

KSR Opens Numerous U.S. Patents To Reexamination

Tuesday, May 15, 2007 --- The Supreme Court's anxiously-awaited decision in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007) means that the United States Patent and Trademark Office was too lax in allowing the roughly 2,000,000 U.S. patents that have not yet expired. Does the patent office now have to reexamine these patents if requested to do so?

* The Patent Office Was Too Lax for Decades *

Most inventions are new combinations of old elements. Before *KSR*, the patent office considered inventions that merely combined old elements in new ways to have been "unobvious" and hence patentable, unless there had been "some suggestion or motivation" to have combined the old elements in the configuration of the invention. M.P.E.P. § 2143.

The patent office has been applying this "suggestion or motivation" test to patent applications for decades. However, the Supreme Court made clear in *KSR* that rigid application of this test was inconsistent with its earlier decisions and thus made it too easy to obtain patents:

[T]he Court of Appeals for the Federal Circuit has employed...the "teaching, suggestion, or motivation" test (TSM test), under which a patent claim is only proved obvious if "some motivation or suggestion to combine the prior art teachings" can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art... [T]he Court of Appeals addressed the question of obviousness in a manner contrary to §103 and our precedents....

KSR made clear that the standard that the patent office had been using for decades was too lax.

* Other Reasons for Combining Old Elements May Now Be Sufficient *

Just three days after the *KSR* decision, the deputy commissioner for patent operations issued a memorandum to its technology center directors. It advised of "points [that] should be noted" while the patent office is studying *KSR*. The memorandum went on: "The Court rejected a rigid application of the 'teaching, suggestion, or motivation' (TSM) test." However, the memorandum said, "It remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed [as the invention]."

Thus, the absence of a "suggestion or motivation" should not have guaranteed the issuance of a patent. The patent office should have

considered whether there were other reasons for combining old elements in the configuration of the invention.

* Many Patents Should Now Be Subject to Reexamination *

Sections 302 and 312 of the Patent Act both authorize a person to ask the patent office to reexamine a patent based on patents and printed publications (commonly referred to as “prior art”) thought to have a bearing on patentability. Once reexamination is granted, a patent examiner reviews the patent application as though the patent had never been granted. If the Patent Examiner finds that the invention was obvious, the claims in the patent are cancelled.

The right to obtain reexamination, however, is limited by statute. Sections 303 and 313 of the Patent Act both require the request for reexamination to present “a substantial new issue of patentability.”

To place patentability in question, the party seeking re-examination will need to demonstrate that each of the elements of the invention had been described in at least one prior patent or publication. This should usually be easy, since most inventions are made up entirely of old elements.

The party seeking re-examination will also have to offer a reason why the skilled artisan would have combined these old elements in the configuration of the invention. For the reason to meet the “new” requirement of Section 303 or 313, it will need to be one that the Patent Examiner did not consider before. However, the KSR decision expanded the types of reasons that must be considered. Thus, this requirement should also often be easy to meet.

For the reason to satisfy the “substantial” requirement of Section 303 or 313, “[i]t is not necessary that a ‘prima facie’ case of unpatentability exist.” M.P.E.P. § 2142. There must merely be “a substantial likelihood that a reasonable examiner would consider the [information] important in deciding whether or not the claim is patentable.” *Id.*

In many cases, the patents and publications that were originally considered by the patent examiner will have disclosed all of the elements of the invention. In these cases, the request for reexamination may not cite any new prior art. Instead, it may be based entirely on the prior art which the patent examiner originally found to be insufficient to bar issuance of the patent. Still, this should not pose a problem.

Section 303 and 313 of the Patent Act both provide: “The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.” Section 2242 of the Manual of Patent Examination Procedure similarly states that prior art may again be considered when “presented/viewed in a new light, or in a different way.” KSR is that “new light.”

* How Will the Patent Office React? *

The realization that the patent office applied the wrong legal standard to millions of unexpired patents may erode confidence in the validity of these patents. This may be particularly true for those patents that claim a “combination of familiar elements according to known methods...that does no more than yield predictable results”—a class of inventions that the Supreme Court in KSR said is “likely to be obvious.”

The reexamination statute was enacted for the very purpose of restoring this confidence. See *In Re Recreative Technologies Corp.*, 83 F.3d 1394, 1396 (Fed. Cir. 1996) (“[t]he reexamination statute was an important part of a larger effort to revive the United States’ competitive vitality by restoring confidence in the validity of patents issued by the PTO”). How the already overburdened patent office will see it—particularly for requests for reexamination that fail to cite any new prior art—remains to be seen.

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