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“Tip of the Month”

The KSR Decision: the Aftermath One Year Later

It has been more than a year since the U.S. Supreme Court handed down what some have called the most far-reaching patent judgment in decades. In *KSR v. Teleflex*, 127 S.Ct. 1727 (2007), the Court held a patent invalid for obviousness, even though there was no previous teaching, suggestion, or motivation to combine prior art patents to solve the particular problem that was the subject of the patent (“the TSM test”). That ruling changed the scope of protection for patents past and future, and is clearly a response to a TSM test that was rigidly applied. The court’s ruling suggests a “flexible approach.”

In post-KSR decisions of the Federal Circuit Court, the “flexible approach” suggests several alternative tests that could lead to a conclusion of invalidity by obviousness. The “flexible approach” relies heavily on the ordinary skill and knowledge of one skilled in the art and the predictability of the claimed invention when this knowledge is applied. New tests and factors include obvious to try, simple substitution of one know element for another, design need and market pressure, finite number of identified solutions, common sense, familiar elements with predictable results, etc. Trends in these post-KSR decisions shows that “obvious to try” and “predictability to one skilled in the art” are the primary rejections for a patentee to overcome.

In the post-KSR era as in the pre-KSR era, a showing of unexpected results is one of the best ways to overcome obviousness. Also, an explicit teaching away is still a useful tool to rebut a finding of obviousness. Additionally, a combination that renders one reference inoperable for its intended purpose is still a basis for finding non-obviousness.

As a result of KSR, the burden of showing nonobviousness will require more creative solutions by patent attorneys and inventors. The KSR decision may also make patents previously issued under a strict interpretation of the TSM test easier to invalidate during patent infringement litigation.

The patent attorneys at Mesmer & Deleault stand ready to assist you in developing a strategy that makes sense for your issued patents and pending patent applications. If you would like our assistance, please call us at 668-1971 or contact us through the Internet at mailbox @ biz-patlaw.com.

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