

CROSS MEDICAL PRODUCTS, INC. v. MEDTRONIC SOFAMOR DANEK, INC.:
MOTIVATION TO COMBINE FOUND IN OLD PROBLEM

In a recent case involving obviousness, the United States Court of Appeals for the Federal Circuit (“CAFC”) in *Cross Medical Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, (05-1043), reversed a district court grant of partial summary judgment of non-obviousness. The district court based this ruling, in part, on the lack of motivation to combine.

Citing *In re Spinnoble*, the district court stated that a non-obvious invention may be found by the discovery of a new problem to be solved even when the solution to the problem is obvious. Furthermore, the district court acknowledged that the motivation to combine can be found in the prior art or in the knowledge of one of skill in the art. However, the district court rejected the argument that that the motivation to combine can be found in a problem to be solved that is in the knowledge of one of skill in the art.

The CAFC declined to follow such a narrow rule and stated that the motivation to combine can be found in the problem to be solved, which need not be found in the prior art references, but can also be found in the knowledge of one of ordinary skill in the art. Furthermore, the problem to be solved need only be similar, not identical, in order to provide a motivation to apply certain teachings to solve the problem.

As a result of this ruling, it is clear that obviousness may depend on a problem to be solved that is not explicitly found in the prior art but implicitly found in the general knowledge of one of skill in the art.

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