



Supreme Court Update:

KSR v. Teleflex and the Determination of Obviousness

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On April 30, 2007, the U.S. Supreme Court issued a unanimous decision in [KSR International Co. v. Teleflex, Inc.](#) This decision addresses the question of how the obviousness of a patent claim should be determined in view of the prior art.

In *KSR*, the Court reversed a decision by the Court of Appeals for the Federal Circuit (“Court of Appeals”) which held that a particular patent claim to a vehicle control pedal apparatus was not obvious, and reinstated the trial court’s decision finding the patent invalid. The Court of Appeals’ decision was based on its principal reliance on the “teaching, suggestion, or motivation” test (the “TSM” test). Under this test, “a patent claim is only proved obvious if the prior art, the problem’s nature, or the knowledge of a person having ordinary skill in the art reveals some motivation or suggestion to combine the prior art teachings.” The TSM test was first formulated by the Court of Customs and Patent Appeals (the predecessor to the Court of Appeals).

In its review, the Court discussed §103 of the patent statute, which forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

The Court also discussed the framework it articulated over 40 years ago in *Graham v. John Deere Co.* for applying §103. In *Graham*, the Court stated that “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure by

others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”

In its decision in *KSR*, the Court found that the Court of Appeals “addressed the question of obviousness in a manner contrary to §103 and [the Court’s] precedents”, particularly *Graham*. The Court stressed that “[t]here is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis. But when a court transforms the general principle into a rigid rule that limits the obviousness inquiry, as the Court of Appeals did here, it errs.”

Since *KSR v. Teleflex* was decided so recently, it remains to be seen how the lower courts and patent office will implement this decision.

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