990

I. Facts

Dillon filed a patent application relating to the discovery that the inclusion of certain tetra-orthoester compounds in hydrocarbon fuel compositions will reduce the emission of solid particulate (i.e., soot) during combustion of the fuel. The claims were rejected under 35 U.S.C. § 103 in view of certain primary and secondary references. The primary reference disclosed hydrocarbon fuel compositions having tri-orthoesters therein for the purpose of "dewatering." The secondary reference disclosed tri-orthoester and tetra-orthoesters for use as water scavengers in hydraulic (non-hydrocarbon) fluids. Dillon appealed the rejection to the Board of Patent Appeals and Interferences, which upheld the rejection. On appeal were claims to hydrocarbon fuel compositions containing these tetraorthoesters, and to the method of using those compositions to reduce particulate emissions during combustion. The Board concluded that the claimed composition and method "would have been *prima facie* obvious from the combined teachings of the references."

Dillon appealed to the Federal Circuit, which reversed the Board's decision. On the issue of *prima facie* obviousness, the original *Dillon* panel held:

The weight of precedent is to the effect that when the claimed subject matter is a new chemical compound or composition, a *prima facie* case of obviousness is not deemed made unless both (1) the new compound or composition is structurally similar to the reference compound or composition and (2) there is some suggestion or expectation in the prior art that the new compound or composition will have the same or similar utility as that discovered by the applicant.

Having found that the prior art did not suggest that the claimed composition would have the property and use discovered by Dillon, the original Federal Circuit panel held that the prior art did not constitute a *prima facie* case of obviousness and reversed on that ground.

On rehearing of the case by the Federal Circuit en banc, the majority reversed the original panel's decision.

II. Issues

- A. Did the original Federal Circuit panel properly consider Dillon's "invention as a whole," including properties and utility undisclosed in the prior art, when considering the obviousness of the invention?
- B. Should the Federal Circuit have considered the patentability of Dillon's method claims?

III. Discussion

- A. No. The en banc panel held "it is not necessary in order to establish a *prima facie* case of obviousness . . . that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by applicant," and concluded that here a *prima facie* case was established because "[t]he art provided the motivation to make the claimed compositions in the expectation that they would have similar properties."

Dillon cited *In re Wright*, 6 USPQ2d 1959, 1961 (Fed. Cir. 1988) to support the proposition that the prior art must suggest the claimed compositions' properties as well as the problem that the applicant attempts to solve. Dillon argued that the claimed compositions had particulate emission reducing properties that were undisclosed in the prior art, and that one with skill in the art would not have been motivated to combine the references to produce a composition with Dillon's disclosed utility.

Although the motivation to combine the references differs from that of Dillon, the Federal Circuit held that the motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness. The Federal Circuit overruled any holdings of *In re Wright* that were contrary to *In re Dillon*.

As the PTO properly demonstrated a case of *prima facie* obviousness, the burden then shifted to Dillon to rebut. The Federal Circuit held that any evidence of unexpected properties of the claimed compounds must be considered. However, Dillon provided no such evidence.

Finally, Dillon argued that the cited references were non-analogous art. The Federal Circuit held that the references could not be excluded on this basis, as they were "within the field of the inventor's endeavor."

- B. No. The Federal Circuit declined to consider the patentability of the method claims, noting that Dillon's appeal to the Board did not argue separate patentability of composition and method claims.

The Federal Circuit, in declining to consider the patentability of the method claims, expressly noted that it would not be appropriate to apply the standard of *In re Durden* 763 F.2d 1406 (Fed. Cir. 1985) to consider the patentability of the method claims. *In re Durden* held that the use of a nonobvious starting material in an old process does not necessarily result in a nonobvious process:

[A]n otherwise old process becomes a new process when a previously unknown starting material, for example, is used in which it is then subjected to a conventional manipulation or reaction to produce a product which may also be new, albeit the unexpected result of what is done. But it does not necessarily mean that the whole process has become unobvious in the sense of § 103. In short, a new process may still be obvious when considered 'as a whole,' notwithstanding the specific starting material or resulting product, or both, is not found in the prior art.

Here, the Federal Circuit rejected the idea *In re Durden* should be a standard applied to all method claims, stating that “[w]hen any applicant properly presents and argues suitable method claims, they should be examined in light of all . . . relevant factors, free from any presumed controlling effect of *Durden*.”