

What Standard of Inventiveness Do I Have to Meet?: The U.S. Supreme Court Issues Decision on Obviousness

In today's decision in *KSR v. Teleflex*, the Supreme Court held that the adjustable automobile accelerator pedal invention underlying Teleflex's patent was obvious, and the relevant patent claim invalid. As a general proposition, it can be bad news for inventors and patent owners when the Supreme Court holds a patent invalid. But it remains to be seen whether this decision will ultimately make it more difficult on patent owners, or significantly increase the invalidity rate.

As many expected would happen, the U.S. Supreme Court reversed the Federal Circuit Court of Appeals, and criticized the concept that a patent claim is only proved obvious if some "teaching, suggestion, or motivation" (TSM) to combine the prior art teachings can be found in the prior art. The action here appears to be on the adverb "only," and the Supreme Court's objection to strictly requiring express words of motivation in published articles or prior patents. The Supreme Court unequivocally recognized that the requirement of demonstrating a teaching, suggestion, or motivation to combine known elements in order to prove obviousness is "helpful insight." It also expressed approval of cases which have used the TSM test in a manner which is flexible, which permits finding motivation *implicit* in the prior art, and which requires considering common knowledge and common sense as potential bases for a suggestion of a combination.

While the impact of today's decision will be the subject of much debate, patent owners will be comforted by the Supreme Court's emphasis that a finding of obviousness by combining elements from the prior art still requires finding some reason to make the combination: "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."

For the text of the Court's decision, see:

<http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>