

Recent Strengthening of Motivation to Combine
by Zachary Smart

Under patent law, two of the most well-known and critical standards to obtaining a patent are novelty and non-obviousness. Obviousness is defined under 35 U.S.C. 103, which states that “[a] patent for a claimed invention may not be obtained, ... if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” Accordingly, a patent claim lacks patentability under the non-obviousness standard when the subject matter of the claim would have been obvious to a person having ordinary skill in the relevant art at the time the invention was created.

Practically speaking, an obviousness rejection of claims of a patent application, generally includes the combination of two or more prior art references that together teach all the claim limitations. As part of such a rejection, the courts have regularly required that a motivation to combine the references be found. This requirement was perhaps somewhat weakened by the Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, in which the Supreme Court held that a motivation to combine prior art may be found using common sense (i.e., rather than finding explicit motivation to combine in the prior art itself).

However, recent Federal Circuit decisions have shown a renewed focus on the importance of showing a particular motivation to combine. For instance, in *Cutsforth, Inc. v. MotivePower, Inc.*, the Federal Circuit determined that the basis of such findings must be developed and explained, stating that “[broad], conclusory statements are not enough to satisfy the ... obligation to provide reasoned explanation for [a] decision.” Additionally, in *Arendi v. Apple, Inc.*, the Federal Circuit warned “that references to ‘common sense’—whether to supply a motivation to combine or a missing limitation—cannot be used as a wholesale substitute for reasoned analysis and evidentiary support ...” Finally, this renewed emphasis by the Federal Circuit was again put on display this month in *In Re NuVasive* when the Federal Circuit vacated an obviousness decision of the Patent Trial and Appeal Board for “[failing] to articulate a reason why the PHOSITA would have been motivated to modify” the prior art.

During prosecution then, applicants should be alert to circumstances where an examiner has

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failed to state, or adequately establish the existence of, a motive to combine reference teachings.