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Recent Federal Circuit Guidance On Obviousness

By **Rob Maier**
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Obviousness is one of the most challenging and amorphous issues in U.S. patent law, and one that all practitioners—litigators and patent prosecutors alike—inevitably confront on a regular basis. Federal Circuit decisions analyzing the issue of obviousness can be complex and, sometimes, seemingly subjective.

When considering the question of whether a claimed invention is obvious in view of two combined prior art references, two basic points are almost always at issue: (1) whether the prior art references are analogous, and (2) whether the hypothetical person of ordinary skill in the art would have had a motivation to combine the multiple prior art references. These factors are critical in any *prima facie* case of obviousness. In theory, this makes sense, because these requirements strike at the core of the obviousness inquiry: which prior art references may be combined, and, just as importantly, *why* would a person of ordinary skill in the art combine them.


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Nevertheless, while simple in theory, these issues are seldom straightforward in practice. Recent Federal Circuit decisions tackle both of these issues.

The Federal Circuit in 'Corephotonics v. Apple'

The Federal Circuit in its recent decision in *Corephotonics v. Apple* confirmed that a reference may qualify as prior art only if it is analogous to the claimed invention. 84 F.4th 990 (Fed. Cir. 2023). The underlying rationale for this approach is that a person of ordinary skill in the art is not presumed to know *all* prior art, but is instead presumed to know all *analogous* prior art—and prior art that is "too remote" from the patents being attacked cannot be used in an obviousness analysis. And, as the Federal Circuit explained, it is a common misstep in these instances to assert that two prior art

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references being combined are analogous art *to one another*; rather, the key inquiry is whether the prior art is analogous art to that of the claimed invention.

In *Corephotonics*, Apple filed a petition for inter partes review (IPR) with the Patent Trial and Appeal Board seeking to invalidate certain claims of Corephotonics' patents, alleging that the two prior art references Apple relied on for its obviousness analysis "are analogous prior art *and are in the same field of endeavor*. . . ." *Corephotonics*, 84 F.4th at 1004 (Fed. Cir. 2023).

Corepohotonics, in its patent owner response, took issue with this analysis, arguing that Apple applied wrong legal standard—instead of alleging that the two prior art references were analogous art to the patent in question, Apple instead argued that the two references being combined in the obviousness analysis were analogous art *to each other*—an approach that the Federal Circuit recently explained is improper. *See Sanofi-Aventis Deutschland v. Mylan Pharmaceuticals*, 66 F.4th 1373, 1380 (Fed. Cir. 2023).

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In its petitioner's reply, Apple clarified its position, arguing that the patents and prior art references were all in the same field of endeavor. Corepohotonics objected, arguing that this was a new position that was absent from the petition.

Ultimately, the board concluded—and the Federal Circuit affirmed—that while Corephotonics was correct on the merits, and Apple's petition and supporting expert declaration "inadequately addressed the issue of analogous art, because it made a comparison only between [the two prior art references] without comparing either reference to the Challenged Patents," Apple was still permitted to rectify the issue during the IPR proceeding.

The Federal Circuit found that Apple, in its petitioner's reply, did not present an entirely new argument; rather, it merely extended its argument that the prior art references were in the "same field of endeavor" as the challenged patent, to explain they are also pertinent to the same problem faced by the inventor of the challenged patent. In addition, according to the Federal Circuit, Apple's reply did not present a new theory; rather, it was merely (and properly) responsive to the arguments that Corephotonics made in its patent owner response.

Accordingly, the Federal Circuit found no procedural error in the board's approach to this issue.

The Federal Circuit in 'Elekta v. ZAP Surgical Systems'

While the *Corephotonics* decision serves as a helpful reminder of the importance of taking care in addressing the analogous art portion of an obviousness analysis, another recent Federal Circuit decision provides further guidance on the next step of the obviousness analysis: *why* would a person of ordinary skill in the art have thought to combine elements from the two prior art references in a way that would reach the claimed invention? Motivation to combine is maybe the most hotly and frequently contested issue in obviousness, and often the outcome turns on this inquiry.

In *Elekta v. ZAP Surgical Systems,* the Federal Circuit considered the question of obviousness and,

in particular, regarding motivation to combine. 81 F.4th 1368, 1375 (Fed. Cir. 2023).

Elekta was an appeal from an IPR proceeding, in which ZAP argued that a person of ordinary skill in the art would have been motivated to combine two references related to systems for treating a patient with ionizing radiation in certain types of radiosurgery and radiation therapy—one using x-ray, and another related to use of a linear accelerator, or "linac."

Patent owner Elekta contended that a person of ordinary skill in the art would not be motivated to make the proposed combination, and further argued that ZAP had not presented substantial evidence in support. Elekta also contended that the board erred by failing to articulate any findings regarding the person of ordinary skill having a reasonable expectation of success in making the combination of references—another component of the obviousness analysis.

Regarding reasonable expectation of success, the Federal Circuit agreed that this issue was not explicitly addressed by the petitioner in the IPR, but determined this did not impact the analysis.

The Federal Circuit found that there was, in fact, substantial evidence supporting the board's decision regarding motivation to combine. In particular, in support of its conclusion, the board looked to expert testimony, the prior art, and the prosecution history of the challenged patent—in which a number of references related to similar systems were considered, and the applicant did not during prosecution raise an argument that these systems were *not* relevant art.

Regarding reasonable expectation of success, the Federal Circuit agreed that this issue was not explicitly addressed by the petitioner in the IPR, but determined this did not impact the analysis because "a finding of reasonable expectation of success can be *implicit*" (emphasis added). As the Federal Circuit explained, evidence of a reasonable expectation of success, just like evidence of a motivation to combine, "may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved." *Elekta v. ZAP Surgical Systems,* 81 F.4th 1368, 1377 (Fed. Cir. 2023).

While reasonable expectation of success is a distinct requirement from motivation to combine, here the Federal Circuit found it was proper for the board to address motivation to combine and reasonable expectation of success in a "blended manner"—perhaps not surprising given the overlap in these issues.

Ultimately, while the question of obviousness will continue to remain at times amorphous and unpredictable, the Federal Circuit will be left to continue to grapple with these issues in ways that can provide future guidance. And, it turns out, the Federal Circuit can at times provide broad leeway to practitioners—and the PTAB—in addressing various complex and overlapping questions within an obviousness analysis.