



PTAB Determines that “Weak” Evidence of Secondary Considerations Does Not Overcome Strong Obviousness Showing

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The PTAB then considered the patent owner’s evidence of secondary considerations of non-obviousness and concluded that it was “weak.” First the PTAB considered the patent owner’s allegation of long felt need. In conducting this analysis, the PTAB applied the patent owner’s own relative definition of “need,” which was simply “to more effectively reduce wear.” The PTAB determined that the patent owner did not provide “credible evidence” that the prior art failed to meet the alleged “need,” as defined by the patent owner. Next the PTAB considered the alleged failure of others, and determined that the patent owner presented insufficient evidence. In particular, the PTAB faulted the patent owner for not submitting evidence that another company attempted to produce equipment that would infringe any of the independent claims, or that another company tried and failed to produce such equipment. The PTAB then considered the patent owner’s allegation that the claimed invention had achieved commercial success, and concluded that the patent owner had failed to establish the necessary nexus. The PTAB characterized the patent owner’s evidence of a nexus—that consumers buy certain products from the exclusive licensee—as demonstrating commercial success, but not a nexus. The PTAB stated that “[i]f all that was necessary to prove a nexus was to show that customers bought more of the identified product than other products, a nexus would exist for every product that exhibits success in the marketplace.” Finally, the PTAB concluded that the patent owner lacked sufficient evidence for its allegation that copying evidenced nonobviousness. According to the PTAB, the only evidence of copying was testimony of the patent owner’s declarant asserting that the petitioner’s product embodies the claims of the patent. The PTAB stated that it “do[es] not determine infringement in *inter partes* review,” and concluded that the evidence was insufficient to show copying.

After weighing the evidence, the PTAB concluded that the patent owner’s “weak” evidence of secondary considerations did not overcome the petitioner’s “strong” evidence of obviousness. The PTAB, therefore, found that all of the challenged claims were unpatentable. The patentatissue was also asserted against the petitioner in *Western Falcon, Inc. v. Moore Rod & Pipe, LLC*, 4:13cv02963, in the District Court for the Southern District of Texas.

Moore Rod & Pipe, LLC v. Wagon Trail Ventures, Inc., Case IPR201300418 (PTAB Oct. 2, 2014).

Categories

Patent Trial & Appeal Board

Inter Partes Review

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