

The New USPTO Obviousness Guidelines: Is the US Coming Closer to an Inventive Step Standard?

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On September 1, 2010, the US Patent and Trademark Office (USPTO) issued new guidelines with respect to the standard of obviousness in view of the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The purpose of these new guidelines is to remind all US Examiners of the principles of obviousness, to specifically confirm that *KSR* applies to all technologies rather than just the predictable arts, and to provide additional guidance in view of selected post-*KSR* Federal Circuit decisions.

In the new guidelines, the USPTO has identified four different "topics" of obviousness, namely:

1. Combining Prior Art Elements
2. Substituting One Element for Another
3. Obvious to Try
4. Considerations of Evidence During Prosecution

However, if one looks at each of the topics in this additional guidance and the underlying decisions closely, it seems that the US standard for obviousness is moving closer to an inventive step style analysis, as discussed in more detail below.

Combining Prior Art Elements

The new USPTO guidelines discuss six cases in this topic, three of which are directed to non-obviousness and three of which are directed to obviousness. In general, the guidelines state that, to establish a *prima facie* case of obviousness using this approach, an Examiner has to show that the combination of known elements must provide a reasonable expectation that these elements work for their intended purposes. One of ordinary skill must have a reason to and knowledge of how to combine these elements to arrive at the pending claims. In this regard, the prior art can be construed broadly and must be reasonably pertinent to **the problem to be solved**.

In contrast, some examples of useful rebuttal evidence of non-obviousness provided by the USPTO include that the prior art teaches away from the claimed combination, that the prior art's teachings undermine the very reason being given for the combination of the elements, and that the **problem to be solved was not previously known**. This, then, seems to be one step toward following the "problem-solution" approach of a traditional inventive step analysis, whereby the first step is determining the problem to be solved, then assessing the solution to this problem in view of the prior art.

Substituting One Known Element for Another

The new USPTO guidelines discuss seven cases in this topic, two of which are directed to non-obviousness and five of which are directed to obviousness. In general, the guidelines state that when using this approach to establish a *prima facie* case of obviousness, any "analogous" art used by the Examiner is not limited solely to those references in the field of endeavor, but includes those one of

ordinary skill would find useful for applicants' purpose. In the chemical arts in particular, the guidelines provide that a chemical compound is obvious over structurally similar compounds where a reason exists for one of ordinary skill to select and modify a lead compound from the prior art.

However, the guidelines also provide that a compound is non-obvious where there is no reason to modify the prior art lead compound, modifying the prior art lead compound would destroy its advantageous properties, or there is no reasonable expectation of success for modifying the prior art compound to arrive at the claimed compound.

Again, the focus of the new obviousness guidelines seems to be on first identifying the problem that is being solved, then assessing the claimed solution to this problem in view of the prior art. In this regard, for chemical cases, the new obviousness guidelines recommend identifying the problem to be solved (i.e., providing a compound for treating a specific disease), then assessing whether the claimed solution to this problem would have been obvious in view of the prior art solutions to this problem (i.e., whether it would have been obvious to modify the prior art lead compound for treating that disease to arrive at the claimed compound). This approach for determining obviousness of a compound seems remarkably similar to a traditional inventive step analysis of this compound.

Obvious to Try

The new USPTO guidelines discuss seven cases in this topic, four of which are directed to non-obviousness and three of which are directed to obviousness. In general, the guidelines state that an obvious to try rationale is proper when **options to solve the identified problem** are known and finite. For example, under the standard of *In re Kubin*, 561 F.3d 1351 (Fed. Cir. 2009), a claimed polynucleotide can be obvious over a known protein where there is a reasonable expectation of success and a reason to try to isolate the claimed polynucleotide from the protein.

However, the guidelines also provide that an "obvious to try" rejection can be rebutted by showing that the prior art teaches away from the claimed subject matter, or that no predictability or reasonable expectation of success is found in the prior art. In the chemical arena, a recommended argument for rebuttal is that no finite and easily traversed number of potential compounds or **known solutions to the problem existed** and there was no reason for selecting a starting compound from **unpredictable alternatives** in the prior art.

Here again, according to the "obvious to try" rationale, a critical component seems to be first identifying the problem to be solved, then assessing how many options to this problem were known in the prior art. Establishing that an infinite, or unreasonable, number of solutions to this problem were previously known in the prior art is a recommended strategy for overcoming such an "obvious to try" rejection. So under this scenario, following an inventive step "problem-solution" approach is also recommended by the USPTO to overcome an obviousness rejection.

Consideration of Evidence

The new USPTO guidelines discuss four cases in this topic. In general, the guidelines state that all evidence of non-obviousness must be considered. Even so, evidence of non-obviousness may be outweighed by contradictory evidence in the record.

Conclusion

While it is unlikely any patent practitioner or Examiner in the US would call the US standard for obviousness to be an “inventive step” standard, in practical effect this seems to be the direction in which the US is headed. The USPTO’s 2010 obviousness guidelines, as well as the underlying cases discussed therein, make clear that US Examiners are now being trained to look to the problem identified by the applicant, and then comparing the applicants’ solution to this problem with the solutions identified in the prior art. Without calling it inventive step, then, these new obviousness guidelines make clear that the current corps of Examiners is being trained using just such an approach. This will be important for all applicants and their counsel to consider when trying to overcome US obviousness rejections moving forward.