



A DECISION BY THE US SUPREME COURT MAKES NEW COMBINATIONS OF KNOWN TECHNOLOGIES MORE DIFFICULT TO PATENT

ADAM MIZERA^{*}
LEGER ROBIC RICHARD, LLP
LAWYERS, PATENT AND TRADE-MARK AGENTS

In a recent judgment *KSR v. Teleflex* published April 30, 2007, the US Supreme Court has attempted to settle a long-lasting debate on the criteria of inventiveness or non-obviousness applicable to patents. The basic criteria to establish the patentability of an invention are novelty, non-obviousness (or inventiveness) and usefulness. In this decision, the Supreme Court analysed this second criteria.

Even though Canada, the United-States and Europe each have their own criteria and specific judicial tests to evaluate the inventiveness of an invention, this decision from the US is important as a majority of patent application filings around the world are made in that country and, consequently, a majority of patent applications are drafted and address the particularities of patent prosecution in the US.

This decision analyses an invention in the automobile industry, which was a new combination of two known technologies. Consequently, the criteria of novelty and usefulness were met by this invention. The defendant accused of patent infringement in this case argued that the patented invention was invalid because of obviousness in view of the prior art known in the field of the invention.

Prior to this decision, the Court of Appeals of the Federal Circuit in the United States had established a strict test by which, in order to establish the obviousness of an invention, one had to find an explicit "teaching, suggestion or motivation" for a person versed in the art of the technology in order to combine two distinct documents of prior art.

The US Supreme Court do not reject this test from the Court of Appeals, but nevertheless distanced itself from a strict interpretation of this test and thus incorporated a *common sense* approach in its analysis, in order to establish that the invention was an obvious combination of known technologies and therefore non-patentable.

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LEGER ROBIC RICHARD, L.L.P.
1001 Square-Victoria - Bloc E - 8th floor
Montreal (Quebec) Canada H2Z 2B7
Tel.: (514) 987-6242 Fax: (514) 845-7874
www.robic.ca info@robic.ca

Therefore, with regards to the prosecution of presently pending patent applications, it could become more difficult to circumvent certain examiners objections in Office Actions with respect to obviousness, especially if the concerned invention is a combination of already-known technologies. Similarly, it is possible that the validity of several issued patents could eventually be attacked for lack of inventiveness in future patent infringement cases.

In parallel to this, following publication of the decision, the US Patent Office distributed a memo to its examiners reiterating the arguments that examiners must present when objecting to an application based on obviousness.

See the reasons of the Supreme Court on the following site:
<http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>

See the memo sent by the USPTO to its examiners:
<http://www.patentlyo.com/patent/files/Focarino.pdf>

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