

ALERT

Federal Circuit Patent Bulletin: *Kennametal, Inc., v. Ingersoll Cutting Tool Co.*

March 25, 2015

"While references that anticipate an invention can, theoretically, still not make it obvious, that is the rare case."

On March 25, 2015, in *Kennametal, Inc., v. Ingersoll Cutting Tool Co.*, the U.S. Court of Appeals for the Federal Circuit (Prost, Newman, Linn*) affirmed the U.S. Patent and Trademark Office Patent Trial & Appeal Board decision in an inter partes reexamination of U.S. Patent No. 7,244,519, which related to cutting tools containing ruthenium as a binder that are coated using physical vapor deposition (PVD), that upheld the patent examiner's anticipation and obviousness rejections. The Federal Circuit stated:

A patent is invalid if "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States." A prior art reference can only anticipate a claim if it discloses all the claimed limitations "arranged or combined in the same way as in the claim." However, a reference can anticipate a claim even if it "d[oes] not expressly spell out" all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would "at once envisage" the claimed arrangement or combination. . . .

Substantial evidence supports the Board's determination that pending claim 1 of the '519 patent is anticipated. Kennametal does not contest that, with the exception of combining ruthenium binders with PVD

Authors

Lawrence M. Sung
Partner
202.719.4181
lsung@wiley.law

coatings, claim 5 of Grab expressly recites all the elements of pending claim 1. . . . Because all the limitations of Kennametal's claim are specifically disclosed in Grab, the question for the purposes of anticipation is "whether the number of categories and components" disclosed in Grab is so large that the combination of ruthenium and PVD coatings "would not be immediately apparent to one of ordinary skill in the art." The fact that a skilled artisan had various ways of formulating a coated cutting insert based on Grab's teaching does not help Kennametal, since many of these are within the scope of its claim.

At the very least, Grab's express "contemplat[ion]" of PVD coatings is sufficient evidence that a reasonable mind could find that a person of skill in the art, reading Grab's claim 5, would immediately envisage applying a PVD coating. Thus, substantial evidence supports the Board's conclusion that Grab effectively teaches 15 combinations, of which one anticipates pending claim 1.

Though it is true that there is no evidence in Grab of "actual performance" of combining the ruthenium binder and PVD coatings, this is not required. "Rather, anticipation only requires that those suggestions be enabled to one of skill in the art." Accordingly, we affirm the Board's determination that pending claim 1 is anticipated. . . .

"A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Obviousness is a question of law, based on underlying factual determinations, including: "the scope and content of the prior art"; "differences between the prior art and the claims at issue"; "the level of ordinary skill in the pertinent art"; and "[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc." The Patent Office "bears the initial burden of showing a prima facie case of obviousness. When a prima facie case of obviousness is made, the burden then shifts to the applicant to come forward with evidence and/or argument supporting patentability."

Kennametal claims that the Board failed to establish a prima facie case of obviousness. . . . Substantial evidence supports the Board's factual determination that Grab expressly taught combining a ruthenium binder with a PVD coating. While references that anticipate an invention can, theoretically, still not make it obvious, that is the rare case. Here, because a person of skill in the art reading Grab would readily envisage the combination of ruthenium binders and PVD coatings, it would have been obvious to that person that these two could be combined with a reasonable expectation of success. Substantial evidence supports the Board's finding that this express teaching was not significantly undermined by the problem of cobalt capping,

especially in view of the similar teaching of Leverenz. . . .

Kennametal's claim of unexpected results is unavailing. Kennametal cites to the '519 patent that, allegedly, shows that the combination of ruthenium binder and PVD coating results in unexpected tool lifetimes. As discussed above, the precise combination of ruthenium binders and PVD coatings was taught in Grab. Accordingly, "the offered secondary consideration actually results from something other than what is both claimed and novel in the claim, [so] there is no nexus to the merits of the claimed invention." Thus, Kennametal's secondary consideration argument falls short.