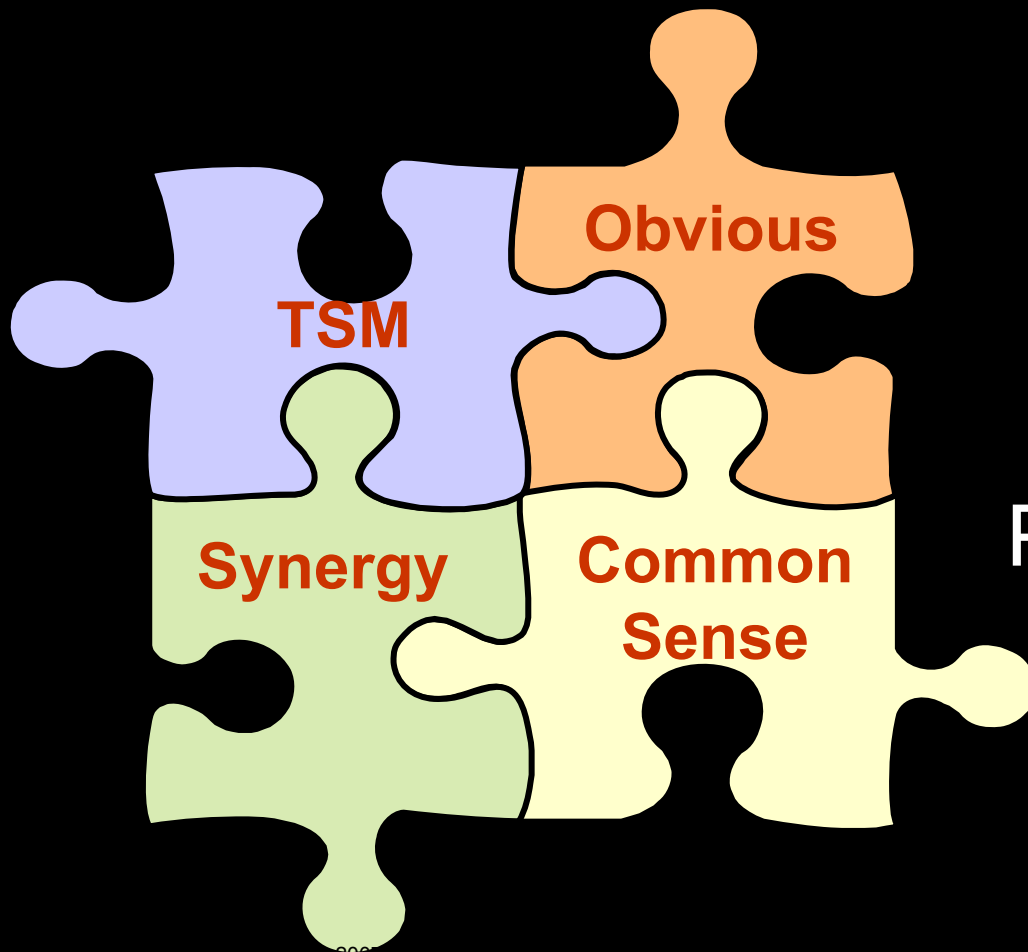


# -KSR- REVISITING THE OBVIOUSNESS PUZZLE



PHILIPPE SIGNORE



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**Obviousness is an old puzzle**

1791

“unimportant  
and obvious”  
inventions  
should *not* be  
patentable

Thomas Jefferson

Level of  
patentable  
innovation

1790

More than an  
aggregation of  
old elements –  
synergy  
required



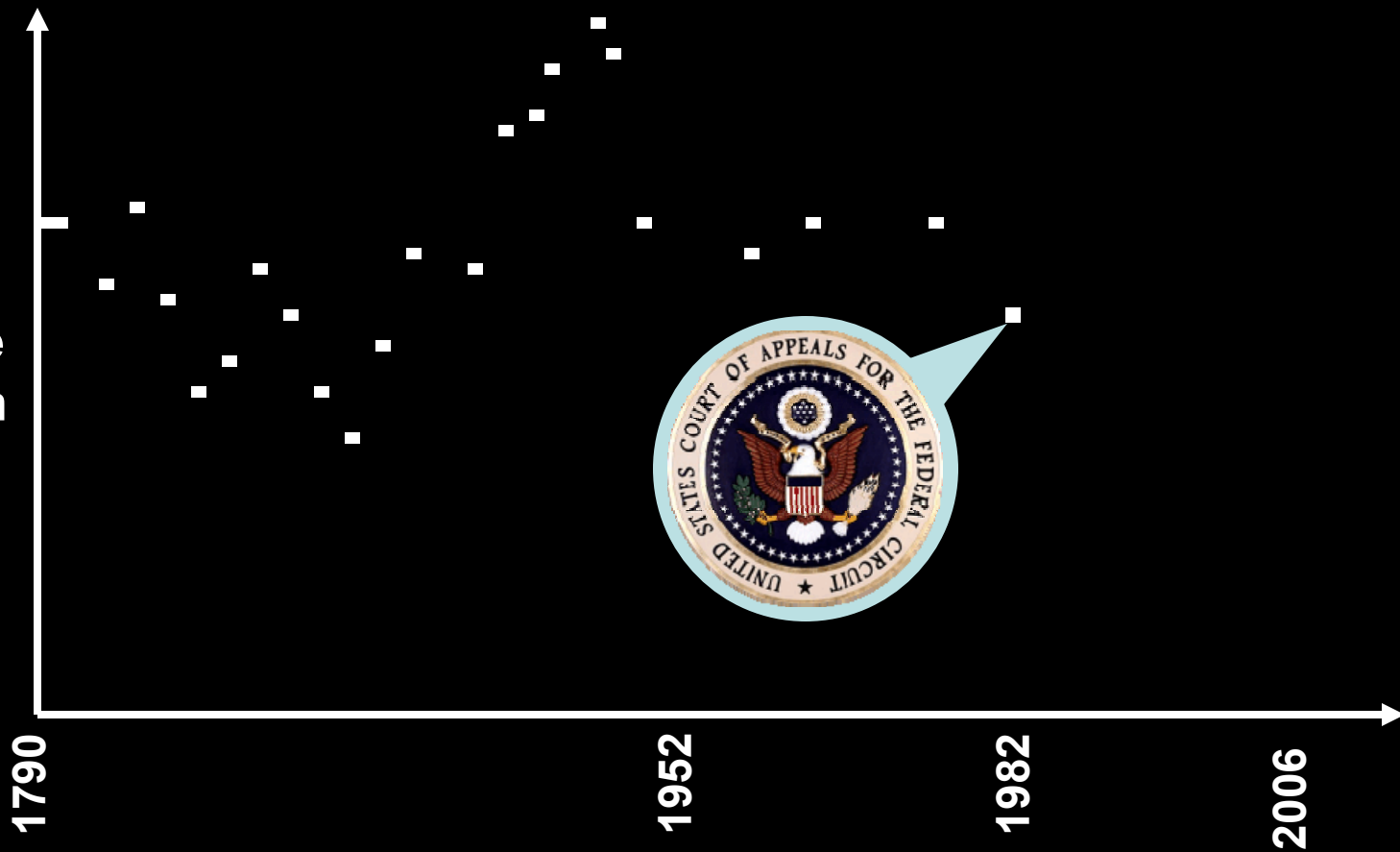
Aggregation of old elements

=

No patentable

1791

Level of patentable innovation



1982

The CAFC is created and applies the "TSM" test

# The TSM Test

Obviousness **cannot** be established by combining the teachings of the prior art to produce the claimed invention, **absent** some **Teaching, Suggestion or Motivation** supporting the combination

[ACS Hospital Systems, Inc. v. Montefiore Hospital](#) (1983)

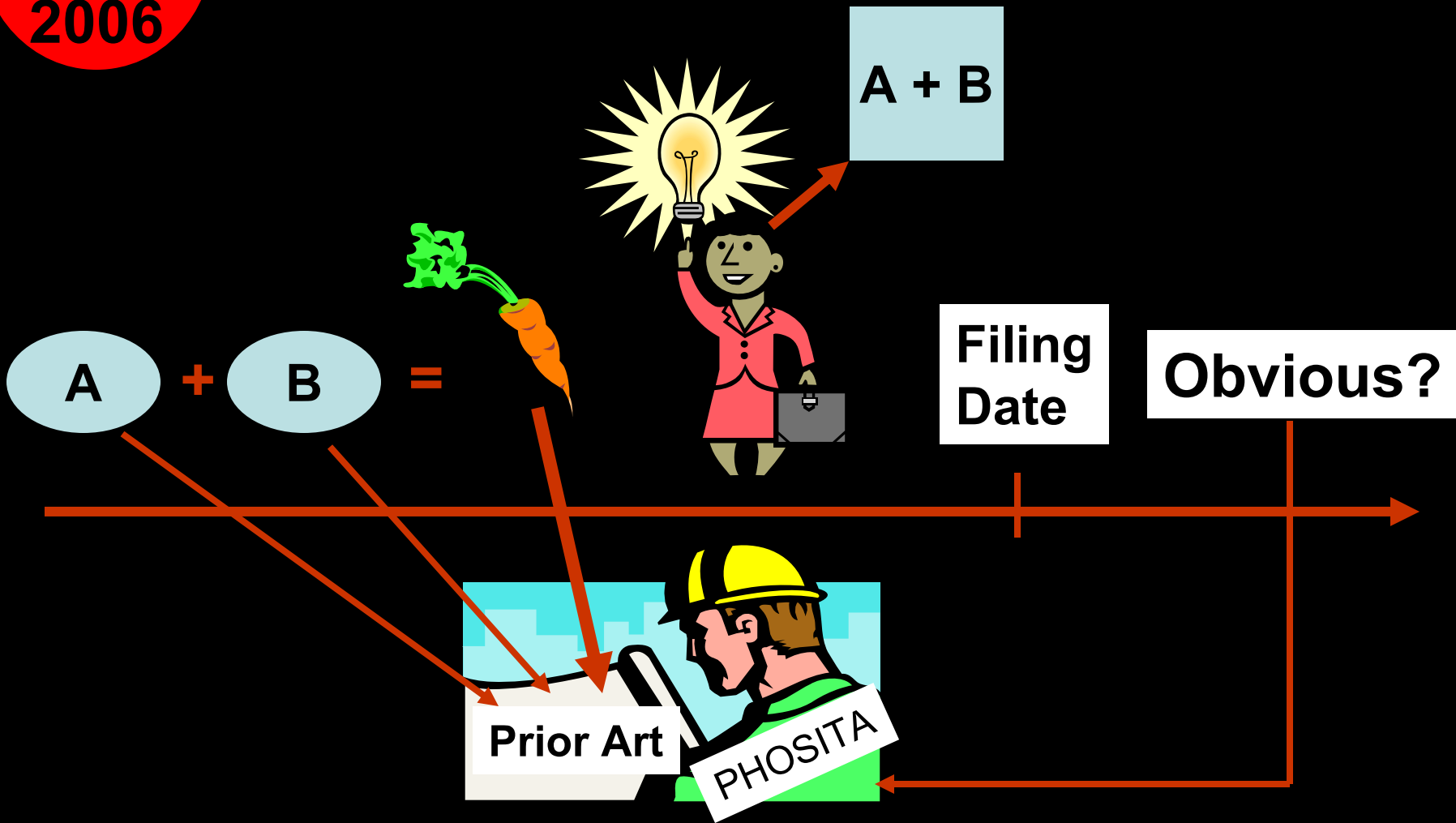
**What is the CAFC's justification for TSM?**

**In hindsight,  
everything seems obvious**



1983  
to  
2006

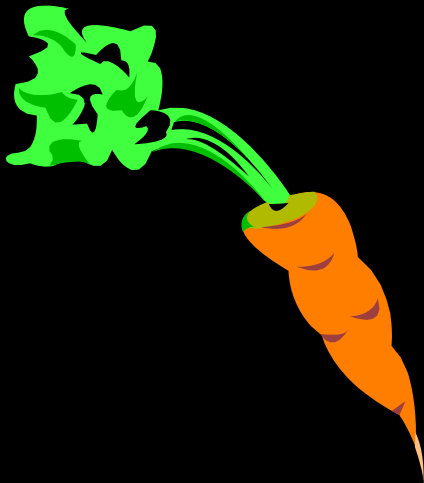
# The TSM Test: a protection against impermissible hindsight

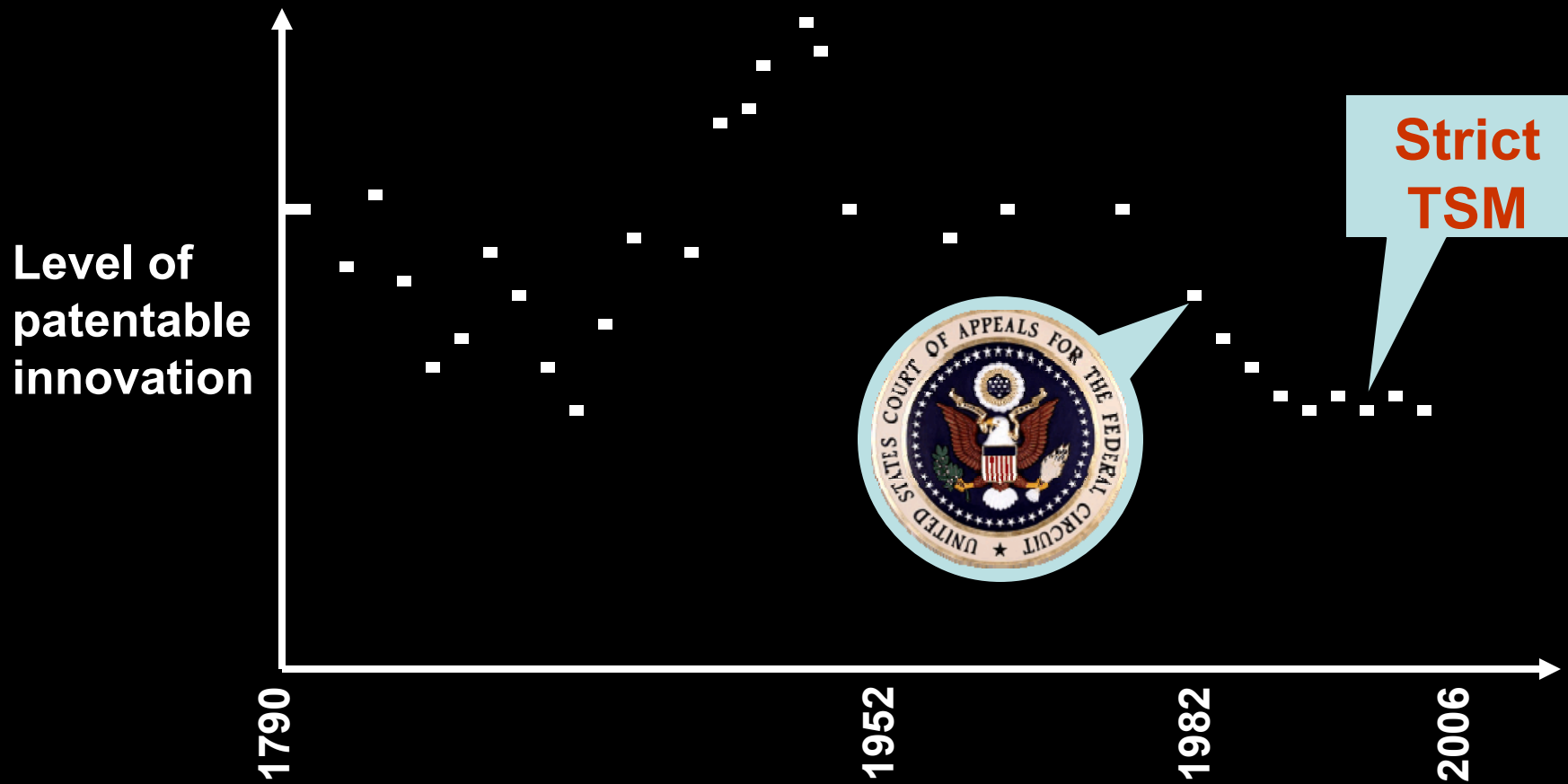


If *no motivation* is found, the invention is *non-obvious*

1983  
to  
2006

**STRICT TSM**



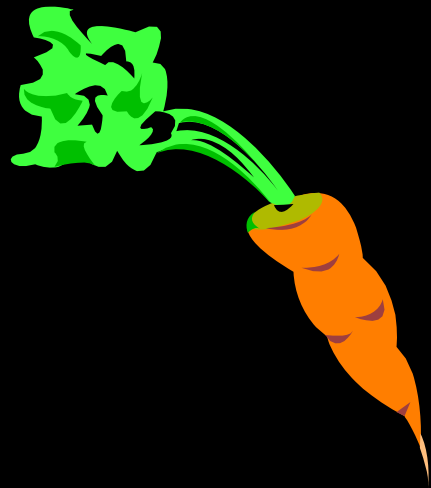


**1982-  
2006**

**The CAFC applies a STRICT "TSM" test**

March  
2006

# FLEXIBLE TSM



IMPLICIT

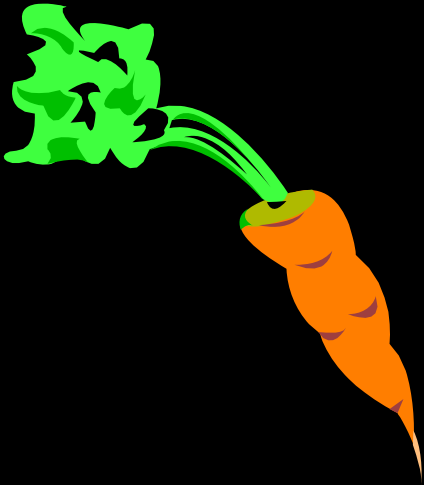


Motivation can be implicit

*In re Kahn*

**Aug.  
2006**

# **VERY FLEXIBLE TSM**

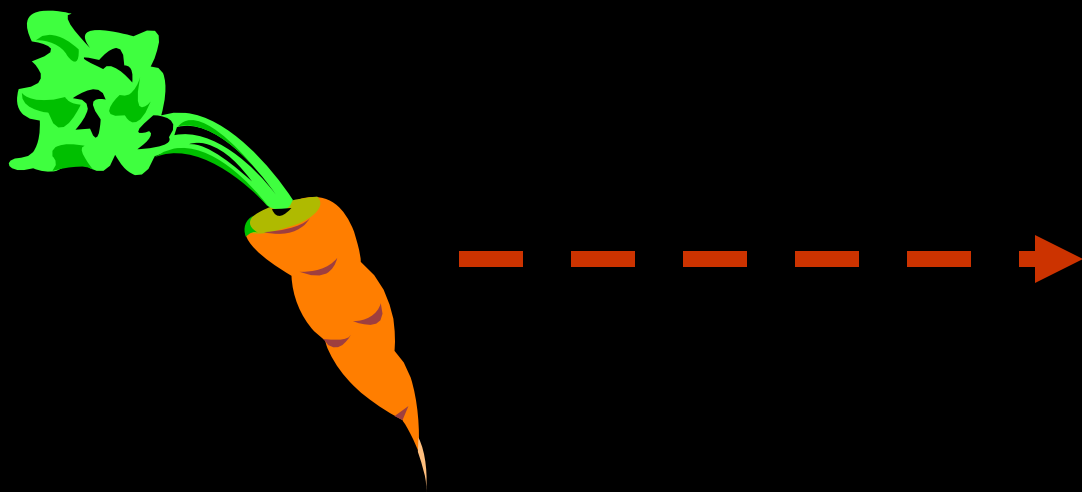


**Motivation can be common knowledge**

**Ormco v. Align**

**Sept.  
2006**

# **VERY, VERY FLEXIBLE TSM**



**Motivation can be evidenced by expert**

**Alza v. Mylan**

**Oct.  
2006**

**VERY, VERY, VERY ....**

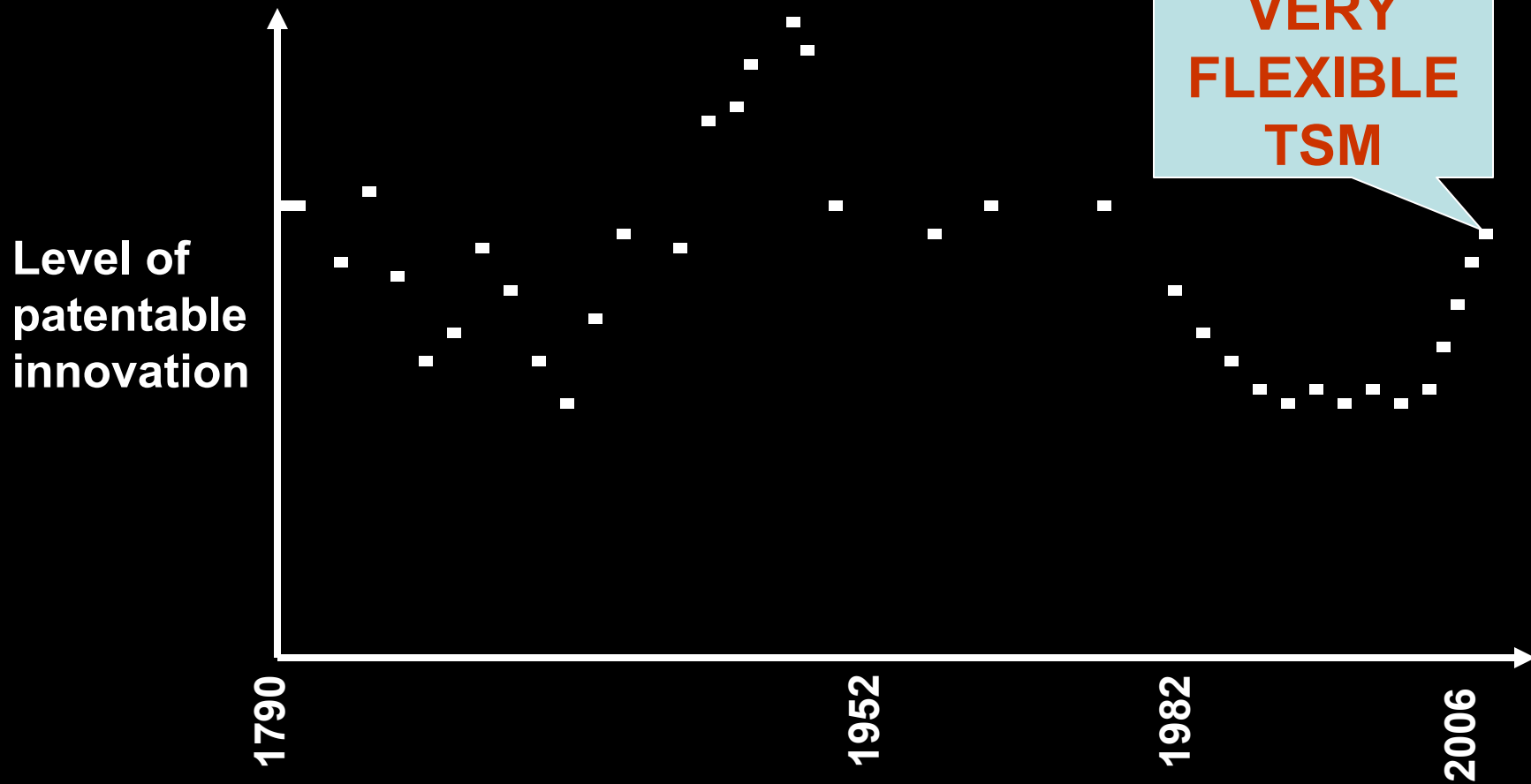
**Motivation need not be evidenced!**

***DyStar v. C.H. Patrick***

End of  
2006







**2006**

The CAFC applies a **VERY FLEXIBLE TSM** test

April  
2007

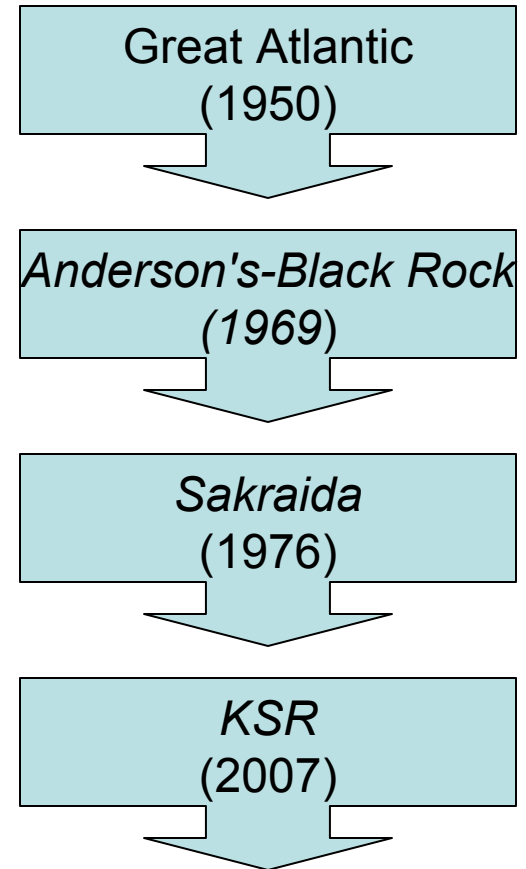
# The KSR Case: The Supreme Court brings *Synergy* Back



***An aggregation of old  
elements combined with  
known methods to yield  
predictable results***

=

**“likely OBVIOUS”**



**The TSM test does not seem to be required**

April  
2007

## The Supreme Court and the TSM Test

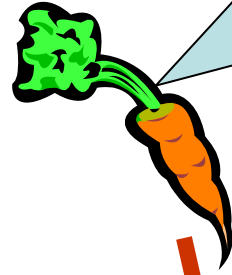
In “*other cases*,” the TSM test is a “*helpful insight*” if applied *with flexibility*

For such cases, it is necessary to determine whether there was an “*apparent reason to combine*” the known elements in the claimed fashion.

April  
2007

# The *NEW* flexible TSM Test

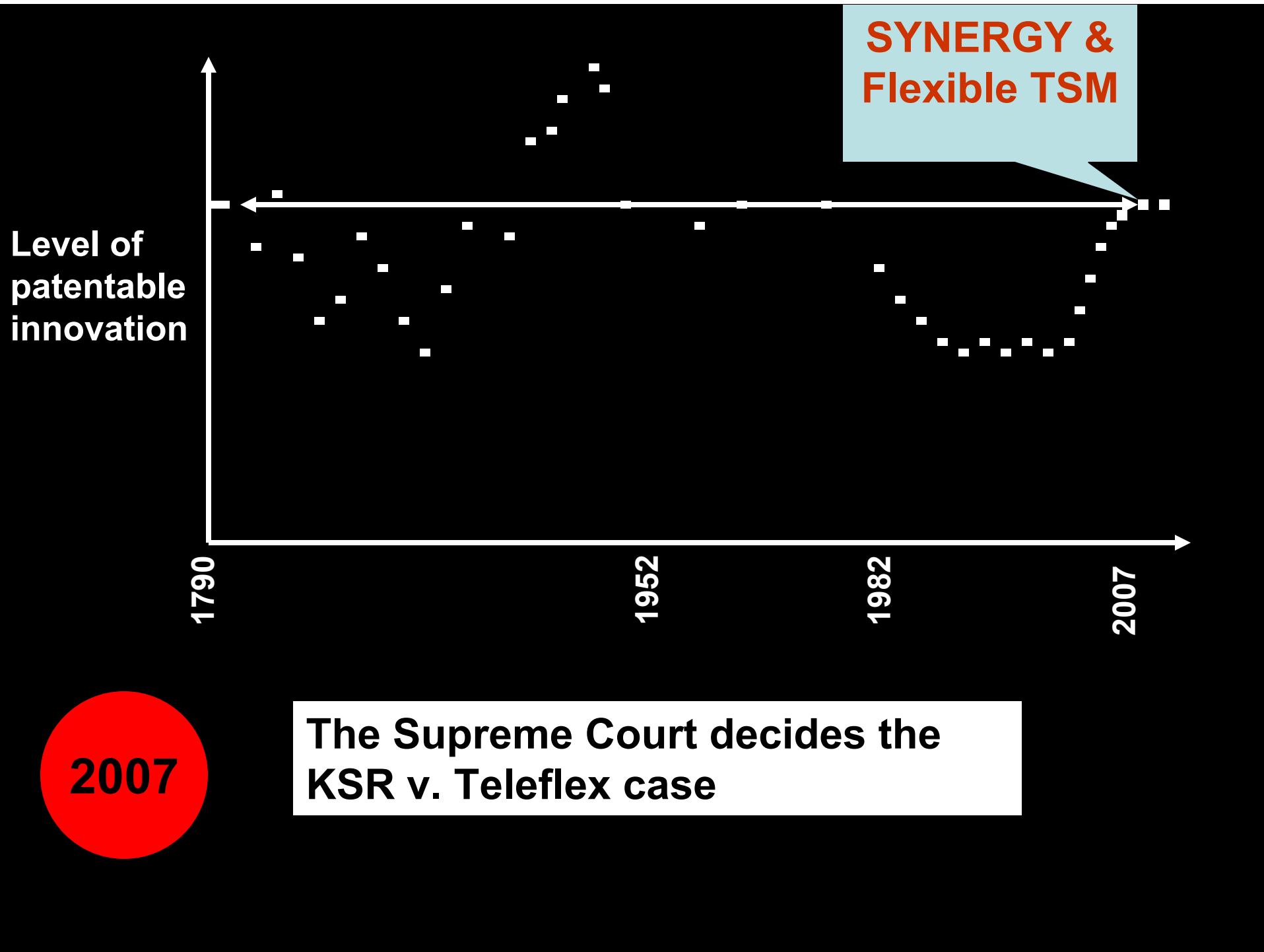
The reason to combine can be inferred from “*any need or problem known*” in the prior art



“market demand” and “a finite number of identified, predictable solutions” can make a combination “*obvious to try*”

PHOSITA *can*:  
1) use *common sense*,  
2) *be creative*





**SYNERGY & Flexible TSM**

Level of patentable innovation

1790

1952

1982

2007

**2007**

The Supreme Court decides the KSR v. Teleflex case

# The KSR effects

## 1) Harder to obtain US patents for certain inventions:

In 2007, the USPTO Board of Appeals published three important decisions based on the KSR decision

Ex parte Smith

Ex parte Kubin

Ex parte Catan

**Unpatentable  
as being obvious**

In October 2007, the USPTO published new Examination Guidelines based on the KSR decision

## 2) Easier to invalidate US patents for certain inventions:

Leapfrog v. Fisher-Price (Fed. Cir. 2007)

Pfizer v. Apotex (Fed. Cir. 2007)

Aventis v. Lupin (Fed. Cir. 2007)

**Invalid  
as being obvious**

# The new USPTO Examination Guidelines for Obviousness in view of KSR

**The new guidelines identify *seven* different “rational” for concluding obviousness:**

**1) Combining prior art elements according to known methods to yield *predictable* results**

**Example: A paving machine with combined known elements onto a single chassis**

**“The *convenience* of putting known elements together is not enough”**

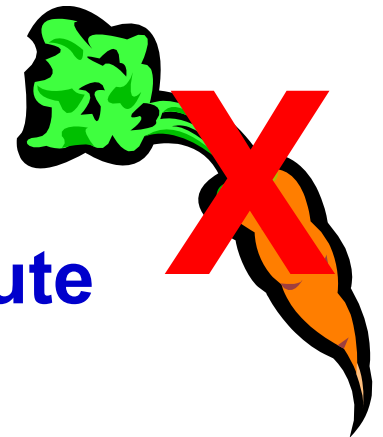


# The new USPTO Examination Guidelines for Obviousness in view of KSR

## 2) Substitution of one known element/step for another to obtain *predictable* results

**Example: A method of decaffeinating coffee using a (known) distillation step instead of the water extraction step used in the known method of decaffeinating coffee**

**“Obviousness does not require absolute predictability of success”**





# The new USPTO Examination Guidelines for Obviousness in view of KSR

## 3) Use of a known technique to improve *similar* devices in the *same way*

The Examiner must show that

- a) a “base” device was known;
- b) it was known to improve a device “comparable” to the base device with the claimed technique; and
- c) one *could apply* the known improvement to the base device



# The new USPTO Examination Guidelines for Obviousness in view of KSR

**4) Applying a known technique to a known device *ready for improvement* to yield predictable results**



# The new USPTO Examination Guidelines for Obviousness in view of KSR

**5) “Obvious to try”:** choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success



# The new USPTO Examination Guidelines for Obviousness in view of KSR

**6) Known work in one field of endeavor may prompt variations of it for use in the same field or a different field**

**Newer technology in one field (electronics, computers, communication networks, etc...) used on old devices of another field (banking, toys, automotive, etc...)**

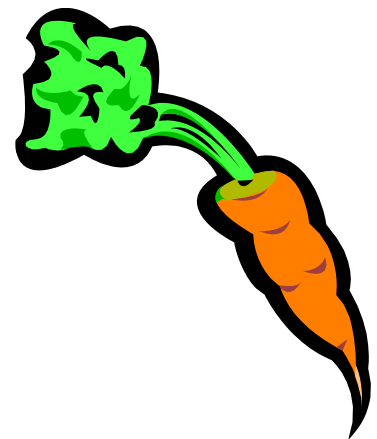


# The new USPTO Examination Guidelines for Obviousness in view of KSR

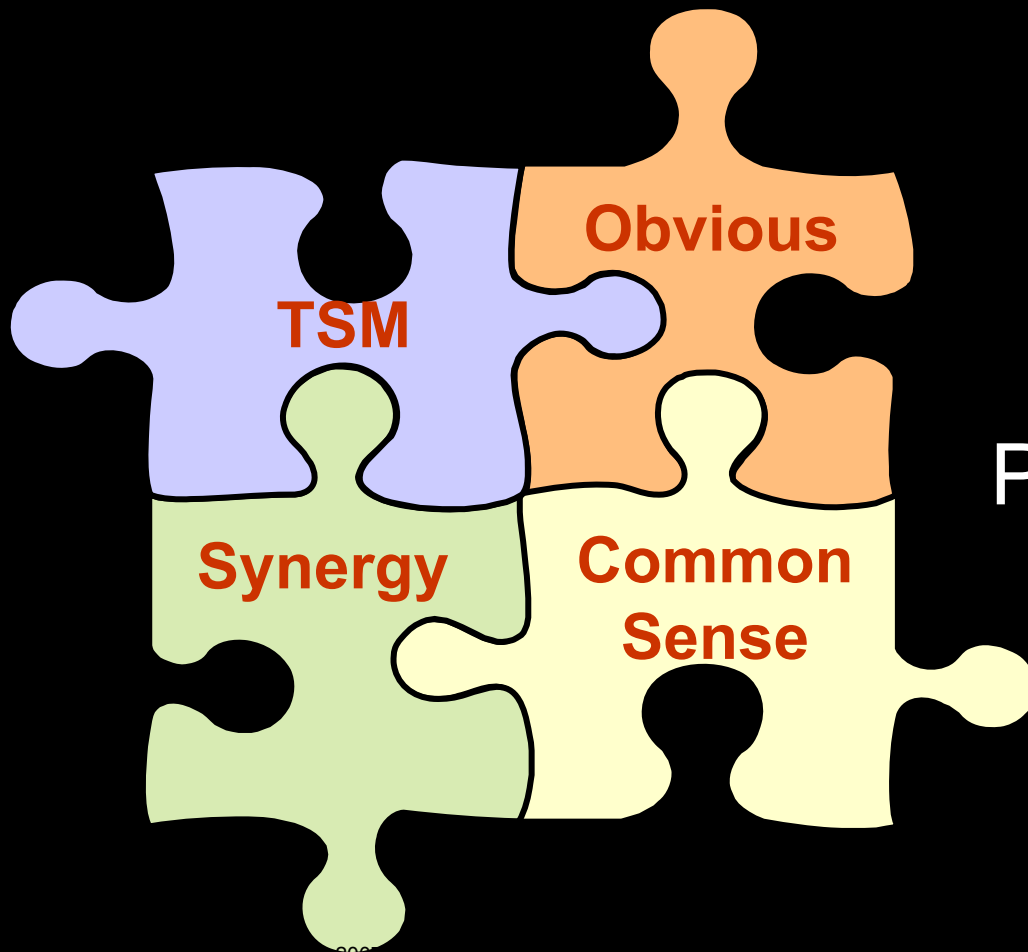
## **7) The flexible TSM test:**

**Absence of a motivation to combine does not help the applicant**

**Presence of a motivation helps the Examiner**



**-KSR-  
REVISITING THE  
OBVIOUSNESS PUZZLE**



**THANK YOU**

**PHILIPPE SIGNORE**

October 2007



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