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How Obvious Is Obviousness?

In *KSR Int'l v. Teleflex*, the Supreme Court unanimously held that rigid application of a “teaching, suggestion, or motivation” (TSM) test violates the flexible approach to obviousness set forth by the Court in *Graham v. John Deere* and subsequent cases. The Court emphasized that the objective analysis for determining obviousness set forth in *Graham* (including, where appropriate, consideration of the secondary factors enumerated therein) remains the defining inquiry for applying the statutory language of 35 U.S.C. § 103. The key focus must be on determining the scope and content of the prior art and differences between the prior art and the claims at issue, in light of the level of ordinary skill in the art. In confirming its holding that the patent claim at issue was obvious, the Court noted that there was no showing of any of the secondary factors identified in *Graham*.

In *KSR*, the Supreme Court addressed the obviousness of a patent claim directed to a mechanism for combining an electronic sensor with an adjustable automobile pedal so that the pedal’s position can be transmitted to a computer that controls the throttle in the vehicle’s engine. The claim specifically described attaching the electronic sensor to the pedal such that the sensor remains in a fixed position while the driver adjusts the pedal. One prior art reference directed to non-computer controlled throttles disclosed all the elements of the claimed invention except the use of a sensor to detect the pedal’s position and transmit it to the computer controlling the throttle. This additional aspect was taught by other, more recent, prior art references directed to computer controlled throttles.

The Supreme Court held that the trial court correctly concluded that the combined teachings of the prior art rendered the patent claim at issue obvious. The Court rejected the Federal Circuit’s conclusions, in reversing the trial court’s finding of obviousness, that 1) the TSM test is not met where the prior art did not address the precise problem that the patentee was trying to solve and 2) the fact that it might have been obvious to try the combination disclosed by the prior art is irrelevant because obvious to try does not constitute obviousness. In addressing the errors committed by the Federal Circuit in rigidly applying the TSM test, the Court stated that while the TSM test is a useful tool, it cannot be applied in a manner inconsistent with *Graham* and subsequent case law applying the teachings of *Graham*.

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Specifically, the Court identified four errors committed by the Court of Appeals for the Federal Circuit in its obviousness analysis: 1) it is error to look only to the problem the patentee is trying to solve in determining whether a combination of elements from the prior art renders a claimed invention obvious; 2) it is error to assume that a person of ordinary skill in the art attempting to solve a problem will be led only to those prior art elements designed to solve the same problem; 3) it is error to conclude that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try; and 4) it is error to apply rigid preventative rules intended to guard against using hindsight when they deny factfinders recourse to common sense.

First, the Court noted that under the correct analysis, the question is whether the combination was obvious to a person of ordinary skill in the art, not whether the combination was obvious to the patentee. Any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the matter claimed. Second, a person of ordinary skill attempting to solve a problem will not be led only to those elements of prior art designed to solve the same problem; familiar items may have obvious uses beyond their primary purposes. For example, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its application is beyond ordinary skill. Third, the fact that a combination of elements was obvious to try can indeed show that it was obvious under § 103. For example, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, pursuing a known combination that leads to success is likely the result not of innovation but of ordinary skill, and is thus obvious. Fourth, while the factfinder should not use hindsight bias or *ex post* reasoning in determining obviousness, rigid rules that deny factfinders recourse to common sense are not the answer. The Court found such rules inconsistent with its prior precedents.

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