



## Federal Circuit Vacates Lower Court's Obviousness Finding Based on Incorrect Application of Inherency Doctrine

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TWI's principal argument at trial was that the '576 patent was obvious in light of the prior art. After a five day bench trial, the district court agreed with TWI and concluded that the '576 patent was invalid as obvious. Although, the district court noted that the prior art did not explicitly disclose the food effect as claimed, it nonetheless found that the food effect was an inherent property of the drug, megestrol.

Reviewing the district court's determination de novo, the Federal Circuit vacated the obviousness decision based on an incorrect application of the inherency standard. Although, the court reiterated that inherency is applicable an obviousness analysis, it stated that inherency is limited when applied to obviousness, and is present only when the limitation at issue is the "natural result" of the combination of prior art elements. The Federal Circuit found that the district court applied the incorrect standard for inherency but noted that because of an insufficient record, it could not conclude that TWi failed to present sufficient evidence to show that the claimed food effect was necessarily present in the prior art. Thus, the court vacated the lower court's inherency analysis and remanded.

*Par Pharm., Inc. v. TWI Pharms., Inc.*, No. 20141391 (Fed. Cir. Dec. 3, 2014).

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