

Shoulda, Coulda, Woulda...A Combination is Not Obvious Simply
Because it Could Have Been Made
by Peter Malen

At one time or another, most practitioners have probably been faced with the contention by an Examiner that a claimed combination is obvious because a person of ordinary skill in the art could have combined reference teachings or, put another way, a person of ordinary skill in the art would have been able to combine reference teachings. The Court of Appeals for the Federal Circuit addressed this issue, albeit briefly, in *Polaris Industries, Inc. v. Arctic Cat, Inc.*, Fed. Cir. 2018-02-09 (“*Polaris Industries*”). (See www.cafc.uscourts.gov/sites/default/files/opinions-orders/16-1807.Opinion.2-8-2018.1.PDF).

In *Polaris Industries*, the court considered whether the Patent Trial and Appeal Board (PTAB) erred in finding that claims 17-19 of US 8,596,405 (the “’405 Patent”) were obvious in view of various references. The PTAB had rejected those claims based on its notion that “*one of ordinary skill has the ability to weigh the various benefits and disadvantages based on subjective preferences in an analysis largely unrelated to obviousness.*” Polaris contended that the analysis of the PTAB suffered from legal error. In vacating the determination of the PTAB regarding claims 17-19 of the ‘405 Patent, the court agreed with Polaris, finding that one of the problems with the analysis articulated by the PTAB was that “*...the Board focused on what a skilled artisan would have been able to do, rather than what a skilled artisan would have been motivated to do at the time of the invention*” (citing *InTouch Techs, Inc. v. VGO Commc’ns, Inc.* 751 F.3d 1327, 1352 (Fed. Cir. 2014) (emphasis in original)).

Polaris Industries thus reaffirms that obviousness of a claim cannot be established by mere possibilities, but instead requires that the Examiner articulate a reason *why* one of ordinary skill in the art would find it obvious to combine reference teachings.