

Generic Industry Skepticism Alone Cannot Preclude Motivation to Combine  
*Auris Health, Inc. v. Intuitive Surgical Operations, Inc., No. 21-1732 (Fed. Cir. 2022)*

By: Reid Huefner & Andrew Choi | May 16, 2022

On April 29, 2022, the CAFC vacated an *inter partes* review decision, where the Patent Trial and Appeal Board refused to invalidate Intuitive Surgical Operation, Inc. (“Intuitive”)’s patent, related to instrument swapping in robotic surgery systems, as obvious. The Board determined that Auris Health Inc. (Auris)’s asserted prior art combination disclosed each limitation of the challenged claims, including a servo-pulley system to mimic a surgeon’s movements via robotic arms, and a robotically-adjustable stand to hold multiple instruments. However, when assessing whether a skilled artisan would have been motivated to combine those references, the Board agreed with Intuitive that no motivation existed. Intuitive argued that “surgeons were skeptical about performing robotic surgery in the first place,” thus a skilled artisan would have had no reason to combine the prior art references to create a more-complex surgical system. Auris appealed the Board’s reliance on general industry skepticism to find a lack of motivation to combine.

In a 2-1 precedential opinion, the CAFC reiterated that the motivation-to-combine inquiry determines whether a skilled artisan would have been motivated to combine the prior art to arrive at the claimed invention. The Court held that, as any problem known in the field at the time of invention and addressed by the patent can provide a motivation-to-combine, “generic industry skepticism cannot, standing alone, preclude a finding of motivation to combine.” The CAFC clarified that evidence of industry skepticism can play a role in the obviousness inquiry, but as a secondary consideration. The CAFC further highlighted that “*specific* evidence of industry skepticism related to a *specific* combination of references might contribute to finding a lack of motivation to combine” (emphasis in original). In vacating and remanding the Board’s decision, the majority held that it was insufficient for the Board to rely exclusively on evidence of general skepticism about the field of robotic surgery to find a lack of motivation to combine the prior art references.

In his dissent, Judge Reyna agrees with the majority that general skepticism by itself could be insufficient to negate a motivation-to-combine, but he disagreed that general skepticism could never be used to support such a finding. Astutely, Judge Reyna opines that the majority opinion should not be understood as proffering a rigid rule making it “impermissible” for the Board to consider evidence of artisans’ generic industry skepticism in determining the presence of a motivation-to-combine, as such would be contrary to the Supreme Court’s holding in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007), articulating an “expansive and flexible approach” to determining obviousness. Further, Judge Reyna dissents with the majority opinion’s assertion that skepticism “may play a role in an obviousness inquiry—but as a secondary consideration,” as it incorrectly suggests that secondary considerations are less important than the other *Graham* factors for determining obviousness.

Practitioners should remember that specific evidence of industry skepticism related to specific combinations of prior art may contribute to a lack of motivation-to-combine, but general industry skepticism alone is insufficient. Further, the majority opinion should not be interpreted as creating an inflexible rule making it impermissible for the Board to consider generic skepticism in assessing the presence or absence of a motivation-to-combine.