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Precedential Opinion: Contingent motion to amend providing nexus of amendments to secondary considerations of nonobviousness resulted in patentability

SEPTEMBER 10, 2020

Lectrosonics, Inc. v. Zaxcom, Inc., Case IPR2018-01129, Paper 33 (Jan. 24, 2020) (designated: Apr. 14, 2020) before Scott R. Boalick, Kalyan K. Deshpande, and Lynne E. Pettigrew

The challenged patent ([US7929902](#)) relates to recording/processing audio with tracks received from wireless devices “operating in either an asynchronous or synchronous mode.” The IPR petitioner asserted obviousness and anticipation grounds for multiple claims. The Board found that certain claims were invalid based on the obviousness and anticipation arguments. The Board also found that Patent Owner’s contingent motion to amend met the statutory requirements and rejected the petitioner’s obviousness argument with respect to the amended claims.

The Board first disagreed with Patent Owner’s arguments against the prior art combination, finding that the Petitioner “set forth sufficient rationale to combine the teachings of the references in the manner asserted and specifically has articulated sufficient reasoning with rational underpinning to combine” and a sufficient basis to find “analogous art to the claimed invention . . . in the same field of endeavor as the claimed invention [or] reasonably pertinent to the problems faced by the inventors of the ’902 patent.”

With respect to the original claims, the Board rejected the Patent Owner’s secondary consideration arguments, finding that the “Patent Owner fails to show the requisite nexus between its alleged objective indicia of nonobviousness and the merits of the claimed invention” or that the Patent Owner’s “evidence of secondary considerations is the ‘direct result of the unique characteristics of the claimed invention.’” The Patent Owner had identified that its inventors received achievement awards for products embodying the relevant claims. The Board, however, found that the Patent Owner had not shown that the awards related to features embodied by the relevant claims.

Finally, with respect to the substitute claims, the Board found that petitioner “present[ed] a weak case of obviousness.” Notably, the Board based its opinion on the fact that the Patent Owner had amended its claims in a way that established “a nexus between the evidence of secondary considerations and substitute claims.” As such, unlike with the original claims, the awards and other objective indicia evidence identified by the Patent Owner supported a finding of non-obviousness for the substitute claims.

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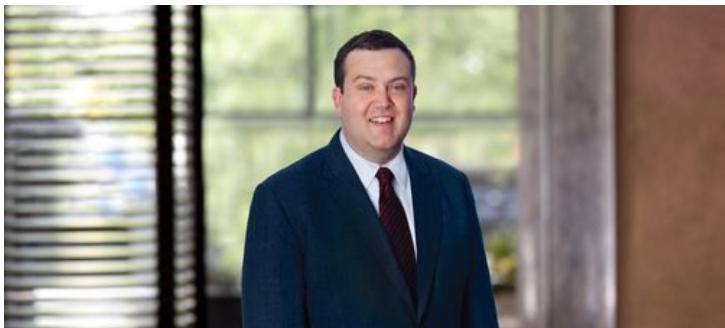
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