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IF A REFERENCE DESCRIBES A MODIFICATION OF A CLAIMED INVENTION AS INFERIOR, THE REFERENCE DOES NOT NECESSARILY TEACH AWAY FROM THE CLAIMED INVENTION**By: Roshni A. Sitapara****I**

n a recent United States Court of Appeals for the Federal Circuit (Fed. Cir.) case (*Gator Tail, LLC v. Mud Buddy LLC*), the Federal Circuit held that if a reference describes a modification of a claimed invention as somewhat inferior, that reference does not necessarily teach away from the claimed invention. Additionally, if a reference merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage investigation into the claimed invention, it does not teach away from the claimed invention.

Teaching Away in 35 U.S.C. 103 Obviousness Rejections

If a reference teaches away from a claimed invention, the claimed invention is more likely to be non-obvious. A reference teaches away from a claimed invention “when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” (In *re Gurley*, Fed. Cir. 1994).

References may also teach away if, when taking two references in combination, it would produce a “seemingly inoperative device.” (*McGinley v. Franklin Sports, Inc.*, Fed. Cir. 2001).

Gator Tail, LLC v. Mud Buddy LLC

In the *Gator Tail* case, decided on June 22, 2015, Gator Tail alleged that defendants, Mud Buddy, LLC and Go-Devil Manufacturing Company of Louisiana, manufacture products that infringe on its patents directed towards “mud motors”.

Mud motors are boat motors designed for shallow water to be used in fishing and hunting. The mud motors that were primarily used from the 1970s to the early 2000s were long tail motors. While the long tail mud motors were effective in shallow muddy waters, they were often difficult to maneuver due to their wide turning radius.

An improved short tail mud motor was claimed in U.S. Patent No, 5,741,165 (Saito). Saito discloses a propulsion system that can be attached to the back of a boat. The system includes a vertically oriented engine connected to a drive shaft. The drive shaft attaches to and drives motion in the propeller shaft. While Saito’s claimed design provides many benefits, since the design incorporates a vertical engine that has to hang off of the back of the boat, it also creates some problems with balance.

Gator Tail’s U.S. Patent No. 7,297,035 claims a design that is similar to Saito but includes a horizontally oriented engine. Gator Tail’s patent also claims directly connecting the engine to a timing belt drive gear that attaches to and drives motion in the parallel propeller, which was not claimed in Saito.

Once Gator Tail filed its complaints, Mud Buddy requested an *ex-parte* reexamination of Gator Tail’s relevant patents. During the reexamination proceedings, the Examiner ultimately confirmed all of the claims of the patents and found that the claims would not be obvious to a person of ordinary skill in the art in light of Saito and

The district court ultimately found that all of the claims of Gator Tail's relevant patents were invalid for being either obvious, indefinite, or failing the written description requirement. In regards to its obviousness rejection, the district court found that the claims were merely a predictable combination of Saito and other references that would have been obvious to a person of ordinary skill in the art with an undergraduate degree in Mechanical Engineering and experience with marine propulsions system.

Specifically, the district court found that one of ordinary skill in the art would be motivated to solve the balance problem in Saito by replacing the vertical engine with a horizontal engine. Furthermore, the district court found that one of ordinary skill in the art would use a timing belt, as used in Gator Tail's patents, to connect a horizontal engine to the horizontal propeller. The district court also concluded that Saito did not teach away from Gator Tail's patents.

On appeal, Gator Tail, among other things, challenged the district court's finding that Saito does not teach away from the claimed invention.

Conclusion

The Federal Circuit found that Saito does not teach away from the use of horizontal engines by describing the short comings of long tail motors that use horizontal engines.

Saito explains that the horizontal engine motors that were on the market at the time of its invention took too much space on the boat. Saito further describes how its design is an improvement over the prior art that incorporated the use of horizontal engines.

In its decision, the Federal Circuit focused on the fact that Saito does not suggest that horizontal engines would render the motor inoperable. Therefore, even though Saito suggests that horizontal engines are inferior to its claimed vertical engine, these statements do not teach away from Gator Tail's invention. As a result, the Federal Circuit held that all of the claims in Gator Tail's relevant patents were invalid.

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