Post KSR v. Teleflex: Is Anything Invented Patentable Anymore?

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Patent Prosecution

- The process of obtaining a patent:
  - A patent is filed for an invention
  - A patent Examiner searches for similar inventions
  - The Examiner issues a rejection or an allowance
  - The patent issues or is abandoned

- Time frame:
  - 18 months to 5 years or more
Obviousness

- 35 U.S.C. 103(a):
  (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Graham v. John Deere (1966)

- Supreme Court defined the test for obviousness as involving:
  1) The scope and content of the prior art
  2) The differences between the prior art and the subject matter to be patented
  3) A determination of the level of ordinary skill in the art
  4) Secondary considerations:
     - Commercial Success, Long Felt Need, Failure of Others
Teaching, Suggestion, Motivation (TSM)

- Federal Circuit established this as the test for obviousness based on *John Deere*:
  1. A teaching or suggestion in the references themselves that would motivate one of ordinary skill in the art to combine their teachings
  2. The combination of references must teach all of the claim limitations
  3. There must be a reasonable expectation of success
KSR v. Teleflex (2007)

- Involved an adjustable automotive gas pedal
- The Supreme Court stated that the TSM test is not the only test for obviousness under John Deere.
- Provided examples of prior decisions of the court they approved of
- Destroyed a tremendous amount of Federal Circuit precedent
- Initial impact only fully known by measured by PTO’s official rules
PTO’s New Obviousness Rules

- Interpret *KSR* as broadly as possible
- State there are now 7 (seven) rationales justifying a finding of obviousness
  - TSM is just one of the possibilities
- The combination of references need not teach all the claim limitations; common sense can be used to supply the remainder
- An Examiner must first 1) Make factual findings as required by *John Deere* and 2) determine the proper rationale to apply to support a finding of obviousness
Obviousness Rationales

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 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
Obviousness Rationales con’t

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...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 reference teachings to arrive at the claimed invention
Analysis of Two Rationales

1) Combining prior art elements according to known methods to yield predictable results

Thomas Edison’s Light Bulb:
- U.S. Patent No: 223,898, issued
- January 27, 1880
- Describes using 1) a carbon filament
- 2) an evacuated glass enclosure

See Wikipedia timeline on state of prior art:
5) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success

Thomas Edison tried hundreds, even thousands of filaments before finding that the carbonized linen thread worked.

- Tried known metallic varieties, then went back to the known carbon filaments before succeeding

- “Genius 1% inspiration and 99% perspiration”

- Given the finite number of identified materials existed, success was simply a matter of finding the right one.
On Jan. 27, 1880 Thomas Alva Edison was granted U.S. Pat. No. 223,898 on an electric lamp. Prior to Edison's invention, light by incandescence had been obtained from low resistance carbon rods placed in closed vessels in which the air had been replaced by other gases. Edison's invention consisted of carbon wire or sheets placed in a vacuum which protected against oxidation and injury to the filament. That, in Edison's day, was a radical departure from prior attempts at a commercially feasible electric lamp.

http://www.ptodirect.com/patent/?4918357

Really?
Is Anything Invented Patentable?

- *KSR* and the PTO’s implementation represent a dramatic return to the pre 1952 Patent Act situation.
- The court seems to be asking once again for the “spark of inspiration” requirement, that something be “unknown” or “undiscovered” in order to justify a patent grant.
- The decision and the rule making appear to be contrary to Congress’ intent.
The Solution:

- Congress must amend 35 U.S.C. 103 to specify what the test for obviousness is.
  - Which of the seven or combination thereof is the right one?
- Until then, patentees face an uphill battle.