

Where (and Even When) Does KSR Belong in Obviousness Arguments? (Or “Did You Learn Everything You Need to Know About § 103 from Dr. Seuss®?”)¹

Introduction

When it comes to combining prior art to arrive at each and every element of a claim, if there is no way that one of skill in the art could have, does it make any sense to argue about whether they would have? We think (usually) not. And it would appear—since *KSR*,² not to the exclusion of before—that the Federal Circuit agrees.

In our view, this rhyme-time approach to obviousness is not only relatively easy to understand, remember, and explain, it is also an important construct to help avoid the temptation to argue the “would have” (perhaps relying on *KSR*) when doing so may very well be a walk backwards on the arc of persuasion, implying as being open a question one had already asserted was closed, and simply giving the art at issue too much credit. That is, don’t get into the weeds if you are not even in the right garden.

And although the Supreme Court’s guidance in *KSR* undeniably bears on the “would have,”³ it seems just as clear that it does not bear on the “could have.”⁴ As such, for the most part, applicants and patentees should only invoke *KSR* when there is as little doubt as there was in that case that the cited art (which certainly can but almost never does include something that is cited as simply being within the knowledge of one of ordinary skill) could have been combined into the totality of the claim at issue.

Indeed, Federal Circuit case law since *KSR* reinforces the canons of logic in suggesting that applicants and patentees may quite often be well-advised to refrain from invoking *KSR*, and in fact to refrain generally from arguing that there is no way that one of skill in the art “would have” (combined the cited art to arrive at the totality of a claim) when, unlike in *KSR*, a compelling—or even colorable—argument can be made that there is no way that one of skill in the art “could have;” in other words, if all of the pieces just aren’t there, who cares whether one of skill in the art (or The Cat in the Hat⁵, or the Easter Bunny, or even a real person) might have had one or more reasons to combine whatever pieces are there into something else?

The Context of *KSR*

In *KSR*, the Supreme Court considered a Teleflex-owned patent that claimed a pedal assembly combined with an electronic pedal-position sensor.⁶ The District Court found the patent obvious based on two prior art patents that respectively taught the pedal and the sensor.⁷ The District Court applied the teaching-suggestion-motivation (“TSM”) test, concluding that a person of ordinary skill would have had sufficient motivation to combine the prior art in the manner claimed.⁸ The Federal Circuit then reversed, deciding that the District Court had failed to make sufficiently specific findings as to which principle known in the prior art would have motivated such a hypothetical person to combine the prior art teachings in such a way.⁹ The Supreme Court later rejected the Federal Circuit’s “rigid” approach to the obviousness inquiry.¹⁰

Notably, both the Federal Circuit and the Supreme Court accepted *de facto* that the prior art patents could have been combined to arrive at the claimed pedal-and-sensor combination.¹¹ That is, the only question left was whether they would have been. This seems to suggest that, in contexts where the question of whether prior art elements could have been combined into a claim is not as easily answered in the affirmative as it was in *KSR*, that this decision might not be particularly relevant. Such a suggestion appears to be supported by recent Federal Circuit opinions.

The Federal Circuit's (Limited) Reliance on *KSR*

Despite the seemingly ubiquitous nature of *KSR*, it is unclear to what extent it actually modified the obviousness inquiry.¹² In fact, in a September 1, 2010 Examination Guidelines Update, the USPTO opined that “practitioners should...recognize the significant extent to which the obviousness inquiry has remained constant in the aftermath of *KSR*.”¹³ Thus, there appears to be no particular reason why, when responding to rejections based on alleged obviousness, applicants should feel compelled to include arguments that incorporate the almighty *KSR*. To the contrary, some Federal Circuit case law suggests that when prior art elements cited by an Examiner could not have been properly combined into a recited claim, the applicant should—without reference to *KSR*—simply argue as much.

For example, in *Honeywell International, Inc. v. United States*, the Federal Circuit explained that, upon finding that the cited prior art references do not contain an element in the recited claim, the obviousness analysis is complete.¹⁴ *Honeywell* involved a claim directed to passive night-vision goggles that are compatible with a full color display that emits perceptible light within the red color band.¹⁵ The court found that the government provided no evidence that the references disclosed the perceptible-red-light element of the claims.¹⁶ The court then explained, without reliance on *KSR*, that such a “failure to prove that the cited references disclose [an] element [of the claim is a failure] to carry [the] burden of proving...that the claimed invention would have been obvious to one of skill in the art.”¹⁷

In other Federal Circuit cases, the court also has first endeavored to determine whether one of skill in the art could have arrived at a given claim before embarking on a separate analysis, under *KSR*, to determine whether such a hypothetical person would have. In *Sundance, Inc. v. Demonte Fabricating Ltd.*, the court first determined that “a combination of [the cited references] satisfies every limitation of the [asserted claim]” and “next turn[ed] to whether the combination would have been obvious at the time of the invention.”¹⁸ Similarly, in *Ecolab, Inc. v. FMC Corp.*, the court first established that “[the Plaintiff’s] expert admitted that one skilled in the art would [have known]” all of the elements of the disputed claim, before turning to the question of “whether it would have been obvious to combine the [known elements]” to arrive at the claimed invention.¹⁹ And in *Spine Solutions, Inc. v. Medtronic Sofamor Danek USA, Inc.*, the court, after analyzing the cited references, stated that “the combination of the [cited references] discloses every limitation of [the asserted claim]; the question remains whether the combination of those references would have been obvious to a person of skill in the art.”²⁰ In each of these cases, then, the Federal Circuit did not bring *KSR* into the analysis until first determining that the prior art elements at issue could have been combined to arrive at the claim.

The Federal Circuit has further suggested that facts, evidence, and arguments directed to a determination as to whether prior art elements would have been combined in the manner claimed are separate and distinct from those directed to a determination as to whether such prior art elements could have been so combined. In *CSIRO v. Buffalo Tech. (USA), Inc.*, after noting that the invention consisted of “a combination of elements, all of which are found in prior art references,” the court then, using *KSR* for guidance, considered arguments regarding whether the references would have been so combined, and ultimately remanded the case for further consideration of that issue.²¹ And in *Hearing Components, Inc. v. Shure, Inc.*, the court declared it necessary for a “party to meet its burden of proving obviousness by [the] ‘clear and convincing’ [standard]” to offer evidence establishing that “the prior art references contained all of the claim limitations,” noting that this was independent of that party’s further obligation to offer evidence establishing that there was “a motivation to combine.”²² In *Hearing Components*, the court found that, because “the jury heard substantial evidence” that the cited references did not teach all the limitations of the claim, “a finding of nonobviousness was permissible.”²³

A Few Takeaways

Given the Federal Circuit’s consideration of the “could have been” and the “would have been” as sequential and independent thresholds for establishing a claim as obvious under § 103, applicants may be well-advised to consider the following recommendations when responding to obviousness rejections:

(1) Insist that the Examiner make a clear explanation on the record as to where each claim element is found in the art that is cited in combination. In particular, do not acquiesce if an Examiner has merely identified some of the claim elements as being in the cited combination, and then concluded that it would have been obvious for one of skill in the art at the time of invention to include a claim element otherwise missing from the cited combination. Too often the “reasons to combine” portion of a § 103 rejection is used by Examiners to fill in substantive gaps between what is recited in a claim and what is taught by the art in combination. If an Examiner is going to take official notice that a claim element was known to those of skill in the art, this should be done as explicitly as *KSR* demands of reasons to combine, and before any such reasons at that. This is a perhaps-subtle-but-crucial distinction between (a) actual claim elements being in the prior art due to being within the knowledge of one of ordinary skill and (b) reasons to combine such prior art elements in the manner claimed being apparent to one of ordinary skill. The former is in the “could have,” and can be attacked by *Honeywell* and *Hearing Components*, among other cases; the latter is in the “would have,” and can be attacked by *KSR*, among other cases.

(2) Strongly consider refraining from arguing the “would [not] have” after convincingly (at least in your view, of course) arguing the “could [not] have.” Doing the opposite may well detract from the convincingness of the first argument, in that it is treating as sensical the Examiner’s proposition that one of ordinary skill in the art would have done something that there is no way that one of ordinary skill in the art could have done. In our view, it is perhaps better to say something like “Therefore, based at least on the reasons given above, Applicant respectfully submits that there was no manner in which one of skill in the art at the time of invention could have combined the cited references and arrived at the combination of elements to which claim x is

directed, rendering immaterial whether such a hypothetical person may have had one or more reasons to combine these references into something else.” (One exception to this recommendation may well be if two or more of the cited references come from such disparate fields that an Examiner would have a hard time establishing that a hypothetical person of ordinary skill in any particular art would have even had all of these references in the first place; this “would have” argument would seem to strengthen rather than chip away at a convincing “could [not] have” argument.)

(3) If an Examiner has convincingly asserted that cited prior art elements could have been combined by one of skill in the art at the time of invention in such a manner as to arrive at the totality of a given claim, then consider amending the claim or, perhaps more precipitously, conceding the “could have” and going to battle (with lowered expectations) on the “would have.” As it was under TSM, and as it is after *KSR*, this is usually—but of course not always—a tough spot.

A Conclusion about “Conclusory”

It seems in light of the framework of this article that a final observation is worth making regarding a particular and popular passage from Justice Kennedy’s opinion of the unanimous Court in *KSR*. The passage is this one, and it is in our view susceptible to being read out of context and cited as part of a “could [not] have” argument; in other words, this passage could be read as useful in making an argument that at least one element of a given claim is simply missing from the combination of cited references:

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.²⁴

In light of the preceding review of the context of *KSR*, and thus what issues were really on the table that day, it seems that this language belongs only in arguments as to the “would have,” and not in arguments as to the “could have,” and can really only fairly be read as “...to support [the necessary-but-not-sufficient ‘would have’ prong of] the legal conclusion of obviousness.”

Daniel P. Williams concentrates his practice in obtaining patent protection for clients in the areas of telecommunications, computer hardware and software, networks, and Internet applications. He has experience in intellectual property litigation, including patent and trade secret litigation. Mr. Williams is also the inventor of U.S. Patent No. 7,130,664.

williamsd@mbhb.com

Christopher D. Butts prepares and prosecutes patent applications, conducts legal research, and provides technological advice in support of validity, infringement, and patentability analyses, patent application preparation and prosecution, and litigation matters in the electrical engineering field.

butts@mbhb.com

Endnotes

1. Dr. Seuss is a registered trademark of Dr. Seuss Enterprises.

2. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). (The Federal Circuit has thus far cited this opinion in approximately one hundred of its own.)
3. See *id.* at 424 (“The proper question to have asked was whether a pedal designer of ordinary skill, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to upgrading Asano with a sensor.” (emphasis added)); see also *id.* at 424-425 (“The consequent legal question, then, is whether a pedal designer of ordinary skill starting with Asano would have found it obvious to put the sensor on a fixed pivot point. The prior art discussed above leads us to the conclusion that attaching the sensor where both KSR and Engelgau put it would have been obvious to a person of ordinary skill.” (emphasis added)).
4. See *id.* at 422-424, where the Court acknowledged the separateness and sufficiency of the “could [not] have” argument by, after noting that Teleflex had asserted it “in passing,” dismissing it due to the lack of clarity as to whether it had been properly raised below where, according to the Court, Teleflex had been “content” to assert only an inadequate flavor of the “would [not] have” argument; as such, the Court agreed—without making its own substantive analysis—with the District Court that one of skill in the art could have combined prior art elements and arrived at the totality of the claim at issue (“The District Court found that combining Asano with a pivot-mounted pedal position sensor fell within the scope of claim 4. Given the significance of that finding to the District Court’s judgment, it is apparent that Teleflex would have made clearer challenges to it if it intended to preserve this claim. In light of Teleflex’s failure to raise the argument in a clear fashion, and the silence of the Court of Appeals on the issue, we take the District Court’s conclusion on the point to be correct.” (internal citations omitted)).
5. The Cat in the Hat is a registered trademark of Dr. Seuss Enterprises.
6. See *KSR*, 550 U.S. at 405.
7. See *id.* at 413.
8. *Id.*
9. See *id.* at 413-414.
10. See *id.* at 415.
11. See, e.g., n.4, *supra*; see also *CSIRO v. Buffalo Tech. (USA), Inc.*, 542 F.3d 1363, 1373-1374 (Fed. Cir. 2008) (“The *KSR* case involved the same kind of problem that is presented here—the question of obviousness as applied to an invention that consists of a combination of elements, all of which are found in prior art references.”)
12. As noted in the PTO’s 10/10/2007 Examination Guidelines, the *KSR* decision heavily relied on its earlier § 103 precedents, and the Supreme Court acknowledged that the Federal Circuit had already adopted a more-flexible version of the TSM test by the time the Supreme Court issued the *KSR* decision. See Patent and Trademark Office, Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Federal Register 195, 57526-57527 (Oct. 10, 2007) (among those cases cited by the Court in *KSR* were *United States v. Adams*, *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, and *Sakraida v. AG Pro, Inc.*); see *KSR*, 550 U.S. at 421 (“We note the Court of Appeals has since elaborated a broader conception of the TSM test than was applied in the instant matter.”).
13. Patent and Trademark Office, Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, 75 Federal Register 169, 53643 (Sept. 1, 2010). The 9/1/2010 PTO Guidelines Update also provides that *KSR* “clearly impacted the manner in which Office personnel and practitioners carry out the business of prosecuting patent applications with regard to issues of obviousness.” *Id.* at 53645. However, the USPTO was not particularly explicit regarding what that “clear impact” was. Indeed, it may be the case that the only practical impact was that applicants were stripped of the ability to require an Examiner to point to an explicit teaching, suggestion, or motivation in the cited references. This much was noted by the PTO: “Since it is now clear that a strict TSM approach is not the only way to establish a *prima facie* case of obviousness, it is true that practitioners have been required to shift the emphasis of their nonobviousness arguments to a certain degree.” *Id.*
14. 609 F.3d 1292 (Fed. Cir. 2010).
15. *Id.* at 1294, 1298.
16. *Id.* at 1299.



17. *Id.* at 1300-1301.

18. 550 F.3d 1356, 1366 (Fed. Cir. 2008) (emphasis added).

19. 569 F.3d 1335, 1350 (Fed. Cir. 2009) (emphasis added). Further, note that the 9/1/2010 PTO Guidelines Update points out that “[i]f [each element of the claim] had not been within the level of ordinary skill in the art, the outcome of the *Ecolab* case may well have been different.” 9/1/2010 Examination Guidelines Update at 53648.

20. 620 F.3d 1305, 1312 (Fed. Cir. 2010) (emphasis added).

21. *CSIRO*, 542 F.3d at 1375, 1376.

22. 600 F.3d 1357, 1373 (Fed. Cir. 2010).

23. *Id.* at 1374.

24. *KSR*, 550 U.S. at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).