In September, the U.S. Patent and Trademark Office (USPTO) published a notice updating the 2007 Patent examination guidelines after the U.S. Supreme Court KSR decision. In general, the update covers the principles of obviousness, the impact of the KSR decision, and obviousness examples from Federal Circuit cases, which include combining prior art elements, substituting one known element for another, and the “obvious to try” rationale. The update reviews the most relevant Federal Circuit case law dealing with obviousness since KSR, and attempts to draw a lesson or teaching point from each of the rulings. It should be kept in mind that they are the “interpretations” made by the USPTO of the KSR decision.

Some of the highlights from the updated guidelines that are most relevant to patent applicants are as follows:

The Principles of Obviousness:

It is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in KSR and discussed in the 2007 KSR Guidelines, they are to adhere to the instructions provided in the MPEP regarding the necessary factual findings.

It remains Office policy that appropriate factual findings are required in order to apply the enumerated rationales properly. If a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel must either withdraw the rejection, or repeat the rejection including all required factual findings.

Combining Prior Art Elements:

Even where a general method that could have been applied to make the claimed product was known and within the level of skill of the ordinary artisan, the claim may nevertheless be nonobvious if the problem which had suggested use of the method had been previously unknown. [In re Omeprazole Patent Litigation, 536 F.3d 1361 (Fed. Cir. 2008)]

Office personnel should note that in this case the modification of the prior art that had been presented as an argument for obviousness was an extra process step that added an additional component to a known, successfully marketed formulation. The proposed modification thus amounted to extra work and greater expense for no apparent reason. This is not the same as combining known prior art elements A and B when each would have been expected to contribute its own known properties to the final product.

Merely pointing to the presence of all claim elements in the prior art is not a complete statement of a rejection for obviousness. In accordance with MPEP § 2143 A(3), a proper rejection based on the rationale that the claimed invention is a combination of prior art elements also includes a finding that results flowing from the combination would have been predictable to a person of ordinary skill in the art. MPEP § 2143 A(3). If results would not have been predictable, office personnel should not enter an obviousness rejection using the combination of prior art elements rationale, and should withdraw such a rejection if it has been made.

Substituting One Known Element for Another:
[I]f the reference does not teach that a combination is undesirable, then it cannot be said to teach away. An assessment of whether a combination would render the device inoperable must not “ignore the modifications that one skilled in the art would make to a device borrowed from the prior art.”

Obvious to Try:

Some commentators on the KSR decision have expressed a concern that because inventive activities are always carried out in the context of what has come before and not in a vacuum, few inventions will survive scrutiny under an obvious to try standard. The cases decided since KSR have proved this fear to have been unfounded. Courts appear to be applying the KSR requirement for “a finite number of identified predictable solutions” in a manner that places particular emphasis on predictability and the reasonable expectations of those of ordinary skill in the art.

[T]he Federal Circuit cautioned that an obviousness inquiry based on an obvious to try rationale must always be undertaken in the context of the subject matter in question, “including the characteristics of the science or technology, its state of advance, the nature of the known choices, the specificity or generality of the prior art, and the predictability of results in the area of interest.”

In the Winter-edition of its newsletter, the firm will provide practice tips for responding to obviousness rejections using a simplified flow chart analysis.