

PRIMA FACIE* OBVIOUSNESS: BLIND EYE ON MADISON PLACE?

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“For too long, this court has turned a blind eye to what [the author] consider[s] to be a grave concern: the application of a prima facie test that necessarily achieves a legal determination of obviousness prior to full and fair consideration of evidence of objective indicia of non-obviousness.”

Hon. Jimmie Reyna, dissent in
Intercontinental Great Brands
(see § V, pp. 19 *et seq.*)

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* This paper was completed on September 13, 2017. It represents the views of the author and is without sponsorship from any other person or organization.

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I. OVERVIEW

More than fifty years since the Federal Circuit decision in *In re Papesch*, 315 F.2d 381 (CCPA 1963), spawned the current procedural mechanism for obviousness involving, *first*, the establishment of a *prima facie* case of obviousness by the Examiner or the patent challenger, which, *second*, if present, then triggers a procedural burden on the patent applicant or patentee to establish unobvious results to overcome such a *prima facie* case.

Establishment of a *prima facie* case is thus part of a procedural mechanism to determine whether an invention is obvious.¹ See § II, *The Kahn Prima Facie Analysis Cited in KSR*. The matter is not that simple, however, as manifested by the three member panel issuing three separate opinions in the *Oetiker* case. See § III, *The Three Separate Opinions in the Oetiker Case*.

Papesch is not a moribund, isolated precedent from more than fifty years ago. Rather, it has been followed in dozens of Court cases, endorsed by the *en banc* Federal Circuit and followed by several of the regional circuits from the days prior to creation of the Federal Circuit. Literally hundreds of Patent Office decisions have relied upon *Papesch*. See § IV, *Whither Stare Decisis?*

¹ *In re Piasecki*, 745 F.2d 1468, 1471-72 (Fed. Cir. 1984)(Newman, J.) (“The concept of *prima facie* obviousness in *ex parte* patent examination is but a procedural mechanism to allocate in an orderly way the burdens of going forward and of persuasion as between the examiner and the applicant.”)

Wegner, *Prima Facie Obviousness: Blind Eye on Madison Place?*

Now, a bold challenge has been made to the procedural regime that has existed since *Papesch*: In *Intercontinental Great Brands* a panel member in dissent has stated that “[f]or too long, this court has turned a blind eye to what [the author] consider[s] to be a grave concern: the application of a prima facie test that necessarily achieves a legal determination of obviousness prior to full and fair consideration of evidence of objective indicia of non-obviousness. There should be no prima facie rule or test in the obviousness inquiry. Stated differently, the burden of persuasion should not shift from the challenger to the patent holder after a legal determination of obviousness has already been made.”² See § V, *Judge Reyna’s Dissent in Intercontinental Great Brands*.

II. THE *KAHN PRIMA FACIE* ANALYSIS CITED IN *KSR*

Quoting Circuit Judge Linn in the *Kahn* case, the Supreme Court in *KSR* explains that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”.³ As set forth in more detail in the *Kahn* case itself “[t]o reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima*

² *Intercontinental Great Brands LLC v. Kellogg North America Co.*, ___ F.3d ___, ___, 2017 WL 3906853 (Fed. Cir. Sept. 7, 2017)(Reyna, J., dissenting-in-part).

³ *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)(Linn, J.).

facie case with evidence of secondary indicia of nonobviousness.”⁴ Circuit Judge Linn elaborated on what was said for the *en banc* Federal Circuit by Judge Lourie in the *Dillon* case:

[I]f an examiner considers that he has found prior art close enough to the claimed invention to give one skilled in the relevant chemical art the motivation to make close relatives (homologs, analogs, isomers, etc.) of the prior art compound(s), then there arises what has been called a presumption of obviousness or a *prima facie* case of obviousness. *In re Henze*, 181 F.2d 196 (CCPA 1950); *In re Hass*, 141 F.2d 122, 127, 130 (CCPA 1944). The burden then shifts to the applicant, who then can present arguments and/or data to show that what appears to be obvious, is not in fact that, when the invention is looked at as a whole. *In re Papesch*, 315 F.2d 381 (CCPA 1963). The cases of *Hass* and *Henze* established the rule that, unless an applicant showed that the prior art compound lacked the property or advantage asserted for the claimed compound, the presumption of unpatentability was not overcome.⁵

In more detail, Circuit Judge Linn in the *Kahn* case explains:

Most inventions arise from a combination of old elements and each element may often be found in the prior art. [*In re Rouffet*, 149 F.3d 1350, 1357 (Fed.Cir.1998)]. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357. Rather, to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this requires that the Board “explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.” *Id.* at 1357–59. This entails consideration of both the “scope and content of the prior art” and “level of ordinary skill in the pertinent art” aspects of the *Graham* test.

⁴ *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006)(Linn, J.)(quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed.Cir.1998)).

⁵ *In re Dillon*, 919 F.2d 688, 696 (Fed. Cir. 1990)(Lourie, J.)(*en banc*)

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious. *Id.* at 1358. The “motivation-suggestion-teaching” requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. *See* 35 U.S.C. § 103 (stating that obviousness must be assessed “at the time the invention was made”)[*In re Dembiczak*, 175 F.3d 994, 998 (Fed.Cir.1999)] (“[I]t is this phrase that guards against entry into the tempting but forbidden zone of hindsight.” (internal quotations omitted)); Giles S. Rich, *Laying the Ghost of the Invention Requirement*, 1 APLA Q.J. 26–45 (1972), reprinted in 14 Fed. Cir. B.J. 163, 170 (2004) (“To protect the inventor from hindsight reasoning, the time is specified to be *the time when the invention was made.*”) (emphasis in original). The Supreme Court recognized the hindsight problem in *Graham* and proposed that “legal inferences” resulting from “secondary considerations” might help to overcome it. 383 U.S. at 36 (“[Secondary considerations] may also serve to guard against slipping into use of hindsight, and to resist the temptation to read into the prior art the teachings of the invention in issue.” (internal quotations omitted)). By requiring the Board to explain the motivation, suggestion, or teaching as part of its *prima facie* case, the law guards against hindsight in all cases—whether or not the applicant offers evidence on secondary considerations—which advances Congress's goal of creating a more practical, uniform, and definite test for patentability. *See Dann*, 425 U.S. at 225–26 (“[I]t was only in 1952 that Congress, in the interest of ‘uniformity and definiteness,’ articulated the requirement in a statute.” (quoting S.Rep. No.1979, at 6 (1952); H.R.Rep. No.1923, at 7 (1952))); *Graham*, 383 U.S. at 17 (“The § 103 [test], when followed realistically, will permit a more practical test of patentability.”).

Although [the CCPA] was the first to articulate the motivation-suggestion-teaching test, a related test—the “analogous art” test—has long been part of the primary *Graham* analysis articulated by the Supreme Court. *See Dann*, 425 U.S. at 227–29; *Graham*, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed.Cir.1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.”

(quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A.1979))). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. *See id.*; *In re Clay*, 966 F.2d 656, 659–60 (Fed.Cir.1992).

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, *see* § 103(a); *Graham*, 383 U.S. at 35; *Dann*, 425 U.S. at 227–29, and helps ensure predictable patentability determinations.

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as

“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references.... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.”

In re Kotzab, 217 F.3d 1365, 1370 (Fed.Cir.2000) (internal citations omitted). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See Lee*, 277 F.3d at 1343–46; *Rouffet*, 149 F.3d at 1355–59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in § 103. *See id.* at 1344–45.

In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. *See, e.g., Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed.Cir.2005) (“One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.”); *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed.Cir.2000)

(“Although the suggestion to combine references may flow from the nature of the problem, ‘[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.’ ” (internal citation omitted) (quoting *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed.Cir.1998))); *In re Beattie*, 974 F.2d 1309, 1312 (Fed.Cir.1992) (“[T]he law does not require that the references be combined for the reasons contemplated by the inventor.”); *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed.Cir.2005) (characterizing the relevant inquiry as “[would] an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, [] have selected the various elements from the prior art and combined them in the manner claimed”); *see also Graham*, 383 U.S. at 35 (characterizing the problem as involving mechanical closures rather than in terms more specific to the patent in the context of determining the pertinent prior art). Therefore, the “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. *See Cross Med. Prods.*, 424 F.3d at 1321–24.

From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art—*i.e.*, the understandings and knowledge of persons having ordinary skill in the art at the time of the invention—support the legal conclusion of obviousness. *See Princeton Biochemicals*, 411 F.3d at 1338 (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).⁶

As explained in the *Mayne* case, “[w]hen the PTO shows prima facie obviousness, the burden then shifts to the applicant to rebut.”⁷

⁶ *Kahn*, 441 F.3d at 986-88 (footnotes omitted).

⁷ *In re Mayne*, 104 F.3d 1339, 1341-42 (Fed. Cir. 1997)(Rader, J.) (“[In the case of chemical compounds, t]he Patent and Trademark Office (PTO) has the burden of showing a prima facie case of obviousness. *In re Bell*, 991 F.2d 781, 783 (Fed.Cir.1993); *see In re Fine*, 837 F.2d 1071, 1074 (Fed.Cir.1988). * * * Over thirty years ago, courts recognized that unexpected properties can show that a claimed compound that appeared to be obvious on structural grounds was not obvious when looked at as a whole. *See, e.g., In re Papesch*, 50 C.C.P.A. 1084, 315 F.2d 381, 391(CCPA 1963). * * * When the PTO shows prima facie obviousness, ***the burden then shifts to the applicant to rebut.*** [*In re Dillon*, 919 F.2d 688, 692 (Fed.Cir.1990) (en banc)]. Rebuttal may take the form of ‘a comparison of test data showing that the claimed compositions possess unexpectedly improved properties ... that the prior art does not have, that the prior art is so deficient that there is no motivation to make what might otherwise appear to be obvious changes, or any other argument ... that is pertinent.’ *Id.* at 692–93 (citations omitted).”(emphasis added).

III. THREE SEPARATE OPINIONS IN THE *OETIKER* CASE

That the matter is not so simple is seen from the *Oetiker* case that generated three opinions for the three judge panel. First, there is the explanation from the senior member of the panel:

The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n. 3(Fed.Cir.1990). The term “*prima facie* case” refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed.Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. *See In re Spada, supra; In re Corkill*, 771 F.2d 1496, 1500 (Fed.Cir.1985); *In re Caveney*, 761 F.2d 671, 674(Fed.Cir.1985); *In re Johnson*, 747 F.2d 1456, 1460 (Fed.Cir.1984).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *See In re Grabiak*, 769 F.2d 729, 733 (Fed.Cir.1985); *In re Rinehart, supra*.

In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument. An observation by the Board that the examiner made a *prima facie* case is not improper, as long as the ultimate determination of patentability is made on the entire record. *In re Piasecki*, 745 F.2d at 1472; *In re Rinehart*, 531 F.2d at 1052.

The record here reveals that the application was fully prosecuted. References were cited and applied by the examiner, the applicant responded with argument, and the examiner then issued a final rejection, stating why he was not persuaded by the applicant's argument. On review the Board stated that its decision was reached “after careful consideration of the appealed claims, the evidence of obviousness relied upon by the examiner and the arguments advanced by the appellant and the examiner”. The Board explained why it was unpersuaded by *Oetiker's* arguments

on appeal. We discern no irregularity in the procedure. The Board, in explaining that the examiner's rejections constituted a *prima facie* case of obviousness, did not make a new rejection.

Oetiker also argues that the concept of a “*prima facie* case of obviousness” has no role outside of the chemical arts. Oetiker refers to the origins of this term in the chemical practice, where properties may not be apparent from chemical structure. Oetiker distinguishes mechanical inventions, where the properties and workings of a mechanical device are apparent in the drawing of the structure. We think that the PTO is correct in treating the concept of the *prima facie* case as of broad applicability, for it places the initial burden on the examiner, the appropriate procedure whatever the technological class of invention. That a *prima facie* case may be established, or rebutted, by different forms of evidence in various technologies does not restrict the concept to any particular field of technology. “[T]he requirement of unobviousness in the case of chemical inventions is the same as for other types of inventions”. *In re Johnson*, 747 F.2d at 1460. This procedural tool is recognized in fields outside of the chemical arts. *E.g.*, *In re Benno*, 768 F.2d 1340 (Fed.Cir.1985); *In re McCarthy*, 763 F.2d 411 (Fed.Cir.1985); *In re De Blauwe*, 736 F.2d 699 (Fed.Cir.1984).

The Board's usage of the term *prima facie* was imprecise for, as discussed *supra*, the term “*prima facie* obvious” relates to the burden on the examiner at the initial stage of the examination, while the conclusion of obviousness *vel non* is based on the preponderance of evidence and argument in the record. However, it was clear that the Board did not make a new rejection. Therefore the Board did not err in declining to consider at that stage the proffered evidence of commercial success.⁸

The Chief Judge of the court was compelled to offer her views in a concurring opinion:

I *** write only to express my understanding of the language that there must be some teaching, reason, suggestion, or motivation found “in the prior art” or “in the prior art references” to make a combination to render an invention obvious within the meaning of 35 U.S.C. § 103 (1988). Similar language appears in a number of opinions and if taken literally would mean that an invention cannot be held to have

⁸ *In re Oetiker*, 977 F.2d 1443, 1445-46 (Fed.Cir.1992)(Newman, J.).

been obvious unless something specific in a prior art reference would lead an inventor to combine the teachings therein with another piece of prior art.

This restrictive understanding of the concept of obviousness is clearly wrong. Other statements in opinions express the idea more generally. We have stated, for example, that the test is: “whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention,” *In re Gorman*, 933 F.2d at 986, and “what the combined teachings ... would have suggested to one of ordinary skill in the art,” *In re Young*, 927 F.2d 588, 591 (Fed.Cir.1991). We have also stated that “the prior art as a whole must suggest the desirability ... of making the combination.” *Uniroyal, Inc. v. Rudkin–Wiley Corp.*, 837 F.2d 1044, 1051 (Fed.Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed.Cir.1984).

I believe that it would better reflect the concept of obviousness to speak in terms of “*from* the prior art” rather than simply “*in* the prior art.” The word “from” expresses the idea of the statute that we must look at the obviousness issue through the eyes of one of ordinary skill in the art and what one would be presumed to know with that background. What would be obvious to one of skill in the art is a different question from what would be obvious to a layman. An artisan is likely to extract more than a layman from reading a reference.

In any event, variance in the language used in opinions does not change the nature of the statutory inquiry. Under section 103, subject matter is unpatentable if it “would have been obvious ... to a person having ordinary skill in the art.” While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination. *In re Nilssen*, 851 F.2d 1401, 1403 (Fed.Cir.1988). Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037 (CCPA 1979). *See, also, EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 906–07 (Fed.Cir. 1985); *In re Sernaker*, 702 F.2d 989, 995 (Fed.Cir.1983). *See also, Ex parte Clapp*, 227 USPQ 972, 973 (Bd.Pat.App. & Inter. 1985) (“To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found *in* a specific reference.⁹

The third member of the panel expressed a different viewpoint:

* * * [Judge Newman's] explanation of the meaning and application of the 'prima facie case' concept should help clarify an area that remains marked by a lack of clarity. The need for that discussion, however, illustrates the pitfalls of the 'prima facie' practice of the PTO, and the difficulties created by this particular legalistically convoluted concept.

An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent. *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967). In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct. *In re Caveney*, 761 F.2d 671, 674 (Fed.Cir.1985).

The process of patent examination is an interactive one. *See generally*, Chisum, *Patents*, § 11.03 *et seq.* (1992). The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion, the exact origin of which appears obscure (*see In re Piasecki*, 745 F.2d 1468, 1472 (Fed.Cir.1984)), seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness.

⁹ *In re Oetiker*, 977 F.2d 1443, 1447-48 (Fed.Cir.1992)(Nies, C.J., concurring)(footnote omitted).

But the ultimate decision that must be made by the PTO in the examination process, and by this court on appeal, is not whether a prima facie case for rejection was made; the only question is whether, on the whole record, the applicant has met the statutory requirements for obtaining a patent. When a final rejection is described in terms of whether a prima facie case was made, that intermediate issue diverts attention from what should be the question to be decided.

Specifically, when obviousness is at issue, the examiner has the burden of persuasion and therefore the initial burden of production. Satisfying the burden of production, and thus initially the burden of persuasion, constitutes the so-called prima facie showing. Once that burden is met, the applicant has the burden of production to demonstrate that the examiner's preliminary determination is not correct. The examiner, and if later involved, the Board, retain the ultimate burden of persuasion on the issue.

If, as a matter of law, the issue is in equipoise, the applicant is entitled to the patent. Thus on appeal to this court as in the PTO, the applicant does not bear the ultimate burden of persuasion on the issue. In the end there is no reason there or here to argue over whether a 'prima facie' case was made out. The only determinative issue is whether the record as a whole supports the legal conclusion that the invention would have been obvious.¹⁰

¹⁰ *In re Oetiker*, 977 F.2d 1443, 1448-49 (Fed.Cir.1992)(Plager, J., concurring).

IV. WHITHER STARE DECISIS?

In the first instance, we have the *en banc* endorsement of *Papesch* in *In re Dillon*, 919 F.2d 688, 696 (Fed. Cir. 1990)(Lourie, J.)(*en banc*), not to mention the dozens of CCPA and Federal Circuit cases relying on *Papesch* as well as the several *hundred* Patent Office decisions also keyed to *Papesch*.

But, there is more:

The several circuit courts that dealt with the issue prior to the creation of the Federal Circuit have weighed in on *Papesch* and endorsed its rationale (while in some situations reaching a holding on a different issue). See *Commissioner of Patents v. Deutsche Gold-und-Silber Scheideanstalt Vormals Roessler*, 397 F.2d 656 (D.C. Cir. 1968); *Carter-Wallace, Inc. v. Otte*, 474 F.2d 529 (2nd Cir. 1972)(dicta); *Monsanto Co. v. Rohm & Haas Co.*, 456 F.2d 592 (3rd Cir. 1972)(dicta); *Eli Lilly and Co. v. Premo Pharmaceutical Laboratories, Inc.*, 630 F.2d 120 (3rd Cir. 1980); and *Eli Lilly & Co., Inc. v. Generix Drug Sales, Inc.*, 460 F.2d 1096 (5th Cir. 1972).

Wegner, *Prima Facie Obviousness: Blind Eye on Madison Place?*

As explained in *Carter-Wallace v. Otte*:

“Chemists do not invent new compounds just for fun. As this court has observed in a decision upholding the validity of a patent on a new chemical compound even though the compound was ‘the end product of a fairly simple series of chemical reactions,’ *Schering Corp. v. Gilbert*, 153 F.2d 428, 431 (2 Cir. 1946), it must be ‘kept in mind that such things must be evaluated not alone by the degree of the change but also by reference to the purpose sought to be accomplished.’ 153 F.2d at 432. The Court of Customs and Patent Appeals has similarly rejected the contention that the obvious chemical structure of a new compound should bar patentability as a new composition of matter. *In re Papesch*, 315 F.2d 381 (CCPA 1963). The doctrine which that court has evolved, as approved by the Court of Appeals for the District of Columbia Circuit in *Commissioner of Patents v. Deutsche Gold-und-Silber Scheideanstalt Vormals Roessler*, 397 F.2d 656, 661 (D.C. Cir. 1968), holds that: ‘Obvious molecular modification coupled with a showing of novel [or unexpected] properties or superiority of known properties can establish patentability.’”¹¹

The Third Circuit in *Eli Lilly v. Premo Pharmaceutical Laboratories* integrated *Papesch* into the framework of *Graham v. John Deere*:

[T]he Court [in *Graham v. John Deere & Co.*, 383 U.S. 1 (1966),] observed that ‘[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. [*Id.* at 17-18.] In cases dealing with the patentability of chemical compounds, the question of obviousness is particularly difficult because the differences between the molecular structure of the new drug and the prior art frequently are slight. Hence, the structure of the new compound may well be obvious when compared with the structure of related drugs that were in existence at the time the new drug was synthesized. Under these circumstances, if the patent law were to define a drug solely by its chemical structure, few new drugs would be patentable. As a consequence, the weight of authority – including every court of appeals that has addressed this question – holds that the structural obviousness of a new chemical compound does not, by itself, render the compound non-patentable. Instead, most

¹¹ *Carter-Wallace, Inc. v. Otte*, 474 F.2d 529, 539-540 (2nd Cir. 1972)(dicta).

courts have taken the view that the determination whether a new drug is nonobvious should be based on a consideration of the properties exhibited by the drug as well as the chemical structure of the drug.

“The Court of Customs and Patent Appeals was the first appellate court explicitly to adopt this approach. That court's leading opinion on structural obviousness and § 103 is *In re Papesch*, [315 F.2d 381 (C.C.P.A.1963),] dealt with the validity of a patent on several trialkyl compounds. The hearing examiner had rejected the patent application on the ground that the new compounds were ‘obvious homologues of the methyl groups shown in the reference compound and the method of preparation [was] substantially the same.’ The court held that although the new compounds were closely related chemically to the prior art, and therefore were structurally obvious, the drugs nevertheless were patentable. After reviewing a number of its own decisions, in which “patentability was found . . . in spite of close similarity of chemical structure,” the court declared:

“From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing. The graphic formulae, the chemical nomenclature, the systems of classification and study such as the concepts of homology, isomerism, etc., are mere symbols by which compounds can be identified, classified, and compared. But a formula is not a compound and while it may serve in a claim to identify what is being patented, as the metes and bounds of a deed identify a plot of land, the thing that is patented is not the formula but the compound identified by it.’ [315 F.2d at 391.]

“The court concluded that ‘[t]here is no basis in law for ignoring any property in making such a comparison.’ [*Id.*] Patentability therefore depends on the outcome of a comparison of both the chemical and pharmacological properties of the old and new compounds.”¹²

¹² *Eli Lilly and Co. v. Premo Pharmaceutical Laboratories, Inc.*, 630 F.2d 120, 127-28 (3rd Cir. 1980)(footnotes integrated into text in brackets or omitted).

Wegner, *Prima Facie Obviousness: Blind Eye on Madison Place?*

The Third Circuit in *Monsanto v. Rohm & Haas*, while denying relief to the patentee on other grounds, nevertheless went out of its way to endorse the basic principles of *Papesch*:

“In [*In re Papesch*, 315 F.2d 381, 391 (CCPA 1963)], while considering the importance of properties of new chemical compounds in the context of determining unobviousness, Judge Rich emphasized:

“ ‘From the foregoing cases it will be seen that this and other courts, . . . have determined the unobviousness and patentability of new chemical compounds by taking into consideration their biological or pharmacological properties. Nine of the ten cases above considered, directly or indirectly, involved such properties. Patentability has not been determined on the basis of obviousness of structure alone. In fact, where patentability was found in the above cases it was found in spite of the close similarity of chemical structure, often much closer similarity than we have here.

“ . . . From the standpoint of patent law, a compound and all its properties are inseparable; they are one and the same thing.’

“See also *Commissioner of Patents v. Deutsche*, 397 F.2d 656 (D.C.Cir. 1969) where Chief Justice, then Judge, Burger, emphasized this same principle.”¹³

¹³ *Monsanto Co. v. Rohm & Haas Co.*, 456 F.2d 592, 600 (3rd Cir. 1972)(dicta).

The Fifth Circuit in *Eli Lilly & Co. v. Generix Drug Sales* adopted the law of *Papesch* for its court:

[Here], we necessarily decide the issue which we did not have to reach in *Monsanto Co. v. Dawson Chemical Co.*, 312 F.Supp. 452 (S.D.Tex. 1970), *rev'd. on other grounds*, 443 F.2d 1035 (5th Cir. 1971). In that case a chemical compound was discovered to exhibit novel, useful, herbicidal activity. An adjacent homologue was disclosed in the prior art, but recognized to be of value only in making pigment. That appeal was controlled by the application of collateral estoppel and we did not decide the merits. In today's holding, we follow the rationale which underlies the decision of the Court of Customs and Patent Appeals in *In re Stemniski*, 444 F.2d 581 (CCPA 1971); and *Commissioner of Patents v. Deutsche Goldund-Silber-Scheideanstalt Vormals Roessler*, 397 F.2d 656 (D.C. Cir. 1968). See Note: Patentability of Chemical Compounds, 50 Tex.L.Rev. 566.

In the field of drug patents today therapeutic value, not chemical composition, is the substance of all incentive to invent. Except where the state of the medical art and the state of the chemical art have been advanced and coordinated to the point that it is possible for the mind to conceive or predict with some minimal reliability a correlation between chemical analogues, homologues or isomers and their therapeutic value, reason compels us to agree that novelty, usefulness and non-obviousness inhere in the true discovery that a chemical compound exhibits a new needed medicinal capability, even though it be closely related in structure to a known or patented drug. When such a fresh, efficacious, undisclosed use is identified, its inventor deserves the full ambit of statutory protection. A limitation to "use" or process patentability, based solely on the existence of prior chemical formulations, would not accord with the basic constitutional power being exercised by the Congress to promote science and the useful arts. Such a niggardly patent reward for costly and painstaking research would discourage both the inspiration-perspiration process of the laboratory and the incentive to publicly disclose products of value to mankind.

However, where a court finds the alleged inventor's work in a field filled with formidable prior art to be no more novel or non-obvious than the conducting of a biological or physiological testing program among catalogued compounds or an easily formulated series of homologues or analogues that logically or predictably should disclose helpful uses, the grant or validation of a patent on the product would be out of keeping with the letter or spirit of the law. This conclusion would be even more compelled where the use claimed by such a tester in his application turns out to be a minor value of the drug which the patent would monopolize. See Judge Dooling's opinion on remand in *Carter-Wallace, Inc. v. Davis-Edwards Pharmacal Corp.*, 341 F.Supp. 1303 (E.D.N.Y.1972).¹⁴

V. REYNA DISSENT IN *INTERCONTINENTAL GREAT BRANDS*

The opinion of Circuit Judge Reyna speaks for itself:

* * * I disagree *** with the majority's decision that affirms the district court's grant of summary judgment of obviousness. I would find that the district court improperly found a prima facie case of obviousness before considering Kraft's evidence of objective indicia of nonobviousness. * * *

* * *

I.

A. Statutory Requirement of Non-Obviousness

In 1952, Congress amended the Patent Act to, inter alia, require that patents be non-obvious. 35 U.S.C. § 103; 2 Donald S. Chisum, *Chisum on Patents* § 5.02[4] (“In Section 103 of the Patent Act of 1952, Congress for the first time gave express legislative recognition to the judicially-developed doctrine that something more than strict novelty is required in order to support a patent.”). Section 103 codified what the common law already had required for a century. See *Hotchkiss v.*

¹⁴ *Eli Lilly & Co., Inc. v. Generix Drug Sales, Inc.*, 460 F.2d 1096, 1103 (5th Cir. 1972).

M. Greenwood & Co., 52 U.S. (11 How.) 248 (1850). A claimed invention is unpatentable “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103.

B. Supreme Court Precedent

The Supreme Court first addressed § 103 in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The Court set forth the framework for determining whether patent claims would have been obvious:

“Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.”

Id. at 17–18, 86 S.Ct. 684 (citation omitted). The Court noted that objective indicia of non-obviousness are “more susceptible of judicial treatment” than the other “highly technical facts” relevant to an obviousness analysis. *Id.* at 36. Objective indicia “may lend a helping hand to the judiciary” that “is most ill-fitted to discharge the technological duties cast upon it by patent legislation.” *Id.* Objective indicia, the Court wrote, help guard against hindsight and “the temptation to read into the prior art the teachings of the invention in issue.” *Id.*

More recently, the Supreme Court clarified the obviousness analysis in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). It explained that trial courts must consider the four Graham factors to determine whether an asserted claim would have been obvious: (1) the scope and content of prior art; (2) the differences between the prior art and asserted claims; (3) the level of ordinary skill; and (4) objective indicia of non-obviousness. *KSR*, 550 U.S. at 406 (citing *Graham*, 383 U.S. at 17–18). The Court noted that “the sequence of these questions might be reordered in any particular case.” *Id.* at 407. It also cautioned fact finders to

consider “the distortion caused by hindsight bias” and “be cautious of arguments reliant upon ex post reasoning.” *Id.* at 421. In *KSR*, however, the patentee's minimal evidence of objective indicia did not “dislodge” the obviousness determination. *Id.* at 426. Thus, the Supreme Court held that the asserted claim would have been obvious. *Id.*

To be clear, nothing in *Graham* or *KSR* requires courts to analyze the first three *Graham* factors first, make a prima facie determination of obviousness, and only then examine objective indicia of non-obviousness. Such a prima facie framework excludes objective indicia in the primary analysis and artificially creates a heightened standard of proof for objective indicia. I am not aware of any Supreme Court authority that endorses—let alone requires—the prima facie framework.

C. Federal Circuit Precedent

This court explained the basic obviousness analysis in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). In *Stratoflex*, the district court concluded that the claimed inventions were “plainly obvious.” 713 F.2d at 1539. As a result, it refused to analyze objective indicia of non-obviousness. *Id.* We held that such an approach was error, noting that each *Graham* factor “is but an aid” in determining whether the claimed invention would have been obvious. *Id.* at 1537. And although we discussed objective indicia after the other three *Graham* factors, we elaborated at length about their importance:

“It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included. Thus evidence rising out of the so-called “secondary considerations” must always when present be considered en route to a determination of obviousness. Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art. ... En route to a conclusion on obviousness, a court must not stop until all pieces of evidence on that issue have been fully considered and each has been given its appropriate weight. Along the way, some pieces will weigh more heavily than others, but decision should be held in abeyance, and doubt maintained, until all the evidence has had its say.”

Id. at 1538–39 (citations omitted). In light of the district court's failure to consider the objective indicia, we did so in the first instance. Id. at 1539. Giving “full consideration” of objective indicia such as alleged commercial success, industry praise, and long-felt but unmet need, we concluded that the claims would have been obvious and thus affirmed the district court under the harmless error rule. Id. at 1540.

More recently, we discussed the role of objective indicia in *Cyclobenzaprine*, 676 F.3d at 1063. In that case, the district court engaged in a three-step analysis to determine whether a certain drug extended-delivery method would have been obvious. First, under the heading “Prior art,” it described four prior art references. *In re Cyclobenzaprine*, 794 F.Supp.2d 517, 534–35 (D. Del. 2011), rev'd in part, 676 F.3d 1063 (Fed. Cir. 2012). In the next section, with the heading “Prima facie case,” the district court determined that “a person of ordinary skill in the art would have been motivated to take a group of known elements to create an extended release version of cyclobenzaprine, and to have a reasonable expectation of success in doing so.” Id. at 537. It also concluded that certain properties and delivery methods would have been obvious. Id. at 536–37. Only later, under the heading “Secondary considerations,” did the court analyze the patentee's objective indicia of non-obviousness. Id. at 537. Finding that the objective indicia did not “overcome the prima facie case of obviousness,” the district court granted summary judgment of obviousness. Id. at 536.

On appeal, we reversed the district court's obviousness determination. We explained that the purpose of objective indicia of non-obviousness is to refute the evidence of obviousness. *Cyclobenzaprine*, 676 F.3d at 1077. That a patent owner may submit this evidence on objective indicia does not mean, however, that the burden shifts to the patent owner to prove non-obviousness. *Cyclobenzaprine*, 676 F.3d at 1079–80. The district court must consider all evidence, including objective indicia of non-obviousness, before making an ultimate conclusion of obviousness. Id. at 1080. We criticized the district court for “impos[ing] a burden-shifting framework in a context in which none exists.” Id. at 1075.

In *Cyclobenzaprine*, we emphasized our earlier statement that “ ‘evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to be obvious in light

of the prior art was not.’ ” Id. at 1075–76 (quoting *Stratoflex*, 713 F.2d at 1538). We noted that some Federal Circuit opinions have used the “prima facie” and “rebuttal” language, but we cautioned that “those cases should not be interpreted as establishing a formal burden-shifting framework.” Id. at 1077. Instead, we interpreted our precedent to hold that “all evidence relevant to obviousness or nonobviousness [must] be considered, and considered collectively.” Id. at 1078. Objective indicia of non-obviousness, we stated, are not mere, after-the-fact considerations relegated to secondary status. Id. They are essential safeguards against hindsight bias. Id. at 1079.

D. Post–*Cyclobenzaprine* Use of Prima Facie Framework

After *Cyclobenzaprine*, some of this court's decisions have continued to endorse the prima facie framework. See, e.g., *Cubist Pharm., Inc. v. Hospira, Inc.*, 805 F.3d 1112, 1130 (Fed. Cir. 2015) (“We sustain the district court's determination that the secondary consideration evidence did not overcome the showing of obviousness based on the prior art.”); *Novo Nordisk A/S v. Caraco Pharm. Labs., Ltd.*, 719 F.3d 1346, 1353–54 (Fed. Cir. 2013) (“The mere fact that the court conducted [the obviousness] analysis using terms such as ‘overcome’ and ‘prima facie’ does not necessarily imply that it shifted the burden of persuasion onto [the patent owner].”).^[*]

^[*]For a more detailed discussion on the burden of persuasion, see *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1360 (Fed. Cir. 2007)(Michel, C.J.):

“It is true that once a challenger has presented a prima facie case of invalidity, the patentee has the burden of going forward with rebuttal evidence. See *Mas–Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1216 (Fed.Cir.1998) (citing *Hybritech*, 802 F.2d at 1376); *Cable Elec. Prods. Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1022 (Fed.Cir.1985) (‘[I]f evidence is presented establishing a prima facie case of invalidity, the opponent of invalidity must come forward with evidence to counter the prima facie challenge to the presumption of section 282.’). But, all that means is that even though a patentee never *must* submit evidence to support a conclusion by a judge or jury that a patent remains valid, once a challenger introduces evidence that might lead to a conclusion of invalidity—what we call a prima facie case—the patentee ‘would be well advised to introduce evidence sufficient to rebut that of the challenger.’ *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1570 (Fed.Cir.1986).

“However, this requirement does not ‘in substance shift the burden of persuasion,’ *Cable Elec.*, 770 F.2d at 1022, because ‘the presumption of validity remains intact and the ultimate burden of proving invalidity remains with the challenger throughout the litigation.’ *Mas–Hamilton Group*,

In light of mixed messages coming from our court—endorsement of a prima facie framework on one hand but insistence to view the evidence as a whole on the other—trial courts have continued to find a prima facie case of obviousness before turning to objective indicia as rebuttal evidence. Despite *Cyclobenzaprine's* warnings, burden-shifting remains common among trial courts. See, e.g., *Bayer Pharma AG v. Watson Labs., Inc.*, 183 F.Supp.3d 579, 589 (D. Del. 2016) (“Under relevant law, once a prima facie case of obviousness has been established, the burden then shifts to the applicant to present evidence of secondary considerations of non-obviousness to overcome this prima facie showing.”); *B–K Lighting, Inc. v. Vision3 Lighting*, 930 F.Supp.2d 1102, 1116–17 (C.D. Cal. 2013) (stating that the patent owner bears the burden of presenting evidence to rebut a prima facie case of obviousness); *Bristol–Myers Squibb Co. v. Teva Pharm. USA, Inc.*, 923 F.Supp.2d 602, 675 (D. Del. 2013) (“With [the alleged infringer] having met its burden to establish a prima facie case of obviousness, the Court will go on to consider the fourth Graham factor: facts regarding objective indicia of nonobviousness.”); *Hitkansut LLC v. United States*, 127 Fed.Cl. 101, 113 (2016) (stating that the patent owner “incorrectly assumes that secondary considerations are part of [the alleged infringer's] burden in proving obviousness. Instead, evidence of secondary considerations is in the nature of rebuttal evidence. ... A patentee typically comes forward with proof of secondary considerations of validity, or ‘non-obviousness,’ in rebuttal to a patent challenger's prima facie case of obviousness.”) (alterations, quotation marks, and citation omitted).

156 F.3d at 1216; see also *Innovative Scuba Concepts, Inc. v. Feder Indus., Inc.*, 26 F.3d 1112, 1115 (Fed.Cir.1994); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 287 (Fed.Cir.1985). The trial court has the responsibility to determine whether the challenger has met its burden by clear and convincing evidence by considering the totality of the evidence, including any rebuttal evidence presented by the patentee. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1534 (Fed.Cir.1983).

“The *basis* (as opposed to the mere existence) of an examiner's initial finding of prima facie obviousness of an issued patent is therefore, at most only one factual consideration that the trial court must consider in context of the totality of the evidence ‘in determining whether the party asserting invalidity has met its statutory burden by clear and convincing evidence.’ *Fromson*, 755 F.2d at 1555. It does not, however, lessen or otherwise affect the burden of proof, nor does it require that unless the patentee introduces evidence of secondary considerations to establish non-obviousness, the patent challenger will necessarily prevail.”

E. This Court's "Prima Facie" Framework Does Not Comport With Supreme Court Precedent

Although this court highlighted the dangers associated with the prima facie framework in *Cyclobenzaprine*, we have not diligently instructed trial courts to abandon the framework altogether.⁵ The time to do so has come. One commentator has stated that "*Cyclobenzaprine* was unrealistic" if it intended to ban district courts from making prima facie findings of obviousness prior to consideration of objective indicia. Chisum § 5.05. I am not the first member of this court to state that such a ban is necessary. See *Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731, 748 (Fed. Cir. 2013) (Newman, J., dissenting) ("[T]he proper analysis of obviousness under 35 U.S.C. § 103 requires that all evidence relevant to obviousness or nonobviousness be considered, and be considered collectively, without resort to presumptions of prima facie obviousness or burden-shifting.") (quotation marks omitted); *Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1367 (Fed. Cir. 2012) (Newman, J., dissenting) ("The district court, holding that a prima facie case of obviousness was established on the prior art alone, shifted the burden of proof to the patentee to rebut the asserted, but improper, prima facie case with the evidence of commercial success and copying. This is a distortion of the burden of proof, which never leaves the challenger.").

Objective indicia of non-obviousness must be considered from the outset, and the burden of proof should never leave the challenger. The purpose of our patent system is the promotion of the progress of science and useful arts. U.S. Const. art. 1, § 8, cl. 8. This purpose is undermined by premature findings of obviousness and over-invalidation of innovative patents. *Novo Nordisk*, 719 F.3d at 1365 (Newman, J., dissenting).

The prima facie approach to obviousness jumbles the proper order of operations. "Prima facie" refers to evidence that is "[s]ufficient to establish a fact or raise a presumption unless disproved or rebutted." *Prima Facie*, Black's Law Dictionary (10th ed. 2014). Whether a party has made a prima facie case is a legal determination. See *Takeda Chem. Indus., Ltd. v. Alphapharm Pty.*, 492 F.3d 1350, 1356 (Fed. Cir. 2007) (calling the prima facie test "consistent with the legal principles enunciated in *KSR*").

Consistent with the prima facie approach endorsed by some of our past decisions, the district court here proceeded in four steps: it (1) considered the first three Graham factors; (2) made a legal prima facie determination of obviousness; (3) considered objective indicia of nonobviousness; and (4) made an ultimate conclusion of obviousness. Steps one and three are factual, whereas steps two and four are legal. It is clear to me that courts are making a legal determination of obviousness at step two. As a result, all of the facts concerning patentability are not considered. This is error.

I read Supreme Court and Federal Circuit precedent to require all factual analysis to occur prior to achieving a legal conclusion on non-obviousness. This should be done without resort to an intermediate prima facie conclusion. See, e.g., *Graham*, 383 U.S. at 36 (not making a prima facie conclusion and instead reserving any legal conclusion until after discussion of all factual predicates); *KSR*, 550 U.S. at 426 (same); *Apple*, 839 F.3d at 1058 (same); *Cyclobenzaprine*, 676 F.3d at 1081–83 (same); *Stratoflex*, 713 F.2d at 1539 (same). Thus, I would instruct the district court to abandon the prima facie framework and instead proceed in two steps: (1) consider all factual evidence, both favoring and disfavoring a finding of obviousness; and (2) make a legal conclusion of obviousness. Accord *Wm. Wrigley Jr. Co.*, 683 F.3d at 1370 (Newman, J., dissenting); Robert A. Matthews, Jr., Annotated Patent Digest § 18:93 (“A court should consider evidence of secondary considerations together with the evidence alleged to create a prima facie case of obviousness before determining whether an invention is or is not obvious. In other words, secondary considerations do not come into play only to rebut a prima facie case of obvious, (even though that is often how they are considered during prosecution). Rather, the considerations factor in to the initial determination of obviousness.”).

I recognize there are practical limitations of legal analysis and writing. A court's opinion must be linear and cover only one issue at a time. Typically, discussion of the objective indicia of non-obviousness comes last in an obviousness analysis. There is nothing inherently wrong with this order per se. Again, Supreme Court precedent is instructive. The Court discussed objective indicia of non-obviousness last in *Graham*. 383 U.S. at 35–36. So too in *KSR*. 550 U.S. at 426. But in both cases, the Court made no “prima facie” finding of obviousness, did not relegate objective indicia into an afterthought, and reserved its legal conclusion for after

discussion of all relevant factual inquiries. *Id.* Our seminal Federal Circuit decisions have done the same. See *Apple*, 839 F.3d at 1058; *Cyclobenzaprine*, 676 F.3d at 1081–83; *Stratoflex*, 713 F.2d at 1539. But the notion that objective criteria are considered after a legal prima facie showing is made has taken root like a spreading vine. This gives rise to cases, such as this case on appeal, where a court determines that a particularly “strong” prima facie showing has been made, making it difficult if not impossible for adequate weighing of evidence of objective indicia of non-obviousness.

* * *

An observer noted that “the law, with respect to the importance of secondary considerations or objective indicia, is going through a transformation.” J. Jeffrey Hawley, *The Resurgence of “Secondary Considerations”*, 16 Fla. Coastal L. Rev. 1, 23 (2014). I hope so. *Cyclobenzaprine* was a step in the right direction. We should finish what *Cyclobenzaprine* started and prohibit prima facie findings of obviousness prior to consideration of objective indicia of non-obviousness.

* * *¹⁵

VI. CONCLUSION

The bold views of Circuit Judge Reyna deserve careful attention by the Federal Circuit. Clearly, they represent a departure from the *en banc* decision of the Court more than twenty-five years ago in the *Dillon* case. It remains an open question whether the new views expressed in *Intercontinental Great Brands* will gain a wider following at the Federal Circuit.

¹⁵ *Intercontinental Great Brands LLC v. Kellogg North America Co.*, ___ F.3d ___, ___, 2017 WL 3906853 (Fed. Cir. Sept. 7, 2017)(Reyna, J., dissenting-in-part)(footnotes omitted).

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Prof. Wegner's practice includes expert opinions; he develops strategies on complex claim drafting and prosecution matters at the Examiner level and at the Board; and he has been involved with appeals at the Federal Circuit.

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