After KSR – Stronger Patents or Just Harder to Get?

A recent United States Supreme Court ruling is causing quite a stir in intellectual property circles. The case is KSR Int'l Co. v. Teleflex Inc., et al., 127 S. Ct. 1727 (2007).

Background

To obtain a patent, the invention must be useful, novel and non-obvious. See Patents. The first of these, utility, is present for nearly every invention. The second, novelty, generally requires that the invention claimed is not disclosed in full in a single reference (patents, published applications or any published document anywhere in the World), and the third, non-obviousness, generally requires that the invention as claimed is not fully disclosed in a combination of references. Previously, to reject a patent for obviousness though a combination of references required some suggestion or motivation in the references themselves (excluding the subject patent application) that would lead one skilled in the pertinent art to make the combination of their teachings.

In Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), the U.S. Supreme Court laid out the requirement that the skill level is "the level of ordinary skill in the pertinent art". That is typically the level of skill that an engineer in the field would possess and is not related to the skill of the inventor.

The previous standard for combination of references was the teaching, suggestion, motivation (TSM) standard as articulated in Al-Site Corp. v. VSI Int'l, Inc., 174 F.3d 1308 (Fed. Cir. 1999). That is, there must be some suggestion or motivation within the references cited to combine their teachings. This test arose in part to overcome the inherent bias that an examiner would have after reading a new invention disclosure and applying hindsight to reject the claims as obvious in light of the references. The language of the holding by the Federal Circuit in Al-Site allowed the nature of the problem to have an effect, holding that "[a] suggestion or motivation to combine generally arises in the references themselves, *but may also be inferred from the nature of the problem or occasionally from the knowledge of those of ordinary skill in the art*.") Id. at 1324 [Emphasis added]. Thus, a problem in need of a solution can be considered to provide motivation. This appears to be the real focus of KSR.

Previously, just because something is "'[o]bvious to try' has long been held not to constitute obviousness". In re Duell, 51 F.3d 1552, 1559 (Fed. Cir. 1995) citing In re O'Farrell, 853 F.2d 894, 903 (Fed. Cir. 1988). Such obviousness to try would likely arise from knowledge of a problem in need of a solution.

In KSR, the language of the U.S. Supreme Court holding that if "a design step [is] well within the grasp of a person of ordinary skill in the relevant art and that the benefit of doing so would be obvious", then the invention does not meet the test

of obviousness. KSR, Syllabis. This is slightly different from In re Duell. But perhaps this is really not expansive, but rather more of a clarification?

Is KSR really important?

The effect of KSR may be mitigated by the fact that many examiners already merely state that the invention is obvious and claim that there is a teaching, suggestion or motivation (TSM), but do not actually identify such teaching, suggestion or motivation as is required. Technically, this does not meet the requirement that the examiner establish a *prima facie* case which then shifts the burden of rebuttal to the patent applicant. Of course, because the examiner has not identified any TSM, it then falls to the patent applicant to point out this defect in the examiner's reasoning. Yet, even so, examiners will often merely respond that "the arguments have been considered, but are unpersuasive", again without pointing to any identification of TSM in the references. This forces the patent applicant to appeal, for which many applicants are unprepared to pay the cost. So, in effect, the TSM standard has long been ignored anyway as applied to many patent applicants, since from a practical standpoint many individual inventors and small companies do not want to spend the money and effort to show that the standard was not met. Thus, use of the TSM standard has never been a rigid rule, and the effect of KSR is moot for most patent applicants. (It should be noted that the U.S. Patent Office has stated that they won't necessarily adopt KSR and cease pointing to teaching, suggestion or motivation.)

Other factors of importance from KSR

What is particularly of concern to the author is the language of the U.S. Supreme Court in KSR in stating "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field *or a different one*." KSR [Emphasis added] This implies that the U.S. Supreme Court may be considering at a future date expanding the scope of non-obviousness to include not only analogous references, *but any reference, irrespective of the field of art*.

What is perhaps even more interesting is that this case on its face appears to be such a clear case of obviousness – the same field of art appears to have been involved, it was merely whether references combining solutions to different problems in the same field could be combined – that one wonders why the U.S. Supreme Court went to such great lengths to reverse when it could have done so merely on the basis of In re Duell.

Will KSR make patents stronger?

Clearly, if a patent applicant can overcome obviousness rejections where the scope of obviousness has been broadened as in KSR, then the patent that

issues will be stronger as it will be less subject to obviousness claims in a reexamination or infringement action.

Will KSR make patents more difficult to get?

For individual inventors and small companies, no. Their position is likely not changed. For larger entities that would normally have fought through the appellate process to show that an examiner was not showing a teaching/suggestion/motivation, probably.

For more information on the patent process, please visit Patent Information.

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