FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Perricone, M.D. v. Medicis Pharm. Corp., 05-1022 (Fed. Cir. Dec. 20, 2005) (Rader, J.)

The court affirmed a summary judgment that most claims in Dr. Perricone's two patents for methods to treat skin with Vitamin C were invalid due to anticipation, or suffered from obviousness-type double patenting. For one group of claims, however, the court reversed the district court's inherency determination. Judge Bryson concurred-in-part and dissented-in-part, arguing that this group of claims was inherently anticipated.

Dr. Perricone owns two U.S. Patents, Nos. 5,409,693 and 5,574,063, "for methods of treating or preventing sunburns (the '693 patent) and methods of treating skin damage or disorders (the '063 patent)."

> [B]oth patents disclose essentially the same subject matter: treatment or prevention of various forms of skin damage through the topical application of ascorbic acid (Vitamin C) in a fat soluble form.

The court affirmed the obviousness-type double patenting summary judgment.

> [T]he district court properly resolved the apparent difference between treatment of various types of skin damage in claims 9 and 16 of the '063 patent and treatment of sunburn in claim 1. Sunburn is a species of skin damage. As such, this court perceives no error in the district court's determination that the earlier species renders the later genus claims invalid under non-statutory double patenting.

The anticipating prior art reference was Pereira.

> The district court concluded that Pereira's disclosed use anticipates Dr. Perricone's claims because Pereira's disclosed compositions include all the various ingredients in the concentrations claimed by Dr. Perricone. Thus, according to the district court, the topical application of Pereira's compositions would necessarily yield Dr. Perricone's claimed skin benefits.

One group of claims, however, withstood anticipation by Pereira.

> Claim 1 of the '693 patent, from which claims 2-4 and 7 ultimately depend, specifically recites application of the fatty acid ester to "skin sunburn." This claim term raises a different problem. The issue is not, as the dissent and district court imply, whether Pereira's lotion if applied to skin sunburn would inherently treat that damage, but whether Pereira discloses the application of its composition to skin sunburn. It does not. . . .
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> Claim 1 of the '693 patent recites a new use of the composition disclosed by Pereira, i.e., the treatment of skin sunburn. The district court's inherent anticipation analysis for this claim contains a flaw. The disclosed use of Pereira's lotion, i.e., topical application, does not suggest application of Pereira's lotion to skin sunburn. In other words, the district court's inherency analysis goes astray because it assumes what Pereira neither disclosed nor rendered inherent.

The other anticipated claims recited application to the skin generally, or to aging skin, the latter being inherently anticipated by Pereira because all skin ages.

Judge Bryson had a different view of certain claims in the '693 patent.

> I dissent . . . from the portion of the judgment holding that the Pereira patent does not anticipate claims 1-4 and 7 of the sunburn patent [the '693 patent]. In my view, the differences between the claims that the court invalidates and those that it holds not to be invalid do not justify a difference in outcome. The written description of the sunburn patent is identical to the pertinent portions of the written description of the skin disorder patent in all material respects. The only significant difference between the two patents for present purposes is that the sunburn patent claims methods for treating and preventing sunburn comprising the topical application of the composition described in the specification, while the skin disorder patent claims a method for treating skin disorders comprising the topical application of the same composition. Moreover, the only difference between the claims of the sunburn patent that this court invalidates and those that it upholds is that the former recite methods for preventing sunburn while the latter recite methods for treating sunburn. The differences between the sunburn and the skin disorder patents, and among the claims of the sunburn patent, simply highlight inherent features of the compositions that are disclosed both in the common written description of the two patents in suit and in the Pereira patent. Under our precedents, those differences do not suffice to avoid anticipation.

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