

Inventors face 'obvious' difficulty

Supreme Court decision raises bar for little guys filing, protecting patents

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In the wake of a United States Supreme Court decision in *KSR International Co. v. Teleflex Inc.* inventors will find it more difficult to obtain some patent and current holders could find some of their patents challenged.

On April 30, the Supreme Court made its decision in a much-anticipated case that addressed the conditions to which "prior art references" - the description and bounds of an invention - may be combined to show an invention as "obvious" and therefore not patentable.

In checking for obviousness after hindsight, the U.S. Court of Appeals for the Federal Circuit had used a test known as the "Teaching, Suggestion or Motivation" test and felt Teleflex had shown that the problem solved by their invention was not recognized in prior art references and therefore patentable.

In a unanimous decision, the Supreme Court reversed the lower court's ruling because it had used a narrow, rigid application of the TSM test that went against the precedent set for "obviousness" in Supreme Court case *Graham v. John Deere*.

What is not so obvious are the potential effects of the decision on the patent system, or patents in general.

Limited impact

"Every patent comes with a question of validity," said patent attorney Craig Miles of the law firm CR Miles in Fort Collins. But the "fact-intensive" case could "really come down to affecting a few patentees."

The invention at issue in the case was an adjustable automobile accelerator pedal with an electronic sensor attached. KSR developed a design with the sensor fixed at the pedal's pivot point. Teleflex moved the sensor to the pedal's fixed point to prevent the sensor's wires from chafing and fraying, and was granted its patent by the U.S. Patent and Trademark Office because no prior art referenced a "fixed point."

When KSR attached an electronic sensor to the fixed point in a later design, Teleflex filed an infringement suit.

The District Court ruled in favor of KSR for meeting the claim that a person of ordinary skill in the art of pedal design would have inevitably come up with the design and placed the sensor at the fixed point based on the prior art references.

The Appeals Court overturned the District Court's decision because Teleflex's design solved the problem of fraying and chafing wires at the pivot point, which was not mentioned anywhere previously.

In its decision, the Supreme Court outlined four areas where the Appeals Court had applied the TSM test too narrowly, including "obviousness cannot be proved by showing the combination of elements was obvious to try."

Furthermore, the electronic sensor and pedal assembly each performed exactly to their separate design references without any modification, the court said. The combination of elements may be a novel idea, but it does pass the test of obviousness because there was no inventive step involved.

Attorneys with the law firm Cochran Freund & Young LLC in Fort Collins, who filed an amicus curie brief with the Supreme Court in support of Teleflex in the case, agreed that the decision may have limited impact.

"This decision from the Supreme Court appears to be limited to the specific facts of this case since the Federal Circuit did not consider the broader teachings of the prior art," the firm wrote in a statement released after the decision.

The changes to the TSM test will make it more difficult to receive a patent that combines prior art elements, and time spent on review of patent filings will increase as reviewers are now required to broaden the range of prior art sources to include market demand, prior skill in the art, and interrelated teachings of multiple patents.

The new TSM test standards will also leave some patent holders vulnerable to anyone looking to challenge their patent.

"It depends on the TSM argument made during the prosecution," said William Cochran, senior attorney at Cochran Freund & Young. "A patent issued on an argument of the TSM test could be a problem."

Big companies cheer

That's good news for some, including a few of the companies that filed briefs in support of KSR such as Intel, Microsoft Corp., Cisco Systems Inc. and General Motors.

"Patents have certainly been a problem with software and computer industries," said Cochran. "Large guys worry about small corporations with great ideas and the large companies end up infringing."

Research in Motion, developer of the Blackberry handheld device, has been involved in six litigations for alleged patent infringement since 2001.

Cochran equates the thousands of patents large companies own to a stockpile of armaments used simultaneously as protection and power. "Patents are like little ICBMs. So if they launch at you, you launch back," he said.

Large companies avoid the mutual destruction of costly and almost never-ending patent litigation battles through licensing agreements and patent sharing. This can leave small companies with just a few patents or integral patents feeling nervous.

"Monopolies would like to steamroll small companies," Cochran said. "The only thing that stops these people is the patent."

For inventors and garage tinkerers with a great idea, Cochran recommends filing a patent application and pick a good attorney.

"It's not a cakewalk anymore."