

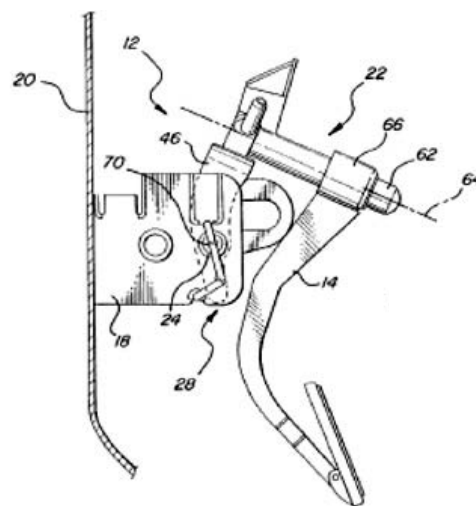
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PATENTS NOW HARDER TO GET, EASIER TO INVALIDATE

The United States Constitution gave Congress the power to grant patents to promote the progress of science and useful arts. On Monday, the Supreme Court, overruling precedent from the Federal Circuit, made clear that in order to promote such progress, routine improvements cannot receive patent protection.

In *KSR International Co. v. Teleflex, Inc.*, the Court considered a patent for an adjustable position gas pedal design wherein the sensor that monitored the pedal's position was placed at a particular point on the pedal. This pedal and sensor placement design was made by combining elements already disclosed to the public in earlier patents. The company accused of infringement argued that the patent claim was invalid because the allegedly innovative design was obvious and, therefore, not patentable.



The Supreme Court sided with the accused infringer, concluding that the patent claim was invalid because it was obvious. Of significance, the Court held that the test for what is “obvious” is not a rigid, narrow rule as applied by the Federal Circuit, but rather is based on the application of common sense and ordinary skill to the information already in the public domain, such as earlier patents and other previously published materials (known as “prior art”). The question is whether the combination of known elements was obvious to a person with ordinary skill in the art, that is, “a person of ordinary creativity, not an automaton.” This holding overrules the teaching, suggestion, and motivation test developed by the Federal Circuit, which the Court determined was inconsistent with its own prior cases that had established a flexible, objective approach.

In light of this decision, patent applicants face more difficulty obtaining a patent and patent owners face a greater challenge protecting the patents they own. As a patent applicant or owner, it may be more prudent now than ever before to perform patentability searches prior to filing a patent application or initiating patent litigation. From the perspective of a potential infringer of a patent, it may be worth considering anew whether such a patent just became (a little more) obvious and, hence, invalid.

To discuss the impact of the *KSR International* decision on your business or any other intellectual property matters, please contact the authors or any member of Powell Goldstein's Technology and Intellectual Property Group.

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