

IP Musings

with **Learned Paw** and **Percy the Lizard**

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Personal Web Technologies, LLC, v. Apple, Inc. (Fed. Cir. February 2017)

Personal Web, the patentee, appealed after an Inter Partes Review (IPR) decision by the Patent

Trial and Appeal Board ("Board"). The Federal Circuit remanded the case, ruling that (1) the Board did not provide an adequate reason for combining prior art references to establish obviousness under 35 U.S.C. 103, and (2) the Board's claim construction was correct.

In siding with Personal Web on the issue of the motivation to combine prior art references, the court appeared to further limit the scope of *KSR International*, which indicated that one does not need to provide evidentiary support (e.g., a reference) to combine prior art references for establishing obviousness. In *Arendi S.A.R.L. v. Apple, Inc.*, the court had placed a different limit on how far can one take *KSR International* to dispense with the TSM test's evidentiary requirements to establish obviousness. More specifically, the court had ruled that a patent challenger cannot rely solely on a "common sense" argument to avoid having to demonstrate that prior art discloses each of the significant claim limitations.

In *Personal Web*, the court said that under the theory of obviousness adopted by the Board and Apple, the Board would have had to find not only "the mere identification in [the prior art] of individual components of claimed limitations," but also that a person of ordinary skill in the art would have been motivated combine the prior art in the way claimed and had a reasonable expectation of success in doing so. What the Board showed at best, the court continued, was that a person of ordinary skill in the art would have understood that they could be combined, but not that they would have been motivated to make the combinations of prior art to arrive at the claimed invention.

The court's ruling in *Personal Web* is consistent with other Federal Circuit cases that limit erosions to patent rights under a series of relatively recent Supreme Court decisions, such as *Mayo*, *KSR International*, and *Alice*.

With respect to the claim construction issue, Personal Web challenged the Board's use of the broadest reasonable interpretation (BRI) standard and requested the court to interpret the claims differently from the Board. The court rejected the argument, indicating that the plain meaning of the terms in the claim language made it impossible to interpret the terms differently under any standard.

