

PTAB's Determination of Nonobviousness Is Reversed for Failure to Properly Understand the Claims at Issue

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Canfield Scientific, Inc. v. Melanoscan, LLC, No. 2019-1927 (Fed. Cir. Feb. 18, 2021)

Canfield Scientific petitioned the PTAB for *inter partes* review of Melanoscan's patent relating to an imaging device used to detect skin cancer and other diseases as obvious over the prior art. The PTAB determined that all challenged claims were patentable. Petitioner appealed to the Federal Circuit, which overturned the PTAB's ruling.

Judge Newman wrote on behalf of the panel reversing the PTAB's decision as to the independent claims, finding both obvious over the prior art, and remanding as to the dependent claims. The court determined that the combination of the prior art presented by the petitioner, when considered by a person of ordinary skill in the art familiar with known methods and elements, would yield predictable results. In particular, the PTAB erred by failing to recognize that the independent claims at issue are not limited as to the location of the subject being imaged. As a result, the PTAB's reasoning for finding nonobviousness based upon a subject being imaged against a rear wall was not determinative. Accordingly, the court found the independent claims obvious and reversed the PTAB's ruling. As to the dependent claims, the court remanded to the PTAB because the PTAB had not separately analyzed the dependent claims upon holding the independent claims patentable.

Read the Federal Circuit's opinion [here](#).

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