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## Legal Updates & News

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#### KSR and Reexamination

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#### KSR and Reexamination

Reexamination requests continue to be filed at a record pace. According to the USPTO's fiscal-year-end statistics, 643 ex parte and 126 inter partes requests were filed in fiscal 2007. This compares to 511 and 70 last year, respectively.

The Supreme Court's decision in *KSR v. Teleflex* promises to make reexamination more popular than ever. In *KSR*, the Supreme Court upended twenty-five years of the Federal Circuit's obviousness jurisprudence. It is readily apparent that by expanding the obviousness inquiry beyond the Federal Circuit's teaching-suggestion-motivation (TSM) test, the Supreme Court has made it much easier for patent challengers to invalidate patents.

*KSR* is an extremely important development for reexaminations. Patent practitioners—prosecutors and litigators alike—are familiar with prosecution histories that follow this pattern: the examiner rejects a claim for obviousness, the applicant argues that the examiner did not identify any “teaching, suggestion, or motivation” to modify or combine, and the examiner immediately allows the claim.

For these and similar applications, patents may have been granted for combinations of old ideas or technical improvements that “were obvious to try,” were motivated by marketplace demands, or simply applied well-understood principles yielding predictable results. According to the Supreme Court, these should not have issued.

*KSR* enhances the effectiveness of using expert declarations to challenge a patent through reexamination. MPEP Sections 2217 and 2617 permit the U.S. Patent and Trademark Office (PTO) to consider “[a]ffidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail” in reexaminations. Given the breadth of new ways in which obviousness can now be proven (the PTO lists eight obviousness rationales in its October 10, 2007 *KSR* examination guidelines, of which the TSM test is only one), an expert may have greater freedom to address obviousness rationales. In a declaration, an expert can explain how one of ordinary skill would have understood the prior art; what features are inherent in the art; what results would have been predictable from a combination, substitution, or improvement; and how the techniques shown in the art represent the finite number of predictable solutions that support an “obvious to try” finding.

But there may be a limitation on an expert's flexibility to challenge a patent in this way. An interesting twist that *KSR* presents in the reexamination context is that reexamination is confined to “patents and printed publications” under Section 301. How the PTO will reconcile this statutory command with its interpretation of *KSR* that “[p]rior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art” has not yet been determined.

Naturally, patentees wishing to protect their patents in reexamination should argue for a strict interpretation of Section 301, and demand that whatever information is applied against their patent

claims be *written down* somewhere: a “printed publication.”

Because this approach is essentially the TSM test in statutory clothing, it remains to be seen whether it can pass muster under *KSR*. It will be interesting to see how the PTO will handle the administrative challenge of dealing with years of examination that applied the “wrong” law of obviousness. Litigants should be on the lookout for the PTO’s guidelines for applying *KSR* in the reexamination context, which are expected shortly.

Clients and litigators are obviously more comfortable with the reexamination process, and recent successes by patent challengers are sure to increase its popularity further. Accordingly, they must pay very close attention to how the PTO handles the administrative challenge of the increase in reexamination requests.