

## Comaper Corp. v. Antec, Inc.

Nos. 09-1248, -1249, Fed. Cir. (Rader, Gajarsa, Dyk\*)

***A broader independent claim cannot be nonobvious where a dependent claim stemming from that independent claim is invalid for obviousness.***

On March 1, 2010, the Federal Circuit affirmed-in-part, vacated-in-part and remanded the district court's judgment entering the jury verdict that Antec willfully infringed U.S. Patent No. 5,955,955, which related to a cooling device designed to mount within the drive bay of a computer, and that certain claims of the patent, but not others, were invalid for obviousness. The Federal Circuit stated:

Antec also argues that a new trial is required because of the inconsistent jury verdicts on obviousness. The jury found that independent claims 1 and 12 of the '955 patent were not obvious. However, it also found that claims 2 and 7, which depend from claim 1, and claim 13, which depends from claim 12, were invalid as obvious. These verdicts are plainly inconsistent, as both the district court and Comaper recognize. "A broader independent claim cannot be nonobvious where a dependent claim stemming from that independent claim is invalid for obviousness." [B]y making its post-verdict motion for a new trial on the ground of inconsistent verdicts, Antec properly preserved this issue for appeal. [W]hen faced with inconsistent verdicts and the evidence would support either of the inconsistent verdicts, the district court must order a new trial.

Here, the district court concluded that the evidence would not support a verdict of obviousness as to claims 2, 7, and 13 of the '955 patent, and resolved the inconsistency in the jury verdicts by granting Comaper's renewed motion for JMOL. The court determined that the evidence was insufficient to support verdicts of obviousness with respect to claims 2, 7, and 13 because the asserted prior art was not analogous to the invention of the '955 patent and the prior art was not sufficiently similar to the claims of the '955 patent. We disagree.

The district court erred in concluding that the prior art asserted by Antec was not analogous prior art; indeed, Comaper itself did not make this argument. “Analogous art is that which is relevant to a consideration of obviousness under [35 U.S.C. § 103].” Two criteria are relevant in determining whether prior art is analogous: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” Undoubtedly, the ’955 patent’s field of endeavor deals with cooling computers and electronic components.

Antec’s asserted prior art references all relate to the same field of endeavor as the ’955 patent. Each piece of prior art involves cooling computer electronics using fans to draw cool ambient air. . . . Because these prior art references are in the same field of endeavor as the ’955 patent, they are analogous prior art, and it was thus proper for the jury to consider them on the issue of whether the ’955 patent would have been obvious.

The district court also erred in concluding that Antec had “fail[ed to] establish that there is sufficient similarity between the proffered prior art and the claims of the ’955 patent, taken as a whole.” What the district court appears to mean is that all of the claim elements of the ’955 patent do not appear in a single piece of prior art. However, this standard governs anticipation, not obviousness. Determining obviousness requires considering whether two or more pieces of prior art could be combined, or a single piece of prior art could be modified, to produce the claimed invention. This analysis typically invokes the familiar teaching-suggestion-motivation (“TSM”) test, asking whether a person having ordinary skill in the art would have found some teaching, suggestion, or motivation to combine or modify the prior art references. . . .

With the correct test in mind, there is no question that there is ample evidence in the record supporting the jury’s verdicts that claims 2, 7, and 13 of the ’955 patent would have been obvious. The district court recognized that Antec had provided extensive claim-by-claim and element-by-element comparisons between numerous prior art references and the claims of the ’955 patent. . . .

In summary, the jury found that independent claims 1 and 12 were not obvious, while dependent claims 2, 7, and 13 were obvious. Under the circumstances of this case, Antec is correct that the jury's verdicts on obviousness reflect an irreconcilable inconsistency. Accordingly, we vacate the judgment of the district court and remand for a new trial on invalidity.

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