



THINK FORWARD

Secondary Considerations Should Be Tied To The Claimed Invention

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The Federal Circuit's recent decision in *ABT Systems and University of Central Florida v. Emerson Electric* (August 19, 2015) ([available here](#)) reinforces the notion that secondary considerations of non-obviousness must typically be tied to the claimed invention or they will be insufficient to overcome an obviousness defense.

The patent at issue claimed a fan with a particular manner of operation. Although there was no single prior art reference that disclosed the claimed fan, each limitation of the claimed fan was collectively disclosed in several prior art references. Finding that there was a motivation to combine these references to achieve the claimed fan, the Federal Circuit considered whether alleged secondary considerations of non-obviousness were sufficient to overcome the obviousness defense. The Court, in particular, considered alleged commercial success, industry praise/recognition, and licensing of the patent at issue. But it rejected all of these alleged secondary considerations, because it found that the patent owner did not show a nexus between the claimed fan and these secondary considerations. In other words, the patent owner failed to show that the commercial success, industry praise/recognition, and licensing were tied to the features of the claimed fan. As a result, the Court held that the claimed fan would have been obvious.

This decision provides a good reminder that evidence of secondary considerations should typically be tied to the claimed invention, whether you are before the U.S.P.T.O. or in court. Patent owners should develop evidence supporting the nexus between any secondary consideration and the claimed invention. Alleged infringers, on the flip side, should develop evidence discrediting any nexus (or rendering it inconsequential).

Brinks attorneys have a wealth of experience addressing obviousness defenses (and related secondary considerations) before the U.S.P.T.O. and in the courts. If you have any questions regarding these issues, please confer with your Brinks team or the author below.