

Keyword(s): obviousness, motivation to combine, general skepticism

General: It is not sufficient to rely exclusively on evidence of general skepticism about the field of the invention to find a lack of motivation to combine.

Auris Health, Inc. v. Intuitive Surgical Operations, Inc.

United States Court of Appeals for the Federal Circuit

No. 2021-1732

Decided: April 29, 2022

Detailed Summary

I. Facts

This appeal arises from an inter partes review (“IPR”) proceeding. Petitioner, Auris Health, Inc. (“Auris”), challenged all five claims of a patent owned by Intuitive Surgical Operations, Inc. (“Intuitive”), U.S. Patent No. 8,142,447 (“the ’447 patent”).

The challenged patent relates to robotic surgery systems. Specifically, the ’447 patent describes an improvement over Intuitive’s earlier robotic surgery systems and allows surgeons to remotely manipulate surgical tools using a controller. Surgery often requires a variety of surgical instruments like scissors, scalpels, and graspers, and clinicians must swap out instruments as they move from one surgical task to the next. Instrument swapping can prove tricky in a robotic surgical system where space is limited; different ranges of motion must be calibrated for different surgical instruments and time is needed to interchange those instruments. The invention embodied by the ’447 patent attempts to address such difficulties via a robotic system with a servo-pulley mechanism, which allows clinicians to more quickly swap out surgical instruments and thereby reduce surgery time, improve safety, and increase reliability of the system.

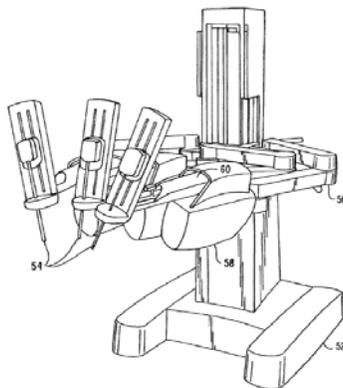


FIG. 2.

’447

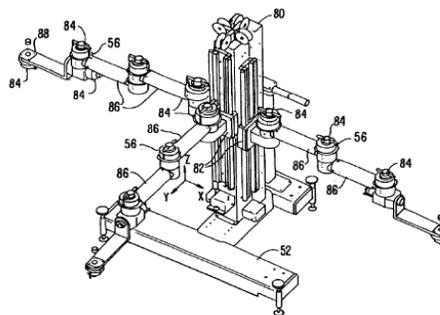
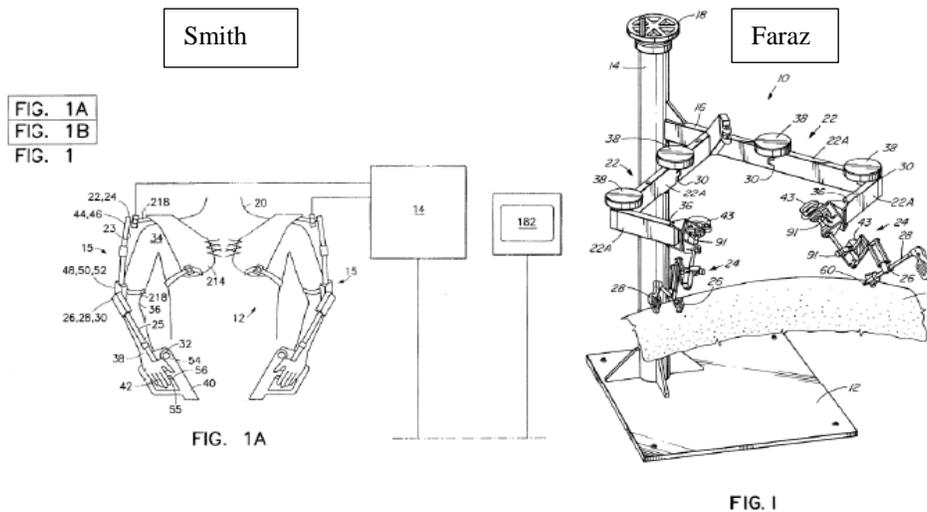


FIG. 3.

The first cited reference, Smith, discloses a robotic surgical system that uses an exoskeleton controller, worn by a clinician, to remotely manipulate a pair of robotic arms, each of which holds a surgical instrument. *See* Smith, Fig. 1A. Smith teaches using a servo-pulley system to mimic the clinician's movements in the robotic arms. However, Smith also provides that the clinician may direct an assistant to relocate the robotic arms.



The second cited reference, Faraz, discloses an adjustable support stand that holds surgical instruments. *See* Faraz, Fig. 1. Faraz's stand can be adjusted either manually or robotically. Faraz provides that its stand may enable a surgeon to perform surgery with fewer assistants because its stand can support multiple surgical implements while they are being moved and can also provide support for a surgeon's arms during long or complicated surgery.

The Board determined that Auris's asserted prior-art combination—Smith and Faraz—disclosed each limitation of the challenged claims. The only issue that remained was whether a skilled artisan would have been motivated to combine Smith and Faraz.

Auris argued that a skilled artisan would be motivated to combine Smith and Faraz to decrease the number of assistants needed during surgery by robotizing some of their tasks. Intuitive responded that a skilled artisan would not have been motivated to combine the references because surgeons were skeptical about performing robotic surgery in the first place, so there would have been no reason to further complicate Smith's already complex robotic surgical system with Faraz's robotized surgical stand.

The Board agreed with Intuitive and concluded there was no motivation to complicate Smith's system, noting that there was skepticism at the time of the invention for using robotic systems during surgery in the first place. Auris appealed, challenging the Board's reliance on general skepticism about the field of robotic surgery to find a lack of motivation to combine.

II. Issues

- Did the PTAB err in relying on general skepticism about the field of robotic surgery to find a lack of motivation to combine?

III. Discussion

- Yes. The court found that PTAB erred in relying on general skepticism about the field of robotic surgery to find a lack of motivation to combine.

Obviousness is a question of law with underlying factual findings relating to the scope and content of the prior art; differences between the prior art and the claims at issue; the level of ordinary skill in the pertinent art; the presence or absence of a motivation to combine or modify prior art with a reasonable expectation of success; and any objective indicia of non-obviousness. *Acoustic Tech., Inc. v. Itron Networked Sols., Inc.*, 949 F.3d 1366, 1373 (Fed. Cir. 2020). The court explained that the motivation-to-combine inquiry asks whether a skilled artisan “not only could have made but would have been motivated to make the combinations . . . of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (emphasis omitted). The court found that “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007). The court held that generic industry skepticism cannot, standing alone, preclude a finding of motivation to combine.

The court explained that evidence of industry skepticism may play a role in an obviousness inquiry, but as a secondary consideration in a significantly different context. *See WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1335-36 (Fed. Cir. 2016). Even then, the evidence of skepticism must be specific to the invention, not generic to the field. *Id.* While Intuitive suggested that the Board may consider generic industry skepticism in a motivation-to-combine analysis to “place [itself] in the minds of” skilled artisans, the court noted that Intuitive offered no case law to suggest that the Board can rely on generic industry skepticism to find a lack of motivation to combine. Accordingly, the court noted that while specific evidence of industry skepticism related to a specific combination of references might contribute to finding a lack of motivation to combine, there was no specific evidence in the present case. Instead, the court found that the Board almost exclusively relied on evidence of general skepticism about the field of robotic surgery to find a lack of motivation to combine Smith and Faraz. The court held that it was improper to credit Intuitive’s vague expert testimony that “there was great skepticism for performing telesurgery” at the time of the invention and, as a result, a skilled artisan “would not have been compelled to complicate Smith’s system further.”

IV. Conclusion

The Court vacated the Board’s Final Written Decision and remanded for further consideration of the parties’ motivation-to-combine evidence.

V. Dissent

The dissent argued that the Board relied on more than just general skepticism to find no motivation to combine and cautioned that the majority opinion may reasonably be understood to announce an inflexible and rigid rule, namely that it is “impermissible” for the Board to consider evidence of artisans’ skepticism toward robotic surgery in determining motivation to combine.