

PATENTING IN THE U.S.

A recent U.S. Supreme Court decision (KSR v Teleflex 30-04-2007) has approved a more rigorous approach to 'obviousness'. In practice this may lead to more exacting official objections during examination of U.S. patent applications, although the objective is not to prevent grant of patents for 'real' inventions, since that is a right enshrined in the U.S. Constitution. The intention is that 'abusive' applications which 'stifle' progress will be weeded out.

The decision relates to a claim of U.S. Patent 6237565 for an automobile pedal, licensed by Teleflex and alleged to have been infringed by KSR. The claim was held to be invalid.

In the U.S. the courts have traditionally applied the requirement of Teaching, Suggestion or Motivation to justify obvious combinations of prior art disclosures. That is, an invention should only be held to be obvious, and therefore non-patentable, over a combination of prior disclosures if a skilled person would be led into making the combination. The Supreme Court has now decided that the TSM test is not a rigid rule and: "the diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way". It is not correct only to look at the problem solved by the patentee. It might be obvious to combine prior disclosures even if they don't have the same objective. There may be other motivations to prompt the skilled person 'obviously' to arrive at the claimed invention. The notional skilled person must be considered to have "ordinary creativity", and a solution may be "obvious to try". The U.S. Constitution requires patents to 'promote' and not 'stifle' progress.

From a practical point of view, this emphasises the importance of including, where possible, an explanation of the 'special' nature of an invention when drafting a patent application; and also it means that, when arguing patentability with the examiner it might be necessary to go further than pointing out the lack of a relevant 'teaching' in the prior art: it might be necessary to point to the 'unusual' nature of the steps which have to be taken to derive the invention from the prior art.