

KSR INTERNATIONAL Co. v. TELEFLEX, INC.:
OBVIOUSNESS ANALYSIS AND THE TSM TEST

Summary

In *KSR International Co.*, the Supreme Court held that the Court of Appeals for the Federal Circuit analyzed the issue of obviousness by a narrow and rigid application of the TSM test that is inconsistent with 35 U.S.C. § 103 and precedents of the Supreme Court. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007).

Detailed Discussion

KSR modified an automobile throttle pedal of their design by adding an electronic position sensor. Teleflex sued for infringement of a patent on which Teleflex holds an exclusive license. KSR countered that the patent was invalid because the subject matter of the patent was obvious under 35 U.S.C. § 103.

A District Court applied the four *Graham* factors and the teaching, suggestion, motivation (TSM) test to conclude that the patent was invalid as obvious. The Court of Appeals reversed because the District Court did not apply the TSM test strictly enough. The Court of Appeals stated that in applying the test, a court must examine the specific understanding that would have motivated an inventor to combine the prior art. The Court of Appeals also stated that prior art cannot supply the motivation for the claimed combination unless the prior art addresses the precise problem that the patentee was trying to solve. The Court of Appeals also stated that obviousness is not established by the so-called “obvious to try” standard.

The Supreme Court rejected the Court of Appeals’ analysis as too rigid an application of the TSM test. The Supreme Court reiterated that the approach set forth in *Graham* should be followed and that caution should be used in granting patents based on elements found in the prior art. A combination of elements without a change in the respective functions of the elements is not patentable because such a combination “withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Id.* at 1739 (quoting *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950)). Therefore, the combination of elements by known methods to yield predictable results is likely to be found obvious. However, if the prior art taught away from combining known elements, a successful combination of such elements is more likely to be nonobvious.

The basis for an obvious combination is not that each of the elements was known in the prior art, but rather the identification of a reason that would have prompted a person having ordinary skill in the art to combine the elements. It is the identification of this reason to combine that is the idea underlying the TSM test, and there is no inconsistency between the *Graham* analysis and this underlying idea. The obviousness

inquiry should not be directed at the problem the patentee was trying to solve, i.e., whether the combination of prior art was obvious to the patentee, but should be directed toward any need or problem known in the field of endeavor at the time of the invention. Further, the obviousness inquiry should not just include only those elements of prior art designed to solve the same problem as that of the inventor. Finally, when a problem has a finite number of identified and predictable solutions, it may be obvious for a person of ordinary skill in the art to try certain combinations of prior art, because success achieved in this case is the product “not of innovation but of ordinary skill and common sense.”

Disclaimer:

This case is not legal advice. Do not act upon it without professional advice. You are welcome to forward this case alert to others if you attribute it to McCracken & Frank, LLP and include the original without alteration.