



Mesmer & Deleault, PLLC  
41 Brook Street, Manchester, NH 03104  
Seacoast Office: One New Hampshire Ave., Suite 125  
Portsmouth, NH 03801



Independence Day

## “Tip of the Month”

### What Does the KSR Decision Mean to My Patents?

The U.S. Supreme Court recently handed down what some have called the most far-reaching patent judgment in decades. In *KSR v. Teleflex*, 550 U.S. \_\_\_\_ (2007), the Court held a patent invalid for obviousness, even though there was no teaching, suggestion, or motivation to combine prior art patents to solve the particular problem that was the subject of the patent (“the TSM test”). It changes the scope of protection for patents past and future, and deserves explanation.

To be patentable, an invention must be new, useful, and non-obvious. Non-obviousness is often the most difficult standard to meet because the examiner at the U.S. Patent and Trademark Office (“USPTO”) can combine two or more references that together make up one’s new invention. This makes it difficult to patent anything, since almost everything new is made of a combination of old elements. An examiner would be tempted to use hindsight to impermissibly combine disparate elements using the patent application itself as a template. That was bad news for patentees.

The U.S. Court of Appeals for the Federal Circuit (“CAFC”) is the sole court of appeals for patent cases. To provide a more objective standard and provide guidance, the CAFC instituted the TSM test. The TSM test requires some teaching, suggesting, or motivation in the prior art to make the claimed combination before rejecting an invention for obviousness. That was good news for patentees.

In reality, there is almost no prior art that explicitly uses the terms of teaching, suggesting, or motivating the reader to make a combination. So, the CAFC has recently allowed the USPTO to find “implicit” teaching, suggesting, or motivating. That was bad news for patentees, since it is difficult for patent attorneys to argue against implicit things that not even the examiners can identify in prior art references.

The KSR case says some very important things:

- The USPTO cannot use the TSM test rigidly – it can use any apparent reason in addition to common sense to make a combination that renders an invention obvious.
- The USPTO can look to solutions or combinations of others unrelated to the problem being solved by the invention to find the invention obvious.
- When an invention is a combination of things known in the prior art, the combination must do more than yield a predictable result – it must be “extraordinary” or have “real innovation.” It will be important to find surprising and unexpected results to be patentable.

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

The 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.

Frank B. Mesmer, Jr., Esq.  
Robert R. Deleault, Esq.  
Phillip E. Decker, Esq.  
077

(603) 668-1971

Fax (603) 622-1445

E-mail: mailbox @ biz-patlaw.com

Visit our web site at: www.biz-patlaw.com