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CLIENT ALERT

Anticipation May Be Properly Raised As Single-Reference Obviousness

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Realtime Data, LLC v. Iancu, 2018-1154 (Fed. Cir. Jan. 10, 2019)
The patent owner's patent claiming systems and methods for providing lossless data compression and decompression using parametric dictionary encoding was the subject of an *inter partes* review. The Patent Trial and Appeal Board (PTAB) invalidated the patent as obvious, and the Federal Circuit affirmed.

At the PTAB, the petitioner challenged the patent on two grounds: (1) obviousness over O'Brien alone and (2) obviousness in over O'Brien in view of Nelson. First, the petitioner argued that O'Brien taught every limitation of the challenged claims. The petitioner offered the second ground, O'Brien in view of Nelson, in the alternative because Nelson clarified that the methods disclosed in O'Brien constituted the claimed "dictionary" encoding. The patent owner agreed that O'Brien taught every limitation of the claims, but disagreed that there was a motivation to combine O'Brien and Nelson. The PTAB found the claims obvious under both grounds.

On appeal, the patent owner argued that the PTAB's decision should be reversed because the PTAB did not make sufficient findings regarding a motivation to combine O'Brien and Nelson. The Federal Circuit disagreed because "the board was not required to make any finding regarding a motivation to combine given its reliance on O'Brien alone." The patent owner also argued that the single reference ground should have been raised as anticipation under § 102 rather than obviousness under § 103. The Federal Circuit rejected that such a requirement because "it is well settled that a disclosure that anticipates under § 102 also renders the claim invalid under § 103, for anticipation is the epitome of obviousness."
A copy of the opinion can be found here.

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