

Will the Standard for Obviousness Change—Will the Supreme Court Consider the Appeal in *KSR International V. Teleflex*?

*by Linda Judge**

As set forth in the MPEP Section 2143, to establish a *prima facie* case of obviousness (35 U.S.C. §103), there are three basic requirements: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine the teachings; (2) a reasonable expectation of success; and (3) the reference(s) teach or suggest all of the claim limitations.

Historically, obviousness has been found if a *person having ordinary skill in the art* (PHOSITA) would have considered a claimed invention obvious in view of the teachings of one or more prior art references as of the date of the invention. Four factual inquiries underlie an evaluation of obviousness: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) other objective indicia of non-obviousness, such as commercial success of the claimed invention, long felt but unmet need.

In *KSR International V. Teleflex*, Teleflex sued KSR for alleged infringement of Teleflex's Patent No. 6,237,565, which claims an adjustable gas-pedal assembly, including an automobile adjustable accelerator pedal and an electronic throttle control. The case was dismissed on summary judgment based on obviousness, with a finding that anyone with an undergraduate degree or modest industry experience "would have found it obvious" to connect the two constituent devices to provide the claimed assembly.

Teleflex appealed the decision, and on appeal the Federal Circuit held that the district court applied an incomplete "teaching-suggestion-motivation test," on the basis that the district court did not make specific findings as to whether there was a suggestion or motivation to combine the teachings of the prior art prior to the invention that led to Teleflex's '565 Patent.

The teaching-suggestion-motivation test has been the historical standard for obviousness, and KSR and others assert that the Federal Circuit's opinion represents a departure from earlier Supreme Court precedents on obviousness, in that the Federal Circuit's test for "nonobviousness" will allow too many patents that claim obvious inventions.

KSR has petitioned the Supreme Court for a writ of certiorari, and is arguing that the Federal Circuit's obviousness standard is too low, that written proof of obviousness should not be required, and that the formalities of the test undermine the ability to determine whether an invention is obvious to one skilled in the art. Five large corporations, including Microsoft, Cisco, and Hallmark are supporting the petition. The Supreme Court has asked the Solicitor General to file a brief expressing the views of the US Government.

In addition, 24 law professors have filed an Amicus brief, in support of KSR, which argues that an obviousness standard which requires that the prior art contain a "suggestion to combine" blurs the line between anticipation and obviousness. The brief states that the historical standard has been to consider the prior art relative to the subject matter of the invention as a whole at the time the invention was made from the perspective of a *person having ordinary skill in the art*. The Amicus brief concludes that the Federal Circuit's obviousness test requires that both the USPTO and the courts base the obviousness analysis on documentary evidence of obviousness, which is largely unavailable to them. The result of this standard is that inventions which might previously have been considered obvious are more likely to result in issued patents.

The Supreme Court has not heard a case on obviousness for twenty years, and given the growing importance of intellectual property, many believe the KSR/Teleflex/ case will be accepted for review.

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