



ARE Patent Law Alert: U.S. Patent and Trademark Office Provides Notice of New Guidelines For The Obviousness Inquiry Based on Post-*KSR* Case Law Development

September 8, 2010

Author(s): Charles R. Macedo

(September 8, 2010) On September 1, 2010, the U.S. Patent and Trademark Office (“PTO”) published a notice of its Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, 75 Fed. Reg. 53643 (Sept. 1, 2010) (“Guidelines”). The new Guidelines became effective September 1, 2010, and the PTO has invited interested members of the public to comment on the Guidelines by sending an e-mail to KSR_Guidance@uspto.gov or by regular mail. The new Guidelines seek to incorporate developments in the case law on obviousness since the issuance of the Supreme Court’s decision in *KSR v. Teleflex*, 550 U.S. 398 (2007).

The Guidelines recognize seven rationales supporting a claim of obviousness as derived from the Supreme Court’s Decision in *KSR*:

- (1) the “teaching-suggestion-motivation” approach;
- (2) combining prior art elements according to known methods to yield predictable results;
- (3) simple substitution of one known element for another to obtain predictable results;
- (4) use of a known technique to improve similar devices, methods, or products in the same way;
- (5) applying a known technique to a known device, method, or product ready for improvement to yield predictable results;
- (6) the “obvious to try” approach — choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; and
- (7) known work in one field of endeavor may prompt variations of that to be used in either the same field or a different one based on design incentives or other market forces, if the variations are predictable to one of ordinary skill in the art.

Regardless of which rationale an Examiner decides to apply, the Guidelines emphasize that “[a]ny rationale employed must provide a link between the factual findings and the legal conclusion of obviousness.” Thus, the Guidelines state:

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.

The Guidelines continue to require the examiner to provide an explicit rationale and a “reasoned explanation” to support a purported combination as part of a prima facie case of obviousness. Indeed, the Guidelines emphasize, “**[t]his requirement for explanation remains even in situations in which Office personnel may properly rely on intangible realities such as common sense and ordinary ingenuity.**”

The Guidelines reinforce that “familiar lines of arguments” against prima facie cases of obviousness still apply, including:

- (1) teaching away from the claimed invention by the prior art;
- (2) lack of a reasonable expectation of success; and
- (3) unexpected results.

The Guidelines include a chart that discusses cases that apply the “combining prior art elements”, “substituting one known element for another”, “obvious to try”, and “consideration of evidence” rationales, and the “teaching points” of each case.

You can find additional publications on the law of obviousness on our firm website at www.arelaw.com, or contact one of our attorneys to discuss your particular issues.

[Mr. Macedo](#)