

In re Donald H. THORPE, et al. Appeal No. 85-1913.
(United States Court of Appeals, Federal Circuit. Nov. 21, 1985)

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Case summary

The Federal Circuit affirmed the rejection by the US Patent and Trademark Office (USPTO) of a number of product-by-process claims based on the lack of novelty of the claimed product. Patentability of product-by-process claims is determined on the basis of the product, not the process.

The facts

Thorpe invented a process for the improved production of prior art color developers in carbon less copy paper systems. As that process differed from prior art ways of making color developers, the USPTO granted a process patent. Thorpe also applied for a patent for "the product of the process of Claim 1" (i.e. the patented process), which consisted of a metal-modified novolac phenolic resin. Before the USPTO, Thorpe argued that the properties of his resin were "about equal" to the prior art resin. The patent examiner compared Thorpe's resin with the prior art and came to the conclusion that it was similar in terms of *inter alia* properties and reaction conditions. The product-by-process claim was therefore rejected. The USPTO's Board of Appeals confirmed the rejection.

The legal issues

Thorpe contended that where a process is found patentable (as in his case), the resulting product should likewise be eligible for patent protection, without further conditions. The Federal Circuit in reaction stated that

"Product-by-process claims are not specifically discussed in the patent statute. The practice and governing law have developed in response to the need to enable an applicant to claim an otherwise patentable product that resists definition by other than the process by which it is made. For this reason, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. [...] The patentability of a product does not depend on its method of production. [...] If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."¹

Any modification of this approach should be done by Congress and not the courts, according to the Federal Circuit.²

¹ See the decision, pp. 2/3.

² Ibid, p. 4.

Thorpe further argued that as to the product as such, the USPTO bore the burden of showing that the product of his process was the same as the product of the prior art. In the view of the Federal Circuit, the USPTO had successfully shifted the burden of proof to Thorpe in establishing a *prima facie* case of unpatentability by finding similar properties between Thorpe's and the prior art product. Thorpe, by contrast, had done nothing to prove the contrary, i.e. that the prior art resin did not "necessarily or inherently possess the characteristics of his claimed product."³

Points of significance

- Product-by-process claims relate to the product itself, not the process of making it. The latter only helps describe the product when other means (e.g. structure, function) are not available. This means that the product as such has to be tested against the patentability criteria. Patents on known or obvious products defined by a novel or inventive process will not be granted.
- This claims format should be distinguished from simple process claims under Article 28.1 (b) of the TRIPS Agreement. Under those, any new, inventive and industrially applicable process is patentable, even if the resulting end product is known or obvious.
- This case concerned a case of **patent prosecution** (i.e. decision by the patent office to (not) grant a patent and review of that decision by a court). When it comes to the question of **patent litigation for infringement** (i.e. the scope of the claims and their validity), the scope of product-by-process claims is controversial. Later decisions by the Federal Circuit on infringement cases diverge on this matter (affirming: *Scripps Clinic Research Foundation v. Genentech Inc Scripps Clinic & Research Foundation* (1991); adopting a contrary position: *Atlantic Thermoplastics Co. v. Faytex Corp.* (1992); see further discussion in the summaries of those cases).
- The TRIPS Agreement leaves Members free to determine the scope of these claims.
- Similarity in product properties may create a *prima facie* case of unpatentability (in this case: lack of novelty; another option: lack of inventive step).

Key words: Product-by-process claims; patentability; novelty; burden of proof.

Available at: <https://law.resource.org/pub/us/case/reporter/F2/777/777.F2d.695.85-1913.html>

³ Ibid, p. 3.