Acco Brands v. Fellowes: Prima Facie Obviousness

Today in *Acco Brands Corp. v. Fellowes, Inc.,* __ F.3d __, __(Fed. Cir. 2016)(Chen, J.), in the course of reversing a PTAB Inter Partes Reexamination ruling of an absence of a case of *prima prima* facie obviousness, the court provides an excellent summary of the procedural law of prima facie obviousness, as per an excerpt included with the attached pdf version of this note.

Regards,
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From the Opinion*:* "A claim 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 at the time the invention was made to a person having ordinary skill in the art . . .' 35 U.S.C. § 103 (2006); *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). During patent examination and reexamination, the concept of prima facie obviousness establishes the framework for the obviousness determination and the burdens the parties face. *See Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1384 (Fed. Cir. 2015). Under this framework, the patent examiner must first set forth a prima facie case, supported by evidence, showing why the claims at issue would have been obvious in light of the prior art. *In re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2007). Once the examiner sets out this prima facie case, the burden shifts to the patentee to provide evidence, in the prior art or beyond it, or argument sufficient to rebut the examiner's evidence. *Id.* The examiner then reaches the final determination on obviousness by weighing the evidence establishing the prima facie case with the rebuttal evidence. *See Leo Pharm. Prods. v. Rea*, 726 F.3d 1346, 1357 (Fed. Cir. 2013)('[C]onsideration of the objective indicia is part of the whole obviousness analysis, not just an after-thought.')(emphasis omitted). If this weighing shows obviousness by a preponderance of the evidence, then the claims at issue were unpatentable. *Rambus Inc. v. Rea*, 731 F.3d 1248, 1255 (Fed. Cir. 2013)."
(footnote omitted)