On August 23rd, the Federal Circuit upheld in part and reversed in part a decision from the Patent Trial and Appeal Board’s (PTAB or Board) concerning Ethicon’s patent on a robotic surgical tool, holding that the Board’s finding of no motivation to combine is not supported by substantial evidence. In doing so, the court determined the PTAB “went too far” in its holding of non-obviousness by requiring Intuitive to specifically identify a preexisting surgical device performing as many functions as required by the Ethicon patent; it was enough that the prior art established such a device was “at least possible.”

Ethicon and Intuitive Surgical are competitors in the surgical technology market.
Ethicon owns U.S. Patent No. 8,616,431 directed to a tool mounting device for coupling a surgical tool to a robotic system with four output bodies to control five different motions or functions. Intuitive filed an inter partes review on anticipation and obviousness grounds. With respect to the obviousness grounds, Intuitive Surgical relied on the combination of two earlier patents — the “Tierney Patent” and the “Whitman Patent.”

The Tierney Patent disclosed a robotic surgical system where a number of different tool types can be coupled to a robotic manipulator. The device of the Tierney Patent comprises four rotary drive elements that control only four different motions. The Whitman Patent discloses a shifter that allows a single rotary output body to control more than one motion.

Ethicon did not dispute—either before the Board or on appeal—Intuitive’s assertion that the prior art teaches each and every limitation of all of the challenged claims. Ethicon’s sole argument before the Board was that a person of ordinary skill in the art would not have been motivated to combine the prior art references to arrive at the claimed invention. The Board agreed with Ethicon. The Board recognized that the combination of Whitman and Tierney would be able to perform more than the four functions disclosed in Tierney. However, it was unpersuaded that a person of ordinary skill would have been motivated to combine the references because Intuitive failed to identify a surgical instrument in the prior art that performed more than four functions. As a result, the PTAB determined there would be no need “to obtain a functionality for which there was no use.”

The Federal Circuit disagreed, finding, as an initial matter, the Board’s determination that Intuitive failed to identify a surgical instrument performing more than four functions was not supported by the evidence; Intuitive had, in fact, cited a third patent (the “Timm Patent”) disclosing at least five different functions. However, even without the Timm Patent, the Federal Circuit found Intuitive presented enough evidence that the combination of Whitman and Tierney rendered the challenged claims obvious.

The Federal Circuit found it was enough that the combination of Whitman and Tierney would allow for more than four functions; the prior art disclosed that a device performing more than four functions was “at least possible.” In light of this evidence, the Federal Circuit found the PTAB erred in requiring Intuitive to specifically identify a preexisting device that actually performed more than four functions.

This decision underscores that a finding of obviousness may result when a combination of prior art shows the claimed technology to be “at least possible.”

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