



# The Dangers Of Hindsight Bias In The Context Of Obviousness

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*Mintz v Dietz & Watson, Inc*, No 2010-1341, 2012 US App LEXIS 10884 (Fed Cir, 30 May 2012), 'Mintz II'

## Abstract

In *Mintz*, the US Court of Appeals for the Federal Circuit set forth protections against improper hindsight analysis in analysing whether a claimed invention is obvious.

## Legal context

In performing an obviousness analysis, it can be difficult to view the prior art without using the inventor's own contribution as a hindsight roadmap. The US Court of Appeals for the Federal Circuit ('Federal Circuit') has tried to address this concern over the years in a variety of ways. Before *KSR Int'l Co v Teleflex Inc*, 550 US 398 (2007), the Federal Circuit used the so-called 'teaching-suggestion-motivation' (TSM) test, which has now been rejected in the USA. In *KSR*, the US Supreme Court called for a more flexible 'common sense' analysis, and left it to the lower courts to work out the details.

In *Mintz*, the Federal Circuit provided further clarification of *KSR* and the three steps to be taken to avoid improper hindsight analysis by:

1. requiring that 'common sense' be articulated;
2. avoiding the use of the patent itself in defining the problem the invention solves; and
3. emphasizing the need to analyse the objective indicia of non-obviousness.

## Facts

Marcus and Neil Mintz invented a casing structure for meat products that permitted meat to



bulge between netting strands while avoiding the more complex stuffing process associated with prior knitted meat encasements. The Mintzes filed a patent application on 6 January 1994, which issued as US Patent No 5,413,148 ('the '148 patent'). The '148 specification described prior art meat encasements, which used a netting that allowed meat to bulge between the netting strands and produce a desirable grid-like pattern on the meat's surface. However, in the prior art meat encasements, the meat would bulge and cook around the netting strands, causing difficulty in peeling the netting off the cooked meat. The prior art tried to solve this problem by using a separate layer of collagen film, or stockinette, underneath the netting. This solution, however, required a two-step stuffing process that was labour intensive and expensive.

The '148 patent solved this problem by integrating a stockinette into the netting surface to make a new kind of meat encasement. Thus, the patent solved the adherence problem without the higher cost of the two-step stuffing process and, at the same time, allowed some bulging to create a desirable grid-like pattern on the meat's surface. The Mintzs began selling their patented product under its Jif-Pak line.

Thereafter PCM, previously a distributor of the Mintz Jif-Pak products, began selling similar products in direct competition with Mintz. PCM filed a declaratory judgment action against Mintz in the United States District Court for the District of South Carolina, while Mintz filed an infringement action against PCM in the United States District Court for the Southern District of California. After consolidation of the separate suits in the California Court, the defendants moved for summary judgment of invalidity (*Mintz v Dietz & Watson, Inc*, 704 F Supp 2d 1004 (SD Cal 2010)).

Claim 1 recites:

An elongated tubular casing structure for encasing meat products, said elongated structure having a longitudinal direction and a transverse lateral direction, said casing structure comprising:

a stockinette member comprising a closely knit tubular member formed of closely knit threads and having a first stretch capacity;

a knitted netting arrangement having a second stretch capacity and comprising a first plurality of spaced strands extending in said longitudinal direction and a second plurality of spaced strands extending in said lateral direction;

the longitudinal and lateral strands of said netting arrangement each intersecting in locking engagement with one another to form a grid-like pattern comprising a plurality of four-sided shapes;

said strands of said netting arrangement being knit into the threads of said stockinette member, whereby said netting arrangement and said stockinette member are integrally formed so that said casing structure comprises an integrally formed structure;



said first stretch capacity being greater than said second stretch capacity;

whereby, when a meat product is stuffed into said casing structure under pressure, said meat product forms a bulge within each of said four-sided shapes to thereby define a checker-board pattern on the surface thereof, said stockinette member forming a shield to prevent the adherence of adjacent meat product bulges over said strands of said netting arrangement.

One piece of prior art included all of the elements of Claim 1, except the limitation that each longitudinal and lateral strand intersect in locking engagement. The defendants argued that this limitation was a known element in the art of knitting and that it would have been obvious to a person skilled in the knitting arts to combine these teachings. In evaluating the issue, the district court stated that ‘you look at the prior art and take a common sense approach to determine whether it would have been obvious to a person of skill in the art to combine the references and come up with the invention.’ The district court concluded that it would have been obvious and predictable to a person of ordinary skill in the knitting arts to fix each point of intersection of the lateral and longitudinal strands to create a structure that would provide a grid impression on the meat product. Thus the district court granted PCM's motion for invalidity. Mintz appealed to the Federal Circuit.

## Analysis

In a panel decision authored by Chief Judge Rader, the Federal Circuit vacated and remanded the district court's decision on invalidity of the '148 patent. According to the Federal Circuit, the district court improperly relied on hindsight bias in performing its obviousness analysis.

First, the Federal Circuit held that more than merely the words ‘common sense’ must be articulated. In its obviousness determination, the district court relied on a ‘common sense approach’ to conclude that it would have been obvious to try the locking engagement specified in the claim language of the '148 patent. The Federal Circuit concluded that ‘with little more than an invocation of the words “common sense” (without any record showing that this knowledge would reside in the ordinarily skilled artisan), the district court over-reached in its determination of obviousness.’

The Federal Circuit also took issue with the district court's sole reliance on the perspective of an artisan in the knitting arts. The Federal Circuit stated that ‘the basic knowledge (common sense) of a knitting artisan is likely to be different from the basic knowledge in the possession of a meat encasement artisan.’

The Federal Circuit also found that the district court erred by using the invention to define the problem that the invention solves: this approach is problematic because it may be the *problem* itself that is non-obvious; once the problem is known, the solution may be virtually certain. Said the court: ‘Often the inventive contribution lies in defining the problem in



a new revelatory way.’ Thus it held that PCM had to prove by clear and convincing evidence that a person of ordinary skill in the meat encasement arts at the time of the invention both would have recognized the adherence problem and would have found it obvious to produce the meat encasement structure disclosed in the ‘148 patent.

Finally, the Federal Circuit found that the district court erred in not considering Mintz’s evidence of objective indicia of non-obviousness. Objective indicia include unexpected results, expert scepticism, copying, commercial success, praise by others, failure by others, and long-felt need. The Federal Circuit stated that ‘these objective guideposts are powerful tools for the courts faced with the difficult task of avoiding subconscious reliance on hindsight.’ It found that Mintz had presented substantial evidence of these objective indicia. For example, when PCM was a distributor of the Jif-Pak products covered by the ‘148 patent, PCM sent many letters and brochures praising the benefits of the Jif-Pak products. Further, despite the old elastic netting being on the market for over 30 years and the collagen film for over ten years, no one had been able to combine the two to solve the meat encasing problem. Mintz also presented evidence of a competitor who tried to solve the problem and failed. Finally there was substantial evidence that the Jif-Pak products were commercially successful and had become the industry standard.

The Federal Circuit vacated and remanded the decision back to the district court.

## Practical significance

*Mintz II* uses strong language to emphasize the need to avoid hindsight bias when analysing obviousness. These same concerns gave rise to the failed TSM test, and have caused the Federal Circuit to look for other protections against their vice. *Mintz II* demonstrates that although *KSR* calls for a flexible approach to determining obviousness, such determinations will nonetheless be held to a strict standard. Conclusions about ‘common sense’ must be articulated and supported, the patent itself may not be used in defining the problem solved by the invention and objective indicia of non-obviousness must be considered. Whether the approach adopted in *Mintz II* will survive, only time will tell. But for now, *Mintz II* provides some protection against improper hindsight analyses.

## Footnotes

Mr. Macedo is also the author of *The Corporate Insider's Guide to US Patent Practice*, published by Oxford University Press in 2009.

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