

KRATZ, QUINTOS & HANSON, LLP – IP Newsletter

THE FEDERAL CIRCUIT CONSIDERS THE FOLLOWING TWO FACTORS IN DETERMINING OBVIOUSNESS UNDER 35 U.S.C. §103: “MOTIVATION TO COMBINE” REFERENCES AND “OBJECTIVE INDICIA OF NONOBVIOUSNESS”

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In the precedential case of *Bosch Automotive Service Solutions, LLC v. Joseph Matal*, decided on December 22, 2017, Bosch appealed a decision from an *inter partes* review (IPR) of its U.S. Patent No. 6,904,796 (the '796 patent), where the U.S. PTO Patent Trial and Appeal Board (“the Board”) found all of the challenged claims unpatentable.

The '796 patent, entitled “Remote Tire Monitoring System,” relates to a handheld tool for: (i) activating remote tire pressure monitoring (RTMS) tire sensors, and (ii) communicating with a vehicle’s RTMS receiving unit. The '796 patent claims to be a “universal activation tool,” which allows “a technician [to move] from working on one vehicle to another vehicle that has a different RTMS activation system, [by having the technician] simply switch between different modes of operation using a switch on the tool.”

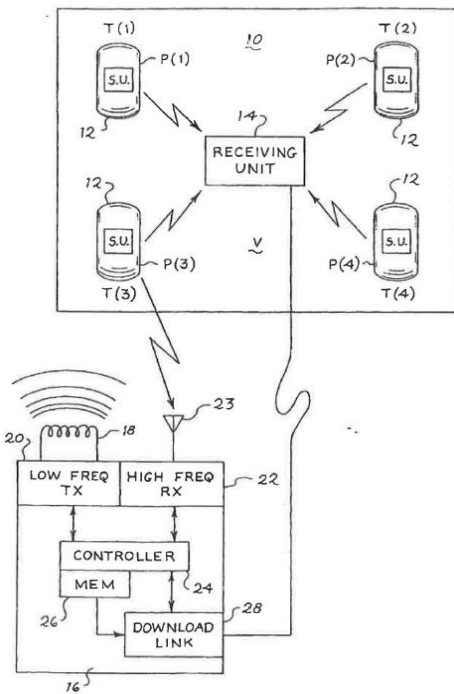
Claim 1, a representative claim of the claimed apparatus, calls for:

a plurality of means for activating RTMS tire sensors, the plurality of means selected from the group consisting of a magnet, a valve core depressor, means for generating continuous wave signals, and means for generating modulated signals, * * * each of the plurality of tire sensors utilizing a different method for activating the said tire sensor. [Emphasis added.]

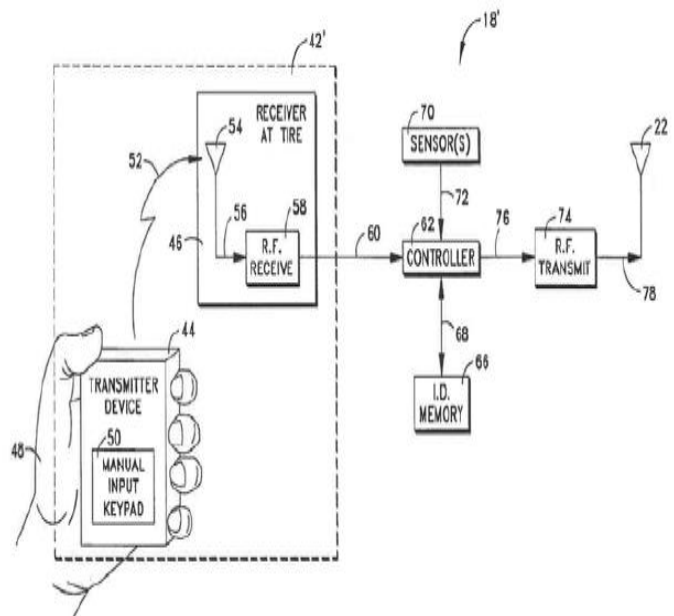
Motivation to Combine the References: The U.S. Court of Appeals for the Federal Circuit (“the Federal Circuit”) considered the combination of four references (McClelland, Kranz, Dixit, and Howell) used by the Board in determining that representative claim 1 is unpatentable as obvious. As shown on the back page, the primary reference of McClelland includes a handheld exciter unit 16 and uses only low frequency continuous wave signal for activating each tire monitor 12. Upon receipt of the activation signal, the tire monitor 12 transmits tire-specific information to the exciter unit 16. One of the secondary references, Dixit, teaches a handheld transmitter tool 44 for communicating with an RF receiver 46 associated with each tire condition sensor unit 18.

Bosch’s main challenge is that: “the type of system and tool of Dixit was so objectively different from the [“universal activation”] device of the '796 patent, that there would be no contemporaneous motivation nor design need to combine the teachings of Dixit with the other cited references.”

According to the Federal Circuit, Dixit’s device: (1) is a single “generic or universal tool,” (2) has the capability of operating with “different RTMS tire sensors,” and (3) can “communicate with tire condition sensor units within different tire condition communication systems at different vehicles.”



McClelland Reference



Dixit Reference

Thus, the Federal Circuit agreed with the Board’s finding of obviousness and held that:

substantial evidence supports the Board’s finding that Dixit teaches the advantage of having a universal tool in the RTMS environment that can communicate with tire sensors in different RTMS systems [McClelland’s use of a continuous wave signal and Kranz’s use of modulated signals]. * * * it provides a rational underpinning for the skilled artisan’s combination of multiple activation means into a single tool. [Emphasis added.]

Objective Indicia of Nonobviousness: Bosch further argued that the Board ignored its multiple evidence of “objective indicia of nonobviousness” directed to: (1) its declaration and claim charts showing “commercial success,” (2) two companies having licensed its ‘796 patent, and (3) industry awards and praises received for its tools. The Federal Circuit agreed with the Board that Bosch has not demonstrated a “nexus” between its claimed invention and its evidence of objective indicia of nonobviousness, and therefore, Bosch’s evidence of objective indicia of nonobviousness is not relevant to the obviousness issue presented in this case.

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