

Is it really a "teaching away"?

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I. Introduction

The law of obviousness, like other areas of law, has a number of doctrines defined by a web of case law precedents filling in the gaps in the bedrock Supreme Court cases, *Graham v. John Deere* and *KSR v. Teleflex*. One of those doctrines is that of "teaching away." However, the "teaching away" moniker is not actually descriptive of the doctrine.

II. Definition of the "teaching away" Doctrine

The "teaching away" doctrine has its case law foundation in *United States v. Adams*, 383 U.S. 39, 52, 86 S.Ct. 708, 714, 15 L.Ed.2d 572, 148 USPQ 479, 484 (1966). There, the Court stated:

We conclude the Adams battery was also nonobvious. As we have seen, the operating characteristics of the Adams battery have been shown to have been unexpected and to have far surpassed then-existing wet batteries. Despite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them together as did Adams, required that a person reasonably skilled in the prior art must ignore that (1) batteries which continued to operate on an open circuit and which heated in normal use were not practical; and (2) water-activated batteries were successful only when combined with electrolytes detrimental to the use of magnesium. **These long-accepted factors, when taken together, would, we believe, deter any investigation into such a combination as is used by Adams.** This is not to say that one who merely finds new uses for old inventions by shutting his eyes to their prior disadvantages thereby discovers a patentable innovation. We do say, however, that **known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness.** [Bold added for emphasis.]

Citing *Adams*, the Court of Appeals for the Federal Circuit (CAFC), in *In re Gurley*, 27 F.2d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994), stated that:

Referring to the statement of inferiority in the Yamaguchi reference, Mr. Gurley argues that Yamaguchi "teaches away" from Gurley's invention. A reference may be said to teach away when **a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference**, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away **if it suggests that the line**

of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. [Bold added for emphasis.]

Citing *Gurley* and pre-CAFC case law, the CAFC, in *McGinley v. Franklin Sports, Inc.*, 262 F. 3d 1339, 1354-55 (Fed. Cir. 2001), explained that prior art indicating the proposed device was inoperable, was a teaching away:

Perhaps McGinley's best argument to save his claims from prima facie obviousness in the light of Pratt and Morgan is his contention that those references together teach away from their combination. We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994). **If references taken in combination would produce a "seemingly inoperative device," we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.** *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244, 56 C.C.P.A. 823 (1969) (references teach away from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

Also citing *Gurley*, the CAFC, in *In re Fulton*, 391 F. 3d 1195, 1201 (Fed. Cir. 2004), explained that disclosure in the prior art of alternatives to what was claimed did not amount to a teaching away, stating:

Appellants disagree with the Board's finding that no prior art references taught away from the combination of Bowerman and Pope adopted by the Board. Appellants quote language from *In re Gurley* that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." 27 F.3d at 553. Appellants argue that "the prior art disclosed alternatives to each of the claimed elements A [the perimeter], B [the shape of the surface], and C [the orientation of the surface]. Choosing one alternative necessarily means rejecting the other, i.e., following a path that is `in a divergent direction from the path taken by the applicant.'" This interpretation of our case law fails. The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives **because such disclosure does not criticize, discredit, or otherwise discourage** the solution claimed in the '198 application. Indeed, in the case cited by appellants, *In re Gurley*, we held that the invention claimed in the patent application was unpatentable based primarily on a prior art reference that disclosed two alternatives, one of which was the claimed alternative. Accordingly, mere disclosure of alternative designs does not teach away. [Bold

added for emphasis.]

That is, the CAFC added the "**does not criticize, discredit, or otherwise discourage** the solution claimed" language. That language seems add a requirement, in addition to *Adams'* requirement that the reference teaches that the claimed invention is "unlikely to be productive of the result sought by the applicant."

Citing *Fulton*, the CAFC, in *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009), found a teaching away, based upon a disclosure of adverse consequences of the claimed invention. There, the Court concluded that:

... A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not "criticize, discredit, or otherwise discourage" investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). In this case, we agree with the district court that Puno does not merely express a general preference for pedicle screws having a "shock absorber" effect. Rather, **Puno expresses concern for failure and states that the shock absorber feature "decrease[s] the chance of failure of the screw or the bone-screw interface" because "it prevent[s] direct transfer of load from the rod to the bone-screw interface."** Puno col.3 ll.64-67 (emphasis added). [Bold added for emphasis.]

Implicating both the *seemingly inoperable device* concept of *McGinley* and the *discourage the solution claimed* concept of *Fulton*, in *In re Urbanski*, (Fed. Cir. 1/8/2016), the Court found the claimed invention obvious over a combination of prior art references Gross and Wong.

Here, the cited references do not teach away from the claimed method. The obviousness rejections are based on Gross in view of Wong. As indicated earlier, Wong teaches that its method produces soy fiber with improved sensory properties without substantially reducing the fiber content. Wong thus provides the motivation to modify the Gross process and suggests the desirability of such modification. Moreover, both Gross and Wong suggest that hydrolysis time may be adjusted to achieve different fiber properties. Nothing in the prior art teaches that the proposed modification would have resulted in an "inoperable" process or a dietary fiber product with undesirable properties. As the Board properly found, one of ordinary skill would have been motivated to pursue the desirable properties taught by Wong, **even if that meant foregoing the benefit taught by Gross.** And Urbanski's claims do not require Gross's benefit that is arguably lost by combination with Wong. The Board therefore did not err in rejecting Urbanski's inoperability argument. [Bold added for emphasis.]

Urbanski seems to add to the teaching away doctrine that any identified benefit to the proposed

combination may preclude a finding that the reference teaches away.

Most recently, in *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, (Fed. Cir. 6/15/2016), the Court found that an expectation that the claimed invention would "work poorly" and could be achieved "only *with very great difficulty, if at all*" were not teachings away:

Caterpillar does not expressly teach away from Ogawa. *** See J.A. 133 (asserting that the "design possibilities of the pin structure are severely restricted on account of its dual function as a swivel bearing and as a detachable mounting of the jaws, which in turn means that an *optimum* design with regard to both desired functions can be achieved only *with very great difficulty, if at all*") (emphases added)); see also *Allied Br. 34* (asserting that "Caterpillar specifically teaches that having both jaws pivotally mounted to the frame via the main pivot pin is expected to work poorly"). There is no teaching away from the combination of Caterpillar and Ogawa because the combination does not utilize the pivot pin attachment mechanism of Ogawa. There is no teaching away in Caterpillar from using the Ogawa feature of two movable jaws.

Admittedly, the *Allied* Court referred to an assertion that it was an "*optimum* design ... [that could be made] only *with very great difficulty, if at all*" but the court did not state that the claimed invention was not that optimum design. In any case, the relevant point added by *Allied*, is that even a device expected to work poorly, does not qualify as seemingly inoperable. (And of course, an appellant should not in their brief admit that the proposed combination would have been perceived as operable!)

I question whether that conclusions in *Urbanski* and *Allied* are consistent with 1994 definition in *Gurley*, that a reference teaches away if it "suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." Admittedly, *Urbanski* provides an alternative benefit as a motivation, instead of the result sought by the applicant. However, *Allied* goes further, indicating that a "expected to work poorly" is sufficient for the prior art to provide a motivation.

III. Conclusion

What this case law leads to is a conclusion that, under current CAFC case law, the doctrine of "teaching away" is much more limited than those words suggest. Under current CAFC case law, a "teaching away" is limited (1) to the prior art indicating that essential functions of the claimed invention would not be present (the "seemingly inoperable" concept), and to (2) the prior art identifying concerns that, notwithstanding seeming operability, the claimed invention presented some other chance of failure, in an application (such as bone implants) where failure is unacceptable.

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