

## Federal Circuit Patent Bulletin: *In re Van Os*

---

January 3, 2017

*"Absent some articulated rationale, a finding that a combination of prior art would have been 'common sense' or 'intuitive' is no different than merely stating the combination 'would have been obvious.'"*

On January 3, 2017, in *In re Van Os*, the U.S. Court of Appeals for the Federal Circuit (Newman, Moore,\* Wallach) vacated and remanded the U.S. Patent and Trademark Office Patent Trial and Appeal Board decision upholding the patent examiner's rejection of certain claims of U.S. patent application Serial No. 12/364,470, which related to a touchscreen interface in a portable electronic device that allows a user to rearrange icons. The Federal Circuit stated:

Obviousness is a question of law based on subsidiary findings of fact. Whether a person of ordinary skill in the art would have been motivated to modify or combine prior art is a question of fact.

The Board's conclusion that claims 38–41 of the '470 application would have been obvious hinges on its finding that a person of ordinary skill in the art would have been motivated to modify Hawkins' [(U.S. Patent No. 7,231,229)] initiation of an editing mode via menu selection or keyboard command with Gillespie's [(U.S. patent publication No. 02/0191059)] disclosure of a sustained touch, "holding the finger steady over an icon for a given duration" to "activate" an icon. Specifically, the Board found, without further discussion, that the combination of Gillespie with Hawkins would have been "intuitive."

In *KSR*, the Supreme Court criticized "[r]igid preventative rules that deny factfinders recourse to common sense" when determining whether there would have been a motivation to combine prior art. The proper approach, as explained in *KSR*, credits the common sense and creativity of a skilled artisan to assess whether there would have been a motivation to combine elements from prior art references in the manner claimed. But the flexibility afforded by *KSR* did not extinguish the factfinder's obligation to provide reasoned analysis. Instead, *KSR* specifically instructs that when determining whether there would have been a motivation to combine, the "analysis should be made explicit."

Since *KSR*, we have repeatedly explained that obviousness findings "grounded in 'common sense' must contain explicit and clear reasoning providing some rational underpinning why common sense compels a finding of obviousness." Even before *KSR*, we explained that while the Board may rely on common sense, it must "explain why 'common sense' of an ordinary artisan seeking to solve the problem at hand would have led him to combine the references."

Absent some articulated rationale, a finding that a combination of prior art would have been “common sense” or “intuitive” is no different than merely stating the combination “would have been obvious.” Such a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine. This type of finding, without more, tracks the ex post reasoning *KSR* warned of and fails to identify any actual reason why a skilled artisan would have combined the elements in the manner claimed.

Here, neither the Board nor the examiner provided any reasoning or analysis to support finding a motivation to add Gillespie’s disclosure to Hawkins beyond stating it would have been an “intuitive way” to initiate Hawkins’ editing mode. The Board did not explain why modifying Hawkins with the specific disclosure in Gillespie would have been “intuitive” or otherwise identify a motivation to combine. “The agency tribunal must make findings of relevant facts, and present its reasoning in sufficient detail that the court may conduct meaningful review of the agency action.” [W]hen the Board’s action is “potentially lawful but insufficiently or inappropriately explained,” we have consistently vacated and remanded for further proceedings. For these reasons, the Board’s holding that claims 38–41 of the ‘470 application would have been obvious is vacated and remanded.