

Does *KSR*'s "Common Sense" Make Sense? The Federal Circuit Adjusts Obviousness in *Mintz v. Dietz & Watson*

KSR v. Teleflex marks the Supreme Court's most recent statement on the law of obviousness.¹ In *KSR*, the Supreme Court at least briefly addressed such concepts as allowing for common sense, avoiding hindsight bias, and looking to problems addressed in patents. But what do these concepts really mean? And to what extent do they apply to the obviousness equation? This year, the Court of Appeals for the Federal Circuit provided some clarification of these issues in *Mintz v. Dietz & Watson*.²

The *Mintz* Case

Facts

Mintz involves U.S. Patent No. 5,413,148 ("the '148 patent"), which claims a casing structure for encasing meat products. The '148 patent discusses two problems—the "adherence" problem and the "cost" problem—that arise in prior-art meat encasements. Prior art meat encasements use a netting that allows meat to bulge between the netting strands; this produces a desirable checkerboard pattern on the meat's surface. However, the meat in the prior art encasements bulges and cooks around the netting strands, making it difficult to peel the netting off the cooked meat ("adherence problem"). Some prior art encasements tried to solve the adherence problem by placing a separate layer of collagen film, or stockinette, between the meat and the netting. But doing so required a two-step stuffing process, which was labor intensive and expensive ("cost problem").³

To overcome the adherence and cost problems, the '148 patent "integrates a stockinette into a netting to make a new kind of meat encasement."⁴ The '148 patent therefore solved the adherence problem without the higher cost of the two-step stuffing process while still allowing some bulging to create the desirable checkerboard pattern on the meat surface.

Federal Circuit's Decision

The Federal Circuit affirmed the lower court's holding of non-infringement, but reversed a ruling that the '148 patent was invalid. The Federal Circuit determined that the district court made clear error in its factual inquiries underlying its obviousness analysis. 35 U.S.C. § 103 sets forth the statutory test for obviousness.⁵ Courts have interpreted this statutory test to require a district court to make four factual inquiries: (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and the prior art, and (4) objective evidence of nonobviousness.⁶ The *Mintz* Court's analysis of factors (2) and (3) is particularly pertinent to a consideration of the evolving standards involved in question of obviousness.⁷

1. Level of Ordinary Skill in the Art

The district court found "that the person of ordinary skill would have familiarity with the knitting art

but no familiarity with the meat encasing art.”⁸ The *Mintz* Court disagreed, concluding that “the level of ordinary skill in the art of the claimed invention includes the meat encasement art.”⁹

The *Mintz* Court’s conclusion rested on three factors. First, the specification of the ’148 patent “repeatedly focuses on the meat encasement art.”¹⁰ Second, the claims of the ’148 patent recite a meat product. In particular, claim 1 of the ’148 patent recites a “casing structure for encasing meat products,” “a meat product is stuffed into said casing structure,” and that the stockinette is “to prevent the adherence of adjacent meat product.” Finally, the ’148 patent’s adherence problem (set forth in the specification) and the solution (embodied in the claimed invention concerns meat encasement, not knitting. In particular, the ’148 patent’s Description of the Prior Art states, “It is known in the meat encasing art” and goes on to discuss the prior art meat encasements and their problems.”¹¹

These three factors, all detailed in the ’148 patent itself, led the *Mintz* court to conclude that “entirely omitting the meat encasement art led the validity search astray.”¹²

2. Differences Between the Claimed Invention and the Prior Art

The district court found all limitations of claim 1 in the prior art except the “intersecting in locking engagement” claim limitation.¹³ Nonetheless, that limitation, the district court opined, was common sense because it would have been obvious to try a locking engagement to solve the problem of forming a checkerboard pattern.

The *Mintz* Court disagreed for three reasons. First, the district court improperly relied on mere common sense; in the *Mintz* Court’s view, common sense, without further justification, has virtually no place in the obviousness analysis: “[t]he mere recitation of the words ‘common sense’ without any support adds nothing to the obviousness equation.”¹⁴ As applied to obviousness, “‘common sense’ is a shorthand label for knowledge so basic that it certainly lies within the skill set of an ordinary artisan.” Second, the district court improperly relied upon a knitter’s perspective, whereas it should have relied on the perspective of a meat encasement artisan. “The basic knowledge (common sense) of a knitting artisan is likely to be different from the basic knowledge in the possession of a meat encasement artisan.” Finally, the district court improperly “used the invention to define the problem that the invention solves.” This approach is problematic because “when someone is presented with the identical problem and told to make the patented invention, it often becomes virtually certain that the artisan will succeed in making the invention.”¹⁵

Suggestions for Using *Mintz* as a Tool to Combat an Obviousness Rejection or Obviousness-based Validity Challenge

Mintz takes a hard stance to safeguard against forbidden reliance on hindsight—a change from the uncertain language of *KSR*. To this end, *Mintz* advances two key principles:

1. a fact finder may not rely on common sense as a basis for a factual finding in an obviousness

analysis, without sufficiently showing that the common-sense knowledge would reside in the ordinarily skilled artisan;¹⁶ and

2. fact finder may not rely on a problem set forth in a patent or application as a basis for obviousness, without sufficiently showing that a person of ordinary skill in the relevant art at the time of the invention would have recognized the problem and found it obvious to generate the claimed invention in order to solve that problem.¹⁷

These principles support the following three strategies for combating an obviousness rejection or defending against an obviousness-based validity attack.

When common sense is proffered as a basis for obviousness, demand sufficient evidence showing (1) scope of the relevant art, and (2) that the allegedly common-sense knowledge would reside in a person of ordinary skill in the relevant art.

Mintz went to great lengths to explain that the district court had erred in its use of common sense to find obviousness. The opinion found the district court in clear error for using an “unsubstantiated reliance” on a “common sense approach.”¹⁸ In particular, “[t]he mere recitation of the words ‘common sense’ without any support adds **nothing** to the obviousness equation. . . . With little more than an invocation of the words ‘common sense’ . . . the district court overreached in its determination of obviousness.”¹⁹

This principle arms those seeking to defend a claimed invention against an attack that the claimed invention is “common sense” or “obvious to try.” A fact finder must articulate exactly why something would be “common sense” or “obvious to try.”²⁰ According to *Mintz*, this articulation requires a showing of what “knowledge would reside in the ordinarily skilled artisan.”²¹ This is important because “common sense” is meaningless in a vacuum; basic knowledge in one field often differs from basic knowledge in another. Therefore, a meaningful obviousness determination requires a fact finder to articulate the scope of the basic knowledge of a skilled artisan.²²

Thus, the fact finder should be urged to advance a prior art reference that demonstrates the basic knowledge of a skilled artisan. Additionally, the fact finder should be reminded that this basic knowledge is required to determine exactly what would be “common sense” to that skilled artisan.

When a fact finder relies on a problem that is set forth in a patent or application as a basis for obviousness, demand evidence showing (1) the relevant art and its scope, (2) that at the time of the invention, the person of ordinary skill in the relevant art would have recognized the problem, and (3) that at the time of the invention, the person would have arrived at the claimed invention in order to solve that problem.

Mintz also emphasizes that a fact finder errs when using the invention itself to define the problem being solved.²³ *Mintz* is clear that the problem sought to be solved may in itself be nonobvious, even if the solution to that problem is obvious.²⁴ This is because “the inventive contribution often lies in

defining the problem in a new and revelatory way.”²⁵ In other words, “when someone is presented with . . . [a] problem and told to make the patented invention, it often becomes virtually certain that the artisan will succeed in making the invention.”²⁶

This principle allows a patentee or applicant to require the fact finder to demonstrate that a person of ordinary skill in the relevant art would have recognized the problem.²⁷ A fact finder may demonstrate that a problem is obvious by, for example, identifying the problem in a reference published before the date of the invention.²⁸

Another strategy for demonstrating an improper use of hindsight is to define the problem solved “in a new and revelatory way”; this can prevent certain art from being considered analogous art. In another recent Federal Circuit case, *In re Klein*²⁹, the Federal Circuit determined that certain prior art was not analogous because it was not “reasonably pertinent to the particular problem” addressed by the invention.³⁰ As a result, that prior art could not be considered in an obviousness analysis.³¹ However, it should be noted that narrowing the scope of the problem being solved, perhaps to avoid certain art, may also narrow the scope of the invention.

Consider drafting a patent application that recites a problem in the prior art and that contains rationale clearly linking that problem to the solution that is embodied in the claimed invention.

Based on the outcome in *Mintz*, certain patentees may find it worthwhile to clearly recite the problem being solved in the specification of the patent. Clearly presenting the problem, along with a link between the problem and the solution, may be more likely to prevent the use of certain prior art against the claims in obviousness contentions. *Mintz* forbids a fact finder from using a stated problem in a patent or application, without more, to further an obviousness argument.

However, clearly reciting a problem and a link between it and the inventive solution is not without danger to the patentee or applicant. By clearly stating the problem and solution, a patentee may limit the scope of their claims to a particular art or industry.

In *Mintz*, for example, the claims at issue were limited only to meat encasements.³² Some patentees may find this type of situation acceptable, particularly when the patentee has a clear understanding of the scope of the relevant industry. However, in a relatively new or nebulous industry, a patentee may prefer to seek the broadest claims possible. In this type of situation, drafting a well-defined problem and solution may not be advisable.

Hersh H. Mehta is an MBHB associate. Mr. Mehta has extensive experience in the intellectual property field, particularly in patent procurement.

mehta@mbhb.com

Chase Means was a 2012 summer associate with MBHB.

Endnotes

1. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).
2. *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372 (Fed. Cir. 2012).
3. *Id.* at 1375.
4. *Id.*
5. *Id.* at 1374.
6. 35 U.S.C. § 103 (2006).
7. *Eli Lilly & Co. v. Teva Pharm. USA, Inc.*, 619 F.3d 1329, 1336 (Fed. Cir. 2010).
8. 679 F.3d at 1376.
9. *Id.*
10. *Id.*
11. *Id.*
12. *Id.*
13. *Id.* at 1377.
14. *Id.*
15. *Id.*
16. *See id.*
17. *See id.*
18. *Id.*
19. *Id.* (emphasis added).
20. *See id.*
21. *Id.*
22. *See id.*
23. *Id.*
24. *Id.*
25. *Id.* 26 *Id.* 27 *Id.* at 1377-78. 28 *See* 550 U.S. at 401 (recognizing that the teaching-suggestion-motivation test "captures a helpful insight"). 29 647 F.3d 1343 (Fed. Cir. 2011). 30 *Id.* at 1348. 31 *Id.* at 1350-52. 32 679 F.3d at 1374.