

# Federal Circuit Patent Bulletin: *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*

June 19, 2017

*“A general statement that lists all challenged claims and all asserted prior art is not a separate, additional articulation that each of the claims may be obvious over any combination of all listed prior art.”*

On June 15, 2017, in *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*, the U.S. Court of Appeals for the Federal Circuit (Moore,\* Clevenger, Chen) affirmed-in-part, vacated-in-part and remanded the U.S. Patent and Trademark Office Patent Trial and Appeal Board inter partes review decision that certain claims of U.S. Patent No. 5,599,758, which related to regenerating a devitalized catalyst/absorber that has absorbed and oxidized nitrates and nitrites after extended exposure to pollutants in the combustion gases of engines, were invalid under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,451,558 (Campbell), Japanese Patent Application No. 62-106826 (Saito), and U.S. Patent No. 5,362,463 (Stiles). The Federal Circuit stated:

Section 102(e) provides, “A person shall be entitled to a patent unless—(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent . . . .” The statute’s reference to “by another” means that an application issued to the same inventive entity cannot qualify as § 102(e) prior art. Here, the patents were issued to different groups of listed inventors. Campbell ’558 issued to Mr. Campbell, Mr. Danziger, Mr. Guth, and Ms. Padron. The ’758 patent issued to Mr. Guth and Mr. Campbell. However, the relevant question is not whether the references list different inventors, but “whether the portions of the reference relied on as prior art, and the subject matter of the claims in question, represent the work of a common inventive entity.” EmeraChem argues the cited portions of

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Campbell '558 are not "by another" and do not qualify as § 102(e) prior art because the Campbell Declaration unequivocally states that Mr. Campbell and Mr. Guth solely conceived of and invented the subject matter in Campbell '558 that is cited against the '758 patent. It argues the Campbell Declaration alone is sufficient to demonstrate a common inventive entity. Relying on this reasoning, it argues the Board erred in holding Campbell '558 is § 102(e) prior art. We do not agree.

The Campbell Declaration by itself fails to demonstrate that the portions of Campbell '558 relied upon as prior art and the subject matter at issue in the '758 patent share a common inventive entity. . . . We do not hold that corroboration of an inventor's declaration is required in every case, but we recognize that corroborating an inventor's testimony is a well-established principle in our case law. . . . We have treated uncorroborated testimony from an alleged inventor asserting priority with skepticism. This concept stems from the concern that "inventors . . . would be tempted to remember facts favorable to their case by the lure of protecting their patent or defeating another's patent." These concerns particularly arise when uncorroborated testimony comes from an interested person recalling long-past events. . . . We do not suggest that an inventor must produce contemporaneous documentary evidence in every case to support his or her declaration. A number of factors may guide the corroboration assessment, including the time period between the event and trial and the interest of the corroborating witness in the subject matter in suit. We have recognized that contemporaneous documentary evidence can serve as "the most reliable proof that the inventor's testimony has been corroborated." But it is "[a]n evaluation of all pertinent evidence [that] must be made so that a sound determination of the credibility of the inventor's story may be reached." [E]ven non-documentary, circumstantial evidence may sufficiently corroborate. We merely hold in this case that the Campbell Declaration is insufficient to demonstrate that the cited portions of Campbell '558 are not "by another." The Board did not err in holding Campbell '558 is § 102(e) prior art. For these reasons, and because EmeraChem does not challenge claims 1-2, 4-14, and 17-19 on any other grounds, we affirm the Board's decision as to these claims. . . .

In a formal adjudication, like an IPR, the APA imposes particular procedural requirements on the USPTO. The agency must timely inform the patent owner of "the matters of fact and law asserted," give all interested parties the opportunity to submit and consider facts and arguments, and allow a party "to submit rebuttal evidence . . . as may be required for a full and true disclosure of the facts." Here, the Board denied EmeraChem its procedural rights guaranteed by the APA by relying on Stiles for its disclosure of limitations independent claims 3, 16, and 20. . . . Given the specificity with which the petition's claim chart and the Institution Decision's list of claims expressly identified particular references' disclosures for some claims and not for others, it cannot be the case that the general statements Volkswagen relies upon provided sufficient notice that Stiles could be applied to all claims. Where the petitioner uses certain prior art references to target specific claims with precision, or the Board does the same in its decision to institute, the patent owner is directed to particular bases for alleged obviousness. A general statement that lists all challenged claims and all asserted prior art is not a separate, additional articulation that each of the claims may be obvious over any combination of all listed prior art. For it to be true that these general statements provided sufficient notice that Stiles may be relied upon for obviousness as to claims 3, 16, and 20, in addition to the specific grounds for rejection listed in the petition's claim chart or the Institution Decision's list of claims, it would have

been necessary to reject every one of the claims listed in the general statement based on the listed combination of all the references. That did not occur in this case.