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The Law of Obviousness In Light of the Supreme Court's *KSR* Decision

KSR最高裁判決に基づく 自明性の判断基準

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(Partially Translated by RYUKA)

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Before *KSR*

- Obviousness required that there be a suggestion or motivation to combine elements known in the prior art
- Obviousness inquiry focused on the problem the patentee was trying to solve

After *KSR*

- A suggestion or motivation to combine is not *required* – they are merely factors that the factfinder may consider
- 組み合わせることに対する示唆もしくは動機付けは不要である—事実認定者が考慮し得る要因に過ぎない

After *KSR*

- A combination of known elements using known methods is likely to be obvious when the combination merely yields predictable results – “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”
- 公知の方法を用いて公知の構成要素を組み合わせることは、得られる結果が予測可能なものに過ぎない場合、自明である可能性が高い。—「法廷では、改良点が、先行技術の構成要素の既知の機能に基づいた、当該構成要素の予測可能な利用に過ぎないかどうか問われなければならない。」

After *KSR*

- In complicated cases, it may often be “necessary” to determine if there was an apparent reason to combine known elements as claimed.
- 複雑なケースの場合、公知の構成要素を特許請求の範囲で請求されているように組み合わせる明らかな理由があったかどうかを判断することが「必要」になる場合もあり得る。

After KSR

- It “can be important” to identify a reason that would have prompted one of skill in the art to combine known elements.
- 当業者が公知の構成要素を組み合わせるきっかけとなったであろう理由を特定することは「重要となり得る」。
- The “reason” can result from “market demands.” It is a flexible inquiry.
- その「理由」は「市場の需要」に起因するものかもしれない。検討すべき対象は多様である。

After *KSR*

- Courts should look to more than the specific problem that the inventor was trying to solve.
- 法廷では、発明者が解決を試みた具体的な課題に目を向けるだけでは十分でない。

After KSR

- Any need or problem known in field may provide a reason for combining elements.
- 関連分野で公知の要求または問題は、どんなものであれ構成要素を組み合わせる根拠となり得る。
- A person of skill in the art is a person of “ordinary creativity, not an automaton.”
- 当業者とは、「通常の創造力」を有する人であって、「機械的な思考をする」人ではない。

Effect of *KSR* at PTO

- Preliminary PTO position

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

May 3, 2007, Memo from Deputy
Commissioner for Patent
Operations

Practical Effect of *KSR*

- Small effect on jury trials – the jury instruction will be changed, but the change may not result in a substantial increase in the number of jury verdicts finding a claim invalid.
- Primary effects:
 - Some judges may be more inclined to stay patent infringement cases pending reexamination on the grounds that the PTO applied a less rigorous standard in issuing the patent
 - Obviousness finding more likely in bench trials
 - Summary Judgment/JMOL of obviousness more likely

Practical Effect of *KSR*

- Summary Judgment/JMOL of obviousness more likely because:
 - Supreme Court set forth new standards (discussed above)
 - Supreme Court reiterated that obviousness is an issue of law for the court (with underlying factual issues)
 - Supreme Court emphasized that factfinders must be able to rely on “common sense”

Practical Effect of *KSR*

- Federal Circuit hopefully will help clarify issue over the next few months
- Prediction: Federal Circuit will interpret *KSR* to avoid radically altering the percentage of invalid patents and issued patent applications

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END