

INTOUCH TECHS., INC. v. VGO COMMC'NS, INC., Appeal No. 2013-1201 (Fed. Cir. May 9, 2014). Before Rader, Lourie, and O'Malley. Appealed from C.D. Cal. (Judge Anderson).

Background:

Patent owner InTouch accused VGo of infringing several of its patents. After hearing testimony from both parties and witnessing product demonstrations, the jury found that VGo did not infringe the claims at issue, and also found that several of the claims were invalid as having been obvious in view of various prior art references.

In finding the claims invalid, the jury relied on one expert's testimony in particular. This expert testified that a claim would be rendered obvious if, for example, the ordinarily skilled artisan "could look at two references, and think they could combine the two references." The expert concluded that a claim was obvious when in "putting [the references] together you actually get [the claim]."

InTouch moved for judgment as a matter of law. The District Court denied the motion, explaining that expert testimony had provided several detailed reasons for an ordinarily skilled artisan to have combined the various references, and the jury could apply its "common sense."

Issue/Holding:

Did the District Court err in denying InTouch's motion for judgment as a matter of law? Yes, reversed and remanded.

Discussion:

Because obviousness is a mixed question of law and fact, the Federal Circuit will leave the jury's factual findings intact if supported by substantial evidence, and will review the legal conclusion of obviousness de novo in light of those facts.

In this case, the Federal Circuit held that the evidence was not substantial enough to support a finding of obviousness. The court pointed to the expert's failure to (1) identify sufficient motivation to combine the references, (2) focus on the relevant time frame, and (3) consider objective evidence of nonobviousness.

The Federal Circuit emphasized that the motivation for combining the references is a critical component of the obviousness analysis and should be made explicit. The expert did not provide any "articulated reasoning with some rational underpinning"; instead, the expert provided vague statements indicating that an ordinarily skilled artisan "could" combine the references and that the references "cover" the claims. The Federal Circuit determined that the expert's testimony constituted mere hindsight.

The Federal Circuit also held that the common sense of the jury, which does not represent the ordinarily skilled artisan, was irrelevant to the obviousness inquiry. Because there was insufficient evidence to establish a finding of obviousness, the court reversed the invalidity judgment.