Tom King and Pranay Pattani for Law360: Federal Circuit May Be Setting Stage For Big Obviousness Changes

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Although nonobviousness is a core principle of our patent system, consistent application of the nonobviousness principle has proven difficult. Even judges of the Federal Circuit have a difficult time reaching consensus on how obviousness law ought to be applied in a given case. These difficulties were recently displayed in Apple Inc. v. Samsung Electronics Co. Ltd., an en banc decision reversing a panel decision. 839 F.3d 103, 1039 (Fed. Cir. 2016). The opinion is mostly notable because the Federal Circuit reversed the panel decision without permitting additional briefing, on the grounds relating to the substantial evidence standard. But the en banc majority also acknowledged that, apart from this procedural issue, the case also raised "big questions about how aspects of the obviousness doctrine ought to operate." Id. at 1075. These issues were not decided by the en banc majority? rather, such "important legal questions" were expressly saved for another day. Id.

Since Apple, a number of Federal Circuit decisions have focused on some of the disputed issues highlighted in Apple. The questions that the Federal Circuit seems to be grappling with include:

- What suffices as "substantial evidence" of obviousness in regards to expert testimony?
- Are the KSR combination rationales factual issues, or are they part of the ultimate conclusion of obviousness?
- Is a "motivation to combine" (whether express or implicit) required to find obviousness?
- Does the core obviousness analysis require weighing competing teachings of the prior art?
- How much weight should courts give to evidence of secondary considerations?

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