

# C L I E N T   A L E R T

## Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* on “Obviousness”

May 9, 2007

On April 30, 2007, the U.S. Supreme Court, in its long-awaited decision in *KSR International Co. v. Teleflex Inc.*, rejected the existing “teaching, suggestion, or motivation” test for determining the obviousness of a patent.

### Background

The case concerned a patent owned by Teleflex (U.S. Patent No. 6,237,565) relating to an adjustable pedal assembly for an automobile (i.e., a pedal that could be adjusted to accommodate drivers of different heights). The pedal arrangement incorporated an electronic control attached to the assembly in a particular way.

KSR had argued successfully in the trial court that the patent was invalid because a person of ordinary skill in the art would have found it obvious to modify an adjustable pedal assembly disclosed in one prior art patent to also include an electrical control disclosed in another patent. In reviewing that issue on appeal, the Court of Appeals for the Federal Circuit (which hears all patent appeals) employed the approach it has used for a number of years, referred to as the “teaching, suggestion, or motivation” test. The Federal Circuit had adopted this test to minimize the effect of hindsight. Under that test, a patent is considered to have been obvious over the combined teachings of two or more items of prior art only if “some motivation or suggestion to combine the prior art teachings” can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art.

The Federal Circuit found that, under that test, the trial court had improperly concluded the Teleflex patent would have been obvious. The Supreme Court took the case to determine whether the Federal Circuit had addressed the statutory requirement of nonobviousness in the proper manner.

### The Supreme Court’s Opinion

The Supreme Court reversed, rejecting the “rigid” approach of the Federal Circuit, and finding the patent invalid as obvious.

The Court referred to the “teaching, suggestion, or motivation” test as “formalistic” and as overemphasizing published articles and the explicit content of issued patents. The Court noted that in many fields there may be little discussion of obvious techniques or combinations and it often may be the case that market demand, rather than scientific literature, will drive design trends. The Court described the test as capturing a helpful insight, but cautioned that insight should not become a rigid and mandatory formula.

The Court suggested that, as a result of its rigid nature, the test might result in granting patent protection to advances that would occur in the ordinary course without real innovation.

The Court observed that common sense teaches that familiar items may have obvious uses beyond their primary purposes and thus in many cases the teachings of multiple patents can be fit together like pieces of a puzzle. The Court suggested a person of ordinary skill would apply ordinary creativity to find such solutions.

The Court also found that obviousness can be proven by showing a combination of elements was “obvious to try” when there is a design need or market pressure to solve a problem and there are only a finite number of identified, predictable solutions.

On the facts of this particular case, the Court found the market demand for vehicles with electronic throttle control systems would have supplied sufficient motivation to a person of ordinary skill in the art to modernize the prior art pedal assembly to meet such a demand, and in doing so that person would have recognized the prior art electronic control as one of a handful of ways to accomplish that modernization.

## **What Are the Implications?**

Although the Supreme Court clearly raised the bar for patentability, the Court did not articulate a general rule to apply. Essentially, the Court shifted the burden of proof. Now, if it is shown that the use of some known technique or feature would have a predictable effect, then the use of the technique or feature will be treated as obvious, in the absence of some showing the prior art knowledge taught away from the suitability or desirability of the particular combination. The decision will make certain patents harder to obtain and will encourage patent infringement defendants to challenge the validity of patents more frequently and vigorously.

By upholding the granting of summary judgment on this issue, the Supreme Court appeared to treat obviousness as principally an issue of legal analysis, rather than a factual dispute. This may encourage lower courts to uphold such challenges on summary judgment, rather than leaving the issue for a jury to decide. Lower courts may be additionally encouraged by the Court’s ruling that conflicting expert testimony did not exclude summary judgment on this issue.

As far as predicting what types of patents are more likely to be invalidated, it will probably take several years for the lower courts (and the Patent Office) to work out the full implications of this decision. The Patent and Trademark Office has already reminded its examiners that, pursuant to the decision, they must continue to supply reasons to justify their position that a person of ordinary skill the art would have found it obvious to combine the teachings of multiple references. However, a response to the examiner that there was no “teaching, suggestion or motivation” in the prior art to make the combination will no longer suffice.

The Court’s suggestion that, in seeking a solution to a known problem, a person of ordinary skill in the art might find it “obvious to try” one of several “known options within his or her technical grasp” may influence some district court judges and patent examiners. The Federal Circuit had previously rejected the “obvious to try” standard. The effect may be limited, however, in that the Supreme Court only endorsed such an “obvious to try” standard “[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions.”

Further, the case focused on situations where combinations of teachings yield “predictable” results. Accordingly, the impact of this opinion on the chemical, biotech, and pharmaceutical fields, which are considered to be “unpredictable arts,” may be less significant. The Supreme Court, on this and other tests, simply expressed a reluctance to adopt litmus tests or shortcuts in an obviousness analysis.

### **For Further Information**

As always, please contact your Wolf Greenfield attorney if you are interested in exploring how this decision affects your IP goals or strategies.

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