Why should reference teachings be combined? Maybe it's not so obvious after all

by Peter Malen

This note concerns the obligation of the USPTO Patent Trial and Appeal Board (PTAB) to adequately explain why a claim would have been obvious over the cited art. While the case that is the subject of this note – *IN RE: Nuvasive, Inc.*, Fed. Cir. 2015-1670 (decided 7Dec16) – concerns arguments raised by the PTAB on appeal to the Court of Appeals for the Federal Circuit (CAFC), this case will be of interest to prosecutors who are faced with obviousness rejections that fail to adequately explain why a person of ordinary skill in the art would combine reference teachings in the allegedly obvious manner advanced by the Examiner in the rejection.

In the case at issue, the PTAB found claim 1 of US 8,361,156 ("'156 Patent") obvious over various combinations of references. *In re: Nuvasive* at 3. Particularly, the PTAB adopted the position of Medtronic Inc. ("Medtronic") (Medtronic initially opposed NuVasive's appeal but later withdrew as Appellee, and the UPSTO intervened) that it would have been obvious to combine prior art teachings to place radiopaque markers proximate to a medial plane, as claimed in the '156 Patent, because this combination would provide '*additional information*' and thereby be beneficial to a person of ordinary skill in the art. Id. at 11. Particularly, Medtronic's expert stated that a person of ordinary skill in the art '*would have considered it common sense*' to place radiopaque markers along the medial plane '*to provide additional information regarding the orientation or location of an implant*.' Id. at 12.

Thus, the question confronting the CAFC in this case was "*whether the PTAB adequately set forth findings and explanations to support the conclusion that a combination of these prior art references would have rendered claim 1 of the '156 patent obvious*." The CAFC concluded that the PTAB had not. Id. at 6. Emphasis added. In this regard, the CAFC noted (citing *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002)) that "*the factual inquiry whether to combine references must be thorough and searching*..." Id. at 7-8. Emphasis added. The CAFC noted further that "...*the PTAB must make the necessary findings and have an 'adequate evidentiary basis for its findings'...[and] the PTAB 'must examine the relevant data and articulate a satisfactory explanation...including a rational connection between the facts found and the choice made*." Id. Emphasis added.

Here, the CAFC noted that "*the PTAB never actually made an explanation-supported finding that the evidence affirmatively proved that the PHOSITA would have sought this additional information*" that purportedly would have resulted from the allegedly obvious combination. Id. at 12. Emphasis added. As well, the CAFC noted further that "*the PTAB never articulated why the additional information would benefit a PHOSITA when implanting...[an] implant [as disclosed in the art]. It also failed to explain the type of additional information a PHOSITA would obtain or how the PHOSITA would use that information*." Id. Emphasis added. Finally, the CAFC suggested that other evidence relied on by the PTAB was inadequate to establish obviousness because such evidence addressed "*neither the benefits that could have been obtained by combining the prior art references nor the PHOSITA's motivation to combine*..." Id. at 13. Emphasis added.

In sum, *In Re: Nuvasive* makes clear that mere conclusory statements are not adequate to establish the existence of a motivation to combine reference teachings. Rather, what is required is: (i) a thorough and searching inquiry to ascertain any supporting facts; (ii) an adequate evidentiary basis for a conclusion of obviousness – such a basis must be present in any facts identified in the inquiry; and, (iii) a satisfactory explanation as to the basis for a conclusion of obviousness – to be satisfactory, the explanation must include a rational connection between the facts relied upon and the conclusion of obviousness.