

April 18, 2024 ISB-IP Section Meeting

# YEAH, BUT ARE YOU **MOTIVATED** TO COMBINE?

*VIRTEK VISION INTERNATIONAL ULC V. ASSEMBLY GUIDANCE SYSTEMS, INC  
CASE NO. 2022-1998 & 2022-2022 (FED. CIR. MAR. 27, 2024)*

Chris Cuneo



# Today's Topics

- Obviousness 35 USC 103
  - Proper motivation to combine references



- Expert Reports & Deposition Preparation

# Brief Patentability Review

- A patent may be granted to anyone who **invents** or **discovers** any **new and useful** and **non-obvious**
  - process,
  - machine,
  - article of manufacture, or
  - composition of matter, or
  - any new and useful improvement thereof.

# Brief Patentability Review

- Useful – 35 USC 101
  - **Not** a judicial exception
    - Scientific theory, abstract idea, natural law, etc.
- New – 35 USC 102
  - Novel – not done before
- **Not** Obvious – 35 USC 103



# Obviousness

- Question of law based on underlying facts
- *Graham v. John Deere Co.*, 383 U.S. 1 (1966).
  - The factual inquiries enunciated by the Court are as follows:
    - (A) Determining the **scope and content of the prior art**;
    - (B) Ascertaining the **differences between the claimed invention and the prior art**; and
    - (C) Resolving **the level of ordinary skill** in the pertinent art.

# Pre *KSR* (before 2007)

- Must be an **EXPLICIT** or *IMPLICIT*
  - Teaching
  - **Suggestion**
  - **Motivation**
- TSM test
- Fairly rigid & easy to get around
  - Impermissible **HINDSIGHT!**



# Post *KSR* (after 2007)

- *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398 (2007)
  - TSM still a **useful test** but should **not** be **rigidly or formalistically applied**
  - persons of ordinary skill are not automatons, but persons of “**ordinary creativity**,” with the capacity to appreciate obvious uses of familiar items and combine those items to solve obvious problems.
  - an “obvious to try” invention may be obvious if at least three other conditions are met:
    - there is a design need or market pressure to solve a particular problem;
    - there are a finite number of foreseeable solutions to the problem; and
    - the result obtained is reasonably predictable.

# Virtek Vision Case

(12) **United States Patent**  
**Rueb**

(10) **Patent No.:** **US 10,052,734 B2**

(45) **Date of Patent:** **Aug. 21, 2018**

(54) **LASER PROJECTOR WITH FLASH  
ALIGNMENT**

(71) Applicant: **VIRTEK VISION INTERNATIONAL  
ULC, Waterloo (CA)**

(72) Inventor: **Kurt D. Rueb, Kitchner (CA)**

(\* ) Notice: Subject to any disclaimer, the term of this  
patent is extended or adjusted under 35  
U.S.C. 154(b) by 0 days.

(21) Appl. No.: **15/826,060**

(22) Filed: **Nov. 29, 2017**

*G06T 7/521* (2017.01); *H04N 9/317*  
(2013.01); *H04N 9/3129* (2013.01); *H04N*  
*9/3194* (2013.01); *B23Q 2717/00* (2013.01);  
*G06T 2207/10028* (2013.01); *G06T*  
*2207/10152* (2013.01); *H04N 13/204*  
(2018.05)

(58) **Field of Classification Search**

CPC ..... *G01C 11/00*; *G01C 11/02*; *G01C 15/002*;  
*G01C 3/00*; *G01C 5/00*; *G01C 9/00*;  
*G01C 11/06*

See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS



# Virtek Vision Case

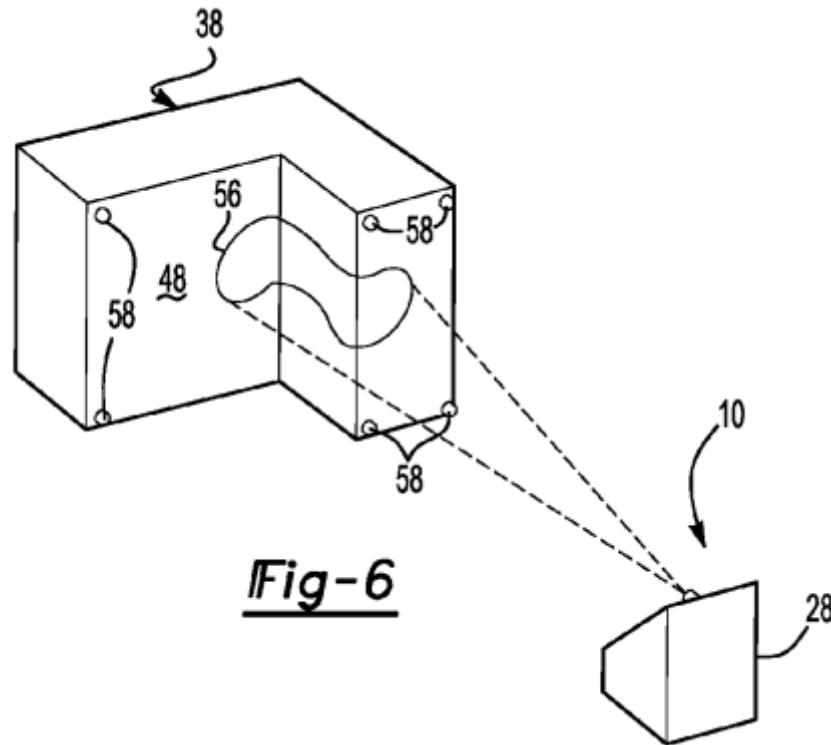
- Claim 1 is only independent claim
  - 1. A method for aligning a laser projector for projecting a laser image onto a work surface, comprising the steps of: \*\*\*
    - identifying a pattern of the reflective targets on the work surface in a **three-dimensional coordinate system**; and
    - after identifying the pattern of the reflective targets on the work surface in the three-dimensional coordinate system, scanning the targets with a laser beam \*\*\*

# Virtek Vision Case



Fig-1

# Virtek Vision Case



# Procedural History

- *Virtek Vision Int'l ULC v. Assembly Guidance Systems, Inc. d/b/a Aligned Vision*, No. 2:20-cv-10857 (D. Mass.)
- IPR filed with PTAB by Aligned in 2021
- PTAB Final Written Decision issued May 6, 2022
  - Found claim 1 (and others – but not all) unpatentable as obvious
- Parties cross appealed to Fed Cir

# What did PTAB hold?

- **Obvious** in view of combination of
  - Ref. A and Ref. B
  - Closely related laser alignment systems
- **Ref. A** – most of claim 1 but discloses using angular directions *not 3D*
- **Ref. B** – discloses using angular directions or 3D coordinates
- Dr. Mohazzab's Declaration a POSITA would have:
  - all the knowledge around this [ ] technique[ ] to put them together and make a system and would know, specifically, *as a matter of choice*, what kind of design to choose.

# What did PTAB hold?

- So, obvious to try?
- PTAB:
  - A person of ordinary skill has good reason to pursue the **known options** within his or her technical grasp.” (citing KSR).
  - The two alternatives satisfy the criterion supplied in KSR of “a **finite number** of identified predictable solutions,” such that it would have been **obvious to try** 3D coordinate process (Ref. B) in the system disclosed in (Ref. A).

# Some Red Flags

- “Although the analysis in the Petition [includes expert Decl.] *could have been more robust*”
- In his deposition Dr. M. admitted “that his written testimony lacked *any description of a reason to combine* the references.”



# What did the Fed Cir hold?

- **Reversed!**
- the Board erred as a matter of law with regard to the motivation to combine.
- **It does not suffice** to meet the **motivation** to combine requirement to recognize that two alternative arrangements such as an angular direction system ... and a 3D coordinate system ... were both **known in the art**



# What did the Fed Cir hold?

- [The Ref. A and Ref. B] disclosures, however, do not provide **any reason** why a skilled artisan would use 3D coordinates instead of angular directions in a system
  - TSM test?
- The mere fact that these possible arrangements existed in the prior art **does not provide a reason** that a skilled artisan would have substituted [Ref. A angular system] ... with the ... 3D coordinate system disclosed in [Ref. B]

# What did the Fed Cir hold?

- There was no argument in the petition regarding why a skilled artisan would make this substitution—other than that the two different coordinate systems were “**known to be used.**”
- Aligned’s expert (Dr. M) testified “it would have been obvious” to use the 3D coordinates instead of angular measurements **because** “**both such measurement systems were known.**”
- Moreover, he stated **eleven times** that **he did not provide any reason** to combine the references in his expert declaration

# What about KSR?

- Citing KSR:
  - an “obvious to try” invention may be obvious if at least three other conditions are met:
    - there is a design need or market pressure to solve a particular problem;
    - there are a finite number of foreseeable solutions to the problem; and
    - the result obtained is reasonably predictable.
- “KSR *did not do away with the requirement that there must exist a motivation to combine various prior art references...*”

# What about KSR?

- Here:
  - there was **no argument about common sense** in the petition or in Dr. Mohazzab's declaration
  - There was **no evidence that there are a finite number of identified, predictable solutions.**
  - There is **no evidence of a design need or market pressure.**
- In short, this case involves nothing other than an assertion that ***because*** two coordinate systems were disclosed in a prior art reference and were therefore “known,” that satisfies the motivation to combine analysis.
- **That is an error as a matter of law.** It does not suffice to simply be known.

# Need Proper Motivation!!



# Expert Reports & Deposition Preparation

- Worth listening to the oral argument at the Fed Cir:
- [https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1998\\_12052023.mp3](https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1998_12052023.mp3)
- Dr. M spent a total of **5 hours** preparing his **56-page** declaration (including review of 5 patents and file history)
- This was his first time testifying as an Expert

# Expert Reports & Deposition Preparation



- Chief Judge Moore

# Lowlights

- Starting at 24:50
- “Very **troubled** by the expert testimony...”
- “17 separate times your expert suggested that he didn’t think references ***needed*** to be combined”
- “Didn’t know the difference between anticipation [102] and obviousness [103]”
- Didn’t know what was in his ***own*** declaration...



# Lowlights

- “I’m a little **horrified...**”
- “I almost wanted to ask *did you take him drinking before the deposition?*”



# Some takeaways

- Use this case to fight **A** exists and **B** exists, **therefore, obvious design choice** type rejections/allegations
- Provide **some articulation of a reason** to combine if challenging a patent (IPR or litigation)
- Have your Expert prepare sufficiently
- Take the Expert drinking **AFTER** the depo

# Questions?

- Chris Cuneo
  - [ccuneo@parsonsbehle.com](mailto:ccuneo@parsonsbehle.com)
  - 208-562-4896

# FAIR USE NOTICE

- Original content is available with the permission of the author solely for the purpose of furthering the ISB IP Section's mission to educate, inform and improve the practice of IP law. All other uses are forbidden without the express consent of the author. For permission to re-use, please contact Chris Cuneo.
- This presentation may contain copyrighted material the use of which has not always been specifically authorized by the copyright owner. This material is made available to the ISB IP Section in an effort to educate and advance understanding of issues of significance to the IP Section. We believe this constitutes a 'fair use' of any such copyrighted material as provided for in section 107 of the US Copyright Law. In accordance with Title 17 U.S.C. Section 107, the material in this presentation is distributed without profit to those who have expressed a prior interest in receiving the included information for research and educational purposes. For more information go to: <http://www.law.cornell.edu/uscode/17/107.shtml>. If you wish to use copyrighted material from this presentation for purposes of your own that go beyond 'fair use', you must obtain permission from the copyright owner.