

**REPORT ON THE U.S. SUPREME COURT CASE OF
*KSR INTERNATIONAL CO. V. TELEFLEX INC.*¹**

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On April 30, 2007, the Supreme Court of the United States delivered its ruling in the case of *KSR International Co. v. Teleflex Inc.* (No. 04-1350).

Summary: The U.S. Supreme Court's ruling makes it more difficult to obtain a U.S. patent, makes it more difficult to defend existing U.S. patents, and makes it less difficult to invalidate existing U.S. patents.

Previously, when a party sought to invalidate an existing patent in view of the disclosures of two or more prior art references, that party would have to show that there was a prior "teaching, suggestion, or motivation" to combine prior technologies to produce the invention as set forth in the claims of the existing patent. The patent examiners at the U.S. Patent and Trademark Office would use the same test when an applicant initially sought patent protection for a claimed invention.

On April 30, 2007, the U.S. Supreme Court indicated that the U.S. Court of Appeals for the Federal Circuit had applied the "teaching, suggestion, motivation" test too rigidly in *KSR International Co. v. Teleflex Inc.* The Supreme Court stated that the "teaching, suggestion, motivation" test can be helpful, but that particular test should not be applied too rigidly.

The Supreme Court stated that the "teaching, suggestion, motivation" test led to a constricted analysis that paid too much attention to an inventor's motivation and too little attention to whether there existed at the time of invention a known problem for which there was an obvious solution.

The Supreme Court stated that a "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."

As a result of this decision of the Supreme Court, it will be easier for a U.S. patent examiner to combine prior art references when rejecting claims in a patent application, and it will also be easier to combine prior art references when attempting to invalidate an existing U.S. patent.

Background: In *KSR International Co. v. Teleflex Inc.*, Teleflex held a patent claiming an adjustable gas pedal equipped with an electronic sensor. KSR developed an adjustable pedal system having an electronic sensor mounted at a pedal's fixed pivot point in order to communicate information regarding the pedal's position. Teleflex sued KSR for infringement, asserting that KSR's pedal system infringed claim 4 of the Teleflex patent. KSR countered that claim 4 of the Teleflex patent was invalid due to obviousness. KSR won in a U.S. Federal District Court, which ruled that claim 4 of the Teleflex patent is obvious. That ruling was overturned by the U.S. Court of Appeals for the Federal Circuit, which ruled that claim 4 of the Teleflex patent is not obvious. On April 30, 2007, the U.S. Supreme Court ruled that claim 4 of the Teleflex patent is obvious.

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