

AURIS HEALTH, INC. V. INTUITIVE SURGICAL OPERATIONS, INC., Appeal No. 2021-1732 (Fed. Cir. April 29, 2022). Before Dyk, Prost, and Reyna. Appealed from the Patent Trial and Appeal Board.

Background:

Auris Health ("Auris") petitioned for inter partes review of Intuitive Surgical Operations' ("Intuitive") patent related to a robotic surgery system to allow a surgeon to remotely manipulate surgical tools. The Board determined that a combination of two prior art references disclose all of the features of the claims of the patent. However, the Board held that a skilled artisan would not have found it obvious to combine the two prior art references to achieve the claimed features.

The Board agreed with Intuitive's argument, which was supported by expert testimony, that a skilled artisan would not have been motivated to combine the two prior art references because of general skepticism by surgeons in the art about performing surgery using robotics at the time of invention. In that respect, the Board agreed with Intuitive that combining the prior art references would further complicate a robotic surgical system, which was contrary to the known skepticism in the art, and thus would not have been obvious. Auris appealed.

Issue/Holding:

Did the Board err in finding that general skepticism in the art is sufficient for nonobviousness? - Yes, reversed and remanded.

Discussion:

The Federal Circuit held that evidence of industry skepticism may be considered in an obviousness inquiry, but the skepticism must be related to the specific combination of references. The Federal Circuit began by considering *KSR*, which stated that a need or problem known in the field of endeavor can provide a reason for combining the elements in the manner claimed. The Federal Circuit interpreted this rationale in *KSR* to indicate that generic industry skepticism alone cannot preclude a finding of a motivation to combine.

The Federal Circuit further stated that the evidence of skepticism must be specific to the invention, not generic to the field. The Federal Circuit determined that the expert testimony relied upon by the Board only related to general skepticism about the field of robotic surgery to find a lack of motivation to combine the prior art references. In light of that evidence being insufficient, the Federal Circuit reversed and remanded back to the Board to consider whether the remaining evidence of record is able to establish a motivation to combine when considering the proper application of industry skepticism to the obviousness inquiry.

Judge Reyna dissented. Judge Reyna asserted that the majority oversimplified the Board's reasoning for finding a lack of motivation to combine. Judge Reyna interpreted the evidence of industry skepticism as being specific to the combination based on the expert testimony related to the combination. Judge Reyna also asserted that the majority failed to consider the Board's additional reasoning for a lack of motivation which relied on Auris' alleged failure to articulate how a skilled artisan would have combined the references without frustrating their goal/purpose.