

Patent Law

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Class 14 – Nonobviousness:
introduction; *Graham* and *KSR*

Recap

Recap

- Abandonment
- Foreign patent filings

Today's agenda

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- Nonobviousness: introduction
- *Graham*
- *KSR*



Nonobviousness

(Post-AIA) 35 U.S.C. § 103 — Conditions for patentability; non-obvious subject matter

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if **the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains**. Patentability shall not be negated by the manner in which the invention was made.

Nonobviousness

→ Patent bargain

- Society doesn't get anything from an obvious advance — it would have been made anyway
- Too many patents cause other problems — search costs; transaction costs to licensing; rewarding wrong individuals; &c

Nonobviousness

→ Counterargument

- Innovation often proceeds in small increments, each important
- Difficult to tell after the fact whether something was obvious or not

Graham

Graham

- Invention: clamp for vibrating shank plows
 - “combination of old mechanical elements”
 - Fifth Circuit: combination produces “old result in a cheaper and otherwise more advantageous way”
 - Eighth Circuit: no new result

Graham

- Possible standard #1
 - “some means of weeding out those inventions which would not be disclosed or devised but for the inducement of a patent” (page 748)

Graham

→ Possible standard #2

- “more ingenuity and skill ... than were possessed by an ordinary mechanic”; “skillful mechanic, not ... inventor” (page 749)

Graham

→ Possible standard #3

- “flash of creative genius” (page 750)

Graham

- The basic test (pages 750–51)
 - Scope and content of the prior art are examined;
 - Differences between prior art and claims are ascertained;
 - Level of ordinary skill in the art is resolved; and
 - Obviousness is determined.
 - Also, secondary considerations might be considered.

After Graham

- How to figure out whether an invention would have been obvious?
 - Federal Circuit: “teaching, suggestion, or motivation” (TSM) test
 - Must be something in the prior art suggesting to combine elements

After *Graham*

→ What counts under TSM test?

- Prior-art reference that suggested the elements be combined
- Way of showing that someone skilled in the art would obviously and naturally know how to combine them (e.g., training or past behavior)
- Has to be super-clear



KSR

KSR

→ The most-cited patent case of all time, ten years after it was decided

	Teleflex Claim 4 (Engelgau)	Rejected Teleflex claim	Redding patent	Asano patent	Smith patent	'068 patent (Chevrolet)	Rixon patent
Adjustable petal assembly	✓	✓	✓	✓			✓
Fixed pivot point	✓			✓			
Electronic sensor	✓	✓			✓	✓	✓
Sensor on pivot point	✓				✓	✓	

KSR

- District court's *Graham* analysis
- Federal Circuit's analysis

KSR

- District court's *Graham* analysis
- Federal Circuit's analysis
 - District court's TSM analysis wasn't specific enough – there was no specific reason to think someone would have known to combine these elements
 - Typical of the Federal Circuit before *KSR*: very demanding analysis

KSR

→ Supreme Court's problem with this analysis?

KSR

→ Supreme Court's problem with this analysis?

- Too strict; ignores "common sense"
- Combination patents need extra scrutiny

KSR

→ What happens to the TSM test?

KSR

→ What happens to the TSM test?

- It provides a helpful insight, but is not a strict requirement
- Expanded motivations: “it often may be the case that market demand, rather than scientific literature, will drive design trends” (page 662)
- “There then existed a marketplace that created a strong incentive to convert mechanical pedals to electronic pedals” (page 663)

KSR

→ Applying the KSR test

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KSR

- Applying the *KSR* test: How would someone of ordinary skill in the art know how to combine these elements?

KSR

- Applying the *KSR* test: How would someone of ordinary skill in the art know how to combine these elements?
 - The big answer: predictability
 - It's a combination of familiar elements according to known methods that yields predictable results

KSR

- What if there were many ways to solve the problem this pedal solved?

KSR

- What if there were many ways to solve the problem this pedal solved?
 - Federal Circuit: evidence it's nonobvious: "asking whether a pedal designer writing on a blank would have chosen both Asano and a modular sensor" (bottom page 663)
 - Supreme Court: "The proper question to have asked was whether a pedal designer ... would have seen a benefit to upgrading Asano with a sensor" (663-64)

KSR

→ “Obvious to try”: arguments for and against finding it obvious?

KSR

→ “Obvious to try”: arguments for and against finding it obvious?

- For: might not fulfill the patent bargain; predictability
- Against: ignores cost of experimentation

KSR

→ Reaction: arguments for and against?

KSR

→ Reaction: arguments for and against?

- In favor of the Supreme Court's side: if the market really was moving in this direction, awarding a monopoly doesn't further the patent bargain
- Against: hindsight is a big problem in patent law – lots of things look obvious after the fact

Next time

Next time

→ More nonobviousness!