O'Dell and Shetler in IPWatchdog: Destroying the Intended Purpose of a Reference May Not Be a 'Golden Ticket' to Patentability

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Haynes Boone Partner **David O'Dell** and Associate **Joshua Shetler** authored an article for *IPWatchdog* explaining that patent claims may still be considered obvious even if combining prior art reduces functionality, so long as the combination provides meaningful benefits and does not destroy the invention's core purpose.

Read an excerpt below.

"The Federal Circuit has noted that the 'loss of key functionality' in a prior art combination does not necessarily render the combination unsatisfactory for its intended purpose."

A patent claim of invention is considered obvious, and thus unpatentable, in light of a combination of prior art references if a person of ordinary skill in the art (POSITA) would have had a reason, or motivation, to combine the references as recited in the claim. There are responses, or defenses, to such a finding of obviousness, including if the combination renders the reference unsatisfactory or inoperable for its intended purpose – also called "frustration of purpose." See In re Fritch, 972 F.2d 1260, 1265 n.12 (Fed. Cir. 1992) ("A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose."). Recent decisions by the Patent Trial and Appeal Board (PTAB) show the Board coming to different decisions on how to treat this defense. In Thermaltake Tech. Co. v. Chen, the Board found that even though the patent owner argued that the proposed modification of an electrical circuit would destroy the circuit's transmission lines and render it inoperable. IPR2024-01230, Paper 51 (PTAB Feb. 17, 2026). In Deere & Co. v. David's Dozer, the Board denied institution of the IPR because the proposed modification would render the primary reference, Funk, inoperable; specifically, the combination was "antithetical to Funk's operation." IPR2024-01442, Paper 7, p. 12 (PTAB Jan. 7, 2025).

Thus, the question remains how to balance these opposing positions when determining if the patent claim is indeed patentable.

Two Cases

There are two seminal cases where proposed modifications would have destroyed the intended purpose of the primary prior art and thus negated a finding of obviousness. In Cook Group Inc. v. Boston Sci. Scimed, Inc., the Patent Trial and Appeal Board (PTAB) found that combining biopsy forceps with another reference would result in loss of the forceps' key functions: the ability to identify and excise tissue. The Board then determined that the modified forceps were inoperable for their intended purpose. The U.S. Court of Appeals for the Federal Circuit affirmed, emphasizing that an inference of nonobviousness is especially strong where the prior art's teachings undermine the very reason proffered as to why an ordinary artisan would have combined the known elements. Similarly, in In re Gordon, the Federal Circuit reversed an obviousness determination where the

modification inadvertently created a faulty gasoline filtration device where the gasoline to be filtered would be trapped at the top, while the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, thus destroying the intended purpose of the primary reference.

No Golden Ticket

Loss of functionality or destroying the intended purpose of a reference is not, however, a "golden ticket" to overcoming a proposed obviousness rejection. The Federal Circuit has noted that the "loss of key functionality" in a prior art combination does not necessarily render the combination unsatisfactory for its intended purpose. Rather, the ordinary artisan would balance the prior art combination's "advantages and disadvantages" when determining whether to combine the two references. Though each prior art combination is unique and requires a case-by-case analysis, the following Federal Circuit case provides insight.

To read the full article from *IPWatchdog*, click **here**.