KSR v. Teleflex:
Re-visiting the obviousness puzzle

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1790: First law
No obviousness requirement

1851:
Hotchkiss decision

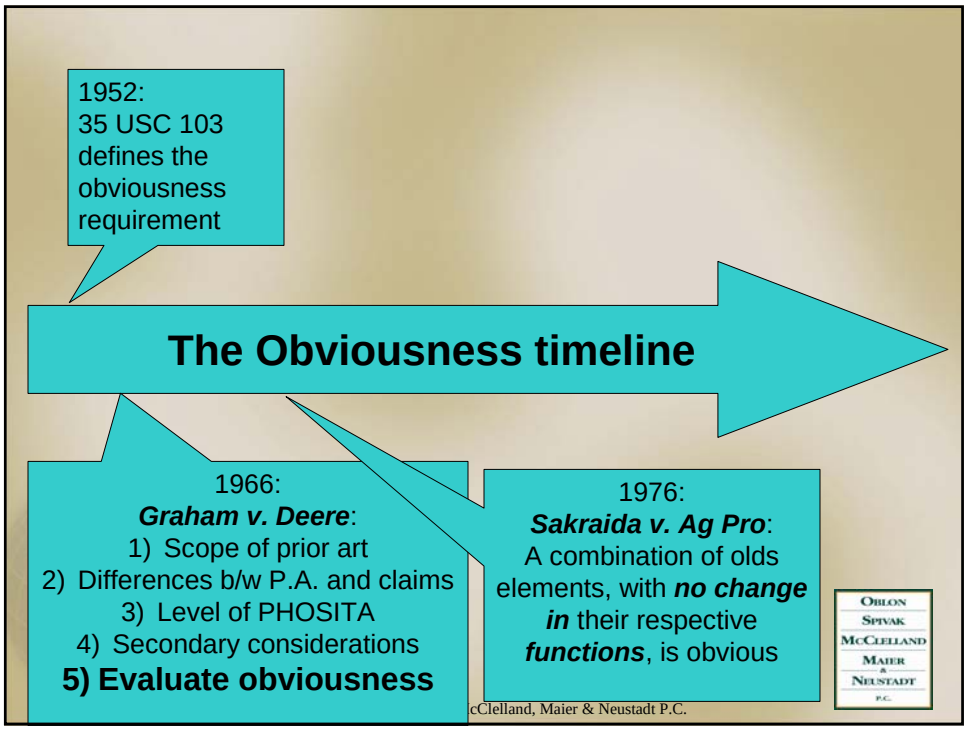
1952:
35 USC 103
codifies Hotchkiss

The obviousness timeline

Jurisprudence struggles to ***define*** additional requirement

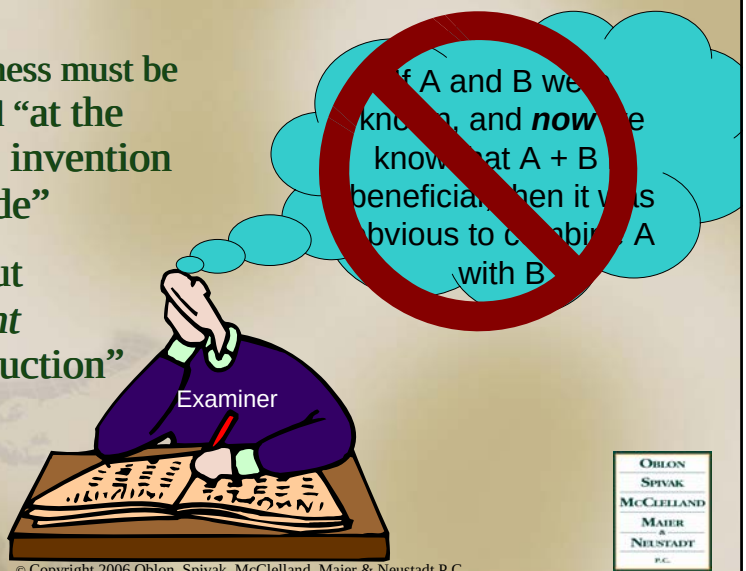
35 USC 103

- A patent may not be obtained …, if 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…



Evaluating obviousness

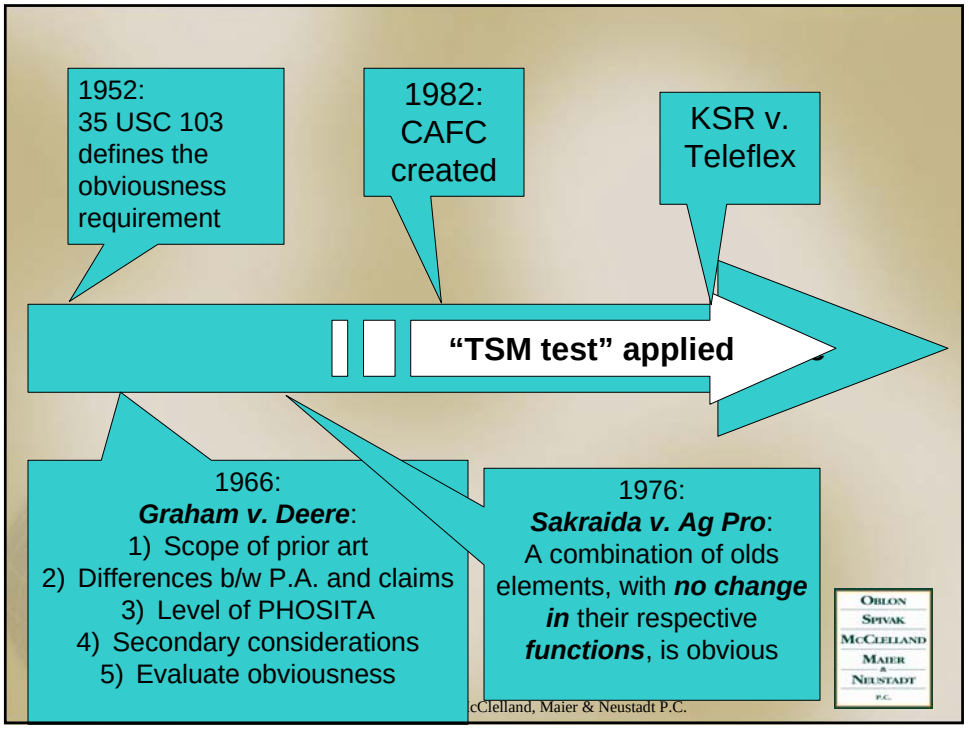
- Obviousness must be evaluated "at the time the invention was made"
- "Without *hindsight* reconstruction"

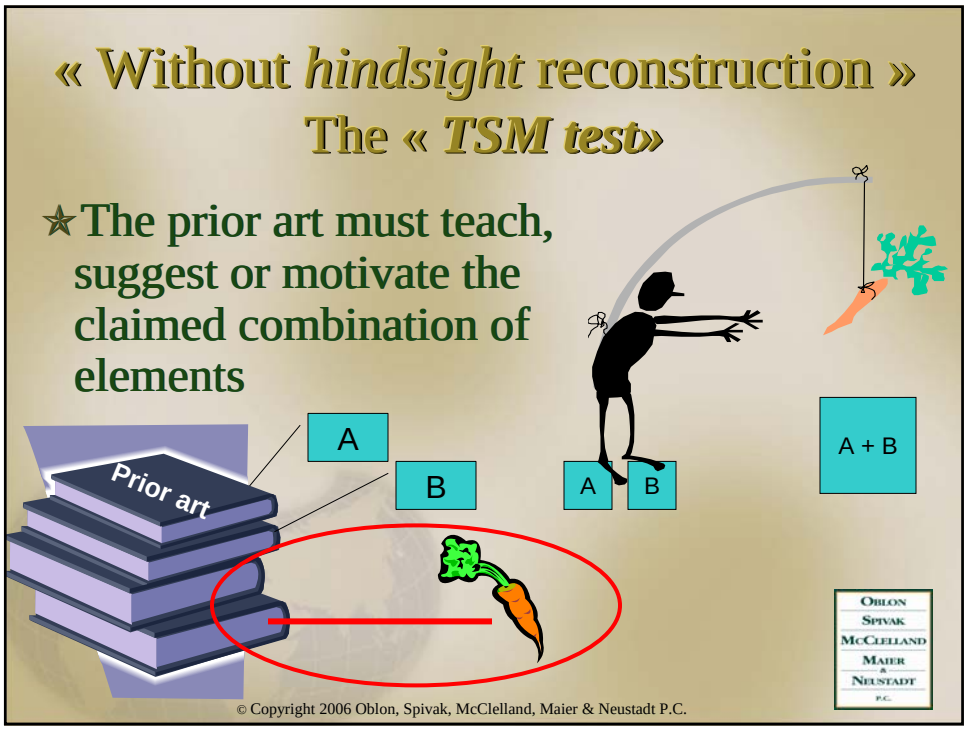


Double protection against «*hindsight* reconstruction »:

1) Consider only "analogous" prior art

2) The "TSM test"


1952:
35 USC 103
defines the
obviousness
requirement
1982:
CAFC
created
KSR v.
Teleflex
"TSM test" applied
1966:
Graham v. Deere:
1) Scope of prior art
2) Differences b/w P.A. and claims
3) Level of PHOSITA
4) Secondary considerations
5) Evaluate obviousness
1976:
Sakraida v. Ag Pro:
A combination of olds
elements, with ***no change in*** their respective ***functions***, is obvious
cClelland, Maier & Neustadt P.C.


« Without *hindsight* reconstruction »
The « *TSM test*»
The prior art must teach, suggest or motivate the claimed combination of elements
Prior art
A
B
A
B
A + B
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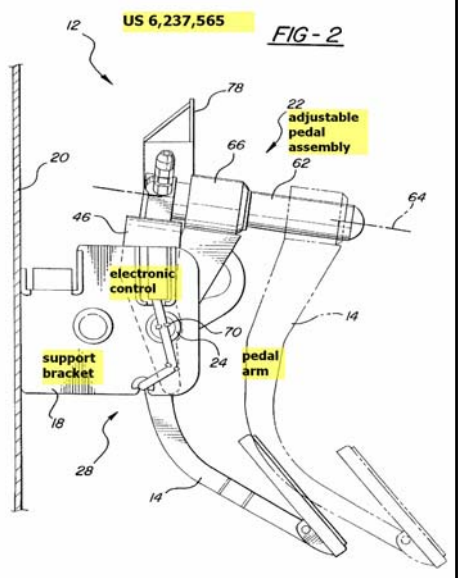
The KSR v. Teleflex case

- Teleflex sued KSR for infringement of Teleflex's patent
- Patent covers an ***adjustable pedal*** with an ***electronic sensor on the support bracket*** for the pedal
- Prior art: (1) adjustable pedal + (2) electronic pedal position sensor ***on the pedal***
- District Court = obvious

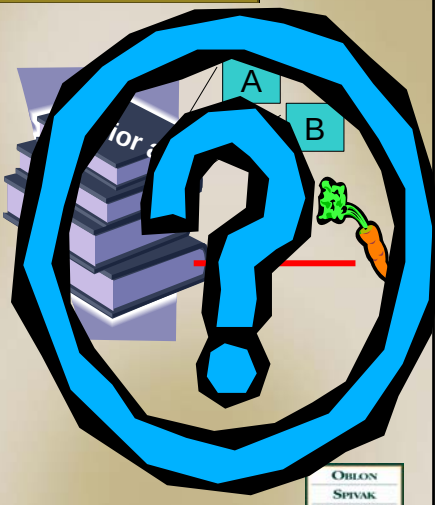


The KSR v. Teleflex

- CAFC remanded the case (January 2005):
- District Court applied an "incomplete" TSM test because it did not make "***specific findings***" as to a motivation to attach an electronic sensor to the support bracket of the prior art assembly.

The KSR v. Teleflex case

- Supreme Court will consider whether the Federal Circuit has erred in applying the TSM test when evaluating obviousness under 35 USC 103(a)
- Decision expected in 2007

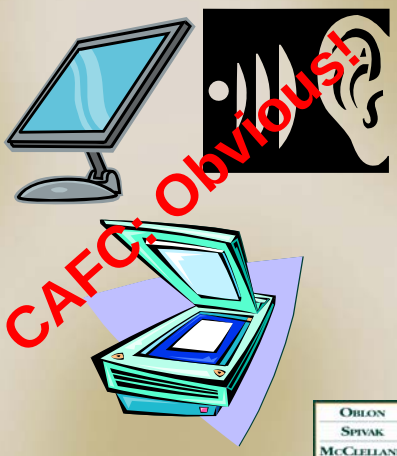


The CAFC reaction: In re Kahn (March 2006)

The **motivation can be implicit** to the nature of the **general problem** facing a person skilled in the art

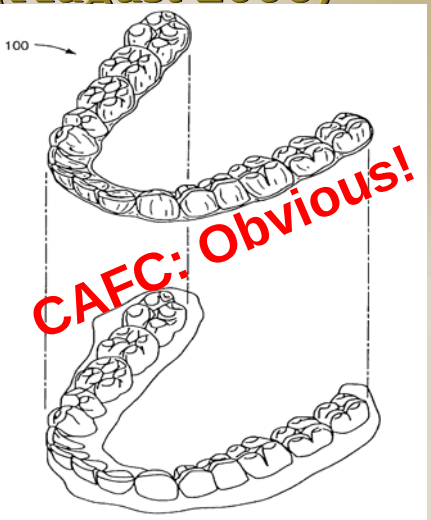
Citing Cross Med case (Fed. Cir. 2005)

- **No explicit motivation to combine the specific elements in the prior art**



The CAFC reaction: Ormco v. Align (August 2006)

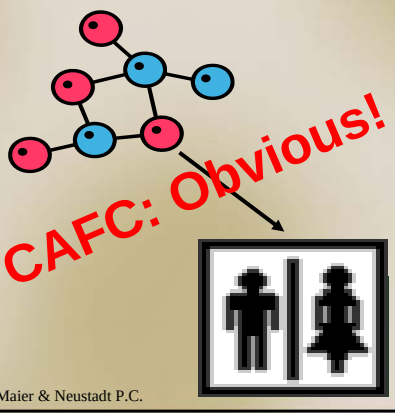
"Providing the devices to the patient in one package is not a patentable feature **in the light of the well-known practice** of packaging items in the manner most convenient to the purchaser."



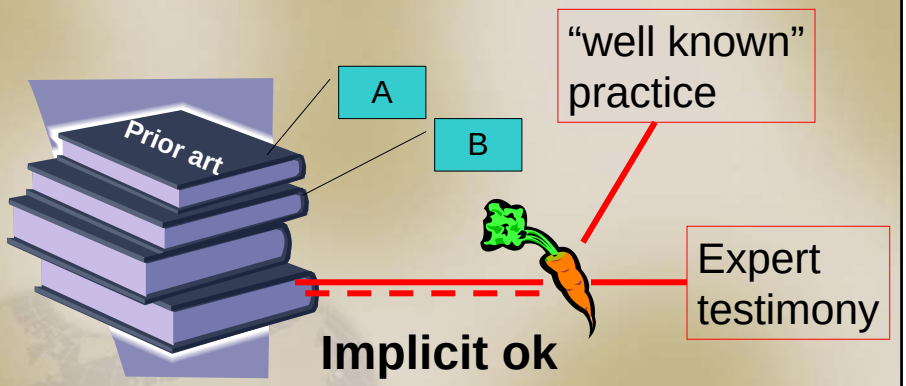
The CAFC reaction: Alza v. Mylan (Sept. 2006)

The **defendant's expert witness testified** that there was a general understanding that oxybutynin would be absorbed in the colon. The **prior art is not inconsistent** with that testimony.

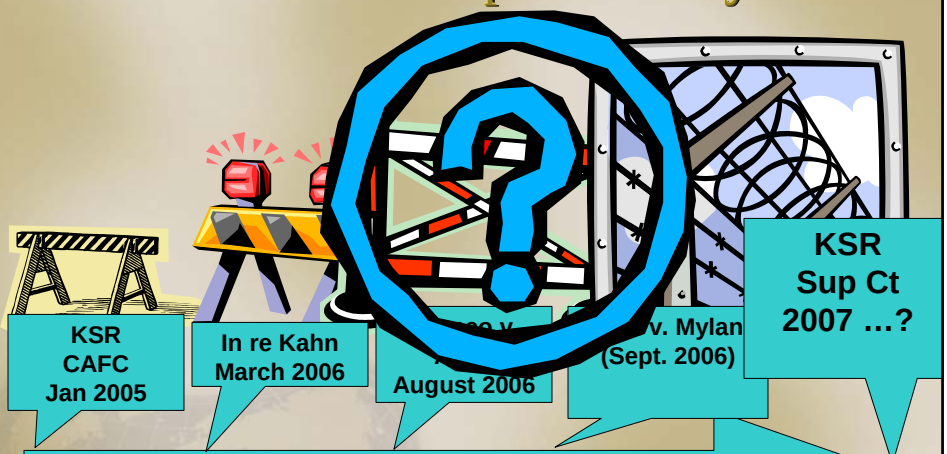
Oxybutynin therapy



The evolving TSM test



The barrier to patentability



The KSR case:
Re-visiting the obviousness puzzle

"The future belongs to people who see possibilities before they become obvious." *Ted Levitt*

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