

## Client Alert

### Federal Circuit Rejects Common Sense Approach to Obviousness

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In a recent precedential opinion, the Federal Circuit admonished a district court's reliance on "common sense" alone to justify a holding that a meat encasement patent was invalid as obvious pursuant to 35 U.S.C. § 103.

In *Mintz v. Dietz & Watson*, a three-judge panel comprised of Chief Judge Rader and Judges Newman and Dyk criticized the district court's common sense-based conclusion that it would have been "obvious to try" the claimed locking engagement of the Mintz patent. According to the panel, "the mere recitation of the words 'common sense' without any support adds nothing to the obviousness equation." The Federal Circuit acknowledged that "common sense" may have a place in the statutory test to refer to knowledge so basic that it would certainly lie within the skill set of an ordinary artisan, but merely invoking those words without supporting record evidence does not satisfy the clear and convincing standard.

The panel was particularly troubled by the district court's failure to fully consider or even make any finding as to what it considered copious evidence presented by the patentee showing objective indicia of non-obviousness. Mintz had presented evidence of unexpected results, expert skepticism, copying, commercial success, praise by others (even the accused infringer), failure by others, and long-felt need, but the lower court ignored these factors on summary judgment and even inaccurately characterized the evidence presented as "scant" upon reconsideration. The Federal Circuit reiterated prior decisions holding that objective indicia of non-obviousness "may often be the most probative and cogent evidence of non-obviousness in the record." The appellate court also cautioned that in cases where the subject matter is less technologically complex, secondary indicia may be even more important to prevent reading the limitations of the claims into the prior art. Instead, the court counseled, the proper analysis requires "a form of amnesia that forgets the invention and analyzes the prior art and understanding of the problem at the date of the invention."

Corporate counsel and litigators on both sides should heed the warnings implicit in this decision. For the patentee, secondary indicia of non-obviousness remains a powerful tool for rebutting allegations of obviousness because they "provide objective indicia of how the patented device is viewed in the marketplace, by those directly interested in the product." As the panel noted, "the significance of a new structure is often better measured in the market place than in the court room." Likewise, accused infringers should avoid the trap of "common sense" logic when facing infringement charges stemming from technologically simple patents. The fact that technology in an asserted patent can be easily understood does not necessarily mean that it would have been obvious to the ordinarily skilled artisan at the time of the invention. When defending against such patents, an accused infringer should be extra careful not to state the problem solved by the patent in terms of the claim language, or else their invalidity theory risks being rejected as based on an improper hindsight reconstruction.

For more information, please contact the professional(s) listed below, or your regular Crowell & Moring contact.

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