

CLIENT ALERT

## Prior Art References Disclosing Members of a Finite Set of Known, Predictable Solutions May Be Combined to Find Obviousness Without the Use of Impermissible Hindsight

MAY 5, 2020

*Uber Technologies, Inc. v. X One, Inc.*, No. 2019-1164 (Fed. Cir. May 5, 2020)

The *inter partes* review petitioner appealed the Patent Trial and Appeal Board's (PTAB) final written decision upholding the patentability of all challenged claims as nonobvious. The patent under review related generally to a system for sharing location information between mobile devices and plotting that information on a map for presentation to the user.

The PTAB found that the asserted prior art did not render obvious the limitation "software . . . to transmit the map with plotted locations to the first individual." This limitation requires "server-side" plotting, which was undisputedly disclosed in one of the petitioner's prior art references. The petitioner's second prior art reference, by contrast, relied upon an alternative approach, "terminal-side" plotting. This disparity led the PTAB to rule that the combination of these references represented "impermissible hindsight" or would be "a wholesale modification" of the second prior art reference.

On appeal, the Federal Circuit recognized that server-side and terminal-side were the only two possible methods of plotting a map with users' locations. This meant there was "a finite number of identified, predictable solutions" to the problem of "helping one user view and track the location of other users." When faced with a finite set of known solutions, the Federal Circuit explained, "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." Here, "server-side plotting and terminal-side plotting were two known, finite, predictable solutions for achieving the transmission of maps and plotted locations." Thus, motivation existed to combine the petitioner's prior art references, and the substitution of server-side plotting would have been obvious as a predictable variation using a known technique—effectively, a design choice.

The Federal Circuit reversed and remanded for the PTAB to consider the obviousness of the remaining limitations of the challenged claims.

A copy of the opinion can be found [here](#).

1 Min Read

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