KSR: It Was Not a Ghost

James W. Dabney
KSR: IT WAS NOT A GHOST

James W. Dabney†

Abstract

In 1982, the Court of Appeals for the Federal Circuit adopted an interpretation of 35 U.S.C. § 103 that differed substantially from prior Supreme Court interpretations of the statute. Under Federal Circuit precedent, the act of filing of a patent application was said to vest in the applicant a provisional entitlement to patent protection for any process, machine, manufacture, or composition of matter that the applicant disclosed and claimed to be his or her “invention.” Under this view, § 103 functioned as a mere proviso to a presupposed entitlement to patent protection. Federal Circuit precedent enforced this supposed entitlement by means of a judicially-devised “test,” referred to as the “teaching-suggestion-motivation test,” under which the United States Patent and Trademark Office and United States courts were said to lack authority to hold that a patent claim was invalid under § 103 in the absence of some proven teaching, suggestion, or motivation to combine the relevant prior art teachings in the particular manner claimed. In KSR International Co. v. Teleflex Inc., the Supreme Court disapproved core premises of Federal Circuit precedent interpreting § 103. KSR reaffirms that § 103 did not abrogate, but to the contrary “codified” the pre-existing legal standard for patentability that the Court had announced in Hotchkiss v. Greenwood. KSR also makes clear that courts, not juries, have responsibility for determining the preemptive effect of undisputed prior art under § 103.

† Member, New York and New Jersey Bars. A.B. Harvard 1976; J.D. Cornell Law School 1979. Mr. Dabney is a Partner in the New York Office of Fried, Frank, Harris, Shriver & Jacobson LLP. He was lead counsel for KSR International Co. in both lower courts and in arguing before the Supreme Court of the United States. The views expressed here are his own and not necessarily those of Fried Frank or any of its clients. The author thanks John F. Duffy, Stephen S. Rabinowitz, Henry C. Lebowitz, Mitchell E. Epner, and Darcy M. Goddard for helpful comments on this article. Adapted with permission from an earlier version published in BNA’s Patent, Trademark & Copyright Journal, Vol. 74, No. 1818 (May 11, 2007) pp. 71-77. Copyright 2007 by The Bureau of National Affairs, Inc. (800-372-1033). Revised version Copyright © 2007 by James W. Dabney.
I. INTRODUCTION

In *KSR International Co. v. Teleflex Inc.*, the Supreme Court reheard a debate over the nature and meaning of 35 U.S.C. § 103 that was thought to have been settled in *Graham v. John Deere Co.* and *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, but was reignited by a 1983 decision of Court of Appeals for the Federal Circuit. The issue was whether Congress, in enacting § 103 in 1952, had codified, or as some persisted in arguing, had abrogated the legal standard of patentability that the Supreme Court announced in *Hotchkiss v. Greenwood* and applied in numerous patent cases decided between 1851 and 1952 including *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*

Adhering to its previous treatments of § 103, the Court in *KSR* held that § 103 “codified” the “bar on patents claiming obvious subject matter established in *Hotchkiss*,” and further, that “[n]either the enactment of § 103 nor the analysis in *Graham* disturbed this Court’s earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the

---

prior art.”

In the particular case before it, the Court held that “fundamental misunderstandings” in Federal Circuit precedent had led the lower court “to apply a test inconsistent with our patent law decisions.” Prior art references that the Federal Circuit held did not make out “a prima facie case of obviousness,” were held by the Supreme Court to mandate summary judgment of invalidity.

The KSR decision restates and reaffirms, as patent law “doctrine,” a series of principles that courts and the United States Patent and Trademark Office (the “PTO”) may properly draw on when considering whether subject matter claimed in a patent or patent application should be deemed “non-obvious subject matter” under § 103(a). The proven existence of a “teaching, suggestion, or motivation” to make particular claimed subject matter remains one basis on which a judgment of invalidity may rest, but it is only one. Courts and the PTO must also consider the degree of skill needed to devise claimed means of solving an objectively defined problem, and may conclude that claimed subject matter “would have been obvious” if, for example, it “[involved] the mere application of a known technique to a piece of prior art ready for the improvement.”

The KSR decision calls into question various procedural aspects of Federal Circuit precedent applying § 103, including the Federal Circuit rule that a patent litigant has no right to a court’s, as distinct from a lay jury’s, independent judgment on the ultimate legal

---

8. Id. at 1739 (citing Great Atl., 340 U.S. at 152). The KSR decision quotes and applies the same passage from Great Atl. as the Court had quoted and applied in Sakraida and Anderson's-Black Rock.

9. Id. at 1743.


11. KSR, 127 S. Ct. at 1743 (“When we apply the standards we have explained to the instant facts, claim 4 must be found obvious.”).

12. Id. at 1739.

13. Id. at 1739-42. See infra notes 108 - 135 and accompanying text.

14. Id. at 1741-42 (“Neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim.”).

15. Id. at 1740. See also Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., 72 Fed. Reg. 57526 (Oct. 10, 2007). In the PTO Examination Guidelines, “[u]se of known technique to improve similar device (methods, or products) in the same way,” id. at 57529, and “[a]pplying a known technique to known device (method, or product) ready for improvement to yield predictable results,” id., are expressly listed as two of seven approved “Rationales” for rejecting patent claims under § 103. “Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify prior art references or to combine prior art reference teachings to arrive at the claimed invention,” id., is now but one, non-exclusive basis on which PTO Examiners may ground a legal conclusion of invalidity.
question of patent validity.\textsuperscript{16} If faithfully applied, the \textit{KSR} decision should restore the traditional role of United States District Judges in making legal determinations of patent claim validity under § 103, and should thereby greatly reduce the cost and uncertainty of patent infringement litigation.

II. THE TRADITIONAL UNDERSTANDING OF "NON-OBVIOUS SUBJECT MATTER": 1851-1982

The concept of limiting patents to "non-obvious subject matter" traces to the Supreme Court's decision in \textit{Hotchkiss v. Greenwood}.\textsuperscript{17} In that case, the Court held invalid a patent that claimed a method of manufacturing knobs (e.g., doorknobs) whose end portions were made of clay or porcelain. The method included steps for fastening a knob to a threaded "shank." The exact same fastening method had previously been used to make knobs having wooden or metal ends; the alleged innovation was applying the pre-existing fastening method to make knobs of clay or porcelain.\textsuperscript{18} In rendering its judgment of patent invalidity, the Court formulated and applied the following legal standard:

\begin{quote}
[U]nless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilful mechanic, not that of the inventor.\textsuperscript{19}
\end{quote}

Between 1851 and 1952, the Supreme Court frequently considered and determined the merits of invalidity defenses to claims for alleged patent infringement, and in so doing, frequently considered and determined whether particular subject matter claimed in an issued patent was sufficiently innovative as to satisfy the general condition for patentability set forth in \textit{Hotchkiss}.\textsuperscript{20} This sizable body

\begin{footnotes}
\textsuperscript{16} See R.R. Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 1514 (Fed. Cir. 1984) ("[I]t is not error to submit the question of obviousness to the jury."). See infra notes 147-157, 167-172 and accompanying text.
\textsuperscript{17} Hotchkiss v. Greenwood, 52 U.S. (11 How.) 248 (1851).
\textsuperscript{18} \textit{id.} at 249-250.
\textsuperscript{19} \textit{id.} at 266.
of "judicial precedents embracing the Hotchkiss condition"\textsuperscript{21} encompassed diverse types of alleged inventions in diverse technological fields, and represented a substantial public investment in the development of patent law.

In 1952, Congress repealed the Patent Act of 1870\textsuperscript{22} and enacted the current Patent Act of 1952, one of whose provisions, 35 U.S.C. § 103, was headed "Conditions for patentability; nonobvious subject matter." The Supreme Court first interpreted the new § 103 in its 1966 Graham decision. Consistently with what was, at the time, the


\textsuperscript{21} Graham, 383 U.S. at 17.

overwhelming majority view of the Courts of Appeals. Graham expressly rejected arguments that § 103 was purportedly “intended to sweep away judicial precedents and to lower the level of patentability.” Graham held, to the contrary, that “the section was intended merely as a codification of judicial precedents embracing the Hotchkiss condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability.”

Three years later, in Anderson’s-Black Rock Inc. v. Pavement Salvage Co., the Court granted certiorari to consider the question whether “the holding on the matter of aggregations in patents in Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545, is still the law . . . .” The answer was “yes.” Anderson’s-Black Rock reversed a judgment of infringement and held a patent claim invalid under § 103, applying what it called “the test of validity of combination patents” and reiterating that § 103 was intended “merely as a codification of judicial precedents embracing the Hotchkiss condition.”


24. Graham, 383 U.S. at 17. At the time of the Graham decision, there were some — including the late Giles S. Rich, then a judge of the Court of Customs and Patent Appeals (“C.C.P.A.”) — who argued that the enactment of § 103 had purportedly effected a radical change in United States patent law. In a 1964 speech entitled “The Vague Concept of ‘Invention’ as Replaced by Sec. 103 of the 1952 Patent Act,” Judge Rich criticized lawyers who had “persuaded a number of courts that it [§ 103] made no change whatever but was ‘mere codification.’” See Brief Amicus Curiae in Support of 35 U.S.C. 103 at Appendix A, Graham v. John Deere Co., 383 U.S. 1 (1966) (Nos. 11, 37, 43), 1965 WL 115655. “Mere codification” was, however, exactly how the Supreme Court interpreted § 103 in Graham. See Graham, 383 U.S. at 17 (“[T]he section was intended merely as a codification of judicial precedents embracing the Hotchkiss condition . . . .”).

25. Graham, 383 U.S. at 17. Accord Sakraida v. Ag Pro, Inc., 425 U.S. 273, 279 (1975) (“This standard [Hotchkiss] was enacted in 1952 by Congress in 35 U.S.C. § 103 as a codification of judicial precedents . . . .”); Dann v. Johnson, 425 U.S. 219, 225-26 (1975) (“As a judicial test, ‘invention’ — i.e., ‘an exercise of the inventive faculty,’ McClain v. Ortmayer, 141 U.S. 419, 427 (1891) — has long been regarded as an absolutely prerequisite to patentability . . . . However, it was only in 1952 that Congress, in the interest of ‘uniformity and definiteness,’ articulated the requirement in a statute, framing it as a requirement of ‘nonobviousness.’”).


28. See Anderson’s-Black Rock, 396 U.S. at 60.

29. Id. at 60 (citing and applying Lincoln Eng’g Co. v. Stewart-Warner Corp., 303 U.S. 545, 549 (1938)).

30. Id. at 62 (quoting Graham, 383 U.S. at 17).
In each of the Court’s precedents applying § 103 prior to the creation of the Federal Circuit, the Court cited and relied on pre-codification precedents when assessing whether subject matter claimed in a patent application or an issued patent should be deemed an “invention” or “non-obvious subject matter.” The Court’s pre-Federal Circuit precedents also consistently interpreted § 103 as specifying one of three “conditions for patentability” whose satisfaction was a “prerequisite to patentability.” Pre-1952 subtests, such as “the test of validity of combination patents,” continued to be applied as particularized applications of what the Court called “the ‘functional approach’ of Hotchkiss” that § 103 “codified.”

In general, as interpreted by the Supreme Court, § 103 and the ‘functional approach’ of Hotchkiss both required that a court (a) posit an objectively defined result to be achieved (e.g., making a clay


32. 35 U.S.C. § 103 is headed: “Conditions for patentability; non-obvious subject matter”.

33. Graham, 383 U.S. at 17. See Sakraida, 425 U.S. at 279 (“It has long been clear that the Constitution requires that there be some ‘invention’ to be entitled to patent protection . . . [t]his standard [Hotchkiss] was enacted in 1952 by Congress in 35 U.S.C. § 103 ‘as a codification of judicial precedents . . . with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability.’”) (quoting Graham, 383 U.S. at 17). See also Dann, 425 U.S. at 230 n.4 (“commercial success without invention will not make patentability” (quoting Great Atl., 340 U.S. at 153)); Anderson’s-Black Rock, 396 U.S. at 61-63 (“The patent standard is basically constitutional”; claimed subject matter “was not an invention by the obvious-nonobvious standard”; “more than that [commercial success] is needed for invention”); Adams, 383 U.S. at 48 (“novelty and nonobviousness—as well as utility—are separate tests of patentability and all must be satisfied in a valid patent”); Graham, 383 U.S. at 17 (“the § 103 condition . . . is but one of three conditions, each of which must be satisfied”); Gardner v. Herz, 118 U.S. 180, 191 (1886) (“under art. 1, sec. 8, subdivision 8 of the constitution, a patentee ‘must be an inventor and he must have made a discovery.’” (quoting Thompson v. Boisslier, 114 U.S. 1, 11 (1885)); Hotchkiss, 52 U.S. (11 How.) at 267 (holding that certain “degree of skill and ingenuity constitute essential elements of every invention” and that claimed subject matter was not patentable because it constituted “the work of the skilful mechanic, not that of the inventor.”).

34. Sakraida, 425 U.S. at 282 (quoting Anderson’s-Black, 396 U.S. at 60).

doorknob having a threaded shank), and then (b) form a legal judgment whether, in light of pre-existing knowledge and technology, the conception of claimed means for achieving the posited result required "more ingenuity and skill... than were possessed by an ordinary mechanic acquainted with the business." This approach to determining patent claim validity under § 103 is very similar to the

---

36. Under Supreme Court patent precedent, one may not patent a "result" as distinguished from practical means for achieving a desired result. See, e.g., Markman v. Westview Instruments, Inc., 517 U.S. 370, 373 (1996) ("A claim covers and secures a process, a machine, a manufacture, a composition of matter, or a design, but never the function or result of either, nor the scientific explanation of their operation") (emphasis added) (quoting 6 E. LIPSCOMB, WALKER ON PATENTS § 21:17 (3d ed. 1985)); Diamond v. Diehr, 450 U.S. 175, 182 n.7 (1981) ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself.") (quoting Corning v. Burden, 56 U.S. (15 How.) 252, 267-68 (1854)). For purposes of validity analysis under § 103(a), the result to be achieved is defined objectively by reference to "the prior art" and "the subject matter sought to be patented," not by reference to what a given applicant might have subjectively thought was the result that he or she was pursuing or the degree of difficulty that he or she subjectively perceived. A patent applicant may not be aware of the closest prior art, or may describe an alleged invention using claim words that are so broad as to leave little or no difference between the claimed subject matter and the prior art. See KSR, 127 S. Ct. at 1741-42 ("neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim.").

37. Under Supreme Court patent precedent, the validity of a patent claim "must be ascertained, not from a consideration of the purposes sought to be accomplished, but of the means pointed out for the attainment thereof; and if such means, adapted to effect the desired results, do not involve invention, they can derive no aid or support from the end which was sought to be secured." Knapp v. Morss, 150 U.S. 221, 227-28 (1893). See also In re Comiskey, 499 F.3d 1365 (Fed. Cir. 2007) (in case where patent claim recited a computer "system" for implementing a lawyer's allegedly novel idea of providing for mandatory arbitration of disputes concerning "unilateral documents" such as wills and trusts, the question of validity under § 103 turned on "whether the addition of general purpose computers or modern communications devices to Comiskey's otherwise unpatentable mental process would have been non-obvious to a person of ordinary skill in the art," not on whether conception of the underlying legal idea would have been obvious).

38. Hotchkiss, 52 U.S. (11 How.) at 265 quoted in Sakraida, 425 U.S. at 279. See, e.g., Graham, 383 U.S. at 24-25 (in view of prior art, ordinarily skilled person would have immediately seen claimed subject matter as means of achieving desired "free-flexing" objective; patent claims held invalid); Adams, 383 U.S. at 42-52 (in view of prior art, ordinarily skilled person would not have seen claimed subject matter as means of achieving desired water-activated constant-voltage battery; patent claims held valid); Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 333-35 (1945) (in view of prior art, ordinarily skilled person would have been capable of devising claimed ink composition as means of achieving desired drying properties; patent claims held invalid); Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 279 (1944) (in view of prior art and secondary considerations, ordinarily skilled person would not have seen claimed subject matter as means of achieving desired leak proof battery; patent claims held valid); Essex Razor Blade Corp. v. Gillette Safety Razor Co., 299 U.S. 94, 98 (1916) (in view of prior art, claimed non-circular opening in razor blade was a "choice... between alternative means obvious to any mechanic"; patent claims held invalid).
"problem and solution" approach to patentability that has long prevailed in much of Europe.\textsuperscript{39}

III. THE FEDERAL CIRCUIT'S REINTERPRETATION OF § 103: 1982-2005

Commencing on October 1, 1982, appeals from district court judgments in civil actions "arising under" federal patent law were diverted from the regional circuits to a newly-created, intermediate appellate court, the Court of Appeals for the Federal Circuit.\textsuperscript{40} As one of its first official acts, the Federal Circuit bound itself to follow all of the holdings that the former Court of Customs and Patent Appeals ("C.C.P.A.") had announced during a fifty-plus year period ending September 30, 1982.\textsuperscript{41}

One C.C.P.A. precedent that the Federal Circuit bound itself to follow was \textit{In re Warner}.\textsuperscript{42} In that case, the C.C.P.A. had stated:

[T]he precise language of 35 U.S.C. § 102 that '[a] person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.\textsuperscript{43}

\begin{itemize}
\item \textsuperscript{39} \textit{See Case Law of the Boards of Appeal of the European Patent Office} 120-21 (A. Rodes et al. 5\textsuperscript{th} ed. 2006) (describing "problem and solution approach" to determining whether claimed subject matter reflects an "inventive step"); Freidrich-Karl Beier, \textit{The Inventive Step in its Historical Development}, 17 \textit{Int'l Rev. Indus. Prof. & Copyright L.} (IIC) 301, 304 (1986) ("[T]he so-called patentability requirement was invented by the Americans, in particular the Justices of the U.S. Supreme Court in the famous case [Hotchkiss].").
\item \textsuperscript{41} \textit{South Corp. v. United States}, 690 F.2d 1368, 1369 (Fed. Cir. 1982) (en banc) ("[T]he holdings of our predecessor courts, the United States Court of Claims and the United States Court of Customs and Patent Appeals, announced by those courts before the close of business September 30, 1982, shall be binding as precedent in this court"). In 1966, when PTO decisions to refuse patents were subject to review by the C.C.P.A., the Supreme Court had "observed a notorious difference between the standards applied by the Patent Office and by the courts." \textit{Graham}, 383 U.S. at 18. With the \textit{South Corp.} decision, the "standards applied by the Patent Office" abruptly displaced the standards that had been "applied by the courts" up until that time. For a provocative treatment of the political debate that preceded the creation of the Federal Circuit and the impact of early Federal Circuit decisions on United States patent law, consult Cecil D. Quillen, Jr., \textit{Innovation and the U.S. Patent System}, 2 VA. L. & Bus. Rev. 208 (2006).
\item \textsuperscript{42} \textit{In re Warner}, 379 F.2d 1011 (C.C.P.A. 1967). See, e.g., \textit{In re Piasecki}, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (following the standard announced in \textit{In re Warner}).
\item \textsuperscript{43} \textit{In re Warner}, 379 F.2d at 1016.
\end{itemize}
This seemingly obscure procedural ruling was, in reality, an aspect of a radical argument for "sweep[ing] away judicial precedents" that has been presented, and expressly rejected, in Graham. Its adoption by the Federal Circuit in 1982 had major substantive ramifications that ultimately led to the KSR decision some twenty-five years later.

Under the interpretation of § 103 announced in Warner and subsequently embraced by the Federal Circuit, a patent applicant's subjective statement of belief that he or she was "the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he [or she] solicits a patent," was said to trigger an entitlement to patent protection that the PTO could not rightly refuse unless the PTO came forward with "evidence" that the C.C.P.A. deemed sufficient to make out what came to be called a "a prima facie case of obviousness." If the PTO failed to locate and produce "evidence" that established a "prima facie case of obviousness" with respect to a claim made in a patent application, then, under C.C.P.A. and pre-KSR Federal Circuit precedent, the PTO was said to have no choice but to allow the claim.

As thus interpreted in Warner and its progeny, § 103 did not state a condition for patentability that a patent applicant had to satisfy before a claim to patent protection could be allowed, but rather purportedly stated a condition for challenges to patentability that the Government had to satisfy before a claim to patent protection could properly be denied. The sole legal authority cited in Warner for its interpretation of § 103 was: "see Graham and Adams." In fact, nowhere in the Supreme Court's Graham and Adams decisions was it held or intimated that, when examining an "alleged new invention," the Government was required to accept an applicant's self-interested claim that he or she was an "inventor" of "non-obvious subject matter" unless the Government succeeded in carrying a particular "burden of proof." On the contrary, both cases held that § 103

---

44. Graham, 383 U.S. at 16.
46. Piasecki, 745 F.2d at 1472.
47. See, e.g., In re Carleton, 599 F.2d 1021, 1024 (C.C.P.A. 1979).
48. Warner, 379 F.2d at 1016.
49. 35 U.S.C. § 131 (2000) ("The Director shall cause an examination to be made of the application and the alleged new invention . . . .") (emphasis added).
prescribes a "test of patentability," not a test of challenges to patentability.

In furtherance of the interpretation of § 103 articulated in *Warner*, the C.C.P.A. applied what came to be called the "teaching-suggestion-motivation test" for determining the sufficiency of evidence relied on as support for a legal conclusion of invalidity under § 103. Under this "test," the PTO was said to be precluded from holding that two or more prior art references rendered a patent claim invalid under § 103 in the absence of "some ‘teaching, suggestion, or motivation’ that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed." With the Federal Circuit's wholesale adoption of C.C.P.A. precedent in 1982, the "teaching-suggestion-motivation test" of challenges to patentability was suddenly extended to the determination of invalidity defenses to claims for alleged patent infringement brought in federal courts. The Federal Circuit's interpretation of § 103 had the practical effect of greatly expanding the scope of what could be patented as an "invention" in the United States. That which a person is skilled enough to make encompasses far more than what a person might be "taught," "suggested" or "motivated" to make at a point in time. In


52. It bears emphasis that the "teaching-suggestion-motivation test," as developed and applied by the C.C.P.A. and the Federal Circuit, was not a test of whether claimed subject matter constituted an "invention" or qualified for patent protection in the first instance, but rather was a test of whether evidence submitted against a patent claim was sufficient to permit a court or the PTO to draw a legal conclusion of invalidity under § 103. The "test" purported to be a severe constraint on the authority of courts and the PTO to form legal judgments.


54. *See, e.g.*, *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984) ("teachings of [prior art] references can be combined only if there is some suggestion or incentive to do so.").

55. One outgrowth of the "teaching-suggestion-motivation test" was the first generation of so-called "business method" patents, which typically disclosed computer systems that differed from prior art systems only in the results they were programmed or configured to provide. Under pre-KSR Federal Circuit precedent, the PTO was said to lack authority to disallow a patent on novel claimed apparatus or methods, no matter how technologically trivial, unless it could "prove" the existence of some "teaching, suggestion, or motivation" to make the particular claimed subject matter. As "[i]n many fields it may be there is little discussion of
the context of infringement litigation, moreover, the Federal Circuit announced a series of procedural rules that greatly magnified the impact of its interpretation of § 103.

In 1983, the Federal Circuit announced that a person asserting a defense of invalidity under 35 U.S.C. § 282(2) bore the burden of proving all facts relevant to the defense by evidence that was "clear and convincing." No authority was cited for this broad proposition, and it was (and remains) very much in tension with Supreme Court precedent. In numerous cases including *Graham*, *Adams*, *Anderson's-Black Rock*, and *Sakraida*, the Supreme Court has determined the merits of invalidity defenses to patent infringement claims without subjecting the factual predicates of those defenses to a "clear and convincing" evidence burden of proof. As the *KSR* case illustrates, moreover, invalidity defenses are frequently based on evidence that has never previously been presented to, or considered by, the PTO. Hence, even if deference to an administrative agency's fact finding could justify a heightened evidentiary burden in some

---

56. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549 (Fed. Cir. 1983). In the law of evidence, the phrase "clear and convincing" evidence connotes evidence that "place[s] in the ultimate factfinder an abiding conviction that the truth of [a litigant's] factual contentions are 'highly probable.'" *Colorado v. New Mexico*, 467 U.S. 310, 316 (1984) (quoting *C. McCORMICK, LAW OF EVIDENCE* § 320 at 679 (1954)).

57. The Court has stated that as a general matter, "[b]ecause the preponderance of the evidence standard results in a roughly equal allocation of the risk of error between litigants, we presume that this standard is applicable in civil actions between private litigants unless 'particularly important individual interests or rights are at stake.'" *Grogan v. Garner*, 498 U.S. 279, 286 (1991) (quoting *Herman & MacLean v. Huddleston*, 459 U.S. 375, 389 (1983)). Examples of "particularly important individual interests or rights" include parental custody rights and citizenship rights. *Herman & McClean*, 459 U.S. at 387-90.

58. See *KSR*, 127 S. Ct. at 1737 (noting that in deciding to issue the patent at issue in the *KSR* case, "the PTO did not have before it an adjustable pedal with a fixed pivot point.").
such a rationale would not support imposition of a "clear and convincing evidence" burden in most cases.

In further procedural developments, pre-KSR Federal Circuit precedent held that the existence of a "[m]otivation to combine" prior art references was a "question of fact," and that a person accused of infringement had no right to independent judicial, as distinct from lay jury, determination of whether subject matter claimed in a patent should be deemed "non-obvious subject matter" as a legal matter. In addition, pre-KSR Federal Circuit precedent held that when a lay jury rendered a verdict on the ultimate question of patent validity, post-verdict or appellate review was limited to "re-creating the facts as they may have been found by the jury, and... applying the Graham factors to the evidence of record..." This meant, in practical terms, that between 1983 and 2005, a defendant asserting a defense of

59. Radio Corp. of Am. v. Radio Eng'g Lab., Inc., 293 U.S. 1 (1934), is sometimes cited as authority for imposing a "clear and convincing" burden of proof with respect to "certain facts" proffered in support of an invalidity defense. See SSIH Equip. S.A. v. U.S. Int'l Trade Comm'n, 718 F.2d 365, 375 (Fed. Cir. 1983) (citing Radio Corp. for the proposition that "certain facts in patent litigation must be proved by clear and convincing evidence.") (emphasis added). Radio Corp. involved an attempt to re-litigate an issue of inventorship that had previously been determined in a contested adversarial proceeding among the rival claimants. Radio Corp., 293 U.S. at 3-6. Such a situation is very different from the usual case, in which an asserted patent is procured ex parte and the facts relied upon to establish invalidity were never the subject of any prior administrative or judicial consideration.

60. An alternative rationale for imposing a heightened evidentiary burden on proponents of a patent invalidity defense has been articulated in cases where the defense rests on "oral testimony... in the absence of models, drawings or kindred evidence..." T.H. Symington Co. v. Nat'l Malleable Casting Co., 250 U.S. 383, 386 (1919). Such evidence has been held "open to grave suspicion; particularly if the testimony be taken after a lapse of years from the time of the alleged invention." Id. But such cases are rare; in the "usual" patent case, prior to the creation of the Federal Circuit, the sounder view in the lower federal courts was: "a preponderance of evidence is sufficient to establish invalidity." Dickstein v. Seventy Corp., 522 F.2d 1294, 1297 (6th Cir. 1975); accord Rains v. Niaqua, Inc., 406 F.2d 275, 278 (2d Cir. 1969) ("[i]n the usual case a preponderance of the evidence determines the issue.").


62. Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 895 n.5 (Fed. Cir. 1984) (where jury returns a verdict on ultimate question of validity, court cannot make independent determination of that issue); R.R. Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 1514 (Fed. Cir. 1984) ("[I]t is not error to submit the question of obviousness to a jury"). But cf. City of Monterey v. Del Monte Dunes at Monterey, Ltd., 526 U.S. 687, 733 (1999) (Souter, J., concurring) ("A federal court commits error by submitting an issue to a jury over objection, unless the party seeking the jury determination has a right to a jury trial on the issue.").

invalidity under § 103 had no assurance that any court, at any level, would ever give the defense any independent consideration.64

The net effect of pre-KSR Federal Circuit precedent was to inject a strong bias into the process of determining questions of patent claim validity under § 103. The first years of the Federal Circuit coincided with a spectacular increase in the percentage of cases in which patent claims withstood invalidity challenges in federal court litigation.65 Prior to the Supreme Court’s October 2005 call for the views of the Solicitor General in KSR, the Federal Circuit had never once applied the Supreme Court’s reasoning or holdings in Anderson’s-Black Rock, Dann, or Sakraida.66 One leading patent law casebook noted in 2003: “In its early decisions, the Federal Circuit essentially repudiated the holdings of Anderson’s-Black Rock and Sakraida.”67

IV. THE KSR LITIGATION: 2002-2006

KSR International Co., a Tier 1 supplier of pedal systems to vehicle manufacturers including Ford Motor Company and General Motors Corporation, was sued in 2002 by a competitor, Teleflex Inc. and its patent holding company subsidiary (collectively, “Teleflex”), for alleged infringement of U.S. Patent No. 6,237,565B1 entitled “Adjustable Pedal Assembly With Electronic Throttle Control” (the “Engelgau patent”).68 The alleged “invention”69 disclosed in the

64. E.g., MercExchange, L.L.C. v. eBay, Inc., 401 F.3d 1323, 1331 (Fed. Cir. 2005) (affirming jury verdict on ultimate question of patent validity on the basis that there was “substantial evidence to support the jury’s finding of nonobviousness,” specifically, expert testimony regarding a lack of hypothetical “motivation” to modify a prior art computer system to behave as claimed in asserted patent), rev’d on other grounds, 126 S. Ct. 1837 (2006).

65. See William M. Landes & Richard A. Posner, The Economic Structure of Intellectual Property Law 338 (2003) (“[I]n the first five years of the new court the percentage of cases in which the validity of a challenged patent was upheld increased enormously over the pre-Federal Circuit era,” going from 35 percent to “a weighted average of 67 percent for the first ten years of the Federal Circuit”).


69. The word “invention” is a term of art in patent law. As used in the Patent Act, the word “invention” refers to “a concept that is complete,” Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 66 (1998), and that falls within one of the subject matter categories listed in 35 U.S.C. § 101, i.e., is a concept that constitutes “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” An “invention” can be made and exist long before it is described in a patent application. Pfaff, 525 U.S. at 68-69 (holding patent invalid “because the invention had been on sale for more than one year in this country before he [the alleged inventor] filed his patent application”).
Engelgau patent was said to have been made on or about February 14, 1998, by one Stephen J. Engelgau of Royal Oak, Michigan. Two embodiments of the alleged “invention” made by Mr. Engelgau are depicted in Figure 4 of the Engelgau patent, reproduced below:

In the terminology of the Engelgau patent, the above figures depict an adjustable pedal assembly (22) that comprises a pedal arm (14), a tubular guide rod (62), a bearing member (66), and a bracket (46), all of which are pivotally mounted on a support (44) for actuating an engine throttle. When a force is applied to the pedal arm (such as when a driver steps on the pedal pad), the entire assembly (22) rotates about a pivot axis that is defined by two pivot shafts (24, 38), thereby either pulling a cable (not shown) via optional cable claw (78) or rotating the internal rotor of a pedal position sensor (42). When an applied force is removed from the pedal arm (such as when a driver eases up or takes his or her foot off of the pedal), a spring (68) urges the pedal arm back toward its resting position.

Adjustment of the resting position of the pedal arm (14) is provided by a guide rod (62), a bearing member (66), and a screw drive mechanism housed in the tubular guide rod (62). Actuation of
the screw drive mechanism causes the bearing member (66) and the pedal arm (14) to slide back and forth along the guide rod (62), thereby adjusting the resting position of the pedal arm (14). The position of the pivot shafts (34, 38) remains constant while the pedal arm (14) slides back and forth along the tubular guide rod (62).

The Engelgau patent concludes with four "claims." The first three claims, numbered 1-3 in the patent, each described the alleged "invention" by reference to (1) "a guide member 62", (2) "a pedal arm (14) supported on said guide member (62) for rectilinear movement in fore and aft directions", and (3) "an electronic control (28)." The patentee, Teleflex, never alleged that KSR had used the "invention" that was pointed to by claims 1-3 of the Engelgau patent.

Claim 4 of the Engelgau patent, by contrast, described and pointed to Mr. Engelgau's alleged "invention" in only the most general of terms. Claim 4 of the Engelgau patent recited (a) an "adjustable pedal assembly having a pedal arm movable in fore and aft directions", and (b) an "electronic control" that was attached to the pedal assembly's support bracket. The recited "adjustable pedal assembly" was said to encompass "any of various adjustable pedal

---

75. Id.
76. Id. at col.4 ll.9-17.
78. '565 Patent col.5 1.26-col.6 l.9.
79. Id. at col.6 ll.10-13.
80. Id. at col.6 ll.14-15.
81. For an illustration of one of the pedal systems whose sale by KSR was alleged to infringe the Engelgau patent, consult U.S. Patent No. 6,655,231 fig.2 (filed Feb. 21, 2002). In the accused KSR pedal systems, a pedal arm is pivotally connected to a goose neck shaped support arm, and mechanism is provided for causing the pedal arm to rotate about the axis of its pivot pin.
82. '565 Patent col.6 ll.17-36. Claim 4 of the Engelgau patent recalls Judge Learned Hand's famous observation: "Upon any work,. . . a great number of patterns of increasing generality will fit equally well. . . ." Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930).
83. '565 Patent col.6 ll.7-36.
assemblies known in the art" and the recited "electronic control" was said to encompass "any of various electronic throttle control mechanisms known in the art." The alleged innovation described by this claim was said to lie in the combination of these two pre-existing components, and specifically, in the decision to attach the claimed "electronic control" to the pedal assembly's support bracket as opposed to some other structure. The extremely limited nature of the Engelgau claim 4 "invention" was confirmed by Teleflex's counsel during the Supreme Court oral argument:

JUSTICE STEVENS: The invention, to use an old-fashioned term, is the decision of where to put the control.

MR. GOLDSTEIN: That is the extent of the entire invention.

KSR moved in the district court for summary judgment of patent invalidity on the basis of multiple prior art references, including (a) U.S. Patent No. 5,010,782 to Asano ("Asano"), which disclosed an adjustable pedal assembly having a pedal arm movable in fore and aft directions; (b) prior art references disclosing electronic controls, namely, modular pedal position sensors that were designed to engage an accelerator pedal's pivot shaft; and (c) prior art references showing electronic controls attached to accelerator pedal support brackets.

In support of summary judgment, KSR made two alternative legal arguments. First, KSR contended that claim 4 of the Engelgau patent was invalid under even the Federal Circuit's then-interpretation of 35 U.S.C. § 103(a). Second, KSR contended that claim 4 of the Engelgau patent was invalid under Supreme Court interpretations of § 103(a) that pre-dated and conflicted with Federal Circuit precedent. In either event, KSR argued that it was not necessary to hold a so-called "Markman" or "claim construction" hearing apart from the

84. Id. at col.2 ll.55-56.
85. Id. at col.3 ll.23-24.
86. Id. at col.1 ll.62-64.
90. Id. at 33-35.
court's consideration of underlying merits issues to which "claim construction" might be relevant. For purposes of summary judgment of invalidity, KSR urged the court to assume the accuracy of the plaintiffs' proposed "construction" of the patent claim language. In this way KSR avoided expensive, time-consuming, and highly uncertain litigation over what eventually proved a moot point, namely, whether the asserted patent claim language should be "construed" in such a way as to encompass the prior art, but to exclude the design of the accused KSR pedal systems (whose design was quite different from that disclosed in the prior art or the Engelgau patent). Unlike the situation with the accused KSR pedal systems, it was undisputed that

91. See Teleflex, 298 F. Supp. 2d at 591 ("the Court finds a Markman hearing to be unnecessary").
92. See id. ("neither party disputes any language of claim 4 in the context of Defendant's motion for invalidity").

During so called Markman "hearings," which are often longer than jury trials, parties battle over experts offering conflicting evidence regarding who qualifies as one of ordinary skill in the art; the meaning of patent terms to that person; the state of the art at the time of the invention; contradictory dictionary definitions and which would be consulted by the skilled artisan; the scope of specialized terms; the problem a patent was solving; what is related or pertinent art; whether a construction was disallowed during prosecution; how one of skill in the art would understand statements during prosecution; and on and on.

The name "Markman hearing" comes from Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996), wherein the Supreme Court held that "the construction of a patent, including terms of art within its claim, is exclusively within the province of the court." Id. at 372. The recent phenomenon of "Markman" hearings, however, flows not from the Supreme Court's Markman decision, but from the Federal Circuit "literal" patent infringement standard which erroneously conflates the distinct concepts of "invention" and "claim." Cf. Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 336 U.S. 271, 276-77 (1949) (invalidating patent claims that "comprehended more than the invention"). Simply stated, there is no necessary correspondence between (a) an "invention" that a person makes and describes in a patent application, and (b) the meaning of claim words that an applicant chooses to characterize such an invention. The latter may, or may not, be accurate or precise in their description of the former. In the author's view, the Federal Circuit's current interpretation of 35 U.S.C. § 271(a), exemplified by the Phillips case, is as divergent from Supreme Court patent precedent as was the interpretation of 35 U.S.C. § 103(a) that the Court disapproved in KSR.

94. See supra note 81. As described in the KSR-owned U.S. Patent No. 6,655,231B1, the accused KSR pedal systems did not include any structure corresponding to the guide rod (62) and bearing member (66) disclosed in the Engelgau patent, and also did not provide for any sliding engagement of a pedal arm with a guide member. The mode of operation of the accused KSR pedal systems was also substantially different from that disclosed in the Engelgau patent. Rather than have a pedal arm slide back and forth along a guide member, as disclosed in the Engelgau patent (and in the Asano patent), the accused KSR pedal systems provided a pedal arm that rotated or swung about a pivot axis located at the end of a goose neck shaped structure.
the claim phrase, "an adjustable pedal assembly having a pedal arm movable in fore and aft directions," described the Asano reference relied on by KSR.

In December 2003, the district court (per The Honorable Lawrence P. Zatkoff, Chief Judge of the Eastern District of Michigan) granted KSR's motion for summary judgment and held that the asserted patent claim was invalid under the Federal Circuit's then-interpretation of § 103(a). Teleflex then appealed the district court's judgment to the Federal Circuit, complaining that the district court had "diluted beyond recognition the barriers that the Federal Circuit has erected to a finding of obviousness." In opposing Teleflex's appeal, KSR once again urged two alternative grounds for affirmance. First, KSR argued that the award of summary judgment was correct as a matter of Federal Circuit law. Second, KSR argued, the award of summary judgment was compelled by long-standing Supreme Court patent precedent to the effect that: "A patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men."

In an unpublished decision dated January 6, 2005, the Federal Circuit vacated the District Court's judgment and remanded the case "for further proceedings on the issue of obviousness, and, if necessary, proceedings on the issues of infringement and damages." Although there was no dispute as to any historical fact relevant to the patentability of the claimed subject matter, the Federal Circuit nevertheless held that a jury trial was needed to decide a hypothetical "fact," namely, "whether a person of ordinary skill in the art would have been motivated, at the time the invention was made, to attach an electronic control to the support structure of the pedal assembly."
In rendering its judgment, the Federal Circuit in KSR did not cite, distinguish, or acknowledge the existence of Sakraida or other analogous Supreme Court patent precedents on which KSR had relied, even though KSR had devoted an entire section of its appellate brief to those Supreme Court precedents.

KSR then petitioned the Supreme Court to issue a writ of certiorari and secured what turned out to be an important time and money-saving stay of further proceedings in the District Court pending the Supreme Court’s decision. On the first day of its October 2005 Term, the Supreme Court issued an Order inviting the Solicitor General to file a brief expressing the views of the United States. After several months of consideration, the Solicitor General in May 2006 filed a brief that urged the Supreme Court to grant certiorari and reverse the Federal Circuit’s judgment. In making that recommendation, the Solicitor General expressly noted that: “KSR has properly preserved its challenge to the court of appeals’ teaching-suggestion-motivation test by urging in the proceedings below that this Court’s decisions provided an alternative basis for affirmance.”

On June 26, 2006, the Supreme Court granted KSR’s petition for a writ of certiorari and set the case for hearing during its October 2006 term. The case was orally argued on November 28, 2006.

V. THE SUPREME COURT’S DECISION

On April 30, 2007, the Supreme Court issued a unanimous, 9-0 decision that reversed the judgment of the Federal Circuit and held the asserted claim invalid under § 103(a) as a matter of law. In reaching this result, the Supreme Court identified a number of “fundamental misunderstandings” in Federal Circuit precedent that had “led the Court of Appeals in this case to apply a test inconsistent with our patent law decisions.”

The Court began its analysis by explicitly “rejecting the rigid approach of the Court of Appeals.” “Throughout this Court’s engagement with the question of obviousness,” the Court explained, “our cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here.” As it had done in Graham, the Court in KSR reaffirmed that

103. KSR, 127 S. Ct. at 1743.
104. Id. at 1739.
105. Id.
35 U.S.C. § 103(a) is "based on the logic of the earlier decision in Hotchkiss v. Greenwood... and its progeny",\textsuperscript{106} that "the principles laid down in Graham reaffirmed the 'functional approach' of Hotchkiss...",\textsuperscript{107} and that basic "premises" of the United States patent system "led to the bar on patents claiming obvious subject matter established in Hotchkiss and codified in § 103."

The Court then proceeded to restate and reaffirm a series of "principles" of patentability that had underlain the Court's past treatment of different types of claimed inventions, and that the Court has now explicitly tied to § 103(a). The "principles" are in the nature of rules or logical precepts that inform legal analysis of whether subject matter claimed in an issued patent should, or should not, be deemed to meet the "non-obvious subject matter" condition for patentability.\textsuperscript{109} The restated "principles" make clear that the preemptive effect of prior art is a "legal determination" that can be, and in the KSR case actually was, resolved by way of relatively inexpensive summary judgment procedure.\textsuperscript{110} The KSR holding further makes clear that the PTO and United States courts have — and always have had — much greater authority to deem patent claims invalid than the Federal Circuit had acknowledged between 1982 and at least 2005.\textsuperscript{111}

### A. Restated Principles of Patentability

The first "principle" reaffirmed in KSR, and now expressly tied to § 103(a), is: "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious."\textsuperscript{112} This principle is reflected in decisions such as Anderson's-Black Rock, Inc. v. Pavement Salvage Co.,\textsuperscript{113} where the Court invalidated patent claims that described paving

\textsuperscript{106} Id. at 1734.
\textsuperscript{107} Id. at 1739.
\textsuperscript{108} Id. at 1746.
\textsuperscript{110} KSR, 127 S. Ct. at 1745-46.
\textsuperscript{111} Id. at 1739-44.
\textsuperscript{112} Id. at 1740 (quoting Sakraida v. Ag Pro, Inc., 425 U.S. 273, 282 (1976)).
apparatus whose two principal components "in combination did no more than they would in separate, sequential operation."\(^{114}\)

A second "principle" reaffirmed in \textit{KSR}, and now expressly tied to § 103(a), is: "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."\(^{115}\) This principle is reflected in decisions such as \textit{Dow Chemical Co. v. Halliburton Oil Well Cementing Co.},\(^{116}\) where the Court invalidated patent claims that described a method of increasing the output of a well comprising use of a hydrochloric acid solution together with an agent capable of inhibiting corrosion of metal well equipment, when substantially the same technique had been used to inhibit corrosion of other kinds of metal equipment exposed to hydrochloric acid solutions. This was, in the Court's view, "no more than a mere application of an old process of inhibition to a new and analogous use of protecting metal well equipment from corrosion . . . ."\(^{117}\)

A third "principle" reaffirmed in \textit{KSR}, and now expressly tied to § 103(a), is: "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability."\(^{118}\) This principle is reflected in decisions such as \textit{Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.},\(^{119}\) where the Court invalidated patent claims that described apparatus for recording or reproducing sound records comprising a flywheel yielding a uniform speed of operation, where an exogenous development — namely, the invention of "talking" motion pictures — had prompted market demand for the claimed subject matter.

A fourth "principle" reaffirmed in \textit{KSR}, and now expressly tied to § 103(a), is:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the

\begin{footnotesize}
\begin{enumerate}
\item \textit{KSR}, 127 S. Ct. at 1740.
\item \textit{Id.} (emphasis added).
\item Dow Chemical Co. v. Halliburton Oil Well Cementing Co., 324 U.S. 320 (1945).
\item \textit{Id.} at 327.
\item \textit{KSR}, 127 S. Ct. at 1740 (emphasis added).
\end{enumerate}
\end{footnotesize}
anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.120

This principle is reflected in decisions such as Essex Razor Blade Corp. v. Gillette Safety Razor Co.,121 where the Court invalidated patent claims describing a razor blade having “a non-circular opening” and recesses designed to cooperate with pins for holding the blade in position, where “[t]he choice” of razor blade configuration “was one between alternative means obvious to any mechanic.”122

A fifth “principle” reaffirmed in KSR, and now expressly tied to § 103(a), is: “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”123 This principle is reflected in decisions such as United States v. Adams,124 where the Court upheld patent claims that described a water-activated battery all of whose components were previously known, but whose combination was one that prior art teachings had both discouraged and suggested, erroneously, would not work.125

Common to all of the restated “principles” is a renewed focus on the degree of skill needed to devise claimed subject matter coupled with recognition that “market demand, rather than scientific literature,” may “drive design trends” in a given context.126 Under KSR, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”127 If the answer to this threshold question is “no” – that is, if a patent claim is written in such a way as to encompass subject matter that constitutes no more than “the predictable use of prior art elements according to their established functions” – then the claim may be held invalid under § 103(a) on that basis alone.128 The Court

120. KSR, 127 S. Ct. at 1742.
122. Id. at 98.
123. KSR, 127 S. Ct. at 1740.
125. Id. at 51-52.
126. KSR, 127 S. Ct. at 1741.
127. Id. at 1740.
128. See, e.g., id. at 1746 (“[M]ounting a modular sensor on a fixed pivot point of the Asano pedal was a design step well within the grasp of a person of ordinary skill in the relevant art”; claim held invalid under § 103); Sakraida v. Ag Pro, Inc., 425 U.S. 273, 282 (1976) (“[T]his patent simply arranges old elements with each performing the same function it had been known to perform”; claim held invalid under § 103).
cited two examples of such invalid claims: "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement."\textsuperscript{129}

On the other hand, if a patent claim is limited to subject matter that constitutes "more than the predictable use of prior art elements according to their established functions,"\textsuperscript{130} then the mere fact that "each of its elements was, independently, known in the prior art," is an insufficient basis for concluding that the claim recites "obvious" subject matter.\textsuperscript{131} Rather, in such cases, assessment of a patent claim's validity under § 103(a) calls for "an expansive and flexible approach"\textsuperscript{132} in which a court may "often" need to consider:

[I]nterrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.\textsuperscript{133}

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed."\textsuperscript{134} And as the KSR case illustrates, the concept of "an apparent reason" to combine or modify prior art references is quite different in character, and much easier to establish, than the pre-KSR Federal Circuit requirement of "clear and convincing evidence" supporting "specific findings showing a teaching, suggestion, or motivation to combine prior art teachings . . . ."\textsuperscript{135}

**B. Disapproved Aspects of Federal Circuit Precedent**

In reaffirming that 35 U.S.C. § 103(a) is "based on the logic of the earlier decision in Hotchkiss . . . and its progeny,"\textsuperscript{136} and that "the principles laid down in Graham reaffirmed the 'functional approach' of Hotchkiss,"\textsuperscript{137} the KSR decision rejects a core if typically unstated

\begin{itemize}
\item \textsuperscript{129} KSR, 127 S. Ct. at 1740.
\item \textsuperscript{130} Id. at 1740.
\item \textsuperscript{131} Id. at 1741 (citing United States v. Adams, 383 U.S. 39 (1966)).
\item \textsuperscript{132} Id. at 1739.
\item \textsuperscript{133} Id. at 1740-41 (emphasis added).
\item \textsuperscript{134} Id. at 1742 (emphasis added).
\item \textsuperscript{135} Teleflex Inc. v. KSR Int'l Co., 119 F.App'x 282, 290 (Fed. Cir. 2005), rev'd, 127 S. Ct. 1727 (2007).
\item \textsuperscript{136} KSR, 127 S. Ct. at 1734.
\item \textsuperscript{137} Id. at 1739.
\end{itemize}
premise of pre-KSR Federal Circuit precedent interpreting § 103. That premise was to presuppose that every patent applicant, by the mere act of filing a patent application, was automatically vested with a provisional entitlement to patent protection for any process, machine, manufacture, composition of matter that he or she might disclose and claim to be an "invention," no matter what its nature. Supra notes 40 - 50 and accompanying text. Echoing the view stated in the text, the American Intellectual Property Law Association (AIPLA) filed an amicus curiae brief in KSR that argued that Sections 101 and 102 of the Patent Act "presume entitlement to a patent" and "Section 103 functions only to limit this entitlement." Brief for American Intellectual Property Law Association as Amicus Curiae Supporting Respondents at 7 n. 10, KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007) (No. 04-1350), 2006 WL 2950592, *7 (emphasis added). In fact, patent protection in the United States is limited by statute to subject matter that constitutes an "invention or discovery," 35 U.S.C. § 100(a) (2000); a patent applicant must swear to a belief that he or she is an "inventor," 35 U.S.C. § 115 (2000); and the PTO must examine any "alleged new invention" (35 U.S.C. § 131(2000)) to determine if it meets "the conditions and requirements of this title," 35 U.S.C § 101, one of which is "the § 103 condition." Graham v. John Deere Co., 383 U.S. 1, 17 (1966).
to skillful men." This aspect of the KSR decision rejects the reasoning of Stratoflex, Inc. v. Aeroquip Corp. and Medtronic, Inc. v. Cardiac Pacemakers, Inc., in which the Federal Circuit had stated "[i]t but obfuscates the law to posit a non-statutory, judge-created classification labeled 'combination patents," and "[r]eference to 'combination' patents is, moreover, meaningless." Contrary to the Federal Circuit's previously stated view, "[n]either the

141. Id. (quoting Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp., 340 U.S. 147 (1950)). See, e.g., Anderson's-Black Rock v. Pavement Salvage Co., 396 U.S. 57, 60-63 (1969) (invalidating claim describing pre-existent asphalt spreader combined with pre-existent radiant burner that together performed no "new or different function"; their combination "was not an invention by the obvious-non-obvious standard"); Toledo Pressed Steel Co. v. Standard Parts, Inc., 307 U.S. 350, 356 (1939) (invalidating claims that recited pre-existing torch body and cap structures that together "performed no joint function" but "served as separately it had done"); Lincoln Eng'g Co. v. Stewart-Warner Corp., 303 U.S. 545, 549 (1938) (invalidating patent claims that recited pre-existing grease gun components together with novel pin fitting; stating, "[t]he mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention"); Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co., 282 U.S. 175, 186 (1930) (invalidating claims that recited pre-existing structures suitable for transporting wet concrete, all of which structures "were old in the art" and whose combination accomplished "no more than an aggregate of old results"); Grinnell Washing Mach. Co. v. E.E. Johnson Co., 247 U.S. 426, 432-33 (1918) (invalidating claims that recited pre-existing structures for driving a wringer washing machine, where the result produced was "only that which arises from the well-known operation of each one of the elements"); Richards v. Chase Elevator Co., 158 U.S. 299, 302-03 (1895) (invalidating claims that recited grain elevator apparatus; stating, "[s]o long as each element performs some old and well-known function, the result is not a patentable combination, but an aggregation of elements"); Knapp v. Morss, 150 U.S. 221, 227 (1893) (invalidating claims that recited adjustable dress form structures; stating, "the combination of old elements which perform no new function and accomplish no new results does not involve patentable novelty"); Brinkerhoff v. Aloe, 146 U.S. 515, 516-17 (1892) (invalidating claims that recited rectal specula; stating, "To sustain a patent on a combination of old devices it is well-settled that a new result must be obtained which is due to the joint and cooperating action of all the old elements. Either this must be accomplished, or a new machine of distinct character and function must be constructed."); Adams v. Bellaire Stamping Co., 141 U.S. 539, 542 (1891) (invalidating claims that recited pre-existing lantern structures, where "[t]he elements combined to form the alleged invention merely constituted an aggregation of old devices, each working out its own effect, without producing anything novel, ...."); Florsheim v. Schilling, 137 U.S. 64, 77 (1890) (invalidating claims that recited corset structures; stating, "in a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other. .... It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of the separate contributions. See also Graham, 383 U.S. at 10 n.3 ("A man has a right to use a saw, an axe, a plane separately; may he not combine their uses on the same piece of wood?") (quoting Letter from Thomas Jefferson to Oliver Evans (Jan. 1814), in 6 WRITINGS OF THOMAS JEFFERSON, AT 298 (Washington ed.)).


144. Id. at 1566.

145. Stratoflex, 713 F.2d at 1540 (emphasis added).
enactment of § 103 nor the analysis in *Graham* disturbed this Court's earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art.\(^{146}\)

The *KSR* decision reaffirms that "[t]he ultimate judgment of obviousness is a legal determination" that courts, not lay juries, have the responsibility for making.\(^{147}\) *KSR* states that "[i]f a *court*, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103."\(^{148}\) *KSR* further states that "a *court* must ask whether the improvement is more than the predictable use of prior art elements according to established principles"\(^{149}\); "Often, it will be necessary for a *court* to look to interrelated teachings of multiple patents",\(^{150}\) "a *court* can take account of the inferences and creative steps that a person of ordinary skill in the art would employ",\(^{151}\) "the *district court* can and should take into account expert testimony",\(^{152}\) and "[t]o facilitate review, this analysis should be made explicit."\(^{153}\)

Under *Graham*, "the ultimate question of patent validity is one of law."\(^{154}\) Not even the most elaborate of special jury verdict forms under Fed. R. Civ. P. 49 can yield an "explicit" "analysis" of whether or why subject matter claimed in an issued patent should or should not be deemed "non-obvious subject matter" as a legal matter.\(^{155}\) This aspect of the *KSR* decision, which resolved the parties' competing arguments as to the preemptive effect of prior art and reinstated a summary judgment of invalidity, appears to reject the reasoning of cases such as *Perkin-Elmer Corp. v. Computervision Corp.*\(^{156}\) in which the Federal Circuit held that persons accused of patent

\(^{146}\) *KSR* Int'l Co. v. Telexflex Inc., 127 S. Ct. 1727, 1739 (2007)

\(^{147}\) *Id.* at 1745-46. See also Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996) ("[T]he construction of a patent, including terms of art within its claim, is exclusively within the province of the court.").

\(^{148}\) *KSR*, 127 S. Ct. at 1734 (emphasis added).

\(^{149}\) *Id.* at 1740 (emphasis added).

\(^{150}\) *Id.* (emphasis added).

\(^{151}\) *Id.* at 1741 (emphasis added).

\(^{152}\) *Id.* at 1741 (emphasis added).

\(^{153}\) *Id.* at 1741.


\(^{156}\) *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 895 n.5 (Fed. Cir. 1984). Federal Circuit precedent in this respect is in avowed conflict with regional circuit precedent. *Compare* Sarkisian v. Winn-Proof Corp., 688 F.2d 647, 651 (9th Cir. 1982) ("The court must, in all cases, determine obviousness as a question of law independent of the jury's conclusion") with *Perkin-Elmer*, 732 F.2d at 895 n.5 (Fed. Cir. 1984) (rejecting *Sarkisian* as making "charades of motions for directed verdict or JNOV under Fed. R. Civ. P. 50 in patent cases").
infringement had no right to independent judicial, as opposed to lay jury, determination of the ultimate question of validity under § 103.157

The KSR decision reaffirms that multiple prior art references can render claimed subject matter “obvious,” and thus unpatentable under 35 U.S.C. § 103(a), in many more and different circumstances than the Federal Circuit had acknowledged between 1983 and at least 2005.158 After KSR, as before, a pre-existent teaching, suggestion, or motivation to combine or modify prior art references is one basis on which a court may deem claimed subject matter “obvious” for purposes of 35 U.S.C. § 103(a).159 To this extent, “[t]here is no necessary inconsistency between the idea underlying the TSM test and the Graham analysis.”160 That “idea” is that in some cases, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the new invention does.”161 The Court cited United States v. Adams162 as an example of such a case.

But after KSR, the absence of a pre-existent teaching, suggestion, or motivation to combine or modify prior art is no longer fatal to a defense of invalidity under § 103(a). This is a profound change from prior Federal Circuit precedent. Under KSR, the presence or absence of a pre-existent teaching, suggestion, or motivation to make claimed subject matter is simply one factor that may provide a sound reason for concluding that claimed subject matter should or should not be deemed “non-obvious subject matter” and thus eligible for a grant of government-backed rights to exclude. In a case like KSR, where the claimed subject matter was a response to an exogenous development (namely, a transition from mechanical to electronic throttle controls in the automotive industry), the absence of a pre-existent teaching, suggestion, or motivation to combine or modify prior art may have little or no bearing on the degree of skill that was needed to react to the new conditions and make at least some subject matter that falls

157. As noted above (see supra note 61-63 and accompanying text), besides permitting lay juries to decide ultimate legal questions of validity under § 103(a), pre-KSR Federal Circuit precedent also treated jury verdicts on ultimate questions of patent validity as if they were general verdicts subject to extremely deferential and limited post-verdict or appellate review.


159. E.g., Mandel Bros., Inc. v. Wallace, 335 U.S. 291, 296 (1948) (prior art suggested claimed improved anti-perspirant; claims held invalid).


161. Id.

within the scope of a broadly worded patent claim. "In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends."

The KSR decision expressly disapproves, as "error," long-standing Federal Circuit precedent holding that "a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try.'" KSR makes clear that in appropriate circumstances, "the fact that a combination was obvious to try might show that it was obvious under § 103."

The KSR decision calls into question the Federal Circuit's long-standing interpretation of the statutory presumption of patent validity as a presumption that "is never annihilated, destroyed, or even weakened, regardless of what facts are of record." The defense of invalidity in KSR was grounded in part on a prior art adjustable pedal system, Asano, that had never been cited to the PTO during the prosecution of the patent-in-suit and whose preemptive effect had never been considered or passed on by PTO during the prosecution of the Engelgau patent. Despite this, the KSR plaintiffs argued that the statutory presumption of validity required the Court to test the sufficiency of KSR's invalidity proofs and legal arguments by reference to a "clear and convincing evidence" standard.

---

163. KSR, 127 S. Ct. at 1741.
164. Id. at 1742 (quoting Teleflex Inc. v. KSR Int'l Co., 119 F.App'x 282, 289 (Fed. Cir. 2005), rev'd, 127 S. Ct. 1727 (2007)).
165. Id.
168. KSR, 127 S. Ct. at 1737 ("Asano was not mentioned in the patent's prosecution" and "the PTO did not have before it an adjustable pedal with a fixed pivot point.").
169. Imprecise usage of the phrase, "clear and convincing evidence," has led to much confusion in the field of patent law. Properly understood, the phrase "clear and convincing evidence" refers to a quantum of evidence that produces, in the mind of a factfinder, an abiding conviction that the truth of a factual matter is highly probable. See supra note 56. The concept of "clear and convincing evidence" has no proper application to the probability that a legal conclusion—such as non-obviousness—should be deemed to follow from established historical facts. See SSIH Equip. S.A. v. U.S. Int'l Trade Comm'n, 718 F.2d 365, 375 (Fed. Cir. 1983) ("We find it appropriate to speak in terms of a particular standard of proof being necessary to reach a legal conclusion."). Further, under Supreme Court patent precedent, legal conclusions of the type typically rendered by individual Examiners, in ex parte examination proceedings under 35 U.S.C. § 131 enjoy very little, if any, deference. See Graham v. John Deere Co., 383 U.S. 1, 34 (1966) ("We are at a loss to explain the Examiner's allowance on the basis of such a distinction."). See also Lear, Inc. v. Adkins, 395 U.S. 653, 670 (1969) (rejecting patent licensee estoppel doctrine, in part because "the Patent Office is often obliged to reach its decision in an
In rendering its judgment of invalidity, the Court in *KSR* held that it “need not reach the question whether the failure to disclose Asano during the prosecution of Engelgau voids the presumption of validity given to issued patents, for claim 4 is obvious despite the presumption.” But the Court added the following, very suggestive comment: “We nevertheless think it appropriate to note that the rationale underlying the presumption—that the PTO, in its expertise, has approved the claim—seems much diminished here.”

The Court’s statement recalls the general administrative law principle that: “[n]ormally, an agency rule would be arbitrary and capricious if the agency has . . . entirely failed to consider an important aspect of the problem . . . .”

Finally, the *KSR* decision appears to affirm the principle, often expressed in Supreme Court patent precedents, that the “commercial success” of a claimed invention may support a legal conclusion of patentability “only in a close case where all other proof leaves the question of invention in doubt.” Teleflex had argued that the claimed invention of the Engelgau patent had enjoyed “commercial success,” but the Court nevertheless held: “Where, as here, the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the

---

<sup>ex parte proceeding, without the aid of the arguments which could be made by parties interested in proving patent invalidity”).</sup>


171. *Id.*


obviousness of the claim is apparent in light of these factors, summary judgment is appropriate.”

The Court noted that in two decisions handed down in 2006, *Dystar Textilfarben GmbH v. C.H. Patrick Co.* and *Alza Corp v. Mylan Labs., Inc.*, the Federal Circuit had “elaborated a broader conception of the TSM test than was applied in the instant matter.” The Court declined to consider whether those decisions – both issued after certiorari had been granted in *KSR*—”may describe an analysis more consistent with our earlier precedents and our decision here.”

In fact, the *Dystar* panel majority had purported to enforce the same restrictions on district court authority as had been articulated and applied in the now reversed Federal Circuit decision in *KSR*, and went so far as to explain and defend the Federal Circuit’s *KSR* decision in a published opinion issued six weeks before oral argument in *KSR* was scheduled to occur.

C. The Court’s Reinstatement of Summary Judgment of Invalidity

The practical importance of the *KSR* decision is perhaps best illustrated by what the Court actually did with the particular patent claim that was asserted in the *KSR* case itself: the Supreme Court reinstated a summary judgment of invalidity on the basis of evidence that the Federal Circuit held did not make out even “a prima facie case of obviousness.” The Supreme Court stated, “[w]hen we apply the standards we have explained to the instant facts, claim 4 must be found obvious.” Consistent with the text of 35 U.S.C. § 282, the

---

177. *KSR*, 127 S. Ct. at 1745.
178. *Id.*
179. *See Dystar*, 464 F.3d at 1367 n.3.
181. *KSR*, 127 S. Ct. at 1743.
182. “The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity,” 35 U.S.C. § 282 (2000). The statute makes no reference to “clear and convincing evidence.” By contrast, Congress has specified a “clear and convincing evidence” burden of proof with respect to one particular invalidity defense that was added to the Patent Act in 1999. See 35 U.S.C. § 273(b)(4) (2000) (“A person asserting the defense under this section shall have the burden of establishing the defense by clear and convincing
Court's past treatments of § 103-based invalidity defenses, and principles of neutrality that prevail in civil litigation between private parties generally, the Court in *KSR* described the factual predicates of the defendant/petitioner's defense of invalidity under 35 U.S.C. §§ 103(a) and 282(2) without reference to "clear and convincing evidence" or any other heightened burden of proof.

The validity of the patent claim at issue in *KSR* depended on the preemptive effect of multiple prior art references. Applying its own precedents, the Federal Circuit in *KSR* had held that a trial was needed to determine the preemptive effect of undisputed prior art references because, in its view, "[m]otivation to combine is a question of fact" even when, as in the *KSR* case, the prior art references relied upon are all admittedly within the field of endeavor of a claimed invention and there is no dispute as to their contents. The Supreme Court rejected this reasoning and treated the preemptive effect of prior art as being an aspect of "[t]he ultimate judgment of obviousness," a "judgment" that the Court characterized as a "legal determination" and thus resolvable on a motion for summary judgment.

The plaintiffs' assertion that a hypothetical person having ordinary skill in the art would have lacked "motivation" to choose a particular reference, "Asano," as a basis for making the claimed invention, was treated in the same fashion as any other unpersuasive legal argument: "The idea," the Court held, "makes little sense."

In the Court's view, the patent claim at issue in *KSR* was invalid under 35 U.S.C. § 103(a) as a matter of law because "[a] person

---

183. See *supra* notes 57-60 and accompanying text.
184. See *KSR*, 127 S. Ct. at 1735-36. See also *Anderson* v. Liberty Lobby, Inc., 477 U.S. 242, 254 (1986) ("[I]n ruling on a motion for summary judgment, the judge must view the evidence presented through the prism of the substantive evidentiary burden."). Thus, although *KSR* was decided in the context of a motion for summary judgment, the Supreme Court's decision necessarily took account of the "substantive evidentiary burden" that applied to the defendant/petitioner's defense of invalidity under 35 U.S.C. §§ 103(a) and 282(2).
186. *KSR*, 127 S. Ct. at 1745.
187. *Id.* at 1742.
having ordinary skill in the art could have combined Asano with a pedal position sensor in a fashion encompassed by claim 4, and would have seen the benefits of doing so." The Court then proceeded to identify a series of "errors" that had led the Federal Circuit to vacate the district court's award of summary judgment of invalidity.

The Federal Circuit's "first error" was its "holding that courts and patent examiners should look only to the problem the patentee was trying to solve." This approach failed to recognize that a "problem" subjectively perceived by a particular patent applicant "may be only one of many addressed by the patent's subject matter." "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim."

The Federal Circuit's "second error," the Court held, "lay in its assumption that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." "Common sense teaches," the Court stated, "that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle."

The Federal Circuit's third "error," the Court held, lay in its conclusion that "a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try.'" As noted above, the Court held that in some cases a showing that claimed subject matter was "obvious to try" could be a legally sufficient reason for concluding that it failed to meet the § 103 condition.

Finally, the Court held that the Federal Circuit "drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias." "A factfinder should be aware, of course, of the

188. Id. at 1743 (emphasis added). For a computer animation showing Asano combined with a pedal position sensor, see http://www.ffhsj.com/index.cfm?pageID=41&itemID=1050&scID=65
189. KSR, 127 S. Ct. at 1742.
190. Id.
191. Id. at 1741.
192. Id. at 1742.
193. Id.
194. Id. (quoting Teleflex Inc. v. KSR Int'l Co., 119 F.App'x 282, 298 (Fed. Cir. 2005), rev'd, 127 S. Ct. 1727 (2007)).
195. Id.
196. Id.
distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." But this did not justify the Federal Circuit's imposition of "[r]igid preventative rules that deny factfinders recourse to common sense . . . "

Applying the principle that "any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed," the Court concluded, as a matter of law, that for purposes of invalidity analysis, "it was possible to begin with the objective to upgrade Asano to work with a computer-controlled throttle . . . ." The Court then analyzed, as a legal question, whether achieving the posited objective would have been within "the grasp of a hypothetical person having "ordinary skill in the art," and thus "obvious" to him or her in legal terms, in view of prior art disclosing both (a) "self-contained, modular sensors" that were "designed independently of a given pedal" so that they could be "taken off the shelf and attached to mechanical pedals of various sorts, enabling the pedals to be used in automobiles with computer-controlled throttles," and (b) fixed position pedal systems in which modular sensors had been attached to an accelerator's support bracket and engaged with the pedal's pivot shaft in the manner disclosed and claimed in the Engelgau patent.

The Court concluded that "mounting a modular sensor on a fixed pivot point of the Asano pedal was a design step well within the grasp of a person or ordinary skill in the relevant art." Positing an objective or result to be achieved, such as "to upgrade Asano," and inquiring whether claimed means of achieving the desired result reflected "a design step well within the grasp of a person for ordinary skill in the relevant art," exemplifies the skill-based "functional approach" to patentability that the Court first announced in *Hotchkiss*...

---

197. *Id.*
198. *Id.*
199. *Id.* (emphasis added).
200. *Id.* at 1745.
201. *Id.* at 1744.
202. *Id.* at 1736.
203. See *id.*
204. *Id.* at 1746.
205. *Id.*
v. Greenwood,\textsuperscript{206} and that the Court has now once again held was "codified in § 103."\textsuperscript{207}

VI. CONCLUSION

The \textit{KSR} decision does not purport to make new law. The decision reaffirms and applies principles that the Court has articulated and applied in numerous of its patent precedents dating back to 1851. It therefore remains an open question whether, and to what extent, the \textit{KSR} decision will be held to entitle a party to review of a lower court's non-application of Supreme Court patent precedent in the absence of a timely exception -- as was made in the \textit{KSR} case. An appellate court generally will not consider legal arguments for reversal that were available, but not presented to, a lower court.

Between 1851 and 1976, the Supreme Court handed down a very large number of decisions addressing core patent law issues, including dozens of "judicial precedents embracing the Hotchkiss condition . . .\textsuperscript{208} These precedents provide a rich source of reasons, principles, and analogies for deciding whether, in a given case, claimed subject matter is properly deemed "non-obvious subject matter," or not. It is reasonable to expect that Supreme Court patent precedent will play an increased role in the Federal Circuit's interpretation and application of § 103 going forward. But in order for Supreme Court patent precedent to play such a role, litigants must give it voice.

\textsuperscript{206} Hotchkiss v. Greenwood, 52 U.S. (11 How.) 248 (1851).
\textsuperscript{207} KSR, 127 S. Ct. at 1746.