

## PATENTWATCH



## To prevent, or treat?

A case concerning the validity of patents for a lotion used to treat sunburn highlights the importance of language in claim construction when patenting other therapeutic agents — specifically whether the invention is described as ‘preventing’ or ‘treating’ an ailment.

The lawsuit concerned was brought by Nicholas Perricone against Medicis Pharmaceuticals Corp., which was accused of infringing Perricone’s two patents (US5,409,693 and US5,574,063) that claim methods for treating or preventing sunburn by the topical application of ascorbic acid in a fat-soluble form. A District Court in Connecticut, USA, ruled that some of the claims of Perricone’s patents were invalid on grounds of double patenting as well as anticipation by an earlier patent (US,4,891,845) describing a cosmetic composition for topical application that contained several of the same ingredients that Perricone disclosed in the ‘693 and ‘063 patents. Perricone appealed and Medicis cross-appealed the ruling.

On appeal, the Federal Circuit upheld the ruling of double patenting as well as sustaining that several of the claims in the Perricone patents were anticipated by the ‘845 patent. However, the Appeals Court

reversed the District Court’s ruling of anticipation and infringement on certain claims. The District Court had reasoned that “[the ‘845 invention] would inherently function in the claimed beneficial manner when topically applied to the skin” — that is, by virtue of its ingredients and formulation, it is obvious that the ‘845 invention could treat sunburn in the same way described by Perricone. But the Appeals Court ruled that the District Court erred when basing its anticipation analysis on inherency, because the issue is not whether, if applied to skin sunburn, the lotion would treat said sunburn, but whether the ‘845 patent discloses the application of the lotion specifically to treat sunburnt skin. As the ‘845 patent only suggests that the lotion might prevent sunburn and does not disclose the application of the lotion to treat sunburn, the Appeals Court overturned the District Court’s ruling of anticipation, and the case was remanded back to the lower courts. This case provides an interesting example of the how language in claim construction can be crucial when disclosing drugs that can prevent and/or treat an ailment.

*Perricone versus Medicis Pharmaceutical Corp.*  
No. 05-1022, -1023 (20 Dec 2005):  
<http://www.fedcir.gov/opinions/05-1022.pdf>