

KSR Int'l Co. v. Teleflex, Inc.

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Standard for
Obviousness

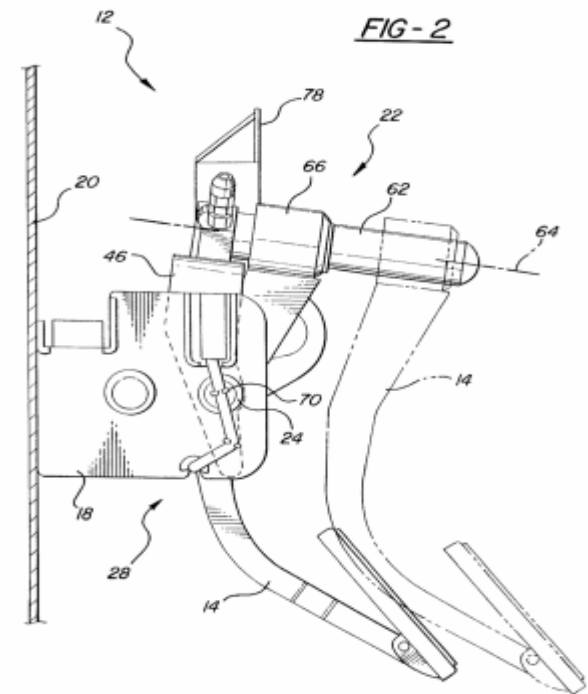


Securing Innovation

KSR Int'l Co. v. Teleflex Inc.

Overview

- Teleflex sued KSR for alleged infringement of U.S. Patent No. 6,237,565, which claims a gas pedal/electronic sensor combination.
- District court granted summary judgment to defendant, saying the invention was obvious. 298 F.Supp2d 581 (E.D. Mich. 2003)
- Federal Circuit overruled, saying the district court had improperly applied the standard for obviousness. 119 Fed. Appx. 282 (Fed. Cir. 2006)
- Supreme Court granted certiorari, will hear oral arguments Nov. 28, 2006.



Animation of the Invention

KSR Int'l Co. v. Teleflex Inc. (Cont.)

Facts

- Claim 4 reads (drawings references omitted):
A vehicle control pedal apparatus comprising:
a support adapted to be mounted to a vehicle structure;
an adjustable pedal assembly having a pedal arm moveable in fore and aft directions with respect to said support ;
a pivot for pivotally supporting said adjustable pedal assembly with respect to said support and defining a pivot axis; and
an electronic control attached to said support for controlling a vehicle system;
said apparatus characterized by said electronic control being responsive to said pivot for providing a signal that corresponds to pedal arm position as said pedal arm pivots about said pivot axis between rest and applied positions wherein the position of said pivot remains constant while said pedal arm moves in fore and aft directions with respect to said pivot.

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(Cont.)

Legal Standard

- 35 USC §103 – Obviousness
 - “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title [35 USC §102], if 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 “teaching-suggestion-motivation” test for obviousness.
 - Does the prior art **teach, suggest, or motivate** this combination?
 - This test is well established in Federal Circuit jurisprudence but arguably isn’t in the statute or in Supreme Court interpretations of §103
 - Also called the “suggestion” test

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Related Precedent

- In *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976), the Supreme Court unanimously found a patent invalid for obviousness, since “all of the individual elements of the patent were old in the dairy business and the combination of the old elements to produce an abrupt release of water directly onto the barn floor did not result in a new or different function” or synergistic effect, which is “an effect greater than the sum of the several effects taken separately.”
- The Federal Circuit dismissed this holding in *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1566 (Fed. Cir. 1983): “We cannot construe [the principles from] *Sakraida v. Ag Pro, Inc.*, ... as a rule of law applicable broadly to patent cases because virtually every claimed invention is a combination of old elements, and...virtually every patent can be described as a ‘combination patent’.” (citations removed)

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298 F.Supp. 2d 581 (E.D. Mich. 2003)

- District court applied the suggestion test
 - Found that the nature of the problem (creating a smaller, less complex, cheaper pedal assembly), combined with the prior art, implicitly suggested this combination.
 - No finding that this suggestion was in prior art, merely an assertion that the suggestion was in the nature of problem.
- **Result:** Teleflex patent invalid for obviousness; court granted summary judgment to accused infringer KSR.

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- District Court held that U.S. Patent No. 5,010,782, issued to Asano et al. disclosed all of the structural limitations of claim 4 with the exception of the electronic control. “Asano teaches an adjustable pedal assembly pivotally mounted on a support bracket with the pedal moving in a fore and aft directions with respect to the support and the pivot remaining in a constant position during movement of the pedal arm.”
- The district court based its finding of a suggestion or motivation to combine largely on the nature of the problem to be solved by claim 4 of the ‘565 patent. The court determined from the patent’s specification that the invention of the ‘565 patent was intended to solve the problem of designing “a less expensive, less complex and more compact [assembly] design.” The court then explained that U.S. Patent No. 5,819,593, issued to Rixon et al. also suffered from being too complex because the pedal position sensor is located in the pedal housing and its fore and aft movement with the adjustment of the pedal could cause problems with wire failure. Thus, the solution to the problem required “an electronic control that does not move with the pedal arm while the pedal arm is being adjusted by the driver.” The court then concluded that “a person with ordinary skill in the art with full knowledge of Asano and the modular pedal position sensors would be motivated to combine the two references to avoid the problems with Rixon ‘593.”



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- The district court also found an express teaching to attach the electronic control to the support bracket of a pedal assembly based upon the disclosure of U.S. Patent No. 5, 063,811, issued to Smith et al. The court stated that Smith provided express teachings as to the desirability of attaching the electronic control to a fixed support member in order to avoid the wire failure problems disclosed in the Rixon '593 patent and solved by the '565 patent.
- The district court explained that the prosecution history of the '565 patent bolstered its finding of a suggestion or motivation to combine the Asano and electronic control references.

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119 Fed. Appx. 282 (Fed. Cir. 2006)

- Federal Circuit vacated and remanded
 - Reliance on the nature of the problem to “suggest” is not proper application of the test
 - Must make a factual finding that this suggestion is in prior art as opposed to conclusory statement
- **Holding:** The district court, in granting summary judgment in favor of KSR, erred as a matter of law by applying an incomplete teaching-suggestion-motivation test to its obviousness determination. The correct standard requires the court to make specific findings showing a teaching, suggestion, or motivation to combine prior art teachings in the particular manner claimed by the patent at issue
 - A successful invalidation as obvious under the suggestion test requires a factual finding that cites specific prior art references.

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- The Federal Circuit held that the objective of the '565 patent was to design a smaller less complex, and less expensive electronic pedal assembly
- The Asano patent, on the other hand, was directed at solving the “constant ratio problem.”
- The district court’s reliance on the problems associated with the Rixon '593 patent similarly failed to provide a sufficient motivation to combine. This is because the Rixon '593 patent does not address the problem to be solved by the '595 patent; rather it suffers from the problem. The district court did not explain how suffering from the problem addressed by the '595 patent would have specifically motivated one skilled in the art to attach an electronic control to the support bracket of the Asano assembly
- The Federal Circuit also did not agree with the district court’s reliance on the express teachings of the Smith patent. Solving the problem of wire chafing is a different task than reducing the complexity and size of the pedal assemblies. What is more, the Smith patent does not relate to adjustable pedal assemblies; therefore, it does not address the problem of wire chafing in an adjustable pedal assembly



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- In addressing the only declaration offered by KSR regarding motivation to combine, the Federal Circuit noted that the issue is not whether a person of ordinary skill in the art had a motivation to combine the electronic control with an adjustable pedal assembly, but whether a person skilled in the art had a motivation to attach the electronic control to the support bracket of the pedal assembly

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At the Supreme Court

- Supreme Court granted petition for certiorari
 - Issue is whether there *must* be evidence in the prior art of a suggestion.
 - Amicus briefs from Solicitor General and law professors requesting that Supreme Court of the United States get rid of the “suggestion” test.
- Precise issue:
 - “Whether the Federal Circuit has erred in holding that a claimed invention cannot be held “obvious”, and thus unpatentable under 35 U.S.C. § 103(a), in the absence of some proven “teaching, suggestion, or motivation” that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed.”

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CAFC Responds to Grant of Certiorari.

- In *Alza Corporation v. Mylan Laboratories*, Case No. 06-1019 (Fed. Cir. Sept. 6, 2006), the Federal Circuit upheld a district court's decision that plaintiff-appellant Alza's patent on an extended release anti-incontinence drug, oxybutynin was invalid for obviousness.
- The court defended the "motivation-suggestions-teaching" doctrine as flexible while withdrawing somewhat from its apparent holding in *KSR*.
- The court said that motivation to combine need not be found explicitly in the prior art so long as there is evidence in the record as to why, at the time of the invention, one skilled in the art would make the asserted combination.
- The court suggests that its holding in *KSR* rests "on the unremarkable premise that legal determinations of obviousness... should be based on evidence rather than on mere speculation or conjecture."

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Summary

- This case may significantly elevate the standard of non-obviousness, which would be a serious setback for individual inventors of mechanical combinations but welcomed by major electronics and software companies.
- Will resolve a long existing conflict between Supreme Court and CAFC jurisprudence.