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Supreme Court/Patents/Obviousness

AIPLA Amicus Brief Argues Obviousness Analysis Must Fend Off Hindsight

KSR International, Co. v. Teleflex, Inc., U.S., No. 04-1350, brief filed 10/12/06.

AIPLA on October 12, 2006, filed an amicus brief in the Supreme Court, urging that proof of obviousness for a combination patent continue to fend off hindsight analysis by requiring evidence of a reason to make the claimed combination that would have been recognized by a person of ordinary skill in the art at the time the invention was made.

The brief argues that the current, well-defined analytical framework, which looks for a reason in some teaching, suggestion, or motivation to make the combination, is of vital import to the patent system and draws upon principles found in Supreme Court case law. Patentability, according to the brief, does not turn on whether the individual elements of an invention can be found in the prior art, but on whether one of ordinary skill would have thought it obvious to combine those elements in the manner claimed. The Petitioner's proposal would require only identification of those individual elements in the prior art, inviting a hindsight perspective and ignoring the statutory mandate that the subject matter of the invention be considered as a whole at the time it was made.

The brief also points out that Petitioner misstates Federal Circuit law as always requiring written proof that explicitly suggests the claimed invention. While some Federal Circuit decisions have occasionally required a writing, those decisions appear to be few and fact specific. As the analysis evolved, the appellate court clearly rejected a blanket requirement for a writing, according to the brief, citing *Cross Med. Prods., Inc., v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293 (Fed. Cir. 2005).

The approach now used by the Federal Circuit follows the statute and Supreme Court decisions, which have long required that proof of obviousness include a reason to combine. If there are cases that plausibly support Petitioner's position, they should not be read to require a strict writing requirement.

Background

The Supreme Court on June 26, 2006, agreed to review the Federal Circuit rule for proving patent invalidity for obviousness, which requires that the prior art teaches, suggests, or provides a motivation to make the combination claimed in a patent.

The specific question for review is as follows:

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."

The claimed invention in this case relates to an automobile accelerator pedal, claiming a combination of (i) a pre-existing type of “adjustable pedal,” and (ii) a pre-existing type of “electronic control,” with the latter being attached to the support of the former. The district court issued a summary judgment that the claim is invalid for obviousness, and in a non-precedential ruling the Federal Circuit vacated and remanded on the fact issues related to the teaching-suggestion-motivation test of obviousness.

To read the AIPLA amicus brief, click [here](#).

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