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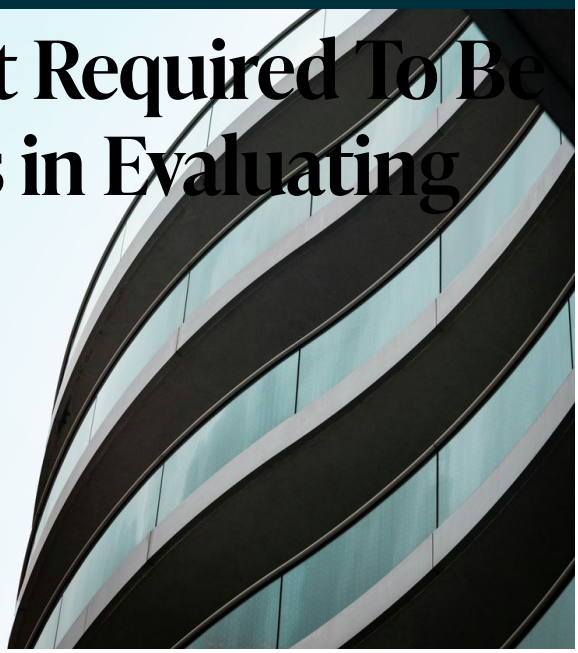
A POSA's Motivation Is Not Required To Be the Same as the Inventor's in Evaluating Obviousness



3 MIN READ

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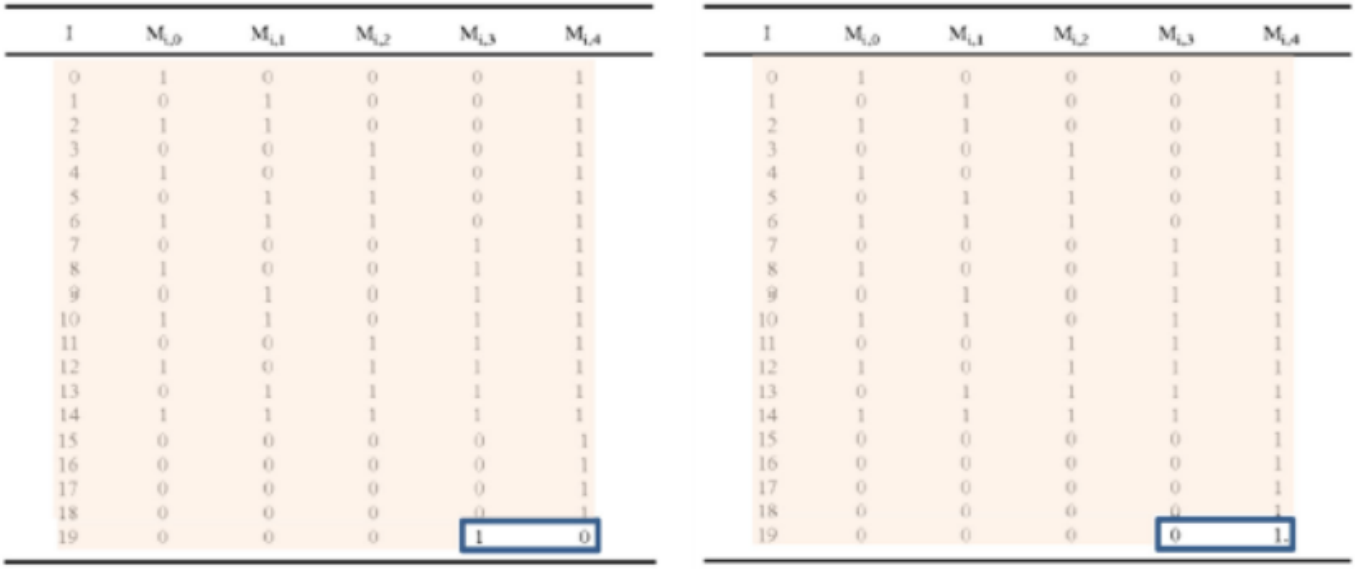
In its first precedential opinion of 2025, *Honeywell v. 3G Licensing*, No. 2023-1354, the Federal Circuit held that a person of ordinary skill in the art (POSA) needs not to have the same motivation as the inventor in an obviousness inquiry, re-emphasizing the Supreme Court's mandate in *KSR* for an expansive and flexible approach to obviousness.

The challenged patent, U.S. Patent No. 7,319,718, is directed to a method for encoding the 5-bit Channel Quality Indicator (CQI) into a 20-bit codeword using a basis sequence table. The claimed method was developed as part of 3GPP's efforts to establish 3G wireless standards. Back in January of 2002, Philips had submitted a proposal to the 3GPP working group for a basis sequence table for encoding CQI (shown below on the left). In February of 2002, LG Electronics (LGE) filed a Korean patent application, to which the '718 patent claims priority, with the basis sequence table shown below on the right. Apart from the last two bits in the last row, which are flipped, the two basis sequence tables are identical. Two days after filing the Korean application, LGE proposed the basis sequence table in the '718 patent to the 3GPP working group with the rationale that this modified table "focus[es] on optimizing system throughput." In July of 2002, the 3GPP working group adopted LGE's proposal.



I	$M_{i,0}$	$M_{i,1}$	$M_{i,2}$	$M_{i,3}$	$M_{i,4}$
0	1	0	0	0	1
1	0	1	0	0	1
2	1	1	0	0	1
3	0	0	1	0	1
4	1	0	1	0	1
5	0	1	1	0	1
6	1	1	1	0	1
7	0	0	0	1	1
8	1	0	0	1	1
9	0	1	0	1	1
10	1	1	0	1	1
11	0	0	1	1	1
12	1	0	1	1	1
13	0	1	1	1	1
14	1	1	1	1	1
15	0	0	0	0	1
16	0	0	0	0	1
17	0	0	0	0	1
18	0	0	0	0	1
19	0	0	0	1	0

Prior Art

I	$M_{i,0}$	$M_{i,1}$	$M_{i,2}$	$M_{i,3}$	$M_{i,4}$
0	1	0	0	0	1
1	0	1	0	0	1
2	1	1	0	0	1
3	0	0	1	0	1
4	1	0	1	0	1
5	0	1	1	0	1
6	1	1	1	0	1
7	0	0	0	1	1
8	1	0	0	1	1
9	0	1	0	1	1
10	1	1	0	1	1
11	0	0	1	1	1
12	1	0	1	1	1
13	0	1	1	1	1
14	1	1	1	1	1
15	0	0	0	0	1
16	0	0	0	0	1
17	0	0	0	0	1
18	0	0	0	0	1
19	0	0	0	0	1

'718 patent

3G Licensing acquired the '718 patent from LGE in 2020 and proceeded to file a dozen lawsuits against various defendants. Several of those defendants petitioned for *inter partes r*eview of the '718 patent based on the January 2002 Philips reference, arguing that a POSA would have been motivated to flip the last two bits of the basis sequence table to reduce error and provide additional protection to the most significant bits (MSB) of CQI. The PTAB rejected this motivation-to-modify argument and issued a final written determination of non-obviousness.

The Federal Circuit reversed, stating that the PTAB's conclusion of non-obviousness was improperly based on its finding that the '718 patent's primary motivation was to "focus on system throughput" rather than minimizing errors and providing extra protection of MSB. The Federal Circuit determined that requiring a POSA's motivation to modify prior art to be the same as the inventor's motivation contradicts *KSR*'s express directive: "The fact that the inventor of the [challenged] patent may have had a different or even novel motivation that led them to [modify the prior art] reference is irrelevant."

The Federal Circuit further held that the PTAB's reliance on the uncertainty of the "preferred" approach for coding CQI to evaluate motivation was erroneous because obviousness "does not require that a particular [modification] must be the preferred, or the most desirable, [modification] described in the prior art in order to provide motivation for the current invention." Noting the uncontroverted testimony of the petitioner's expert that a POSA would have been motivated to swap the last two digits of the table in Philips to reduce errors and maximize protection of MSB, the Federal Circuit reversed the FWD as unsupported by substantial evidence.

Requiring the motivation to modify to be the same motivation as that of the patent inventor has no basis in obviousness doctrine. KSR directs precisely the

opposite, explaining that "[i]n determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls."

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