

SPECIAL ALERT

U.S. Supreme Court Broadens “Obviousness” Patentability Bar

The United States Supreme Court has issued a decision that some commentators believe may make it more difficult to obtain new patents and easier to challenge existing patents.

Federal patent law states that a patent shall not issue if "the differences between the [invention] and the prior art are...obvious...to a person having ordinary skill in the art..."¹

In 1966, the Supreme Court set forth a factual inquiry (Graham inquiry) for applying “obviousness” that addressed: scope and content of pertinent prior art; differences between prior art and the claimed invention; level of ordinary skill in the art at time of invention; and evidence of secondary considerations such as the invention’s commercial success, long felt needs solved by the invention, and prior failure to achieve the invention’s results.²

The Federal Circuit Court further narrowed “obviousness” with a “teaching, suggestion, or motivation” (TSM) test requiring the prior art, the problem’s nature, or the knowledge of a person having ordinary skill in the art reveal some suggestion or motivation to combine the teachings of the prior art.

The question of applying “obviousness” to challenge patent validity has now come before the Supreme Court again.³ In this case, a company accused of infringing a patent claim, countered that the claim was invalid as obvious. The District Court applied both the Graham inquiry and TSM test to find "little difference" between the claim and combined prior art teachings. The Federal Circuit Court reversed for failure to interpret the TSM test strictly enough.

On April 30, 2007, a unanimous Supreme Court rejected the Federal Circuit’s strict application of the TSM test as too narrow and rigid, supported the Graham inquiry, and further expanded the analysis of “obviousness” to include consideration of the changing demands of the marketplace and the progressive increase of total knowledge in an art.

Commentators have expressed fears that the Supreme Court’s latest decision may open the doors to more extensive “obviousness” challenges to validity and enforceability of currently existing patents. By the same token, surviving the broadened “obviousness” hurdle will likely enhance both the validity and enforceability of patents prosecuted subsequent to this decision.

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¹ 35 USC § 103; www.uspto.gov/web/offices/pac/mpep/documents/appx1_35_U_S_C_103.htm

² *Graham v. John Deere Co.*, 383 U.S. 1 (1966);

http://cyber.law.harvard.edu/ilaw/BMP/graham_v_john_deere.html

³ *KSR Int'l v. Teleflex, Inc.*, 550 U.S. ____ (2007); www.supremecourtus.gov/opinions/06pdf/04-1350.pdf