

Practice Tips for Presenting and Responding to Motivation-to-Combine Arguments in IPR Proceedings

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David Cavanaugh, Joshua Stern and Kevin Yurkerwich, in this article published by Bloomberg BNA's *Patent, Trademark & Copyright Journal*, provide an overview of recent Patent Trial and Appeal Board decisions denying institution of *inter partes* review (IPR) based on the failure of a petitioner to sufficiently articulate a motivation or reason to combine, and share practice tips for practitioners to follow when either drafting a petition that relies on obviousness or preparing a preliminary response.

In IPR proceedings, the preliminary response allows a patent owner to argue that an IPR proceeding should not be instituted. One way a patent owner may oppose institution of an obviousness ground that relies on multiple references or teachings is to argue that the petition does not adequately articulate a motivation or reasons why a person of ordinary skill in the art would combine the cited prior art references or teachings. Indeed, the Federal Circuit recently confirmed the role that motivation to combine arguments can play in IPR proceedings, holding that the Patent Trial and Appeal Board "must make a finding of a motivation to combine when it is disputed." [Read the full article](#)

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