



KSR



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KSR

- First – and only – Supreme Court holding on standard of obviousness in 30+ years (since 1976 *Sakraida* barn flushing case)
- Next Supreme Court restatement of obviousness principles unlikely for several years (at least)



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KSR – “No Change” for Some Cases

KSR ... would not lead to ‘great changes’ in the way the Federal Circuit looks at obviousness. ... [T]he judgment in the first CAFC decision on obviousness post-KSR [first drafted before KSR,] ‘did not require one iota of change’.”

-- Joff Wild, *IAM Magazine*, May 21, 2007 (quoting Circuit Judge Rader)



KSR

“A person of ordinary skill is ... a person of *ordinary creativity*...

[H]e not an automaton.” – KSR



How *Smart* is the Skilled Worker?

A Smarter Skilled Worker
=
A Higher Standard of Patentability



KSR Obviousness – Other Uses

- “Common sense teaches... that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” – *KSR*



“Obvious to Try” (I) – *Reasons to Try*

- “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, [PHOSITA] has good reason to pursue the known options within his or her technical grasp....” – *KSR*



“Obvious to Try” (II) – *Reasons....*

Reasons Lead to Obviousness

- If this [design need or market pressure] leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. ...[T]he fact that a combination was obvious to try might show that it was obvious under § 03.” – *KSR*



What does Worker Really Know?

- Presumption favors Examiner's interpretation
- Fact-based Expert Opinions Establish Skill Level
- "Substantial evidence" Test at the Court



KSR: Problem Creates a *Reason*

- "[A]ny ... ***problem*** known in the field ... at the time of invention and [met] by the patent can ***provide a reason for combining the elements*** in the manner claimed." – KSR



KSR: Known Problem... “Obvious to Try”

- “[A] patent's subject matter can be proved obvious ... by noting that there existed at the time of invention *a known problem* for which there was an obvious solution encompassed by the patent's claims.” – KSR



KSR Identifying a Problem = Obviousness

- “Problem”/ “Solution” in the Specification: *Unnecessary* under U.S. Law
- “Problem” should *not* be Stated in U.S. Spec.
- Disparity from International Practice