

Has the Bar Been Moved Higher?: Obviousness in Patent Law

In order to receive patent protection in the United States, an invention must be novel, have utility, and not be “obvious.” In April 2007, in deciding the case of *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the U.S. Supreme Court held that the U.S. Court of Appeals for the Federal Circuit had to adjust the analytical approach used when determining the obviousness of an invention. The Court did not change the test used for the obviousness inquiry; rather, the decision simply reinforced the proper way to apply the test. This decision is highly relevant to the patentability of currently pending applications and future new applications, because the examination guidelines used by the patent examiners are guided largely by decisions made by the Federal Circuit and the Supreme Court. In addition, this decision could affect the enforceability of currently valid patents if any such patent was granted on the basis of the improper “rigid” approach of applying the test to determine obviousness.



As a practical consequence, the Court’s “expansive and flexible” approach to the test will result in more findings of claimed inventions being obvious as compared to the “rigid” approach.

The obviousness inquiry is guided by the Federal Circuit’s teaching, suggestion, and motivation (TSM) test. Under the TSM test, a patent claim is obvious when “some motivation or suggestion to combine the prior art teachings can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art.”

The Court’s decision confirmed that the TSM test remains good law, but the ruling clarified that “an expansive and flexible” type of approach is to be used when applying the test. According to the Court, proper application of the TSM test should prohibit patents from being issued “without real innovation,” because “the results of ordinary innovation are not the subject of exclusive rights under the patent laws.”

The validity of an issued patent may be attacked on the basis of an obviousness argument. In *Graham v. John Deere*, the Supreme Court instructed courts weighing challenges to obviousness to look to the scope and content of prior art, the differences between prior

art and the claim at issue, the level of ordinary skill in the pertinent art, and, if relevant, secondary considerations of commercial success, including long-felt but unresolved needs and the failure of others. *KSR*, 127 S. Ct. 1727, 1734 (2007). The TSM test recognizes the fact that every invention is, in some sense, a combination of known elements, and the test seeks to prevent hindsight bias that might cause a fact finder to read the claimed invention into the prior art teachings. The Federal Circuit recently had an opportunity to apply the guidance provided in the *KSR* ruling.

On May 9, 2007, the Federal Circuit agreed with the lower court that claim 25 of Leapfrog Enterprises’ patent for a children’s learning device was invalid on grounds of obviousness. *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 06-1402, 2007 WL 1345333 (Fed. Cir. 2007). In upholding the lower court’s finding that the claimed device was obvious, the Federal Circuit employed the flexible analysis recently mandated by *KSR*. The claimed device included a housing of switches activated by push buttons that depicted letters of the alphabet. In use, when buttons were pressed, the claimed device produced the sounds of the phonemes associated with the letters on the buttons. The court found that the claimed device was essentially a combination of two pieces of prior art: an older design that accomplished the same function as the claimed device by using an electric motor and mechanical structures; and a more recent device that, like the claimed device, used electronics but performed a slightly different function. The Federal Circuit agreed with the lower court that an individual who has ordinary skill in the art of learning toys for children would have found it obvious to combine the function of the prior art devices to enjoy the benefits provided by contemporary electronic components. Finally, the claimed device did contain one element, a reader, that the two pieces of prior art did not. The court, citing *KSR*, stated that using a reader in this type of device was not “uniquely challenging or difficult for one of ordinary skill in the art.” Accordingly, the court agreed that the patent claim was invalid because of its obviousness in light of the combination of the prior art and the knowledge that one of ordinary skill in the art possesses. TFL

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