

# Stating the obvious

## Determining obviousness in the United States



To be patentable in the United States, among other things, a claimed invention should be both novel and non-obvious in view of the prior art. Proving that the invention is not obvious may be challenging, especially if the invention is of the so-called “combination” type, i.e. it is directed to a new combination of known elements.

The difficulty with prosecuting “combination” inventions in the US is mainly due to the common practice of US examiners to cite a number of documents, each disclosing only a subset of the features of the invention. This is accompanied by an assertion that the teachings of the combined documents disclose the entire invention. However, once granted, a “combination” patent can be difficult to challenge in the US courts. One reason for this is the so-called “teaching-suggestion-motivation test” (“TSM”) for determining obviousness, which has been a stalwart of the US Federal Circuit jurisprudence for twenty years. Briefly, the “TSM” test provided that a patent claim could be obvious only if there was some motivation or suggestion to combine the prior arts teachings.

This practice changed on 30 April 2007, when in *KSR International Co. v. Teleflex Inc.*, the US Supreme Court unanimously rejected the Federal Circuit’s “TSM” test for obviousness, at least in the “rigid” form in which it has been consistently applied.

The patent claim at issue involved adjustable automobile accelerator pedals and accompanying electronic sensors. In 1998 KSR began to develop one such pedal system for various automobile lines. Teleflex sued KSR for infringing one of their patents, which disclosed a pedal configuration containing a bracket-mounted, electronic pedal-position sensor. Relying on the TSM test, the District (trial) Court determined that the patent in question was obvious in light of the prior art. On appeal, however, the Federal Circuit reversed the decision, ruling that the District Court misapplied the TSM test by failing to make a specific finding as to the understanding or principle that would have prompted a skilled addressee to attach the electronic control to the support bracket.

In overruling the decision of the Federal Circuit Court in a further appeal, the Supreme Court made some important observations. First, the Court confirmed that the TSM test helps to “capture a helpful insight” by providing that a “patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. However, the Court offered important qualifications of the reasons for combining prior art. For example, it explained that “any need or problem known in the field of endeavour” may provide a reason to combine prior art elements.

The Court also asserted that inventors seeking to solve a problem may reasonably be expected to combine prior art elements other than those developed to solve that exact problem. It was noted that objects often have obvious uses beyond their primary purpose, which uses may be obvious to a skilled addressee. It was concluded that combinations including such objects should still qualify as obvious. It was further stated that a patent claim may be obvious simply because the particular combination of features of an invention was “obvious to try.”

Applying this broader interpretation of the TSM test to the particular case, the Supreme Court determined that a person having ordinary skill

in the art would have combined the prior art elements and would have appreciated the benefits of having done so. The relevant claims of Teleflex’s patent were consequently found invalid as being obvious.

The Supreme Court’s decision will likely have a significant impact on US patent practice for patents involving “combination” inventions. The decision raises the bar on non-obviousness for US patent applicants and patentees. This will likely make it more difficult to obtain US patents and to defend already granted US patents in the courts. On the other hand, a party defending against an infringement action in the US will have a powerful weapon in their arsenal.



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