



United States Supreme Court Instructs Federal Courts to Expand Application of Obviousness Standard with *KSR v. Teleflex Decision*

On April 30, 2007, the Supreme Court handed down an opinion that will make it easier for patents to be challenged or denied on the basis that the invention in question is too obvious to deserve patent protection. The ruling may also leave the door open for existing patent holders to face new litigation over the obviousness standard.

According to United States patent law, an invention must meet the standards of being both "novel" and "non-obvious" over the prior art to be considered patentable.¹ The analysis applied in determining the obviousness of an invention has historically included the so-called "TSM" test, which stands for "teaching, suggestion, and motivation." The test is based on the logic that an invention is *obvious* if the prior art inherently teaches, suggests or motivates one to combine existing references which, when so combined, teach the newly claimed invention. In order to overcome a Patent Examiner's rejection of patent claims, or to counter a challenge against the validity of the patent in court that is based on the claim that an invention is *obvious*, patent attorneys, agents and litigators often argue that the prior art references fail to meet the "TSM" test, and that the invention therefore meets the standard of being *non-obvious*.

On April 30, 2007, the Supreme Court of the United States rendered its decision in *KSR International Co., Petitioner v. Teleflex Inc. et al.*, reversing a Federal Court of Appeals decision and upholding a lower District Court's decision that found the patent claim at issue to be *obvious* over the prior art and therefore not patentable. Using the "TSM" standard, the Court of Appeals had stated that the prior art references themselves failed to "teach, suggest or motivate" one to combine the references and upheld the patent, finding the patent claim at issue *non-obvious* and thus patentable. The invention and patent claim at issue involved vehicle accelerator peddles which were adjustable in position and included an electronic sensor mounted on a support of the peddle for signaling peddle movement to an electronic throttle.

¹ 35 U.S.C. §§ 102 and 103, respectively.



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In reversing the decision, the U.S. Supreme Court stated that the Court of Appeals applied the "TSM" test too strictly, by failing to conduct the obviousness analysis from the viewpoint of "one of ordinary skill in the pertinent art." Specifically, the Supreme Court indicated that one must view the prior art references from the perspective of "one of ordinary skill in the art," and not solely from the perspective of the inventor who, at the time of his invention, was considering but one problem to solve, among many possible problems encountered in the applicable technical field. The Supreme Court further indicated that the "teaching, suggestion and motivation" to combine the references in prior art need not come exclusively from the references themselves, but rather can be derived from a "common sense" consideration as to what "one of ordinary skill in the art" may see as beneficial to combine.

If you have any questions regarding the case described above, or would like further information, please contact Katie H. McGuire at 585.899.2936 or kmcguire@jaeckle.com, or Dennis B. Danella at 585.899.2957 or ddanella@jaeckle.com.

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