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The Practical Effect of the KSR Decision

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In *KSR*, the Supreme Court swung the pendulum away from the rigid “teaching/suggestion/motivation” test, or “TSM,” towards a more flexible analysis. In delivering the opinion for the Court, Justice Kennedy wrote that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” He finished the opinion by writing that “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” The message of the Supreme Court was that the claims of a patent may be considered obvious by combining any references that may be of assistance to the person of ordinary skill in the art. Those references need not specifically teach or suggest such a combination.

In the short period since the Supreme Court's holding in *KSR*, there have been at least 17 Federal district court and appellate cases citing the *KSR* decision. The analyses used in these 17 cases can be placed into three categories: (1) cases that briefly mention *KSR*, but do not apply the TSM test or the obviousness analysis in *KSR*; (2) cases that attempt to follow the holding in *KSR* by using a common sense analysis; and (3) cases that attempt to follow the holding in *KSR* by using a more flexible version of the TSM test.

The cases that only mention *KSR* but do not use any version of the TSM test (i.e., the cases that fall into category (1) above) need not be further discussed¹. However, the cases that fall into the other two categories will be analyzed.

First, the cases that attempt to follow the holding in *KSR* by using a common sense analysis typically revert to the analytical procedures set out in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). These procedures require the court to consider: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue, and (3) the level of ordinary skill in the art. These three factors are considered as applicable as part of an obviousness analysis. In addition, the court may take into consideration secondary factors. *Graham*, at 17. This forms a “flexible” approach to determining the issue of obviousness.

An example of this approach is demonstrated in *Semiconductor Energy Lab. v. Chi Mei Optoelectronics Corp.*, 2007 WL 1793770 (N.D.Cal.). There, the district court stated that “this court's analysis... regarding obviousness must be flexible and guided by common sense.” *Id.*, at 18. See also *McNeil-PPC Inc. v. Perrigo Co.*, 2007 WL 1624764 (S.D.N.Y.). See also *Omeprazole Patent Litigation v. Mylan Laboratories Inc.*, 2007 WL 1576153 (S.D.N.Y.). These cases seem to have followed the proper analysis prescribed by the Supreme Court in *KSR*.

On the other hand, there are courts that consider the proper obviousness analysis under Section 103 of the Patent Act to be an analysis that uses a modified version of the Federal Circuit's TSM test. The *KSR* opinion itself alluded to the fact that the TSM test may be used in making a § 103 analysis as long as it is not applied in a rigid manner. Before the holding in *KSR*, district courts followed the Federal Circuit's TSM test in a rigid manner, meaning that there had to be a teaching, suggestion, or motivation to combine the cited prior art references to produce the patented invention or else the patent was considered to be valid. However, after *KSR*, several courts have used a more flexible version of the TSM test.

The analysis that these courts use takes into consideration the creativity of a person ordinarily skilled in the art. Examples of opinions following this approach include *Takeda Chemical Industries v. Alphapharm*, 2007 WL

1839698 at 10 (C.A.Fed. (N.Y.); and *Abbott Laboratories v. Sandoz Inc.*, 2007 WL 1549498 (N.D. Ill.); and *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007). It is the opinion of the authors that courts faced with a challenge to the validity of a patent on the basis of obviousness should take into consideration that a person of ordinary skill in the art may possess the creativity to combine teachings from references that might not themselves directly relate to one another.

¹ All of these cases acknowledge the holding in *KSR*, but claim that the holding in *KSR* is not applicable to their cases: *Torspo Hockey Int'l v. KOR Hockey*, 2007 WL 1752725 (D. Minn.); *Omegaflex Inc. v. Parker-Hannifin Corp.*, 2007 WL 1733228 (Fed. Cir. Mass.); *Praxair Inc. v. ATMI Inc.*, 2007 WL 1732205 (D. Del.); *Sundance Inc. v. De Monte Fabricating*, 2007 WL 1655423 (E.D. Mich.); *Ecolab Inc. v. FMC Corp.*, 2007 WL 1582677 (D. Minn.); *Edizone v. Cloud Nine*, 2007 WL 1585546 (D. Utah); *Pfizer Inc. v. Apotex Inc.*, 2007 WL 1464593 (Fed. Cir.); *Smith & Nephew Inc. v. Arthrex Inc.*, 2007 WL 1467228 (D. Or.); *Eaton Corp. v. ZF Meritor*, 2007 WL 1577838 (E.D. Mich.); *Syngenta Seeds Inc. v. Monsanto Co.*, 2007 WL 1295028 (Fed. Cir. Del.); *Trading Tech. Int'l v. GL Consultants Inc.*, 2007 WL 1468552 (N.D. Ill.).