

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF FLORIDA
TALLAHASSEE DIVISION

HVLPO2, LLC,

Plaintiff,

v.

Case No. 4:16cv336-MW/CAS

OXYGEN FROG, LLC, and
SCOTT D. FLEISCHMAN,

Defendants.

_____ /

ORDER DENYING PLAINTIFF’S RENEWED MOTION FOR
JUDGMENT AS A MATTER OF LAW OR, IN THE
ALTERNATIVE, FOR A NEW TRIAL

This is a patent case. Both this Court and a jury concluded that Plaintiff’s patents¹ are obvious. Subsequently, Plaintiff filed a renewed motion for judgment as a matter of law (“JMOL”) that Defendants had failed to establish obviousness. ECF No. 240. Plaintiff also moved in the alternative for a new trial because it believes this Court erroneously admitted lay opinion on the issue of obviousness. *Id.* For the reasons that follow, Plaintiff’s motion is **DENIED.**

¹ This Court uses the phrase “Plaintiff’s patents” informally for sake of ease. This Court recognizes that, technically speaking, patent *claims* are the actual subject of an obviousness analysis. The patent claims at issue in this case are claims 1 and 7 of United States Patent Nos. 8,876,941 and 9,372,488.

I. Background

Plaintiff's patents purport to claim a method and apparatus for controlling an oxygen-generating system. *See* ECF No. 11-2, at 27; ECF No. 11-26, at 27. More specifically, the patents "claim a method and device for managing oxygen that involves a controller device configured to control two power circuits." ECF No. 240, at 18. This Court ruled on summary judgment that Defendant Oxygen Frog, LLC, ("Oxygen Frog") infringed Plaintiff's patents. ECF No. 106.

This case then proceeded to a jury trial on the issue of obviousness (among other issues). Defendants argued that Plaintiff's patents were obvious in light of a combination of two prior arts: the Cornette reference and the Low Tide reference. At the close of evidence, Plaintiff moved for JMOL that Defendants had failed to establish obviousness. This Court took Plaintiff's motion under advisement and allowed the issue to go to the jury.

The jury was provided a special verdict form that included interrogatories about indicators of non-obviousness and obviousness (i.e., *Graham's* "secondary considerations")² as well as

² *See Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).

a question on the ultimate issue of obviousness. ECF No. 214, at 2–3. The jury concluded that not a single indicator of non-obviousness had been established. *Id.* at 2. As for indicators of obviousness, the jury concluded that the evidence established “independent invention of the claimed invention by others before or at about the same time as the named inventor thought of it.” *Id.* at 3. Moreover, by means of a special written finding, the jury also concluded that the “evidence show[ed] the network of people in the art participating in forums and trade shows were evolving the claims regarding the patent, in relation to the use of concentrators and storage tanks to replace O₂ tanks.” *Id.* Ultimately, the jury found that Plaintiff’s patents are obvious. *Id.*

After receiving the jury’s verdict, this Court continued to take Plaintiff’s motion for JMOL under advisement and permitted the parties to brief the issue. Both parties filed briefs accordingly. ECF No. 219; ECF No. 221. This Court then denied Plaintiff’s motion for JMOL in a written order. ECF No. 227. Subsequently, Plaintiff filed a renewed motion for JMOL or, in the alternative, for new trial. ECF No. 240. That motion is the subject of this order.

II. Plaintiff's Renewed Motion for JMOL

A. Legal Standards

The Federal Circuit has “consistently permitted courts to submit legal questions which contain underlying factual issues, like obviousness, . . . to the jury.” *Dow Chem. Co. v. Nova Chems. Corp. (Can.)*, 809 F.3d 1223, 1226 (Fed. Cir. 2015) (Moore, J., concurring in denial of petition for rehearing en banc). “There is no question that the judge must remain the ultimate arbiter on the question of obviousness.” *R.R. Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1515 (Fed. Cir. 1984). “He or she exercises that role first in exercising the judge’s duty of giving proper instructions on the law to the jury before it considers its verdict.” *Id.* “The judge exercises control on the question again when presented with a motion for JNOV^[3] or new trial.” *Id.*

“[W]hen presented with a motion for JMOL following a general verdict on obviousness, [the trial court has the duty] to review the factual findings for substantial evidentiary support . . . and the ultimate conclusion on obviousness for legal correctness.”

³ The abbreviation JNOV (i.e., judgment notwithstanding the verdict or, in latin, judgment *non obstante veredicto*) is the old way of referring to a renewed motion for JMOL. See, e.g., *Cabinet Vision v. Cabnetware*, 230 F.3d 1382, *2 n.1 (Fed. Cir. 2000) (unpublished table decision) (citing Fed. R. Civ. P. 50 Advisory Committee Notes).

McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1359 (Fed. Cir. 2001) (Michel, J., dissenting) (citing *R.R. Dynamics*, 727 F.2d at 1513).

B. *Analysis*

Plaintiff raises five arguments in support of its renewed motion for JMOL. *See* ECF No. 240. Specifically, Plaintiff argues: (1) this Court failed to properly consider the PTO's issuance of the '488 patent over the cited references; (2) Scott Fleischman's conclusory testimony was insufficient to support a finding of obviousness; (3) Defendants failed to identify all claim elements in the cited references; (4) Defendants failed to present any evidence regarding a motivation to combine the cited references; and (5) Defendants failed to present any evidence, or rebut Plaintiff's evidence, of secondary considerations. *See id.* This Court addresses each argument in turn.

1. Whether this Court Failed to Properly Consider the PTO's Issuance of the '488 Patent Over the Cited References

Plaintiff argues that "both of the prior art references relied upon by [D]efendants were presented to and considered by the PTO during the original prosecution of the '488 patent." *Id.* at 9. Plaintiff further notes that "[t]his is powerful evidence of the

patents' validity, since as the Federal Circuit has explained, 'it may be harder to meet the clear and convincing burden when the invalidity contention is based upon the same argument on the same reference that the PTO already considered.'" *Id.* at 9–10 (quoting *Sciele Pharma Inc. v. Lupin Ltd.*, 684 F.3d 1253, 1260 (Fed. Cir. 2012)).

However, what Plaintiff fails to note is that this Court has no way of knowing whether the Low Tide reference was *actually* considered by the PTO. Indeed, as Defendants point out:

[Plaintiff] only filed 3 pages of paper that simply identified the web address of the LowTide video. [Plaintiff]'s filings did not include the document, in this case a media file showing the content of the video itself. By rule, the USPTO includes copies of all non-patent prior art it considered in the publicly available file wrapper precisely so the public knows what the Examiner included. The only thing the patent office included in the official USPTO filewrapper was the three pages submitted reluctantly by [Plaintiff]. There is no note or indication in the file wrapper that the Examiner actually went beyond looking at what was filed, and actually went to YouTube and watched the video.

ECF No. 243, at 3–4 (emphasis omitted).

Regardless, even if this Court were to assume that the PTO examiner actually watched the entire Low Tide video, that does not mean the Low Tide reference cannot be a basis for invalidating

Plaintiff's patents. *See, e.g., Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1555 (Fed. Cir. 1985) ("The Examiner's decision, on an original or reissue application, is never binding on a court."). All that is required is that this Court give appropriate weight to the fact that the PTO has already considered the cited references. *See Sciele*, 684 F.3d at 1260. This Court has done exactly that.⁴ Plaintiff may rest assured that this Court is not "paying lip service to the presumption of validity." *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 961 (Fed. Cir. 1986). Despite this Court's careful consideration of the fact that the PTO granted the '488 patent after purportedly reviewing the cited references, this Court nonetheless concludes that Plaintiff's patents are obvious.

2. Whether Scott Fleischman's Allegedly Conclusory Testimony was Insufficient to Support a Finding of Obviousness

Defendant Scott Fleischman testified at trial. ECF No. 239-

3. Plaintiff argues that Mr. Fleischman's testimony was "conclusory and factually unsupported." ECF No. 240, at 15.

⁴ Presumably, so has the jury. The patent file wrapper was introduced into evidence and Plaintiff argued to the jury that the wrapper demonstrated the PTO had already considered the cited references. Regardless, the jury was specifically instructed that Defendants had to prove obviousness by clear and convincing evidence. ECF No. 213-3, at 9, 12. "Whether a reference was previously considered by the PTO, the burden of proof is the same: clear and convincing evidence of invalidity." *Sciele*, 684 F.3d at 1260.

Specifically, Plaintiff argues that Mr. Fleischman “did not articulate any reasoning to support his conclusion of obviousness” and “provided no testimony as to why it would have been obvious in 2012 to a person skilled in the art to ‘swap out’ the manual pressure switch depicted in the Cornette reference and replace it with a digital pressure switch capable of sending signals to control multiple circuits.” *Id.* at 16.

But Plaintiff ignores much of Mr. Fleischman’s testimony. Mr. Fleischman—an engineer by training and education—testified that creating a “full system with [a] pressure switch, tank compressor, and multi-generators” was “trivial”; something that engineers “do every day” and “are taught how to do.” ECF No. 239-3, at 4. When discussing the Cornette reference, Mr. Fleischman again noted that “[w]hat Mr. Cornette did, . . . I didn’t need him to teach this to me, because it’s just so common, ordinary stuff that engineers do every day, . . . this here is just an outlet box, and he wired it into the pressure switch that’s on the tank.” *Id.* at 6; *see also id.* at 7 (“I mean, we do this stuff all the time. Turning stuff on and off with a pressure switch is common. You can call any electrician, and they can set this up.”). When asked about the possibility of expanding the system disclosed in the Cornette

reference, Mr. Fleischman again focused on the ease by which a tradesman could implement changes. *Id.* at 16 (“Every electrician knows how to do it.”); *see also id.* at 19–20.

Plaintiff also ignores Mr. Fleischman’s testimony as to the motivation for combining the Cornette reference (which discloses a single-circuit oxygen-generating system automated by a pressure switch) and the Low Tide reference (which discloses a manually operated multi-circuit oxygen-generating system):

Q. Okay. One of the issues in this case is whether one would have a motivation to combine the two elements of automating a system and also providing a second circuit. Do you think a person having a Cornette system and desired [sic] would face the problem of needing to add more power for more concentrators, would it be obvious for them to try using a multiple circuit with an appropriate pressure switch?

A. Absolutely.

Id. at 17–18.

Mr. Fleischman even testified that the Cornette reference appeared to disclose a pressure switch capable of operating two circuits. *Id.* at 78–79.

Nevertheless, even if Mr. Fleischman’s testimony was insufficient, there was still other evidence on which the jury could rely. For example, the jury could rely on the prior-art references

themselves. Accordingly, even if Plaintiff is right, Plaintiff's second argument does not warrant relief.

3. Whether Defendants Failed to Identify All Claim Elements in the Cited References

As previously noted, Defendants argued that Plaintiff's patents were obvious in light of a combination of two prior arts: the Cornette reference and the Low Tide reference. Generally speaking, each and every element (i.e., limitation) of a claim must be disclosed by a combination of prior art in order for that combined prior art to render the claim obvious. *See, e.g., Par Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1194 (Fed Cir. 2014) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006)). Plaintiff argues that Defendants failed to establish obviousness because they did not identify each and every claim element in the cited references. ECF No. 240, at 16–21. Specifically, Plaintiff argues that the cited references do not disclose “a controller device configured to control two circuits.” *Id.* at 18.

However, as this Court already explained in its prior order, “Plaintiff overstates the requirement of an obviousness inquiry and fails to consider the facts in the light most favorable to

Defendants.” ECF No. 227, at 2. Indeed, as this Court already noted:

The elements of Plaintiff’s patents (as construed for purposes of infringement) are: (1) a multi-circuit oxygen-generating system and (2) a controller device that can turn one or more circuits on/off based on pressure values. *See* ECF No. 104; ECF No. 106; *see also* ECF No. 219, at 19 (“Claims 1 and 7 of the patents in suit claim a method and device for managing oxygen that involves a controller device configured to control two power circuits.”). It is undisputed that the Low Tide reference discloses the first element; i.e., a multi-circuit oxygen-generating system. *See* ECF No. 219, at 19 (“The Piebes Low Tide video admittedly discloses an oxygen generating system that operates on two power circuits.”). So the only thing that is allegedly missing is the second element; i.e., the controller device.

The Cornette reference discloses a controller device; specifically, a pressure switch. *See* ECF No. 219, at 19. Because that pressure switch was running on a single-circuit system, perhaps it was not configured to control multiple circuits. But that doesn’t mean it can’t serve to disclose the automation/controller-device aspect needed for the second element of Plaintiff’s invention. A person of ordinary skill in the art would be able to combine the pressure-switch element of the Cornette reference with the multi-circuit element disclosed by the Low Tide reference consistent with Plaintiff’s invention. Viewed in the light most favorable to Defendants, there was evidence to support a finding that such compatibility was possible. *See* Trial Testimony of Scott Fleischman, ECF No. 219-1, at 78–79 (stating that the Cornette reference disclosed a two-pole pressure switch).

Id. at 2–3.

Even if, as Plaintiff suggests, the control element is actually missing from the cited references, Plaintiff fails to consider caselaw discussing common sense,⁵ modifications,⁶ and the flexibility⁷ of an obviousness analysis.

Consider an analogy. Let's imagine that the controller device in Plaintiff's patents was an arcade-style controller instead of a pressure switch. For example, let's imagine something like this:



Let's also imagine that the Cornette reference featured an arcade-style controller instead of a pressure switch. However,

⁵ See, e.g., *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016) (noting that common sense may be invoked to supply a limitation missing from the prior art where the limitation is unusually simple and the technology particularly straightforward).

⁶ See, e.g., *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1307 (Fed. Cir. 2006) (“A claim can be obvious even where all of the claimed features are not found in specific prior art references, where ‘there is a showing of a suggestion or motivation to modify the teachings of [the prior art] to the claimed invention.’” (quoting *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000))).

⁷ See, e.g., *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007) (“Throughout this Court’s engagement with the question of obviousness, our cases have set forth an expansive and flexible approach”); see also *id.* at 421 (“Rigid preventative rules that deny factfinders recourse to common sense . . . are neither necessary under our case law nor consistent with it.”).

since the Cornette system only runs on one circuit, the controller only has one button:



In this analogy, would Plaintiff really argue that a person of ordinary skill in the art could not combine the controller element of the Cornette reference with the multi-circuit element of the Low Tide reference to come up with the invention claimed in Plaintiff's patents? That is, would Plaintiff not credit a person of ordinary skill in the art with the common sense to use a two-button controller? Surely, that is no inventive step.

Similarly, realizing that a two-pole pressure switch would be needed to control two circuits is not inventive either. At most, it's just an "obvious engineering choice" needed to make one purportedly inventive element (controlling a system based on pressure) compatible with another purportedly inventive element (a multi-circuit oxygen-generating system). *Cf., e.g., Application of Larson*, 340 F.2d 965, 968 (C.C.P.A. 1965) (agreeing "that the use of a one piece construction instead of the structure disclosed in

[prior art] would be merely a matter of obvious engineering choice”); *cf. also Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1160–61 (Fed. Cir. 2007) (rejecting argument that prior-art device did not have same functionality as patent claim, even though one was mechanical and one was electronic).

Simply put, Federal Circuit caselaw recognizes that the obviousness inquiry is not as strict as Plaintiff suggests:

KSR does not require that a combination only unite old elements without changing their respective functions. Instead, *KSR* teaches that “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” And it explains that the ordinary artisan recognizes “that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” The rationale of *KSR* does not support [the] theory that a person of ordinary skill can only perform combinations of a puzzle element A with a perfectly fitting puzzle element B. To the contrary, *KSR* instructs that the obviousness inquiry requires a flexible approach.

ClassCo, Inc. v. Apple, Inc., 838 F.3d 1214, 1219 (Fed. Cir. 2016)

(citation omitted) (quoting *KSR*, 550 U.S. at 415–16, 420–21).

Accordingly, Plaintiff’s third argument does not warrant relief.

4. Whether Defendants Failed to Present Any Evidence Regarding a Motivation to Combine the Cited References

“An obviousness determination requires a finding that a person of ordinary skill in the art would have been motivated to combine or modify the teachings in the prior art and would have had a reasonable expectation of success in doing so.” *Regents of Univ. of Cal. v. Broad Inst., Inc.*, 903 F.3d 1286, 1291 (Fed. Cir. 2018). Plaintiff argues that “Defendants completely failed to introduce any evidence as to a motivation to combine.” ECF No. 240, at 23. However, Plaintiff conveniently ignores Scott Fleischman’s testimony that it would be *obvious to try* to combine the teachings of the cited references.

The Supreme Court has clearly held that “obvious to try” is a valid motivation to combine:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was *obvious to try* might show that it was obvious under § 103.

KSR, 550 U.S. at 421 (emphasis added).

Here, Mr. Fleischman explicitly testified that it would be obvious to try to combine the teachings of the cited references. *See supra* p. 9 (quoting ECF No. 239-3, at 17–18).

“For an invention to be obvious to try, there must be a finite number of known choices in the prior art, and a reasonable expectation of success for the choice that is tried.” *Hoffman-La Roche Inc. v. Apotex Inc.*, 748 F.3d 1326, 1340 (Fed. Cir. 2014) (Newman, J., dissenting) (citing *KSR*, 550 U.S. at 421). Here, there was evidence as to both elements. For example, multiple witnesses testified that there are only a few ways to obtain oxygen, only a few ways to create an oxygen-generating system, and only a few ways to power an oxygen-generating system that has more than a few concentrators. And Mr. Fleischman testified that it would be relatively easy to combine the cited references with an appropriate pressure switch. *See supra* pp. 8–9 (quoting ECF No. 239-3). Accordingly, Defendants presented sufficient evidence regarding a motivation to combine the cited references.

5. Whether Defendants Failed to Present Any Evidence, or Rebut Plaintiff’s Evidence, of Secondary Considerations

Long ago, the Supreme Court held that certain “secondary considerations . . . may have relevancy” as “indicia of obviousness

or nonobviousness.” *Graham*, 383 U.S. at 17–18. Since then, the Federal Circuit has repeatedly stressed that these considerations are not truly *secondary*; i.e., they are not merely an afterthought to be considered subsequent to a determination of obviousness. *See, e.g., Navico Inc. v. Int’l Trade Comm’n*, 696 F. App’x 989, 999 (Fed. Cir. 2017) (unpublished) (“Objective indicia of non-obviousness are vital to an obviousness determination and must be considered, not ignored as a mere afterthought.”). The Federal Circuit has also noted that “evidence of secondary considerations may often be the most probative and cogent evidence in the record.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). Finally, it is important to remember that while the burden of persuasion as to obviousness remains with the patent challenger, “a patentee bears the burden of production with respect to evidence of secondary considerations of nonobviousness.” *Zup, LLC v. Nash Mfg., Inc.*, 896 F.3d 1365, 1373 (Fed. Cir. 2018).

Plaintiff argues that “[it] introduced, through Marc Kornbluh, extensive evidence regarding secondary considerations of non-obviousness” that was “unrebutted by [D]efendants.” ECF No. 240, at 26. Specifically, Plaintiff argues it offered evidence

regarding “commercial success, copying, and teaching away from the patented invention.” *Id.* at 27; *see also id.* at 29 (mentioning “recognition in the industry”). But Plaintiff fails to consider the true import of its evidence as well as other evidence in the record.

As to commercial success and industry recognition, Plaintiff notes “Mr. Kornbluh testified that demand for [Plaintiff’s] product existed from its inception and that, since 2012 more than 300 units have been sold, generating more than \$2 million in revenue.” *Id.* at 27. Plaintiff also notes “Mr. Kornbluh testified that [Plaintiff] has achieved industry recognition, both in terms of its competitor (OGSI) referring glass blowing customers to [Plaintiff] and in terms of its products being featured in the Henry Schein catalog.” *Id.* at 27–28. However, as Defendants point out, Plaintiff failed to identify a nexus between Mr. Kornbluh’s testimony and the actual invention claimed in Plaintiff’s patents, and any speculation as to such nexus was rebutted by other evidence:

[Plaintiff] utterly failed to connect whatever sales it had and what ever market demand it enjoyed to the two-circuit feature of [the] claimed invention. [Plaintiff] did not do any kind of market analysis to determine why its customers buy its products. [Plaintiff] indicated [it] makes significant marketing expenses and indicated it gets referrals [from] OGSI. Those could be the reasons customers buy [Plaintiff’s] products. There is no evidence of record of a single

customer buying [one of Plaintiff's products] because of a long-felt, unsatisfied need to automatically shut-off a two-circuit system. To the contrary, the jury heard testimony from Mr. Cornette and Mr. Fleischman along the lines of that the two-circuit aspect of these systems in fact was not popular and not the reason people were excited about these systems.

ECF No. 243, at 6–7; *cf. also Everlight Elecs. Co., Ltd v. Nichia Corp.*, 719 F. App'x 1008, 1011 (Fed. Cir. 2018) (unpublished) (affirming district court's holding that “a reasonable jury could have found [evidence of commercial success] to be undermined by credible doubts raised at trial as to the nexus between the patented features and the success”); *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) (“For objective evidence [of non-obviousness] to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention.”).

As to copying, Plaintiff argues that “the evidence demonstrated, without doubt, that Oxygen Frog copied HVO's product, right down to the color.” ECF No. 240, at 28. Again, it seems Plaintiff conveniently ignored Mr. Fleischman's testimony that he did not copy Plaintiff's patented invention and that his

product was green because, like his product, frogs are green.⁸ ECF No. 239-3, at 19–20, 71. The jury apparently found Mr. Fleischman’s testimony credible because it concluded that Plaintiff had failed to establish copying as an indicator of non-obviousness. ECF No. 214, at 2.

Finally, as to “teaching away,” Plaintiff emphasizes that “Mr. Piebes testified that he did not incorporate the concept of turning everything on and off based on a sensed pressure in the holding tank because ‘it didn’t work.’” ECF No. 240, at 28. But the “Mr. Piebes Test” is not one of *Graham*’s secondary considerations. In other words, whether Mr. Piebes could accomplish a certain feat isn’t what the fact-finder should focus on. Rather, the proper subject of a “teaching away” inquiry is whether “*the prior art* indicates that the invention would not have worked for its intended purpose or otherwise teaches away from the invention.” *Meiresonne v. Google, Inc.*, 849 F.3d 1379, 1382 (Fed. Cir. 2017) (emphasis added). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be

⁸ At least the average, stereotypical frog is. A true anuraphile knows that frogs “sport[] just about every color in the rainbow.” Pearl Tesler, *The Amazing, Adaptable Frog*, Exploratorium, <https://www.exploratorium.edu/frogs/mainstory/frogstory3.html> [<https://perma.cc/E3CS-3EHD>].

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*, 27 F.3d 551, 553 (Fed. Cir. 1994). Here, Plaintiff provided no evidence—nor could it—showing that the *cited references* taught away from automating a two-circuit oxygen-generating system by using a pressure switch.

In fairness, courts have recognized that “unsuccessful attempts by others” can be an objective indicator of non-obviousness. *See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575 (Fed. Cir. 1986); *see also Graham*, 383 U.S. at 17 (referring to “failure of others”). But Mr. Piebes never testified that he failed to automate a two-circuit oxygen-generating system by using a pressure switch. Instead, what Mr. Piebes said was that “it didn’t work for [his] needs.” ECF No. 219-3, at 14. In other words, Mr. Piebes did not fail—he was able to create the patented invention but simply didn’t like the way it worked. In fact, Mr. Piebes noted two specific concerns: (1) the system was “drawing oxygen straight from the oxygen concentrators before they had time to get up to oxygen concentration” and (2) “it was turning off and on multiple times throughout a workday.” *Id.* The fact that the invention claimed in Plaintiff’s patents does not suit

Mr. Piebes's tastes does not mean Mr. Piebes failed to create the invention; rather, it might just mean the invention is lacking.⁹

Nevertheless, "[a]lthough secondary considerations must be taken into account, they do not necessarily control the obviousness conclusion." *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1372 (Fed. Cir. 2007). Here, there was sufficient evidence of obviousness to overcome Plaintiff's purported indicia of non-obviousness.

C. Conclusion

Plaintiff raised five arguments in support of its motion for JMOL. *See supra* p. 5 (citing ECF No. 240). As set out above, each of those arguments is unavailing. Accordingly, Plaintiff is not entitled to JMOL.

⁹ Indeed, Mr. Fleischman specifically testified about the benefit of a delay valve in his product. ECF No. 239-3, at 49, 50, 55. A delay valve might have solved Mr. Piebes's first concern, but it's not part of Plaintiff's patents as construed by this Court.

III. Plaintiff's Alternative Motion for New Trial

As an alternative to its motion for JMOL, Plaintiff also moves for a new trial. ECF No. 240, at 30–31. Plaintiff argues that “[a] new trial is . . . appropriate because the deposition testimony of Mr. Piebes to the effect that [Plaintiff’s] patents are ‘obvious’ should not have been admitted.” *Id.* at 30. Initially, this Court disagrees that it was error to admit such testimony. But even if it was error, “[n]ot every evidentiary error . . . requires reversal.” *Peat, Inc. v. Vanguard Research, Inc.*, 378 F.3d 1154, 1162 (11th Cir. 2004). “[A] new trial is warranted only where the error has caused substantial prejudice to the affected party.” *Id.* This Court finds that the testimony in question did not substantially prejudice Plaintiff. This is particularly true given this Court’s limiting instruction as to Mr. Piebes’s testimony as well as the final jury instruction reminding the jury that “[t]he ultimate conclusion of whether a claim is obvious should be based upon [the jury’s] determination of several factual decisions,” ECF No. 213-3, at 12. Accordingly, Plaintiff is not entitled to a new trial.

IV. Conclusion

Plaintiff raised five arguments in support of its motion for JMOL as to obviousness. As set out in this order, each of Plaintiff's arguments is without merit. Plaintiff also alternatively moved for a new trial based on an evidentiary error. However, that argument is also without merit.

Accordingly,

IT IS ORDERED:

Plaintiff's renewed motion for judgment as a matter of law or, in the alternative, for a new trial, ECF No. 240, is **DENIED**.

SO ORDERED on February 20, 2019.

s/Mark E. Walker
Chief United States District Judge