

CLIENT ALERT

USPTO Issues New Guidelines for Determining “Obviousness” After Supreme Court’s *KSR* Decision

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Summary

The United States Patent and Trademark Office (PTO) recently published Examination Guidelines for determining obviousness during patent examination, in view of the Supreme Court’s decision in the *KSR* case, which changed the analysis of obviousness. (See our *Client Alert* dated May 9, 2007 for details of the case.) These Guidelines have also been reproduced in section 2141 of the most recent revision of the Manual of Patent Examining Procedure.

The Guidelines expand the rationales on which an obviousness rejection can be based, and they are likely to drive development of new strategies for responding to obviousness rejections. But the Guidelines are not expected to dramatically affect the outcome of patent prosecution in most cases.

Background

To be patentable in the U.S., a claimed invention must be new (35 U.S.C. § 102) and non-obvious (35 U.S.C. § 103) in view of the prior art. Before *KSR*, the Federal Circuit had been determining obviousness largely by deciding whether the prior art provided some teaching, suggestion or motivation to make the claimed invention. The Supreme Court in *KSR* rejected the Federal Circuit’s rigid application of this “teaching, suggestion or motivation” test for obviousness, emphasizing a more flexible approach.

The Court pointed out that its landmark decision of *Graham v. John Deere Co.* had provided a broad framework for applying 35 U.S.C. § 103. While the teaching, suggestion, or motivation test can be a useful tool for guarding against the improper use of hindsight in the obviousness determination, the Court held that it is not a substitute for the flexible framework of *Graham*.

The New Guidelines

KSR rejected the way the Federal Circuit had been applying the law of obviousness, which the PTO had been following; thus, the purpose of the Guidelines is to assist Examiners in determining obviousness in view of the holding in *KSR*, and to provide Examiners with supporting rationale for obviousness determinations.

According to the Guidelines, assessment of obviousness remains a question of law based on underlying *Graham* factual inquiries including: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art.

Objective evidence of non-obviousness must also be assessed by the PTO. Objective evidence includes secondary considerations such as evidence of commercial success, long-felt but unsolved need, failure of others, and unexpected results. Utilizing the Guidelines, Examiners are expected to resolve the *Graham* factual inquiries and then determine whether the claimed invention is obvious in light of the prior art.

Obviousness Rationales

The Guidelines provide seven rationales for determining obviousness of a claimed invention in light of the prior art, although additional rationales may be used:

- 1) Combining prior art elements according to known methods to yield predictable results
- 2) Simple substitution of one known element for another to obtain predictable results
- 3) Use of a known technique to improve similar devices (methods or products) in the same way
- 4) Applying a known technique to a known device (method or product) ready for improvement to yield predictable results
- 5) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success
- 6) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art
- 7) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art teachings to arrive at the claimed invention

Only one rationale is needed to form the basis of an obviousness rejection, but the Examiner is required to clearly articulate the rationale.

Once an Examiner makes an obviousness rejection supported by the *Graham* factual findings and an appropriate rationale, the burden shifts to the Applicant to demonstrate that the PTO erred in its findings or to provide evidence that the claimed subject matter would have been nonobvious. The Applicant’s burden may be met by argument and/or by submission of evidence

to demonstrate nonobviousness of the claimed invention. The Examiner must then consider the rebuttal evidence in reevaluating the obviousness rejection.

Commentary

The Guidelines expand the rationales that Examiners can apply to support obviousness rejections. At this early stage, it is difficult to assess the impact the Guidelines will have on patent prosecution. Some technology areas traditionally considered “unpredictable” in the patent context—such as the biotech, pharmaceutical, and chemical arts—may feel less impact from the Guidelines, which have a great emphasis on predictability.

Here are some initial suggestions to consider for practicing under the Guidelines:

- In some practice areas, it may become routine to include evidence of unexpected/surprising results in patent applications.
- When prosecuting applications, it may be advisable to include evidence of secondary considerations such as unexpected results, commercial success, long felt need, and failure of others in Declarations in response to obviousness rejections.
- It may be advisable to make obviousness arguments that are procedurally focused on the Guidelines, like those often made in response to written description and utility rejections since publication of the Written Description Guidelines and the Utility Guidelines.
- The commonly-used approach of arguing that each claim limitation was not taught or suggested by even a combination of prior art references may still be an effective strategy.

For Further Information

Overall, prosecution strategies will need to be assessed on a case-by-case basis as Examiners make obviousness determinations based on the rationales elucidated by the new Guidelines. Please contact your Wolf Greenfield attorney to develop appropriate strategies as additional information on the PTO’s implementation of the Guidelines becomes available.

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