Determining Obviousness under 35 USC 103 in view of KSR International Co. v. Teleflex
KSR v. Teleflex Guidelines

- See also MPEP 2141, Eight Edition, Revision 6 (September 2007).
KSR v. Teleflex Guidelines

- In KSR, the Supreme Court:
  - Reaffirmed the obviousness test established in Graham v. Deere
  - Stated that the Federal Circuit had erred by applying the “teaching-suggestion-motivation” (TSM) test in a rigid and formalistic way
KSR v. Teleflex 82 USPQ2d 1385

● The basic Factual Inquiries of Graham v. John Deere:
  - Determining the scope and content of the prior art;
  - Ascertaining the difference between the claimed invention and the prior art; and
  - Resolving the level of ordinary skill in the pertinent art.
The question of obviousness must be resolved on factual determinations.

The Examiner fulfills the critical role of fact finder.

The Examiner must ensure that the written record includes finding of fact concerning the state of the art and the teachings of the references applied.
Once the finding of facts is articulated, the examiner must provide an explanation to support an obviousness rejection under 35 USC 103.

This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense.
In many fields it may be that there is little discussion of obvious techniques or combinations, and it may be the case of market demand, rather than literature, will drive design trends.

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art references need not teach or suggest all the claim limitations.

- **However** Examiners **must explain** why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.
In determining obviousness, neither the particular motivation to make the claimed invention nor the problem the inventor is trying to solve controls.

The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.

Factors other than the disclosure of the prior art may provide the basis for concluding that it would have been obvious.
Graham v. John Deere Test Tips

- Determining the scope and content of the prior art:
  - The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed. (MPEP 904.02)
  - Examiners should continue to follow the general search guidelines set forth in section 904 to 904.03 of the MPEP.
  - Prior art can either be in the field of applicant’s endeavor or be reasonably pertinent to the particular problem with which the applicant was concerned.
  - Prior art that is in a field of endeavor other than that of the applicant or solves a problem which is different from that which the applicant was trying to solve should also be considered for the purpose of 35 USC 103.
Ascertaining the differences between the claimed invention and the prior art.

- Ascertaining these differences between the claimed invention and the prior art requires interpreting the claim language and considering both the invention and the prior art as a whole. (MPEP 2141.02)
Graham v. John Deere Test Tips

- Resolving the level of ordinary skill in the art.
  - In many cases, a person of ordinary skill in the art will be able to fit the teachings of multiple disclosures together like a piece of a puzzle.
  - In addition, Examiners may rely on their own technical expertise to describe the knowledge and skills of a person of ordinary skill in the art.
Graham v. John Deere Test Tips

- If after going through the Graham factual analysis, the examiner concludes that the teaching-suggestion motivation rationale (TSM) is still applicable, then a rejection using TSM can still be made.
  - TSM is still valid but it is not the only rationale to support a conclusion of obviousness under 35 USC 103 when employing the Graham analysis.
- The examiner must also consider one or more of the following rationales set forth below.
A – Combining Prior Art Elements According to Known Methods

- See pages 2-5 of the Handout.
- The keys to rationale A:
  - The elements are all known but not combined as claimed.
  - The technical ability exists to combine the elements as claimed and the results of the combination are predictable.
  - When combined, the elements perform the same function as they did separately.
B – Simple Substitution of One Known Element for Another

- See pages 6-8 of the Handout.
- The keys to rationale B:
  - The prior art differs from the claim by the substitution of some components.
  - The substituted components were known.
  - The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.
C – Use of Known Technique to Improve Similar Art in Same Way

- See pages 9-12 of the Handout.
- The keys to rationale C:
  - Claimed invention has an “improvement” over a base device (or method, product) taught in a reference.
  - The prior art also teaches a “comparable device” improved in the same way.
  - The technical ability existed to improve the base device in the same way and the result of the improvement is predictable.
D – Applying Known Technique to Known Art Ready for Improvement

- See pages 13-17 of the Handout.
- The keys to rationale D:
  - Similar to rationale C, but broader.
  - Claimed invention has an “improvement” over a base device (or method, product) taught in a reference.
  - The prior art teaches a known technique that is applicable to the base device.
  - Those in the art would have recognized applying the known technique would have yielded an improvement and was predictable.
E – Obvious to Try Among a Finite Number of Identified Solutions

- See pages 18-20 of the Handout.
- The keys to rationale E:
  - Recognized problem or need in the art including market pressure or design need.
  - Finite number of identified predictable solutions.
  - Those in the art could have pursued known solutions with reasonable expectation of success.
F – Design Incentives or Market Forces Prompting Variations

- See pages 21-23 of the Handout.
- The keys to rationale F:
  - The prior art teaches a base device (or method, product) similar or analogous to the claims.
  - Design incentives or market forces would have prompted change to the base device.
  - Known variations or principles would meet the difference between the claimed invention and the prior art and the implementation would have been predictable.
G – Teaching, Suggestion or Motivation to Combine

- See pages 24-27 of the Handout.
- The keys to rationale G:
  - This is the familiar “motivation” rejection where a teaching, suggestion or motivation to combine appears either in the references or in the knowledge generally available to one of ordinary skill.
Allowing in a Post-KSR World

- While KSR may provide strong support for obviousness rejections, claims will still be allowable because:
  - Insufficient facts, or a persuasive showing by applicant countering one or more findings of fact.
  - Consider:
    - Have the claims been given their broadest reasonable interpretation? Is there a special definition?
    - Is there confidence in the search? Did you search for the missing feature by itself?
    - Have the references been properly interpreted and considered for common sense conclusions and what they would teach to those in the art?
Allowing in a Post-KSR World

• …claims can be allowable because (cont’d):
  – Secondary considerations, e.g. commercial success, long felt need, and unexpected results.
    • Recall that the KSR rationales rely on “predictable results” or an “expectation of success”. Secondary considerations may be used to address this.
    • See MPEP 716 through 716.04 for tips on evaluating the persuasiveness of secondary considerations.
    • Further training on 132 affidavit practice coming soon.
Allowing in a Post-KSR World

- ...claims can be allowable because (cont’d):
  - Claimed elements could not have been combined by known methods.
    - E.g. due to technological difficulties. This is different from “would not” have been combined because of a lack of motivation.
    - Arguments concerning “teaching away” and “destroying the teachings” can apply, but be careful.
      - See MPEP 2145 Section X. D. “References Teach Away from the Invention or Render Prior Art Unsatisfactory for Intended Purpose”, as well as MPEP 2141.02 and 2143.01.
Allowing in a Post-KSR World

...claims can be allowable because (cont’d):

- Claimed elements could not have been combined by known methods.
  - Arguments concerning “hindsight” can still apply, but be careful.
    - See MPEP 2145 Section X. A. “Impermissible Hindsight”. A hindsight argument would have to overcome the findings of fact and conclusions expressed in the rationales.
  - Arguments concerning “expectation of success” can still apply, but be careful.
    - See MPEP 2143.02 “Reasonable Expectation of Success is Required”. “Expectation of Success” can be a factor in unpredictable arts, e.g. some chemical areas, but the electrical arts are more predictable and this issue would be rare.
Allowing in a Post-KSR World

...claims can be allowable because (cont’d):
  - Claimed elements do not merely perform the function that each element performs separately.
    - E.g. a synergistic effect, see MPEP 716.02(a), section I.

This is not an exhaustive list.

If you see an allowable feature in the spec or a dependent claim, offer it to applicant.
Allowing in a Post-KSR World

Note: Mere statement or argument by the applicant that the Office:
   – 1) has not established a prima facie case of obviousness, or
   – 2) that the Office’s reliance on common knowledge is unsupported by documentary evidence,

will not be considered a substantively adequate rebuttal or an effective traversal of the rejection.

See 37 CFR 1.111(b).
THE END