FEDERAL CIRCUIT PATENT LAW CASE UPDATE

In re Johnston, 05-1321 (Fed. Cir. Jan. 30, 2006) (Newman, J.)

The court affirmed the Board of Patent Appeals and Interferences' determination that all claims in Johnston's application for a patent covering large diameter spiral pipe were either anticipated or obvious. Within the obviousness inquiry, the Board correctly found a motivation-to-combine because the prior art "shows the suitability of spirally formed pipe in large cylindrical/shaped structures" and the references disclosing the motivation-to-combine were highly relevant.

Johnston's patent application claims a "large diameter spiral pipe, in excess of 12 or 15 feet in diameter, formed by bending a long sheet of metal or other ductile material into a helix, and then joining the adjacent edges by welding or other means to form a pipe into shapes such as cylindrical or arched."

Citing four U.S. Patents and other materials, the examiner rejected the claims as unpatentable.

> The Board adopted the dictionary definition of "pipe" as "a tubular or cylindrical object, part or passage," and held that on this definition large cylindrical structures such as silos and storage tanks are "pipes" within the meaning and scope of the claims, rendering the claims obvious or anticipated. . . . It is well established that dictionary definitions must give way to the meaning imparted by the specification, Phillips v. AWH Industries, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), but in this case Mr. Johnston himself gave "pipe" the broad meaning he now criticizes.

The court affirmed the Board's determination that a number of the claims were anticipated as fully disclosed in the prior art references.

Claims 5-9, however, required an obviousness inquiry.

> Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination. . . . An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art. As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the field of the specific invention, the subject matter of the references, the extent to which they are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field. . . .
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> The Board found motivation to combine the teachings of the Steel Handbook and PRD Cortec, in that both references deal with the same field of technology, and both show spirally formed pipe of large diameter. The Handbook teaches the interchangeability of round and arched pipe in various applications, and recognizes the need to provide greater capacity without increasing height, such as for use in a culvert under a road. The Handbook also teaches that spirally-formed round pipe can be re-shaped into arch shapes to provide greater cross-sectional area for a given height. PRD Cortec teaches the formation of a 15-foot diameter spirally-formed pipe, but does not explicitly show deforming such pipe into other shapes, such as arches. . . .
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> We agree with the Board that PRD Cortec contains the motivation or suggestion to combine its large diameter pipe with the teachings of the Handbook. PRD Cortec shows the suitability of spirally-formed pipe in large cylindrical/shaped structures, and the Handbook shows large cylindrical/shaped structures. These teachings are in the same field of endeavor and deal with related subject matter.

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