David L McCombs, Eugene Goryunov, Jonathan Bowser, and Samuel Drezdzon in IP Magazine: 'On Second Thoughts

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In an *inter partes* review (IPR) or postgrant review (PGR) proceeding, a patent owner may attempt to rebut an obviousness showing by presenting evidence of secondary considerations tending to show non-obviousness.

Evidence of a long-felt but unsolved need, the failure of others, unexpected results, industry skepticism, commercial success, copying, licensing, and industry praise are considered in the secondary considerations inquiry. The patent owner offering evidence of secondary considerations must establish a “nexus” between the evidence and the merits of the claimed invention. Nexus must either be demonstrated or may be presumed in appropriate circumstances. In *Fox Factory, Inc v. SRAM, LLC*, the U.S. Court of Appeals for the Federal Circuit neatly harmonised existing Federal Circuit case law on when a patent owner may be entitled to a rebuttable presumption of nexus into a straightforward test.

This article reviews the Federal Circuit’s guidance in *Fox Factory*, as well as recent Patent Trial and Appeal Board (PTAB or board) decisions that applied *Fox Factory*, and analyses why some patent owners were successful in establishing a nexus while others were not.

Excerpted from *IP Magazine*. To read the full article, click on the PDF linked below.

'On Second Thoughts'

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