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Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

Obviousness Of Claims: Common Sense Alone Is Not Enough

Law360, New York (September 26, 2013, 11:54 AM ET) -- Sometimes, common sense is simply not enough. This is particularly true when it comes to determining the obviousness of claims based only on common sense with no further support. A pair of recent decisions, one from the Federal Circuit and the other from the Patent Trial and Appeal Board, recently held that establishing obviousness in view of the prior art requires more than an unsubstantiated claim of common sense and common subject matter. These decisions should serve as valuable reminders to practitioners, whether it be during litigation, re-examination or patent prosecution, of what is required but often overlooked.

In *Plantronics Inc. v. Aliph Inc.*, the U.S. Court of Appeals for the Federal Circuit reversed and remanded the District Court for the Northern District of California's determination that Plantronics' patents were obvious. The district court found on summary judgment that the patent-in-suit, related to a headset inserted in the ear, was obvious over several pieces of prior art.

In reaching that decision, "the district court found that [the references] disclosed 'a receiver, ear cushion, stabilizer support and pad' and that any gap between these prior art elements and those recited, in relevant part, claims 1 and 11 of the [patent-in-suit] was bridged by 'common sense.'" Effectively, the district court determined that the combination of elements found in the art was "a matter of common sense for those skilled in the art at the time of the invention."

In reversing the district court's finding on summary judgment, the Federal Circuit pointed out that precedent has established that "the mere recitation of the words 'common sense' without support adds nothing to the obviousness equation." An obviousness finding grounded in common sense "must contain explicit and clear reasoning providing some rational underpinning why common sense compels a finding of obviousness."

In *Plantronics*, the Federal Circuit citing to its decision in *In re Nouvel*, (Fed. Cir. 2012), stated that without the necessary reasoning to support common sense, the court should not assume "that 'an ordinary artisan would be awakened to modify prior art in such a way as to lead to an obviousness rejection.'" This aids in protecting against the impermissible hindsight excoriated against by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex*.

To protect against the reliance on hindsight, the Federal Circuit noted that objective indicia of nonobviousness must be considered prior to making the ultimate decision on obviousness. This is especially true where "'common sense' may not be so apparent in view of objective evidence of non-obviousness (e.g., commercial success and copying)." Here, the Federal Circuit found that the district court's post hoc analysis of objective indicia after concluding that "common sense" rendered the patent obvious was improper. As the court noted, the rule holds that "all evidence pertaining to the objective indicia of non-

obviousness must be considered before reaching an obviousness conclusion.”

The Patent Trial and Appeal Board in *Heart Failure Technologies LLC v. Cardiokinetix Inc.* recently arrived at the same conclusion. Petitioner Heart Failure sought to institute an inter partes review, under 37 CFR § 42.108, of a Cardiokinetix patent related to a device used to divide a heart chamber into productive and nonproductive portions. In denying the petition, the administrative patent judges found no reasonable likelihood that Heart Failure would prevail with respect to at least one of the challenged claims.

Heart Failure filed a petition for inter partes review and argued that the Cardiokinetix patent was obvious over a combination of prior art references related to “the repair of a human heart.” In response, Cardiokinetix argued that the petitioner “made no more than a bare assertion of obviousness, without any explanation of how the teachings of the references would be arranged or combined or why a person of ordinary skill would have made the combination.” The PTAB agreed with Cardiokinetix and stated that the fact that all the relied-upon references concern human heart repair “is not in itself sufficient rationale” for making the asserted combination.

Acknowledging that many heart repair devices exist, the PTAB nevertheless went on to state that this alone does not make the combination of the previously disclosed features obvious. Relying on KSR, the PTAB stated that there must be some “articulated reason with some rational underpinnings to support a legal conclusion of obviousness.” The petitioner must, as the PTAB explained “show some reason why a person of ordinary skill in the art would have thought to combine particular available elements of knowledge ... to reach the claimed invention.”

The similar determinations of the administrative patent judges in *Cardiokinetix* and the Federal Circuit in *Plantronics* were each based on the underlying principal that, without “an adequate rationale for the combination of the cited references,” or a showing that a combination of the references disclose all the claimed subject matter, the mere presence of the combined elements in the prior art is not sufficient to reasonably find a claim obvious. In other words, “common sense” or “common subject matter” alone, without a rational articulated reason, may not render a patent or a claim obvious in light of the prior art.

While this principal may not be new, it is often difficult to express or articulate with certainty. As noted by the Supreme Court in KSR and as repeatedly articulated by the Federal Circuit, “[a]n invention may be a combination of old elements disclosed in multiple prior art references.” By “[a]pplying a flexible approach to the obviousness inquiry, the Supreme Court observed that common sense can be a source of reasons to combine or modify prior art references to achieve the patented invention. Therefore, motivation to combine may be found explicitly or implicitly in market forces; design incentives; the ‘interrelated teachings of multiple patents’; ‘any need or problem known in the field of endeavor at the time of invention and addressed by the patent’; and the background knowledge, creativity, and common sense of the person of ordinary skill.”

Faced with such a wide array of options to serve as the basis for an obviousness argument, relying on “common sense” or “common subject matter” without an articulated and well supported reason is insufficient and will surely result in a flawed attack.

Practice Tips

Re-Examinations

Inter partes review and ex parte re-examinations are valuable and comparatively less expensive tools than litigation that are available to a defendant or potential defendant

fighting off a would-be infringement claim. Backed by sound reasoning and appropriate references, the granting of a petition for re-examination has traditionally been nearly always guaranteed.

However, as evidenced by these decisions, a petitioner who approaches obviousness with a cavalier attitude and unsupported reasoning based on "common subject matter" and "common sense" alone may very well find the time, effort and cost of preparing and filing a petition wasted. This may undermine a litigation strategy and result in the denial of a stay or the lifting of a stay previously granted.

Accordingly, it is worth allocating the time and effort to develop a well-supported and well-reasoned argument. Regardless of an obviousness rejection's basis — combinations of known elements, pre-existing components, design incentives, interrelated teachings, need or problem in the field, background knowledge, or creativity or common sense of one skilled in the art — simply stating something is obvious does not make it so.

Despite the flexibility in any obviousness analysis, a finding of obviousness must still be supported by the record. Petitioners would be well served to include expert testimony, supporting publications and a thorough, reasoned analysis of the relied-upon art to support invalidity arguments and contentions in any petition or brief they plan to file.

Contrastingly, a patent owner faced with a validity challenge in inter partes review or ex parte re-examination should not think twice about challenging, as early in the process as possible, an obviousness assertion based on "common sense" and/or "common subject matter." A petition that fails to provide sufficient evidence as to why the references would be combined by one skilled in the art might be particularly susceptible to an early disposition based on unsubstantiated and unsupported claims of obviousness. As the discussed court decisions note, saying a combination is obvious does not make it so.

Litigation

Likewise, a patent owner in the midst of a litigation should be prepared to defend on all fronts against a validity challenge based on obviousness. This includes challenging unsupported statements of obviousness, obviousness based on the same subject matter cited during prosecution and obviousness based on common sense. The defense should also factor in the courts' analyses and consideration or lack thereof of secondary indicia of nonobviousness.

An accused infringer, on the other hand, must make sure that its invalidity arguments are supported by credible evidence establishing explicit and clear reasoning that provides rational underpinnings as to why common sense compels a finding of obviousness and how and why one of ordinary skill in the art would combine the cited references.

The accused infringer must be prepared to offer expert testimony, if necessary, to explain to the court that the claims of obviousness are based not on hindsight but on relevant evidence and sound rational reasoning. An accused infringer must be prepared to show that the motivation to combine references of known elements is based on more than just similar subject matter. There must be a real showing that one skilled in the art would have looked to the cited prior art to solve that long-unfilled need.

Prosecution

From a patent prosecution stand point, any attorney or agent that practices before the U.S. Patent and Trademark Office has experienced the all-too-familiar obviousness rejection containing a statement that the element missing from the single cited reference, or from the combination of cited references, is "common knowledge" — resulting in the claims being deemed obvious. Such rejections may be prone to challenges based on the

reasoning outlined in these decisions. Despite the USPTO's note in the Manual of Patent Examining Procedure that rejections based on "official notice of facts not in the record" or "common knowledge" should be judiciously applied, they are not all that unusual.

Plantronics and Cardiokinetix, while decided in different forums, shed some light on how to approach such rejections. By advocating strongly against an examiner's position, and pointing out the errors in the examiner's action (e.g., stating why the examiner's noticed fact is not common knowledge or well-known in the art) may provide an applicant with a sufficient basis to shift the burden back to the examiner to explain the rejection. (See MPEP 2144.)

By shifting the burden to the examiner, similar to the position of the petitioner in a re-examination or of a plaintiff in an infringement action, and by demanding that the office produce authority to support such a statement, an applicant may achieve success in overcoming such an unsupported position. Failing to aggressively challenge such an unsupported examiner's assertion will likely require one or more claim amendments to overcome such an obviousness rejection. By failing to adequately and affirmatively traverse the examiner's assertion of official notice, an applicant may waive the right to later challenge the obviousness rejection based on such "official notice" or "common knowledge."

--By Andrew Grodin and Joel Bock, Dentons

Andrew Grodin is a senior managing associate and Joel Bock is a partner in Dentons' Short Hills, N.J., office.

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