

CLASS 8

OBVIOUSNESS II

IMPLEMENTING THE GRAHAM FRAMEWORK

PATENT LAW & POLICY
PROFESSOR WAGNER



Today's Agenda

KSR v. Teleflex

Perfect Web Techs v. Infousa, Inc

The PHOSITA

The Scope and Content of the Prior Art

Secondary Considerations

1

KSR v. Teleflex

**“Standing on the Shoulders of Giants”
The Problem of ‘Combination Patents’**



Hindsight Bias

Predictability



Three Ways to Combat Hindsight

Carefully define the scope of the prior art

Restrict the combining of references

Evaluate secondary considerations

The Role of the Federal Circuit

Graham: 1966; Adams: 1966; Sakraida: 1976

[virtually no discussion of hindsight, or ways to address]

Federal Circuit: Created in 1982

Tasked with stabilization, management of the law.

Especially since 1990: establishes doctrine to combat hindsight

The Teaching, Suggestion, Motivation Test

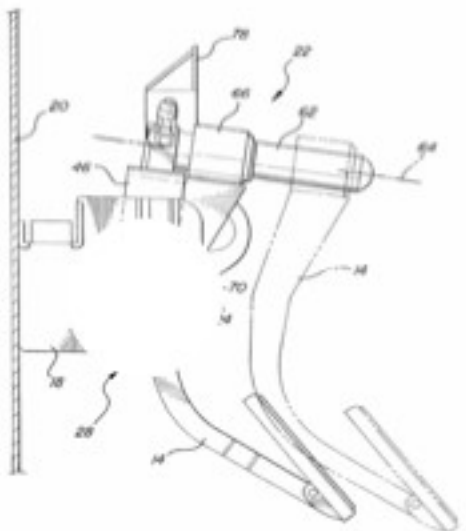
4000. Where a statute confers benefits on the owner of a particular piece of property, the statute is presumed to confer those benefits on the owner of the property.

SUPREME COURT OF THE UNITED STATES

KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL.
CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

KSR v. Teleflex (2007)

In *KSR v. Teleflex*, the Supreme Court held that the obviousness test for patentability is not limited to the prior art, but also includes common knowledge and common sense. The Court held that the obviousness test is not limited to the prior art, but also includes common knowledge and common sense. The Court held that the obviousness test is not limited to the prior art, but also includes common knowledge and common sense.



Perfect Web Techs. v. InfoUSA

1. A method for managing bulk e-mail distribution comprising the steps:

(A) matching a target recipient profile with a group of target recipients;

(B) transmitting a set of bulk e-mails to said target recipients in said matched group;

(C) calculating a quantity of e-mails in said set of bulk e-mails which have been successfully received by said target recipients; and

(D) if said calculated quantity does not exceed a prescribed minimum quantity of successfully received e-mails, repeating steps (A)-(C) until said calculated quantity exceeds said prescribed minimum quantity.

The court in Perfect Web allows the use of “common sense” as evidence of obviousness.

Is this consistent with the TSM analysis? With KSR?
Will it allow hindsight to infect the analysis?
Are the safeguards enough?

2

The PHOSITA

Daiichi Sankyo v. Apotex

The parties here disputed the level of ordinary skill in the art.

Why? What does Apotex want?

**What happens if the PHOSITA is more skillful?
In §103? What about § 112?**

3

The Scope & Content of the Prior Art

What art is appropriate for § 103?

- Basic point: all 'prior art' defined by § 102
 - 102(a): publications, 'known or used'
 - text of § 103 makes this clear
 - 102(b): publications, 'known or used', on sale
 - *In re Foster*
 - 102(e): prior patent application by another
 - *Hazeltine Research*, but note 103(c) 'common ownership' exception
 - 102(f): 'derivation' from prior invention
 - *Odds-On Toys*
 - 102(g): prior "invention" by another
 - *In re Bass*
 - 102(c): abandonment [not yet]
 - 102(d): overseas patenting [not yet]

What art is appropriate for § 103?

The “Analogous Art” Requirement

Pertinent to the field of the invention

Pertinent to the types of problems to be solved

[why these limitations?]

The Scope of the Prior Art

Section 102 Defines the Available Prior Art

Only “Analogous Art” is Permitted

All Analogous § 102 Art is

Attributed to the Knowledge of the PHOSITA

See a Problem?

1. § 103 allows references to be combined cover all elements of the claim
2. All prior art related to the field or to the problems to be solved is included in the analysis
3. But we know that 'we stand on the shoulders of giants' - given (1) and (2), is there likely to be anything truly 'nonobvious'?
 - Especially given hindsight!

4

Secondary Considerations

Graham: "Secondary Considerations"

Federal Circuit: "Objective Indicia of Non-obviousness"

**Note the Federal Circuit (in Stratoflex):
'jurisprudentially inappropriate'
to exclude consideration of SIs**

Secondary Considerations

Commercial success

Long-felt need / failure of others

Evidence of copying

Skepticism (prior to invention) / praise (after invention)

Licensing/acquiescence to the patent

U.S. Patent Aug. 26, 2003 Sheet 2 of 2 US 6,628,817 B1



**Iron Grip Barbell v. USA Sports
(Fed. Cir. 2004)**

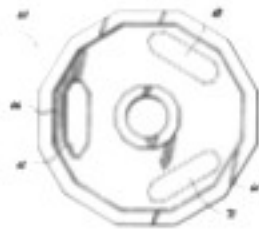
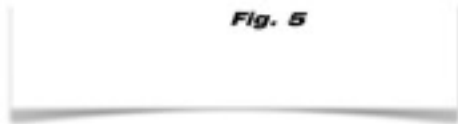


Fig. 5



1. A weight plate for physical fitness including:
a plate body formed with a central throughbore and having a plate periphery;
said body further formed with solely a triad of spaced apart elongated handle openings disposed generally equiangularly and positioned radially outwardly from said central throughbore and at least midway out from the center of the body to said radial periphery, said openings having respective outboard edges cooperating with said plate to define a triad of integral handle elements for grasping by a single hand to effect transport of said weight plate.

Fig. 5



'015 patent



prior art

Commercial success	
Long-felt need / failure of others	
Evidence of copying	
Skepticism (prior to invention) / praise (after invention)	
Licensing/acquiescence to the patent	

Secondary Considerations

Commercial success

The key showing in Commercial Success: Nexus

Note a recent trend at the Federal Circuit: tightening up the nexus requirement.

Secondary Considerations

Long-Felt Need / Failure of Others

Why is this factor seen as especially pertinent?

Do you agree?

What is meant by the 'need'?

Where do you find the 'long-felt need'?

Secondary Considerations

- Copying
 - How relevant is this factor?
- Skepticism/Praise
 - How relevant is this factor?
 - Where would one look to find it?
- Licensing/Acquiescence
 - How relevant is this factor?

NEXT CLASS

OBVIOUSNESS III
CLASS EXERCISE

PATENT LAW & POLICY
PROFESSOR WAGNER

