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PTAB Denies Petition Overlooking Objective Indicia of Non-Obviousness

By Scott McKeown on September 18, 2019



Unrebutted Secondary Indicia Considered in Assessing Becton-Dickinson Factors

The submission of so-called "objective indicia of non-obviousness" at the PTAB is rarely effective, especially in the predictable arts (i.e., [mechanical/electrical](#)). This is because the most common form of such evidence, "commercial success" is often difficult to tie to any particular claim feature (unlike drug formulations, for example). That said, as a *Graham Factor* that is assessed in an obviousness determination, the failure to address previously established indicia could prove fatal to your petition.

In *Stryker Corporation v. Kfx Medical, LLC*, IPR2019-00817, the petitioner ("Stryker") sought to invalidate claims of a medical device patent owned by patent owner ("KFX"). The challenged patent was previously upheld in patent reexamination. Further, the patent was previously litigated through jury trial and also upheld. *Kfx Medical Corp. v. Arthrex Inc.*, No. 11-cv-1698-DMS (BLM) (S.D. Cal.) The district court and jury specifically considered KFX's "secondary considerations evidence" and ultimately rejected Arthrex's invalidity arguments in part, on this basis. The Federal Circuit affirmed on appeal without an opinion.

The Board, in denying institution of Stryker's petition under 35 U.S.C. §§ 314(a) and 325(d), relied on the factors expressed in two precedential PTAB decisions, [Becton, Dickinson & Co. v. B. Braun Melsungen AG](#), IPR2017-01586, Pap. 8 at 17-18 (PTAB Dec. 15, 2017) and [NHK Spring Co. v. Intri-Plex Techs., Inc.](#), Case IPR2018-00752, Pap. 8 at 19-20 (PTAB Sept. 12, 2018) (precedential).

The Board found that the first six *Becton, Dickinson* factors weighed in favor of denial because the prior art arguments were largely considered during prosecution and reexamination. But notably, under the seventh factor "the status of any related district court proceeding," the Board expressly held that the "Petitioner's Failure to address the known evidence of secondary considerations further weighs in favor of denying institution." The Board held that because the secondary considerations evidence was "developed fully" during the prior litigation, and that because the Petitioner was aware of this evidence and did not present the evidence in the petition, that the Board could properly consider the evidence and exercise its discretion to deny institution. [here](#)

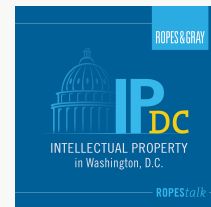
Even where not explicitly blessed by the Federal Circuit, Petitioners would be wise to address previously argued objective indicia in order to complete a proper *Graham* factor analysis.

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