

In re Translogic Tech., Inc.

No. 06-1192, Federal Circuit (Mayer, Rader,* Prost)

[A]n obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

On October 12, 2007, the Federal Circuit affirmed the Board of Patent Appeals and Interferences decision upholding the patent examiner’s rejection during a reexamination of the claims of U.S. Patent No. 5,162,666, which related to a transmission gate series multiplexer, as obvious. The Federal Circuit stated:

An invention is unpatentable as obvious if the differences between the patented subject matter and the prior art would have been obvious at the time of invention to a person of ordinary skill in the art. . . . “The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation [(TSM)], or by overemphasis on the importance of published articles and the explicit content of issued patents.” [The suggested route is] a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention, without unduly constraining the breadth of knowledge available to one of ordinary skill in the art during the obviousness analysis.

This court finds that the claims of the ‘666 patent were unpatentable under 35 U.S.C. § 103(a). Gorai is within the scope of the relevant prior art because it both pre-dates the ‘666 patent filing date of March 15, 1991 and discloses series 2-input multiplexer circuits. Moreover a person of ordinary skill in the art would have a thorough understanding of electrical switching systems and knowledge of actual electrical implementations of multiplexers such as the [transmission gate multiplexers (TGMs)] in Weste. . . .

Translogic mistakenly argues that variants of a circuit connecting 2:1 multiplexers in series are not relevant prior art with respect to the ‘666 patent because these variants do not address the same problem, namely an improved multiplexer circuit. However, this argument overlooks the fundamental proposition that the series circuits in Gorai are prior art within the public domain and the common knowledge of a person of ordinary skill in the art. Thus, the Gorai reference is a relevant prior art reference with respect to the ‘666 patent and clearly discloses a series 2:1 multiplexer circuit.

[A]n obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” In this case, a person of ordinary skill in the art at the time of the invention would have recognized the value of using a known element, a 2:1 TGM, as taught by Weste, for the 2:1 multiplexers in the series arrangement of multiplexers in Gorai. A person of ordinary skill in the art would have appreciated that any conventional multiplexer circuit could be utilized to implement the 2:1 multiplexer circuits in Gorai. After all, TGMs were well-known multiplexer circuits as evidenced by the Weste 1985 textbook. In other words, in looking for a multiplexer circuit for the individual 2:1 multiplexers disclosed in Gorai, a person of ordinary skill in the art would have solved this design need by “pursu[ing] known options within his or her technical grasp.” Thus, this court agrees with the Board’s determination. The Board based its decision on sound reasoning that a person of ordinary skill in the art would select a specific circuit based on the need for a 2:1 multiplexer circuit for the individual multiplexers shown in Gorai. Specifically, a person of ordinary skill in the art at the time of the invention would have been able to choose TGMs as an option. While other circuits could have been used to implement the 2:1 multiplexers, TGMs were a well-known circuit as shown by the explanation of TGM circuits in the 1985 textbook by Weste. This court finds that substantial evidence in the record supports the Board’s finding that a person of ordinary skill in the art would have used TGMs in the N:1 circuit configuration shown in Gorai. In sum, this court agrees with the Board’s conclusion that the ‘666 patent is unpatentable under 35 U.S.C. § 103(a) over Gorai in view of Weste.

Because this court finds that Gorai in view of Weste renders the ‘666 patent unpatentable, the court will not address Tosser in view of Weste. However, the analysis of Tosser in view of Weste would undoubtedly reach the same result because Tosser also discloses a series multiplexer circuit.

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