

**In-Class Exercise: Objective Indicia of Nonobviousness**

In addition to examining the elements of the claim, there are several kinds of evidence that are considered to be “objective” indicia that an invention would have been nonobvious to someone of ordinary skill in the art. The sorts of things that are commonly cited as supporting a finding of obviousness or nonobviousness include:

- ▶ Commercial success of the invention.
- ▶ Long-felt (but unmet) need for the invention.
- ▶ Failure of others to develop the invention.
- ▶ Professional skepticism of the invention.
- ▶ Unexpected results.
- ▶ Prior art “teaching away” from the invention.
- ▶ Simultaneous (or near-simultaneous) invention by multiple inventors.

For each of the following, decide whether the evidence is relevant to a finding of obviousness or nonobviousness and, if so, which way it leans.

1. The invention is a dual-activity deepwater drilling apparatus that is just a combination of two prior-art references, the Horn and Lund references.
  - ▶ Dual-activity drilling rigs command a 12% price premium over prior-art drilling rigs.
  - ▶ Some customers demand dual-activity rigs.
  - ▶ A competitor mentioned “innovations such as Transoceans dual-derrick concept.”
  - ▶ *Offshore Magazine* called it “critical to the future” and said it provided “20–40% faster tripping.”
  - ▶ BP, a potential customer, doubted it would work and did its own testing; it worked even better than Transocean claimed.
  - ▶ Maersk, a competitor, said “we have to incorporate the same efficiency improvement features as used by our competitors.”
  - ▶ Maersk concluded it could copy the invention because the Transocean patents were invalid.
  - ▶ People in the industry thought it wouldn’t work due to “clashing.”
  - ▶ Transocean licensed the invention for more than litigation costs.
  - ▶ Drilling had been moving offshore for decades, and there was a need for improved efficiency and ways to avoid interruptions.

2. The invention is a plastic fishing lure with an embedded salty compound. It was well-known in the prior art that fish are attracted to salty tastes and are less likely to let go of salty bait.

- ▶ No one in the industry thought it would work.
- ▶ Salt causes problems when embedded in plastic.
- ▶ Textbooks explained that artificial lures were not as good as live bait because they couldn't be made to taste salty.
- ▶ Salty compounds can ruin the texture of the lure's surface.
- ▶ Salt can cause explosions (!!) in the manufacturing process.

3. The invention is a cold medicine combining ibuprofen, a painkiller, and pseudoephedrine, a decongestant.

- ▶ There was a long-felt need for a combination ibuprofen / pseudoephedrine cold medicine, since it makes it easier to treat a cold without taking several drugs.
- ▶ Consumers are willing to pay more for the combined drug than they are for the two drugs separately.
- ▶ A recent FDA rule change eliminated obstacles for getting regulatory approval for combination drugs like the invention.