

**May 13, 2005**

**[Supreme Court: Patent Professors Support Tighter Obviousness Standard](#)**

*KSR International v. Teleflex* (On Petition for Certiorari)

In January 2005, the CAFC decided *Teleflex v. KSR* — holding that there must be a suggestion or motivation to combining two or more references in an obviousness finding. This “*teaching-suggestion-motivation test*” has been a stalwart of Federal Circuit obviousness jurisprudence for twenty years. During that time, the Supreme Court has not heard a single obviousness case.

KSR has petitioned the Supreme Court for a writ of certiorari — arguing that the Federal Circuit’s obviousness standard is too low. In its petition, the KSR argues that the CAFC’s jurisprudence is inconsistent with the Supreme Court’s most recent obviousness decisions of *Anderson’s-Black Rock* (1969) and *Sakraida* (1976). In *Sakraida*, the High Court held that a combination which only unites old elements with no change in their respective functions is precluded from patentability under 103(a). Under the *Sakraida* standard, the Teleflex patent is arguably obvious. Although patent cases are rarely heard by other circuit appellate courts, a circuit split remains between the CAFC and several other circuits on this issue.

Two *amicus curiae* briefs have been filed in support of the petition for certiorari. An element of both briefs is that *written* proof of obviousness should not be required to prove basic knowledge or common sense.

**I. Brief of Twenty-Four Law Professors:**

An impressive group of law professors have banded together in support of KSR. The professors argue that the CAFC has essentially ignored the idea of a person having ordinary skill in the art (PHOSITA) and simply consults the scope and content of the prior art references. At best, the appellate court has relegated the PHOSITA to the role of a “reference librarian, assisting in locating appropriate prior art references but apparently incapable of applying them in light of his or her knowledge or skill.”

The brief notes that this case is a good one for cert: simple technologies, procedurally clean, and experienced counsel for both sides.

The twenty-four professors include [Robert Brauneis](#), [Katherine Strandburg](#), [Margo Bagley](#), [James Bessen](#), [Michael A. Carrier](#), [Rochelle Cooper Dreyfuss](#), [Christine Haight Farley](#), [Cynthia M. Ho](#), [Timothy R. Holbrook](#), [Peter Jaszi](#), [Jay P. Kesan](#), [Mark A. Lemley](#), [Glynn S. Lunney, Jr.](#), [Ronald J. Mann](#), [Robert P. Merges](#), [Kimberly A. Moore](#), [Janice M. Mueller](#), [Joseph Scott Miller](#), [Craig A. Nard](#), [Malla Pollack](#), [Arti K. Rai](#), [Pamela Samuelson](#), [Joshua Sarnoff](#), and [John R. Thomas](#). Of course, [John F. Duffy](#) would be twenty-five, but he already signed on to the original KSR petition.

Download the Professor’s Brief: [KSR Amicus 24 Professors.pdf \(276 KB\)](#).

## II. Brief of the Progress & Freedom Foundation:

[PFF](#)'s brief focuses on the “growing unease about patent quality” as a justification for tightening the standards for obviousness. According to the brief, a loose obviousness standard undermines the basic justification for the patent system and encourages people to hamstring the system.

Download the PFF Brief: [ProgressFreedomFoundation.pdf \(206 KB\)](#)

## III. FILES:

- [KSR Petition for Cert \(760 KB\)](#) (Including CAFC and District Court decisions in Appx);
- [24 Professors in support of petition.pdf \(276 KB\)](#);
- [Progress Freedom Foundation in support of petition.pdf \(206 KB\)](#);
- [Animation of the subject matter of the invention](#). Prepared by [Demonstratives, Inc.](#) of Ames Iowa.

## IV. Links:

- [Patently-O Prior Discussion of the CAFC decision](#).
- European Attorney Axel Horns hopes that this case may spark a similar debate in Europe over the could/would approach of the EPO.[\[Article\]](#).
- Ernest Miller has thrown his hat in support of the petition — although he just wants a nice precedential opinion. [\[Blink\]](#).

## V. Misc:

One question that I asked Professor Brauneis is whether increasing the obviousness standard would disproportionately affect small businesses and individual inventors who may be more likely to invent through by combining well known items in a novel fashion. In reply, Brauneis noted that while corporate researchers may have more resources to invent from whole-cloth, corporate law departments also have more resources to file dubious patent applications for strategic purposes. For Brauneis and the 24-professors, the bottom line is that “if the claim in the patent application describes something that would be obvious to a person having ordinary skill in the art, it's bad policy to grant the patent.

For those interested in this issue, there is still time to file with the Court.