

## Drezdton in Law360: Fed. Circ. Ruling Provides Some Insights On Prior Art

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**PRACTICES** Patent Litigation, Patent Office Trials, Patents

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In *University of Maryland Biotech Institute v. Presens Precision Sensing*, Nos. 2016-2745, 2017-1057 (Nov. 3, 2017) (nonprecedential), the Federal Circuit affirmed the U.S. Patent and Trademark Office Patent Trial and Appeal Board's *inter partes* re-examination decision that found U.S. Patent No. 6,673,532 ("the '532 patent") invalid as obvious over two prior art references.

The Federal Circuit's decision highlighted that, while "a person of ordinary skill generally would not be motivated to modify a reference by contradicting its basic teachings [or] by making it inoperable for its intended purpose," portions or elements of a secondary reference may be combined with the particular physical arrangement of a primary reference even if the secondary reference discloses a different or incompatible overall physical arrangement. This case also serves as an insightful data point of the level of creativity the Federal Circuit attributes to the fictional POSITA (person of ordinary skill in the art).

The technology at issue in this case offers practitioners a relatively straightforward illustration of the useful but sometimes tricky technique of starting with a primary reference's base physical structure and/or principle of operation, and modifying it with a more narrowly tailored teaching from a second reference such as a particular component of a structure or a single idea/concept that modifies the primary reference. This technique expands the universe of available prior art but, at the same time, accentuates the importance of the motivations to combine such references. ...

Excerpted from *Law360*. To read the full article, click [here](#).