

GOOGLE LLC v. KONINKLIJKE PHILIPS N.V., Appeal No. 2019-1234 (Fed. Cir. January 6, 2020). Before Lourie, Bryson, and Taranto. Appealed from PTAB.

Background:

Philips owned a patent directed to mobile device keypads that display primary characters (e.g., letters and numbers) and secondary characters (e.g., accents and currency symbols). The keypad displays the secondary characters upon holding a primary character for an extended period of time, and upon selection of a secondary character, the keypad returns to the default state of displaying the primary characters.

Philips sued Acer Inc. and others for infringement based on their use of the Google Chrome web browser and Android OS. Google then challenged the Philips' patent in *inter partes* review as one of the interested parties. Google argued that the patent would have been obvious over a Japanese prior art reference that discloses mobile device keypads which have all of the claim features except the last step of the keypad returning to the default state after secondary-character-selection. The prior art reference teaches instead, after the secondary-character-selection, maintaining the display of secondary characters and not returning to the default state of displaying the primary characters. Google argued that it would have been obvious to try the return-to-default techniques in lieu of the disclosed last step of the prior art reference.

In response, Philips argued, and the PTAB ultimately agreed, that it would not have been obvious to try the return-to-default techniques because such is merely one of many potential keypad techniques available. Google appealed.

Issue/Holding:

Did the PTAB err in deciding that the Philips' patent is not obvious? Yes, reversed.

Discussion:

The Federal Circuit emphasized that there is only a minimal difference between Philips' claimed invention and the prior art reference—i.e., whether the keypad returns or does not return to the default state after the selection of the secondary character. The Federal Circuit stated that, although the prior art reference discloses not returning to the default state, it would have been obvious to try the only other option (i.e., returning to the default state) when there are only two options available (i.e., returning or not returning to the default state) after the secondary-character-selection.

The Federal Circuit found that Philips was trying to inappropriately shift the inquiry away from the question of what options are available at the last step after the secondary-character-selection by asserting that there is a wide variety of keypad techniques in general. Such wide-scope inquiry is, however, a red herring in this case. Relying on *KSR*, the Federal Circuit stated that the "obvious-to-try inquiry...must focus on known options at what is undisputedly the sole point of novelty in the claim at issue."

The Federal Circuit also noted that the return-to-default option was readily available and familiar to someone skilled in the art, and that the prior art reference was directed to an attempt to improve upon prior return-to-default techniques.