Patent Law

Prof. Roger Ford
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Class 11 – Nonobviousness: introduction; *Graham* and *KSR*

Recap

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→ "abandoned, suppressed, or concealed" inventions

→ (pre-AIA) § 102(g) as prior art

→ (pre-AIA) statutory bars

- § 102(b)
- § 102(c)
- § 102(d)

→ derivation

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

→ § 102: no patent if an invention is not novel

→ § 103: no patent if an invention is obvious

→ Why would we need both sections?

Nonobviousness

→ Patent bargain

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

Nonobviousness

→ Evidence

- Novelty is a demanding standard – a single reference must contain everything in a claim
- Obviousness can help fill gaps in the evidentiary record

Nonobviousness

→ Counterarguments?

Nonobviousness

→ Counterarguments?

- Incremental innovation: Innovation often proceeds in small increments, each important
- Evidence: It can be hard 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)

- 1. Scope and content of the prior art are examined.
- 2. Differences between prior art and claims are ascertained.
- 3. Level of ordinary skill in the art is resolved.
- 4. Obviousness is determined.
- 5. Also, secondary considerations might be considered. (More on this later.)

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" (662)
- "There then existed a marketplace that created a strong incentive to convert mechanical pedals to electronic pedals" (663)

KSR

→ Applying the KSR test

	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	✔				✔	✔	

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

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

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- Federal Circuit: evidence it's nonobvious: "asking whether a pedal designer writing on a blank would have chosen both Asano and a modular sensor" (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

→ Sometimes a combination is "obvious to try." Should that be obvious?

KSR

→ Sometimes a combination is "obvious to try." Should that be obvious?

- Argument for: might not fulfill the patent bargain; predictability
- Argument against: ignores cost of experimentation

"**How long will it take the Federal Circuit to overrule this inexplicable nonsense?** The novice reader may find that question to be ignorant, since the Supreme Court is the highest court of the United States. Those well acquainted with the industry know that the Supreme Court is not the final word on patentability, and while the claims at issue in this particular case are unfortunately lost, the Federal Circuit will work to moderate (and eventually overturn) this embarrassing display by the Supreme Court. This will eventually be accomplished the same as it was after the Supreme Court definitively ruled software is not patentable in *Gottschalk v. Benson,* and the same as the ruling in *KSR v. Teleflex* will be overruled. … **The Federal Circuit continues to refine the *KSR* 'common sense test,' narrowing the applicability in case after case and tightening the ability for 'common sense' to be used against an application. We are almost 5 years post *KSR* and there is still a lot of work left to be done by the Federal Circuit to finally overrule the Supreme Court's *KSR* decision.**"

Gene Quinn (UNH alum!), on *Mayo v. Prometheus*

KSR

→ Reaction: Do we agree with the Court's decision?

KSR

→ Reaction: Do we agree with the Court's decision?

- In support: 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!