According to the recent U.S. court decision of Randall Mfg. v. Rea, 2012-1611 (Fed. Cir. 2013), common knowledge and common sense are important factors in determining the patentability of the purported invention.

On October 30, 2013, a three-judge panel of the United States Court of Appeals for the Federal Circuit (CAFC) emphasized that common knowledge, available in the art at the time of invention, is highly material in evaluating the motivation to combine or modify references in determining the patentability of the claims. The court vacated a decision of the Board of Patent Appeals and Interferences that reversed the Examiner's determination that the claims were obvious.

The CAFC stated that the previous decision too narrowly focused on four references cited by the Examiner during prosecution and failed to consider well-documented background knowledge that could explain why one skilled in the art would have been motivated to combine the references to arrive at the claimed invention.

The patent in question, U.S. Patent No. 7,214,017 ('017), is owned by FG Products and is directed to a partitioning apparatus including two separate half-width panels. The panels are independently movable in a lengthwise direction of the shipping container and may be raised and stowed against the ceiling of the shipping container.

The primary reference, Aquino, cited by the Examiner, described a side-stowage method rather than a ceiling-stowage method. Before the Board, FG argued that one skilled in the art would not have been motivated to modify Aquino to include the ceiling stowage since Aquino already described the different stowage method.

Randall argued that the ceiling stowage was well-known at the time of invention and was preferred in the industry, permitting moving the panels out of the way.

The CAFC found the Board failed to appropriately consider the additional evidence of record demonstrating the breadth of knowledge of one skilled in the art and the industry practice favoring ceiling stowage.

The record established that a prevalent and preferential method of stowing a bulkhead panel was to raise it to the ceiling. Accordingly, the CAFC believed it was transparent to see why one skilled in the art would have thought to modify Aquino to include this feature. Citing KSR, the CAFC stated that FG’s design was nothing more than the “combination of familiar elements according to known methods…each
performing the same function it had been known to perform...yield[ing] predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416-17 (2007).

Accordingly, the CAFC vacated the Board's decision for failure to consider the knowledge of one skilled in the art when evaluating motivation to modify the references. This decision confirms that common knowledge is a decisive factor in determining obviousness.

In the future, we will likely encounter more rejections based on the rationale that it is obvious to combine familiar elements according to known methods in view of common knowledge and/or common sense, yielding predictable results.

However, the CAFC provided some guidance on how to traverse obviousness rejections based on common knowledge in the art. Specifically, FG’s invention conformed to industry standards, while Aquino was shown to be an exception to industry standards. Thus, the common knowledge and/or common sense rationale of the Examiner could be traversed when the claimed invention does not conform to industry standards and the prior art reference does, i.e., when the facts are opposite of that in *Randall*.

Also, it may be possible to traverse the rejection by demonstrating that the elements of the invention are not combined according to known methods, or that the elements perform a function different from that of the prior art, the common knowledge, and/or the industry standards.