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New Tools for Arguing Against the Use of Hindsight and Common Sense in Obviousness Rejections

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Legal Update

In a victory for patent applicants and owners, a recent decision by the Federal Circuit re-emphasized the importance of the *Graham* factors to avoid the ever-present risk of using hindsight when making an obviousness determination, and questioned the all-too-familiar reliance on “common sense” to make obviousness arguments. In *Mintz v. Dietz & Watson, Inc.*, the court vacated a previous summary judgment ruling of obviousness against the patentee of a patent directed to a casing structure for encasing meat products. In the decision, the court repeatedly warned against “the forbidden use of hindsight” and the “prohibited reliance on hindsight,” as well as the need for “a court to walk a tightrope blindfolded (to avoid hindsight).” As discussed below, patent applicants and plaintiffs will likely find the court’s warnings useful in support of arguments against obviousness.

In vacating the summary judgment ruling of obviousness, the Federal Circuit identified several problem areas with the district court’s analysis that can be useful in arguing for patentability. One problem area related to the lower court’s erroneous discounting of the importance of familiarity or experience with the primary technical field in its analysis. Another problem area called into question the reliance on “a common sense view” or “common sense approach” to make the prior art combination. The Federal Circuit found such reliance unsubstantiated. Yet another problem area focused on the use of impermissible hindsight to piece together the obviousness rejection. The Court found that the invention was improperly used to define the problem, and further, that the importance of objective indicia as required by *Graham* was ignored. While the prejudicial effects of hindsight have been known for some time, *Mintz* reminds practitioners of several ways in which the bounds of obviousness can be stretched too far.

When references are used in a rejection, consideration should be given to the identification of a person having ordinary skill in the art and the technical field with which this person would be familiar. In *Mintz*, the Court determined that the district court omitted familiarity with the primary technical field, in this instance meat products, and instead skewed the validity search to a secondary technical field. The Court noted that without some understanding of the primary technical field in various settings, the person having ordinary skill would not grasp many aspects of the invention. Accordingly, while references from a secondary technical field can be analogous to some situations in the primary technical field, it is not permissible to exclude the primary technical field in the identification of the “person having ordinary skill in the art.”

Moreover, rejections relying on a “common sense view” or “common sense approach” must refer to knowledge so basic that it certainly lies within the skill set of a person having ordinary skill in the art. According to *Mintz*, making a bald assertion of “common sense” without additional evidence is insufficient to support an obviousness rejection. In particular, it was found that there was no support to find that it would have been “obvious to try” a locking engagement between the longitudinal and lateral strands of the netting arrangement. While the criteria for supportive evidence remains uncertain, factual evidence must be provided to substantiate the assertion that the asserted knowledge is basic in that art. Therefore, practitioners should be on the lookout for “common sense” reasoning in a rejection and require the Examiner to present factual evidence to substantiate the “common sense” assertion.

Additionally, this case joins a litany of other cases that strongly urge against the use of hindsight in making an obviousness rejection. *Mintz* focuses on making sure that reliance on hindsight does not result in a failure to consider objective indicia of non-obviousness, such as those provided in the *Graham* factors. In fact, *Mintz* makes clear that the consideration of objective indicia is not discretionary; it is mandatory. “[O]bjective criteria thus help turn back the clock and place the claims in the

context that led to their invention.” Some of the more useful indicia can include unexpected results, expert skepticism, copying, commercial success, praise by others, failure by others, and long-felt need, many of which can help to establish an understanding of the problem at the time of the invention. While the weight such indicia should be given in view of the obviousness rejection is case dependent, *Mintz* insures that the presentation of the indicia cannot be wholly dismissed and must be fully considered in light of obviousness. Thus, incremental inventions with respect to an easily understood technology are not necessarily obvious when viewed in the context of objective indicia of non-obviousness.

While uncertainty remains regarding the criteria for factual evidence needed to substantiate “common sense” assertions and the weight given to secondary considerations of objective indicia, the impact of *Mintz* is overall a boon for applicants and plaintiffs. In this regards, practitioners should be on the lookout to call out prejudicial effects of hindsight by: 1) considering the appropriate prior art in the invention’s relevant field of art; 2) requiring “common sense” reasoning be fully articulated and substantiated; and 3) emphasizing the impact of objective indicia on nonobviousness.

This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.

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