



## Federal Circuit Reverses PTAB's Conclusion that Claims Challenged in Reexamination Would Have Been Obvious

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The 330 Patent is directed to a composition for deicing road surfaces using a natural product known as “desugared sugar beet molasses” (DSBM). DSBM was previously considered a waste product and it costs less than half the cost of regular molasses. Univar, a licensee of the 330 Patent, filed three requests for reexamination of the 330 Patent. An examiner found a substantial new question of patentability, merged the reexaminations and ultimately found the challenged claims unpatentable in light of three prior art references. The PTAB agreed. On appeal, Natural argued that the examiner and the PTAB never established a *prima facie* case of obviousness because they failed to address the differences between the references and the challenged claims. Natural further argued that the PTAB failed to consider objective evidence of nonobviousness.

The Federal Circuit agreed with Natural and reiterated that, in a patent reexamination, it is the examiner's burden to demonstrate a *prima facie* case of obviousness. The first reference taught making molasses in the traditional sugared form. It did not teach making DSBM. The PTAB ignored the fact that the second reference was directed to a substantially different problem and failed to explain why the teachings would be reasonably pertinent to deicing road surfaces. Similarly, the PTAB failed to address the differences between the third reference and the invention taught in the 330 Patent. Finally, the PTAB erred in finding no nexus between the objective evidence of record and the claimed invention; the prior art taught using molasses in general, not using DSBM specifically (which the prior art considered a waste product). Accordingly, the Federal Circuit reversed the PTAB's judgment that the challenged claims were unpatentable as obvious.

## Categories

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Obviousness

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