

Is combining prior art references intuitive? Another reminder from the
Federal Circuit regarding the PTO's burden in supporting obviousness
rejections
by Logan Christenson

In a recent decision, the Federal Circuit has reminded the Patent Trial and Appeal Board (PTAB) that when rejecting claims based on a combination of prior art references, the Patent Office is required to show that there was sufficient motivation to combine the references. This case follows on the heels of several other recent cases reaching similar conclusions (see, e.g., <http://www.wnlaw.com/blog/reference-teachings-combined-maybe-not-obvious/>, summarizing another recent Federal Circuit case having a similar outcome; and <http://www.wnlaw.com/blog/recent-strengthening-motivation-combine/>, also summarizing similar cases), highlighting the fact that this is a key aspect of the law to pay attention to when dealing with obviousness rejections.

In the case of *In re: Van Os* Fed. Cir. 2015-1975 (decided Jan. 3, 2017), the Court has explained that where the PTAB finds a combination of prior art to be “intuitive” or “common sense,” without further discussion, the PTAB’s analysis is inadequate to support an obviousness rejection. For inventors, patent owners, and patent practitioners, this decision provides another helpful tool for responding to rejections where the Examiner has not fully explained why a person having ordinary skill in the art would be motivated to combine the cited references in the way the Examiner has asserted.

Application 12/364,470 (the ‘470 application), is directed to a touch screen interface that allows a user to rearrange icons. The independent claims at issue recite an “interface reconfiguration mode.” Claim 38, for example, recites a “first user touch” to open an application, a longer “second user touch” to initiate the interface reconfiguration mode, and a “subsequent user movement” to move an icon. *In re: Van Os*, at 2.

The PTAB affirmed the Examiner’s rejection of the claims over a combination of two references. The first reference, US Patent 7,231,229 (“Hawkins”), describes a device with an interface mode that allows a user to rearrange buttons by dragging them from one location to another. The interface mode is initiated via menu selection or keyboard command. *Id.* The second reference, US Pub. No. 02/0191059 (“Gillespie”), describes an interface with an activated and inactivated state, where individual icons can be activated by various means, including by holding the finger over an icon for a sustained duration. *Id.* at 2-3. The Examiner

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asserted that one of ordinary skill in the art would have been motivated to modify Hawkins' initiation of an editing mode via menu selection or keyboard command with Gillespie's sustained touch activation method to arrive at the claimed invention. The Examiner found, and the PTAB affirmed, that such a combination "would be an intuitive way for users of Hawkins' device to enter into the editing mode." *Id.* at 3.

On appeal, the Federal Circuit reversed the PTAB. The Court explained that "obviousness findings grounded in 'common sense' must contain explicit and clear reasoning providing some rational underpinning why common sense compels a finding of obviousness." *Id.* at 4 (citing *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013)). The Court further explained that without some articulated rationale for combining the cited prior art, a statement that the combination is "intuitive" or would have been "common sense" is merely a conclusory statement inadequate to support a valid finding of obviousness. *Id.* at 5. According to the Court, the thin analysis represented "ex post reasoning" of the type warned of by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 and 421 (2007). Because neither the PTAB nor the Examiner provided any reasoning or analysis to show motivation to add Gillespie's initiation feature to Hawkins' editing mode, the PTAB's decision was vacated and the case was remanded back to the PTAB. *In re: Van Os* at 6.

Also of interest, Judge Newman wrote separately from the panel majority, concurring in part and dissenting in part. Judge Newman agreed that the reasoning of the PTAB and Examiner was insufficient to support a ruling of obviousness. In Judge Newman's opinion, however, the PTAB should simply have been reversed and the appellant's claims granted, rather than remanding the case to the PTAB for a second chance to provide the required reasoning. According to Judge Newman, the Patent Office failed to carry its "statutorily required burden of demonstrating unpatentability, although they had full opportunity to do so." *In re Van Os* (Newman, J., concurring in part, dissenting in part) at 3.

In summary, where an Examiner has made an obviousness rejection based on a theory that it would be obvious to combine two or more references, patent application stakeholders should carefully analyze the Examiner's reasoning to ensure the Examiner is providing "explicit and

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clear reasoning" compelling the asserted finding. In particular, conclusory statements such as the combination being "intuitive" or "common sense" do not provide the necessary support for the rejection and should be challenged accordingly. The challenge may be made using the legal principles expounded by the Federal Circuit in this case and the string of related recent cases.