

The IPcentral Weblog

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KSR v. Teleflex--preliminary thoughts.

So, now cert. has been granted, and everyone will be thinking about obviousness. Including us, as we think about when and whether to file another brief.

KSR v. Teleflex raises the issue of whether to disqualify a patent claim as "obvious" an examiner needs to find a written "suggestion or motivation" in the prior art.

This is a tremendously complex problem. The patent office is flooded with claims, some of which (no one knows how many) ought to be rejected, and some of which ought not to be rejected, and many of which are rejected *but not for the reasons that they ought to be rejected for*. In spite of this vast numbers of patents are granted, many of which then sit around and do nothing, and very few of which end up in dispute, and even fewer of which end up in litigation. At which point the Federal Circuit may get involved, and as a corrective to things that are going wrong at the patent office, establishes assorted presumptions, rules of thumb, and so on, which strike me as being awfully wooden. Evidently the Supreme Court thought so to, in *eBay v. MercExchange*, although their corrective

erred pretty far in the other direction, being watery rather than wooden. But the Supreme Court can't tinker with any part of the system without affecting all the other parts. Only Congress can do that. But Congress doesn't seem to have the will to do anything; furthermore arguably the underlying *statute* is fine, and in any case there is the fact that in spite of these layers and layers of practical and conceptual problems, the system is working reasonably well for pharma and biotech, so one doesn't want to mess that up while fixing the problems that supposedly (this is disputed) are more overwhelming for computers and software. Oh, and no one knows how to measure any of this. In spite of which everyone is going to talk a lot about costs and benefits.

So, the obviousness standard. The patent bar likes an objective test such as the "suggestion" test, to protect claimants from overly imaginative examiners. The insights of a PHOSITA (person having ordinary skill in the art) would supply such a test but aren't available to the patent office due to conflicts of interest. The more subjective standard takes us back to older precedents (flash of genius!) that no one likes. The Supreme Court's opinion in *eBay v. Mercexchange* suggests that the Supreme Court has little respect for the complexity of this problem or for the need for certainty. I'm not certain if it is just that the issue is too much to absorb all at one time, or if there is a role of judicial philosophy here--more wooden looking-just-at-the-patent-statute and nothing else. If the Supreme Court just rejects the Federal Circuit test but comes up with nothing to put in its place, rather as they did in *eBay*, well, that isn't good.

Realistically, the options for the Supreme Court will be:

To affirm the Federal Circuit's "suggestion" test.

To get rid of the "suggestion" test and just say "that wasn't what Congress intended." And leave Congress or the Federal Circuit or the PTO to come up with another solution to the hindsight problem. Ugh.

To tell the Federal Circuit that it needs to revive consideration of what a PHOSITA would think, but give them no indication of how to solve the problem of access to a PHOSITA.

To adopt something like the EU Standard of obviousness, or the U.K. standard.

Any thoughts? Other options?