

# What KSR did and did not change about the law of patent obviousness

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In its landmark 2007 *KSR v Teleflex* decision, the Supreme Court rejected the rigid application of the “teaching, suggestion or motivation” test for patent obviousness, unquestionably lowering the standards that infringers must meet to challenge the validity of patents. While *KSR* has been recognized for bringing about a major shift in the law of obviousness, three aspects of the decision merit a more nuanced analysis, and suggest ways in which patentees can continue to safeguard their interests after *KSR*.

## TSM remains a useful test of obviousness

*KSR* did not abolish TSM, it simply held that TSM cannot be so rigidly applied to deny the existence of ordinary creativity and common sense. Under TSM, as applied by the Federal Circuit in its decision, an invention is obvious only if the prior art contains a teaching, suggestion or motivation that would have led a person of ordinary skill to have made the invention. As the test is traditionally described, the prior art in which the requisite teaching, suggestion or motivation can be found includes not only written references such as patents and publications, but also the knowledge of the person of ordinary skill and the nature of the problem solved by the invention. However, as a practical matter, courts before *KSR* chose largely to focus their obviousness inquiries upon patents and publications.

In *KSR*, the Supreme Court was careful to note there was no “necessary inconsistency” between TSM and the broader obviousness analysis set forth in its 1966 *Graham* ruling. Indeed, the *KSR* decision acknowledged TSM can be a “helpful insight” in avoiding hindsight and requiring that there be some plausible motivation that would have led one of ordinary skill to the patented invention. *KSR* simply mandated flexibility and reminded courts that the scope of the prior art need not be limited to art that addresses the specific problem the inventors had in mind, and the requisite motivation for the invention need not originate from the words of the written references, but instead can arise from the application of common sense to an apparent market or design need. As explained by *KSR*, persons of ordinary skill are not automatons, but persons of “ordinary creativity,” with the capacity to appreciate obvious uses of familiar items, and combine those items to solve obvious problems.

While *KSR* rejects the rigid application of TSM, the reasoning displayed *KSR* nevertheless resembles a traditional TSM analysis insofar as it relies primarily on the express teachings of written references. *KSR* did not eliminate TSM so much as permitted its limited supplementation. And decisions after *KSR* have continued to take advantage of the analytical logic afforded by the TSM framework.

## “Obvious To Try” Did Not Become The New Standard For Obviousness

Before *KSR*, it was well-established that “obvious to try” was not the proper standard for determining obviousness. The logic behind this principle is as follows: most, if not all, inventions can be characterized as a combination of prior art elements assembled to address a particular technological problem. Given sufficient time and resources, a person of ordinary skill seeking to solve the problem would be able to try all possible prior art combinations, including the patented combination. If “obvious to try” were the true measure of

obviousness, brute-force drudgery would trump inspiration, and virtually all patents would be obvious. Accordingly, to be obvious, an invention must not merely be “obvious to try”; the prior art also must lead one of ordinary skill to make the invention with a reasonable expectation of success.

Contrary to some expressed beliefs, *KSR* did not make “obvious to try” the new standard for obviousness. *KSR* instead held that an “obvious to try” invention may be obvious if at least three other conditions are met: there is a design need or market pressure to solve a particular problem; there are a finite number of foreseeable solutions to the problem; and the result obtained is reasonably predictable. In essence, *KSR* re-confirmed the principle that “obvious to try” alone is insufficient to demonstrate obviousness. What it explained is that, while “obvious to try” is not alone sufficient for a finding of obviousness, it may be a viable starting point which, when supplemented by the other three desiderata, will carry the day.

After *KSR*, one would assume that patents concerning relatively “unpredictable” technologies, such as pharmaceuticals and biotechnology, would be relatively safe from being found obvious. However, courts have relied on *KSR* to invalidate some of these patents based upon findings that there were a finite number of possible choices leading to the invention, making and testing those choices was routine experimentation, and most importantly the results obtained were reasonably predictable. This growing body of post-*KSR* law cautions patentees in all fields to be proactive about documenting and preserving proof of the unpredictability of their work well before the start of any patent litigation. In terms of rebutting charges of obviousness under *KSR*, evidence of experimental failures and dead ends may well be as important as proof of technological and commercial success.

## The burden of proof remains clear and convincing – for now

Least remarked upon – but perhaps most deserving of comment – is the doubt that *KSR* casts upon the long-standing requirement that obviousness must always be shown by clear and convincing evidence, rather than by a mere preponderance of evidence. The justification for this heightened burden of proof rests upon the legal presumption that the Patent and Trademark Office properly determines whether or not an invention is obvious in view of the prior art before it, and that any patent issued by the PTO accordingly is valid. However, one could reasonably question whether the presumption of validity and the clear and convincing burden and should apply in instances where, as in *KSR*, the evidence of obviousness was never before the PTO.

While the Supreme Court expressly declined to address whether or not the presumption of validity should apply in those circumstances, it did note in passing that the rationale underlying the presumption – that the PTO correctly issued the patent – “seems much diminished here.” In the year and a half since *KSR* was decided, lower courts have generally ignored this aspect of the *KSR* decision, and have continued to apply the presumption of validity and the clear and convincing burden even when the proffered proof of obviousness was not previously before the PTO. However, in view of *KSR*’s clearly expressed skepticism about the logic underpinning that practice, it remains to be seen whether it may soon take another case to address it.