

Defeating Obviousness Rejections by Arguing Against Improper Prior Art Modifications

Article By:

Bethany R. Lahmann

In an opinion issued on June 5, 2023, the Federal Circuit provided a useful framework for overcoming obviousness rejections during patent prosecution, where a proposed modification to a prior art reference renders it unsatisfactory for its intended purpose.^[1] Appropriately applying this framework may provide a strong position against a motivation to combine references, or otherwise modify a prior art device in an obviousness rejection.

In *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, Medtronic appealed an *inter partes* review decision of the Patent Trial and Appeal Board, holding that Medtronic had failed to establish unpatentability of various claims of U.S. Patent Nos. RE45,380; RE45,760; and RE47,379.^[2] Arguing that Teleflex's claims were obvious over the cited references, Medtronic maintained that the intended purpose of the prior art is not dispositive of whether a skilled artisan would have been motivated to make a modification.^[3] Medtronic raised the 2021 Federal Circuit case, *Intel Corp. v. Qualcomm Inc.*, 21 F. 4th 784, (Fed. Cir. 2021) as allegedly supporting this contention.^[4] As explained in the present case, in *Intel*, the Federal Circuit rejected the Patent Trial and Appeal Board's reasoning that a proposed rationale for modifying a circuit was insufficient because it would have resulted in the circuit not being suitable for its intended purpose.^[5] However, the Federal Circuit distinguished the present case from *Intel* because the *Intel* prior art made express recognition of use cases that were compatible with the proposed modification.^[6]

The patents of the present case are directed to coaxial extension catheters, which are insertable into standard guide catheters.^[7] The primary reference, Ressemann (U.S. Patent No 7,604,612), cited by Medtronic, disclosed an evacuation sheath assembly used to aspirate embolic material while occluding blood flow using sealing balloons.^[8] Medtronic argued that a skilled artisan would have been motivated to modify Ressemann by removing its sealing balloons and replacing its inflation lumen with a pushrod or wire so that it could be used as an extension catheter.^[9]

As opposed to *Intel*, in the present case, it was found that the above-proposed modifications would destroy the prior art's entire premise (embolic protection), strongly counseling against an obviousness determination.^[10] In its analysis, the Federal Circuit placed significant emphasis on whether the purpose of the device is shared with that of the challenged claims.^[11] That is, where a modification would undermine a device's ability to meet its desired goals (here safely advancing interventional devices to treat cardiac lesions)^[12], which is the same goal as that of the examined

claims, there would be less motivation to modify the reference to read on the examined claims. The Federal Circuit also concluded that the substantial additional modifications in view of the proposed modifications necessary to continue to allow the prior art device to function according to its primary premise, also was suggestive of impermissible hindsight bias.^[13]

In arguing non-obviousness of a proposed modification to a prior art reference, patent prosecutors should consider the following factors in determining whether a proposed modification would render the prior art reference unsatisfactory for its intended purpose:

- 1) What is the primary prior art reference's main purpose?
- 2) Is the main purpose the same as that of the examined claims? (Are both directed to the same functionality?)
- 3) Would the modification undermine the prior art device's ability to perform its main purpose?
- 4) Would further modifications be necessary to still allow the prior art to function in accordance with its primary premise? (Are such modifications extensive?)
- 5) Are there other functions disclosed in the prior art that would be consistent with the proposed modification and to what degree are they disclosed?

As an example, a strong showing against a motivation to modify primary reference would include:

- (1) the main purpose is the same as that of the examined claims;
- (2) the proposed modification would undermine the ability of the primary reference device to perform its main purpose;
- (3) any further modifications necessary for the modified prior art device to continue to function in accordance with its main purpose would be extensive; and
- (4) there are not alternative functions disclosed that would be consistent with the proposed modification.

For patent practitioners, especially those in the mechanical arts, applying these considerations provides an effective framework for refuting a *prima facie* case of obviousness.

FOOTNOTES

[1] *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, No. 21-2359, (Fed. Cir. 2023).

[2] *Id.* at 2.

[3] *Id.* at 11.

[4] *Id.*

[5] *Id.* at 13 (quoting *Intel*, 21 F.4th at 800).

[6] See *id.* at 13 (citing *Intel*, 21 F.4th at 801).

[7] *Id.* at 3.

[8] *Id.* at 4.

[9] *Id.* at 8.

[10] *Id.* at 13.

[11] See *id.* at 13-14.

[12] *Id.* at 12.

[13] *Id.*

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