

Keywords: obviousness; secondary considerations; commercial success.

General: Commercial success evidence should be considered so long as what was sold was within the scope of the claims. The patent applicant need not sell every conceivable embodiment of the claims in order to rely upon evidence of commercial success.

In re Glatt Air Techniques, Inc.
No. 2010-1141 (Fed. Cir. January 5, 2011)

I. Facts

Glatt Air Techniques, Inc. (“Glatt”) owns U.S. Patent No. 5,236,503 (“503 patent”) directed to a coating apparatus known as a Wurster coater. Wurster coaters coat particles (e.g., pharmaceutical ingredients) by spraying a coating material onto the particles as they circulate within the coating apparatus. Prior art Wurster coaters suffered from particle agglomeration, because the circulating particles prematurely entered the stream of coating material before the spray pattern was fully developed. To solve this problem, Glatt developed a shielding for the coating spray nozzle to prevent the particles from entering the spray prematurely.

Claim 5 recites the invention in “Jepson” format, with the preamble defining the prior art:

5. In a fluidized bed coater having a product container opening upwardly into an expansion chamber and downwardly into a lower plenum chamber through an air distribution plate/screen having openings formed therethrough for upward air flow from said lower plenum chamber into said product container, said product container including a substantially cylindrical partition spaced above said air distribution plate/screen for defining an inner upbed area and an outer downbed area, and an upwardly discharging spray nozzle mounted substantially centrally within said cylindrical partition, **the improvement comprising shielding means positioned adjacent said spray nozzle for shielding the initial spray pattern developed by said nozzle against the entrance of particles moving upwardly through the upbed.**

Because the claim uses “means-plus-function” language to recite the novel aspect of the invention, the claim element is construed with reference to the specification. The specification of the ‘503 patent provides embodiments of the invention that include a cylindrical partition surrounding the coating spray nozzle that acts as a physical shield to prevent premature entry of the circulating particles. Additionally, the specification notes that “other shielding arrangements may be utilized. For example, shielding of the spray nozzle may be accomplished by formation of an air wall or stream that surrounds the nozzle and prevents particles from prematurely entering into the spray pattern.”

In 2007, a third party requested ex parte reexamination of the patent. The U.S. Patent and Trademark Office (“PTO”) granted reexamination. The examiner found the Wurster coating apparatus described in the preamble of claim 5 to be admitted prior art because “preamble elements in a Jepson-type claim are impliedly admitted to be old in the art...” The examiner rejected claim 5 as obvious in view of the admitted prior art and German Patent DE 3323418 (“Naunapper”).

Naunapper combats particle agglomeration by temporarily increasing airflow from the circulation air source. The burst of air clears blockages by blowing through the agglomeration and dispersing the particles. The examiner argued that Naunapper teaches an air wall shielding means and that it would be obvious to combine Naunapper’s shielding means with the admitted prior art.

In addition to traversing the examiner's obviousness rejection, Glatt provided secondary consideration evidence, including commercial success, to rebut the examiner's prima facie case of obviousness. The examiner determined that Glatt's secondary evidence was not commensurate in scope with claim 5, and found the evidence to be insufficient to overcome the prima facie case of obviousness.

Glatt appealed the examiner's rejection to the Board of Patent Appeals and Interferences ("Board"), which affirmed the examiner's rejection. The Board found that Naunapper "plainly teaches an arrangement that can provide... an air wall or stream surrounding the [coating spray] nozzle to address the same or similar problem discussed in the '503 Patent." Additionally, the Board agreed with the examiner that Glatt's evidence was unpersuasive because "no evidence demonstrates any unexpected result or commercial success based on the actual difference between the claimed invention, as broadly recited, and Naunapper's apparatus." Thus, the Board concluded that the secondary considerations were insufficient to outweigh the evidence of obviousness. Glatt appealed.

II. Issues

- A. Did the Board err in finding a prima facie case of obviousness over claim 5 of the '503 patent?
- B. Did the Board err in rejecting Glatt's secondary considerations evidence?

III. Discussion

- A. Yes. The Federal Circuit found that while the Board was correct in finding that Naunapper teaches modulating gas flow in the coating apparatus, Naunapper does not teach shielding circulating particles from entering the initial spray pattern. The court found that Glatt's invention prevents the agglomeration from occurring, while Naunapper teaches a way to remedy a blockage caused by the agglomeration. Thus, the court held that because Naunapper does not teach shielding, the Board failed to make a proper rejection based on a prima facie case of obviousness.
- B. Yes. The examiner and the PTO agreed that Glatt's secondary considerations were not commensurate with the scope of claim 5. The PTO construed "shielding means" to include both a physical shield and an air wall shield. The PTO suggested that for the submitted evidence to be commensurate in scope with claim 5, Glatt must provide evidence addressing the air wall means. The Federal Circuit disagreed with this position, finding that precedent clearly dictates that Glatt need not provide commercial success evidence from multiple embodiments for the evidence to be commensurate in scope with claim 5. The court reasoned that it is unlikely that a company would sell a product containing multiple, redundant embodiments of a patented invention and thus, under the PTO's logic, there would never be commercial success evidence for a claim that covers more than one embodiment.

IV. Conclusion

A patent applicant "need not sell every conceivable embodiment of the claims in order to rely upon evidence of commercial success." Commercial success evidence should be considered "so long as what was sold was within the scope of the claims."