

***Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356 (Fed. Cir. 2023) ([Taranto, Chen, Stoll](#))**

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Yita LLC petitioned for IPR of two patents owned by MacNeil IP LLC. This summary focuses on the proceedings on MacNeil’s patent relating to vehicle floor trays that “closely conform[]” to certain walls of the vehicle foot well.

The Board found that Yita had not shown the challenged claims to be unpatentable. Despite finding that a skilled artisan would have been motivated to combine the asserted references with a reasonable expectation of success, the Board rejected Yita’s obviousness challenge because MacNeil’s evidence of secondary considerations—commercial success, long-felt need, and industry praise—was compelling evidence of nonobviousness. The Board found that MacNeil was entitled to a presumption of nexus to the objective evidence because MacNeil’s marketed “WeatherTech[] vehicle trays embody the claimed invention and are coextensive with the claims.”

The secondary considerations evidence related to the “close conforming vehicle floor tray.” The Board found that, although one of Yita’s asserted prior-art references disclosed this feature of the claims, a finding of nexus was nonetheless appropriate because Yita “d[id] not establish that close conformance was *well-known*.” Quoting *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 330 (Fed. Cir. 2016), the Board stated “it is the claimed combination as a whole that serves as a nexus for objective evidence; proof of nexus is not limited to only when objective evidence is tied to the supposedly “new” feature(s).” Accordingly, the Board gave MacNeil’s evidence of secondary considerations “substantial weight.”

On appeal, the Federal Circuit concluded that the Board’s finding of nexus rested upon two legal errors. First, the court explained that “objective evidence of nonobviousness lacks a nexus if it exclusively relates to a feature that was known in the prior art—not necessarily well-known.” Thus, “[w]here prior art teaches a feature and a relevant artisan would have been motivated

to use it in combination with other prior-art teachings with a reasonable expectation of success to arrive at the claimed invention—as the Board here found—a secondary consideration related exclusively to that feature” is not probative of non-obviousness.

Second, the Federal Circuit criticized the Board’s reliance on *WBIP*, clarifying that the secondary-consideration evidence may be linked “to the inventive combination of known elements,” i.e., the claimed combination as a whole, only “when no single feature (but only the combination) is responsible for the secondary-consideration evidence.” Secondary considerations are not given force if they “exclusively related to a single feature that is in the prior art.” Here, the Board found the secondary-consideration evidence “relate[d] entirely” to the close-conformance limitation, which was disclosed in the prior art. The Federal Circuit also clarified that the “coextensiveness inquiry bears only on the presumption of nexus; it does not decide the overall nexus question.” The “decisive problem for MacNeil” here was that the feature of the commercial product that gave rise to the objective evidence of non-obviousness was found in the prior art.

Thus, because the only *Graham* factor the Board weighed in favor of nonobviousness was the secondary-consideration evidence, and because this finding lacked substantial-evidence support under the proper legal standard, the court reversed the Board’s finding that the claims of the challenged patent were not unpatentable for obviousness.

RELATED CASE:

- *Medtronic, Inc. v. Teleflex Innovations S.à.r.l.*, 70 F.4th 1331 (Fed. Cir. 2023) ([Moore, Lourie, Dyk](#)) (affirming the Board’s holding that a “close” prima facie case of obviousness was overcome by “strong” objective evidence of non-obviousness, including “considerable commercial success,” “extensive praise within the industry,” “solv[ing] problems the industry previously considered ‘impossible,’” and “multiple competitors cop[y]ing” the invention).