

[KSR International v. Teleflex](#)

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In a follow-up to my [discussion on the Alza case](#), it is important to note that the U.S. Supreme Court agreed to review an appeal of a key patent case that could set a standard for when an invention is obvious. The Court has taken up the appeal by KSR International Inc., a Canadian manufacturer of gasoline pedals for cars and light trucks, arguing that a patent held by a rival manufacturer is invalid because it was obvious at the time it was patented.

In *Teleflex Inc. v. KSR Intern. Co.* (Fed. Cir. 2005), the CAFC held that when combining two or more references in an obviousness finding, there must be a suggestion or motivation to combine the teachings. This “teaching-suggestion-motivation test” has been applied by the Federal Circuit in hundreds of cases since set out in 1985. The Federal Circuit applies this test even where a patent claims nothing more than a combination of pre-existing, off-the-shelf components in which each component performs exactly the same function that it had been known and was designed to perform.

In *KSR*, the Federal Circuit held that the prior art did not render the claimed invention unpatentable because they had not proven, beyond genuine dispute and by clear and convincing evidence, that there was a suggestion or motivation to combine the teachings of the prior art in the particular manner claimed by the patent at issue ([U.S. Patent No. 6,237,565](#)).

Now, the Supreme Court has granted cert in *KSR Intern. Co. v. Teleflex Inc.*, Supreme Court No. 04-1350. In its Petition For A Writ Of Certiorari, KSR presented the following question:

Whether the Federal Circuit has erred in holding that a claimed invention cannot be held obvious, and thus unpatentable under 35 U.S.C. § 103(a), in the absence of some proven “teaching, suggestion, or motivation” that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed.”

This case raises a question of broad and general importance: What is the proper interpretation of the patentability standard set forth in § 103 of the Patent Act? The answer to this question affects every pending U.S. patent application, every issued U.S. patent, and every U.S. federal court challenge to the validity of a patent.

Section 103 was first enacted in 1952; it provides that a patent cannot issue on subject matter that would have been “obvious” to a hypothetical “person having ordinary skill in the art” or [PHOSITA](#). Four factual inquiries underlie an evaluation of obviousness: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any other objective indicia of non-obviousness, such as commercial success of the claimed invention, long felt but unmet need.

KSR argues that under the Supreme Court’s interpretation of § 103, a combination of pre-existing elements does not constitute an “invention”, and does not meet the “condition for

patentability” specified in § 103(a), if each element in the claimed combination does nothing more than what it was previously known or designed to do. They argue that the Federal Circuit’s interpretation of § 103 is wrong in holding that a combination of pre-existing elements will always constitute an “invention”, and will always meet the “condition for patentability” specified in § 103, unless there is proven “some ‘suggestion, teaching, or motivation’ that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed.” They argue that the “teaching-suggestion-motivation test” has no basis in the text of § 103 or in any decision of the Supreme Court.

It seems *Alza* was the Federal Circuit’s attempt to shore up its reasoning behind the test with their statement that obviousness is a question of law, reviewed de novo, based upon underlying factual questions while the presence or absence of a motivation to combine references in an obviousness determination is a question of fact.

This is of particular importance to pharmaceutical and biotechnology research-based companies who are against any change to the test (and might make it difficult to patent known drugs for new uses).