SHIMOKAJI & ASSOCIATES, P.C.

Intellectual Property Lawyers
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NEWSLETTER

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We specialize in the litigation and registration of patent, trademark, and copyright matters. The clients we serve range from start-ups to Fortune 500 companies, government entities, and universities. Though located in the US, our expertise and representation has an emphasis in Asia.

— LATEST NEWS & EVENTS —

Happy New Year 2013 - The Year of the Snake

The snake is intuitive, introspective and refined. Not outwardly emotional, the snake works very modestly in the business environment. The snake will plot and scheme to get its way. They are not great communicators and can be possessive.

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Secondary Considerations Alone Can Establish Non-Obviousness

In *Transocean v. Maersk*, a prior Federal Circuit decision determined that there was a prima facie case of obviousness. On remand, the jury found that secondary considerations of non-obviousness overcame the prima facie case of obviousness.

On the current appeal, the Federal Circuit explained that the "establishment of a prima facie case . . . is not a conclusion on the ultimate issue of obviousness . . . [and] evidence rising out of the so-called 'secondary considerations' must always when present be considered enroute to a determination of obviousness."

The Federal Circuit acknowledged that findings of non-obviousness based only on secondary considerations was uncommon. However, the jury found non-obviousness based on commercial success, industry praise, unexpected results, copying, industry skepticism, long-felt need, and licensing. The court went onto find that there was substantial evidence to support the jury finding and that the objective evidence established non-obviousness, even though the prior art showed obviousness.

PRACTICE POINT:

In litigation, secondary considerations of non-obviousness should be emphasized when the prior art appears to be against you.

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