



# THINK FORWARD

## Obviousness: Common Sense Cannot Replace Reasoned Analysis & Evidentiary Support

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On August 10, 2016, the Federal Circuit, in *Arendi S.A.R.L. v. Apple Inc.*, reversed the Patent Trial and Appeal Board's (the Board) finding of invalidity when the Board wrongly applied the "common sense" rationale to conclude that it would have been obvious to supply a missing limitation from a prior art reference to arrive at the claimed invention.

### Board's Erroneous Application of The Common Sense Rationale

In *Arendi*, the single software patent at issue involved a method for inserting information into a document by first searching the document for a name or address, and then searching a database for the same (a duplicate) name or address. The prior art at issue taught *recognizing* different types of text in a document (i.e., phone numbers) but did not teach the "search" limitation. Nonetheless, the Board found that it would be "reasonable to presume, as a matter of common sense[.]" that an ordinary artisan would search for a duplicate phone number before adding a new number.

On appeal, the Federal Circuit held that the Board's conclusion that it would have been "common sense" for an ordinary artisan to supply the limitation missing from the prior art was not supported by substantial evidence. Specifically, the Federal Circuit found the Board erred by relying on "a conclusory assertion from a third party about general knowledge in the art without evidence on the record," which was "particularly problematic" since the missing limitation was a key limitation.

The Federal Circuit went on to enumerate the following three limitations to using common sense in the obviousness analysis: (i) common sense is normally used to provide a known motivation to combine, not to supply a missing claim limitation; (ii) invoking the common sense rationale to supply a missing limitation is only appropriate where the technology at issue is particularly straightforward and the missing limitation is peripheral, or unusually simple—versus a limitation which "plays a major role in the subject matter claimed"; and (iii) referencing common sense without reasoned analysis and evidentiary support does not provide substantial evidence that supplying a motivation to combine, or a missing limitation, would be obvious to one of skill in the art.

Subsequently, the Court reversed the Board's finding of unpatentability because the missing limitation was not a peripheral one, and expert testimony and the prior art did not specifically show why the prior art would search for a phone number to discover a duplicate name. Accordingly, the Board's conclusion, with no elaboration, that it would be "common sense" to add a search for phone numbers to the prior art was conclusory and unsupported by substantial evidence. The Court emphasized that while common sense can be invoked to supply a motivation to combine, or even to supply a missing limitation, common sense cannot be used as a "wholesale substitute for reasoned analysis and evidentiary support."

## **Implications**

*Arendi* potentially strengthens the position of those holding, and those attempting to obtain, patent rights. During prosecution, *Arendi* emphasizes that patent examiners must provide more than just a bare conclusion that it would be common sense to combine prior art to arrive at the claimed invention. *Arendi* also serves as a strong reminder to applicants and patent owners alike that conclusory obviousness assertions based on common sense are less likely to stand on appeal and that reasoned analysis and evidentiary support must be supplied to support common sense positions.

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