



Archetype IP

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Can a patent claim be obvious over a combination of prior art references without an explicit motivation to combine?

According to the US Supreme Court, the answer is *yes*. For example, “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR v. Teleflex*, 127 S Ct 1727, 1740 (2007)(citing two of its own prior cases, *Anderson’s Black Rock* and *Sakraida*, in which obviousness was found because the combined components together predictably did nothing more than what the each component had done separately in the prior art).

According to the Federal Circuit, the answer has been sometimes *yes* and sometimes *no*. In some post-*KSR* cases the Federal Circuit has required a motivation to combine to be explicitly identified -- e.g., *Procter & Gamble v. Teva* (Fed. Cir. 2009)(“A party seeking to invalidate a patent on the basis of obviousness must demonstrate by clear and convincing evidence that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention . . .”). In some more recent cases the Federal Circuit has recognized that a motivation to combine need not always be explicit -- e.g., *In re Ethicon* (Fed. Cir. January 3, 2017)(“*KSR* directs that an explicit teaching, suggestion, or motivation in the references is not necessary to support a conclusion of obviousness.”).

In *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.* (Fed. Cir. August 22, 2017), the claims related to a particular type of electric motor and there was no dispute that each claim limitation was found in one or the other of two prior art references. The Federal Circuit affirmed obviousness, agreeing with the Board that the combination of the two references “would have provided predictable results to address known problems associated with other types of motors.”

Arguably, a motivation to combine to create the claimed invention might have been found in the “known problems” associated with the other types of motors, but that was never articulated by the Board or the Federal Circuit. More important was that the elements were all *old* and the result of the combination was *predictable*, each component doing exactly what it had done previously in the prior art.

Practical points:

- *KSR* established that a motivation to combine can be helpful but ***is not necessary*** in all situations, and the Federal Circuit appears to be embracing that position more openly.
- There are several routes to obviousness discussed in *KSR* in which factors such as ***predictability of the result of combination, simple substitutability, or known techniques for improving similar devices*** can effectively substitute for an explicit motivation to combine.
- Those additional routes to obviousness can be presented separately from (and parallel to) more traditional arguments regarding motivation to combine, strengthening the overall invalidity argument and providing alternative grounds for the decision-maker to find obviousness.

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