

ALLIED ERECTING AND DISMANTLING CO., INC. v. GENESIS ATTACHMENTS, LLC,
Appeal No. 2015-1533 (Fed. Cir. June 15, 2016). Before Newman, Dyk, and Wallach.
Appealed from PTAB.

Background:

Allied held a patent directed toward heavy machinery tools that can easily share a common support structure. Genesis filed a petition for *inter partes* reexamination, contending that Allied's patent was invalid because its claims were anticipated and/or obvious. The reissue Examiner allowed amended claims, but Genesis then appealed to the Patent Trial and Appeal Board ("PTAB"). The PTAB held that certain allowed claims would have been obvious in view of "Caterpillar" and "Ogawa" prior art references, and it remanded the application to the Examiner to determine whether the remaining claims would have been obvious in view of these two references and an additional U.S. patent.

Upon remand, Allied elected to reopen prosecution, and it again amended its claims. The Examiner found that these amendments did not overcome the teachings of the Caterpillar and Ogawa references. Allied again appealed, and the PTAB issued another decision affirming the Examiner's rejections. More specifically, although Allied's claims required "a pair of movable blades pivoted together about a main pivot pin" and only one of Caterpillar's corresponding blades is movable, the PTAB held that this feature would have been obvious in view of Ogawa's teaching to provide two movable blades. Allied then submitted a Request for Rehearing, and once this Request was denied, Allied finally appealed to the Federal Circuit.

Issue/Holding:

Did the PTAB err in holding Allied's claims to be obvious? No, affirmed.

Discussion:

Allied argued on appeal that the PTAB's combination of Caterpillar and Ogawa is improper for two reasons. First, Allied asserted that the PTAB relied on improper hindsight and that the PTAB's combination of references would require a substantial redesign and change to Caterpillar's principle of operation by inhibiting its quick release functionality. Second, Allied contended that Caterpillar teaches away from the combination of Caterpillar and Ogawa because it opines that a modification such as that taught by Ogawa could achieve an *optimum* design with only great difficulty. The Federal Circuit rejected both of these arguments.

The Federal Circuit held that one of ordinary skill could have, contrary to Allied's assertion, modified Caterpillar's design in view of Ogawa without impacting Caterpillar's quick change functionality. It also noted that whether the structures of Caterpillar and Ogawa can be physically combined is not the proper inquiry for obviousness. The Federal Circuit concluded by holding that Caterpillar does not expressly teach away from Ogawa. Caterpillar's expressed doubt about whether the modification taught by Ogawa would result in an *optimal* design is not sufficient to constitute a teaching away.