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## Chisum on Patents

Publication 00525

Release 109

July 2007

### HIGHLIGHTS

#### Highlights of This Release

- *Donald S. Chisum on the Supreme Court's Latest Word on Obviousness and Combination Inventions: KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (April 30, 2007)*

*KSR* is the Supreme Court's first visit in the 21st Century to the critically important patentability standard of "nonobviousness."

The Supreme Court has addressed the nonobviousness standard numerous times, beginning in 1850. *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1850). For a discussion of the Supreme Court's role in developing nonobviousness, see *Chisum on Patents* § 5.02.

The *1952 Patent Act* codified the obviousness standard as 35 U.S.C. Section 103. Essentially, the standard provides that a claimed invention is not patentable if the invention's subject matter as a whole would have been obvious, on the date of the

invention, to a person of ordinary skill in the art (the famed "POSITA").

**A. Supreme Court's Critique of Federal Circuit's "Teaching, Suggestion or Motivation" (TSM) Test.** For many years, the Federal Circuit has applied a "TSM" test for determining whether an invention that combines prior art elements meets the non-obviousness standard. See *Chisum on Patents* § 5.04[1][e], *Federal Circuit Guide* § 1542. For a discussion of the Court of Appeals for the Federal Circuit, see *Chisum on Patents* § 11.06[3][e], § 21.02[5].

The TSM test requires that, in order to bar from patentability a claimed invention consisting of a combination of prior art elements, the prior art must contain a "teaching, suggestion or motivation" to combine those elements.

In *KSR*, the Supreme Court reviews and critiques the TSM test.

*KSR* involved a patent claim to an adjustable automobile pedal with an electronic control. *U.S. Pat. No. 6,237,565*. The Supreme Court held that a district

court correctly granted summary judgment that the claim was invalid for obviousness. In reversing that judgment, the Federal Circuit had erred by applying its TSM test too rigidly.

The Court noted that the TSM requirement was first established by the Court of Customs and Patent Appeals, the Federal Circuit's predecessor, in 1961. See *In re Bergel*, 292 F.2d 955, 956-57 (CCPA 1961). The Court acknowledged that a requirement that a "teaching, suggestion, or motivation to combine known elements" be demonstrated to show that a combination of prior art elements is obvious "captured an helpful insight." Common sense dictates that a patent claim to "a combination of two known devices" be looked at with care, but it "can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" as in the claim. Most inventions are combinations of what is known. However, when applied as a "rigid and mandatory formula," as it was in the case at bar, the TSM test is "incompatible" with Supreme Court precedent.

**B. Ten Key Points.** In *KSR*, the Supreme Court made ten key points.

First, obviousness is not confined by a "formalist conception" of TSM or an over-emphasis on the explicit content of prior art.

Second, in many fields, there is little discussion of obvious techniques and combinations, and "market demand, rather than scientific literature, will drive design trends." For a discussion of the influence of market rather than technical factors in obviousness assessments, see *Chisum on Patents* § 5.04[1][c], §5.05[2][f].

Third, patents on "advances that would occur in the ordinary course without real innovation retard[] progress."

Fourth, patents on a combination of known elements "deprive prior inventions of their value or utility."

Fifth, obviousness is not controlled by a patentee's "particular motivation," "avowed purpose," or the specific problem he or she sought to solve. Rather, a patent claim is invalid if its "objective reach" extends to any obvious solution of any known problem. For a discussion of analogous art, see *Chisum on Patents* § 5.03[1][a], *Federal Circuit Guide* § 1512. For a discussion of the pertinence of the "purpose" of the inventor and of the prior art, see *Chisum on Patents* § 5.04[1][e][vii], § 5.04[6][d]; *Federal Circuit Guide* § 1542.50.

Sixth, "[a] person of ordinary skill is ... a person of ordinary creativity, not an automaton." For a discussion of the "POSITA" and the level of ordinary skill, see *Chisum on Patents* § 5.03[4]; *Federal Circuit Guide* § 1520.

Seventh, in some circumstances, "the fact that a combination was obvious to try might show that it was obvious under § 103." For a discussion of "obvious to try," see *Chisum on Patents* § 5.04[1][f]; *Federal Circuit Guide* § 1543.10.

Eighth, "hindsight bias" should be avoided, but a rigid preventative rule must not "deny factfinders recourse to common sense." For a discussion of the impermissibility of "hindsight" in assessing obviousness, see *Chisum on Patents* § 5.03[2][c]; *Federal Circuit Guide* § 1541.

Ninth, when advances, based on "instinct, simple logic, ordinary inferences, extraordinary ideas, and sometimes even genius," become prior art ("our shared knowledge"), they "define a new threshold from which innovation starts once more." Because "progress beginning from higher levels of achievement is expected in the

normal course, the results of ordinary innovation” are not patentable.

Tenth, “[n]either the enactment of § 103 nor the analysis in [*Graham v. John Deere Co.*, 383 U.S. 1 (1966)] disturbed this Court’s earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art.” For a discussion of *Graham*, see *Chisum on Patents* § 5.02[5][a]. For a discussion of the patentability of “combinations,” see *Chisum on Patents* § 5.04[5][c]; *Federal Circuit Guide* § 1544.30.

**C. Impact of *KSR*—Federal Circuit Decisions.** *KSR* clearly requires a more common sense approach to assessing the obviousness of “combination” inventions. However, it does not totally reject the Federal Circuit’s TSM test—only a “rigid” approach to that test. It acknowledged that most inventions are combinations of prior art elements. It indicated that the TSM test had “no doubt” been applied in accordance with Supreme Court precedent “in many cases.”

The Court noted that the Federal Circuit itself, in decisions rendered while *KSR* was pending before the Court, had cautioned against rigid approaches and had emphasized that there is no requirement of an explicit suggestion to combine. Most notable is Chief Judge Michel’s opinion in *Dystar Textilfarben GMBH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356 (Fed. Cir. 2006). In *KSR*, the Supreme Court quotes the *Dystar* statement: “Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense.” The Court also quoted *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291 (2006) as follows: “There is flexibility in our obviousness jurisprudence

because a motivation may be found implicitly in the prior art. We do not have a rigid test that requires an actual teaching to combine ... .”

**D. Reasonable Expectation of Success.** The Federal Circuit has linked to its TSM test a further requirement: there must have been a “reasonable expectation of success” in making an invention consisting of a combination of prior art elements. See *Chisum on Patents* § 5.04[1][g]; *Federal Circuit Guide* § 1543.20.

In *KSR*, the Supreme Court did not disturb the expectation of success concept. At one point, the patent owner argued that the prior art elements “cannot be combined” as in the patent claim in question. The Supreme Court held that this argument had not been raised in the lower courts “in a clear fashion,” but it appeared to assume that evidence of difficulties or unpredictability in combining prior art teachings might render a combination non-obvious.

Likely, the expectation of success concept will be of increased importance after *KSR*, especially in assessing the obviousness of inventions involving more complex technology than that at stake in *KSR*.

**E. Secondary Considerations.** Under Federal Circuit law, so-called “secondary considerations,” or “objective evidence,” such as a patented invention’s commercial success or copying by an accused infringer, frequently play a role in obviousness determinations. See *Chisum on Patents* § 5.05; *Federal Circuit Guide* § 1530. There is little discussion of these considerations by the Supreme Court in *KSR*. It noted that *Graham* “invited courts, where appropriate, to look at any secondary considerations that would prove instructive.” But it agreed with the district court that the patent owner had “shown no secondary factors to dis-

lodge the determination that [the patent's claim] is obvious.”

**F. Summary Judgment—Role of Experts—Obviousness as a Legal Conclusion.** In *KSR*, the Supreme Court noted that, in addition to applying the TSM in an excessively rigid fashion, the Federal Circuit had misunderstood the role of expert testimony in the context of motions of summary judgment.

The Court noted that “[t]he ultimate judgment of obviousness is a legal determination.” For a discussion of law and fact in obviousness assessments, see *Chisum on Patents* § 5.04[3]; *Federal Circuit Guide* § 1561.

Expert testimony should be considered, but a “conclusory affidavit” by an expert does not preclude summary judgment that a patent’s claim is invalid where “the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors.” For a discussion of summary judgment on obviousness, see *Chisum on Patents* § 5.04[3]; *Federal Circuit Guide* § 1564.

**About the Author:** Donald S. Chisum was Professor of Law at Santa Clara University, Santa Clara California. He received his A.B. degree in 1966 and his law degree in 1968, both from Stanford University.

Mr. Chisum is a leading authority in patent law and intellectual property rights in technology. He is the author of the authoritative twenty-six volume reference text on patent law, *Chisum on Patents*, published in 1978, and co-author with Michael Jacobs of the text, *Understanding Intellectual Property Law*. Mr. Chisum continually supplements and revises the Patents treatise to include patent law developments, and has authored numerous journal articles. Mr. Chisum has also testified before the U.S. House of Representatives Committee on the Judiciary, Subcommittee on Intellectual Property and Judicial Administration, on the subject of patents in space (1985), the Transgenic Animal Reform Act (1989) and the Biotechnology of Patent Protection Act of 1991. Mr. Chisum is active in national and international professional organizations. He was on the Board of Directors of the American Intellectual Property Law Association and was Editor of the Association’s AIPLA Quarterly Journal. Mr. Chisum regularly lectures at patent law meetings and conferences, having addressed the Judicial Conference of the Court of Appeals for the Federal Circuit, the Patent Academy of the Patent and Trademark Office, the annual meeting of the American Intellectual Property Law Association, and regional patent law associations.

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