

PUBLICATION

U.S. Supreme Court Clarifies Standard for Obviousness

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The year 2007 has been an active year for the U.S. Supreme Court in the area of patent law. One of the several cases decided this year is *KSR International Co. v. Teleflex Inc.*, — S.Ct. —, 2007 WL 1237837 (Apr. 30, 2007).

At issue in *KSR v. Teleflex* was U.S. Pat. No. 6,237,565 entitled “Adjustable Pedal Assembly With Electronic Throttle Control.” The patent was held by Teleflex and pertained to a gas pedal. The gas pedal included an electronic sensor that automatically adjusts its position to the height of the driver.

KSR is a Canadian company that markets gas pedals. Teleflex claimed that KSR manufactured a gas pedal that infringed on the '565 Teleflex patent. Teleflex sued KSR in the Eastern District of Michigan, claiming that two of KSR's adjustable gas pedal systems literally infringe Claim 4 of the '565 Patent.

In response to the lawsuit, KSR asserted that Teleflex's patent combining a gas pedal with a sensor would have been obvious to one of ordinary skill in the art. Therefore, according to KSR, the patent was invalid. KSR filed a motion for summary judgment on this issue citing several prior art patents. The motion was supported by an affidavit from an expert. The motion was granted, prompting Teleflex to appeal to the U.S. Court of Appeals for the Federal Circuit.

On appeal, the Federal Circuit reversed the District Court's summary judgment. The Federal Circuit noted that a claimed invention cannot be held “obvious” by arbitrarily combining two or more prior art references. According to the court, “[w]hen obviousness is based on the teachings of multiple prior art references, the movant must also establish some 'suggestion, teaching, or motivation' that would have led a person of ordinary skill in the art to combine the relevant prior art teaching in the manner claimed.” The Federal Circuit then remanded the matter back to the District Court, noting that the trial court had failed to make specific findings as to a suggestion or motivation to combine the prior art teachings.

KSR filed a writ of *certiorari* with the U.S. Supreme Court. The attention of the patent bar was quickly obtained when the “cert.” was granted. Numerous amicus briefs were then filed on behalf of the parties.

In discussing the law, the Supreme Court first noted that Section 103 of the Patent Act “forbids issuance of a patent when '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.’” Citing *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950), the Court then noted that a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” The Court also cited its earlier decision in *Sakraida v. AG Pro, Inc.*, 425 U. S. 273, 282 (1976), which held that when a patent “simply arranges old elements with each performing the same function it had been known to perform” and yields no more than what one would expect from such an arrangement, the combination is obvious.

The Supreme Court ruled that the Federal Circuit had failed to apply the proper obviousness test. The Court held that an “obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.” Further, “[t]he results of ordinary innovation are not the subject of exclusive rights under the patent laws,” wrote Justice Anthony Kennedy for the Court. “Were it otherwise, patents might stifle rather than promote the progress of useful arts.”

The lessons to be learned from the KSR decision are manifold. These include:

1. a determination of obviousness should not be based upon a single, rigid formula;
2. in examining patent applications, examiners are not obligated to allow a patent claim merely because there is no explicit “teaching, suggestion or motivation” to combine two references;
3. when considering whether a patent claim is obvious in view of prior art, the inquiry is not whether the combination was obvious to the patentee, but whether the combination was obvious to a person with ordinary skill in the art; and
4. 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, summary judgment is appropriate.