KSR International Co. v. Teleflex Inc.
Agenda

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- Case History
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Overview

**KSR International Co. v. Teleflex Inc.** is a decision by the **Supreme Court** of the United States concerning the issue of **obviousness** as applied to patent claims.

**Holding**

The Federal Circuit erred in rigidly applying the narrow teaching/suggestion/motivation standard for obviousness under **35 U.S.C. § 103**, for precluding application of “obvious to try” considerations, and for too rigidly constructing the use of hindsight, in conflict with the broader obviousness evaluation established in **Graham**. Federal Circuit reversed and remanded.

**Court membership**

- **Chief Justice**: John Roberts
- **Associate Justices**
  - John P. Stevens
  - Antonin Scalia
  - Anthony Kennedy
  - David Souter
  - Clarence Thomas
  - Ruth Bader Ginsburg
  - Stephen Breyer
  - Samuel Alito

**Case opinions**

- **Majority**: Kennedy, joined by **unanimous**

**Laws applied**

- **35 U.S.C. § 103**
35 U.S. Code § 103

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.
Parties Involved

Plaintiff: Teleflex Inc.

- Over 60 years old.
- Makes Catheters, actuators, and wire rope.
- The wire rope is used for suspension bridges and the like.
- They happen to be a competitor to KSR.
Defendant: KSR Intl.

- KSR is a Canadian auto-parts manufacturer and is over 50 years old.
- Manufacture all sorts of pedal systems, such as electronic throttle controls and sensors.
- KSR’s biggest buyers include Nissan and General Motors.
The "TSM" test

TSM stands for Teaching Suggestion Motivation

- The TSM test, established by the Federal Circuit means, when analyzing the obviousness of an invention while comparing it with prior art, these are the three questions that have to be asked:

  - Is the prior art quoted helpful in teaching the reader the method of producing the invention?
  
  - Does the prior art or any of its contents suggest any method of producing the invention in question?
  
  - Does the prior art talk about problems related to a particular technology motivating an invention in a particular manner?
Case History

• Teleflex filed an infringement suite against one of KSR's products over patent US 6,237,565 B1 (Adjustable pedal assembly with electronic throttle control) in 2002.

• KSR immediately disputed that the combination of the two elements was obvious, and the claim was therefore not patentable.

• The District Court ruled in favor of KSR in 2003.

• But the Court of Appeals for the Federal Circuit reversed in January 2005.

• Oral arguments were heard by the Supreme Court on November 28, 2006.
Case History

- On April 30, 2007, the Supreme Court unanimously reversed the judgment of the Federal Circuit, holding that the disputed claim 4 of the ‘565 patent was obvious under the requirements of 35 U.S.C. §103.

- Supreme Court rejected the District Court’s rulings, because the Court of Appeals had applied the "teaching-suggestion-motivation" (TSM) test in a narrow, rigid manner inconsistent with §103, and issued a Certiorari to the United States Court of Appeals for the Federal Circuit.
Litigation Animation: KSR v. Teleflex

• As **3D ANIMATIONS** of patent embodiments can be entered into the record allowing the visuals special status in the courtroom and making them a valuable part of the appellate process.

• KSR via Demonstratives, Inc. (acquired by ESI) animators created 3D model of the prior art (US 5,010,782) and 1994 GM ETC Pedal. Animation of this 3D model was used to show the court how a person skilled in the art would view this embodiment.
Litigation Animation: KSR v. Teleflex

http://www.demonstratives.com/blog/?ksrteleflex_using_courtroom_animations_to_simplify_complexity&show=entry&blogID=545
The "person having ordinary skill in the art" standard

- Justice Kennedy who supervised this case stated that,

- "A person of ordinary skill is also a person of ordinary creativity, not an automaton."

- He acknowledged that his description of a Person Having Ordinary Skill In The Art (PHOSITA) does not necessarily conflict with other Federal Circuit cases that described a PHOSITA as having "common sense".

- He also emphasized that his opinion was directed at correcting the "errors of law made by the Court of Appeals in this case" and does not necessarily overturn all other Federal Circuit precedent.
Implications

- The USPTO Board of Patent Appeals and Interferences (BPAI) cites KSR in about 60% of its decisions related to obviousness irrespective of whether it affirms a patent examiner's rejection or reverses the rejection.

- The BPAI stresses that examiners must still give strong reasons for their rejections while citing KSR case.

- The USPTO management has also supported this emphasis with a memorandum to all technology directors by instructing them that when making an obviousness rejection
  - "it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."

- TSM still remains a part of the calculation of obviousness, though it provides forceful instruction on the manner in which the test is to be applied.
Popular Citations/Applications of KSR


A similar case was seen in **Perfect Web Technologies, Inc. v. InfoUSA, Inc.** (U.S. Patent 6,631,400 all claims)
4. A vehicle control pedal apparatus (12) comprising:
a support (18) adapted to be mounted to a vehicle structure (20);
an adjustable pedal assembly (22) having a pedal arm (14) moveable in force and aft directions with respect to said support (18);
a pivot (24) for pivotally supporting said adjustable pedal assembly (22) with respect to said support (18) and defining a pivot axis (26); and
an electronic control (28) attached to said support (18) for controlling a vehicle system;
said apparatus (12) characterized by said electronic control (28) being responsive to said pivot (24) for providing a signal (32) that corresponds to pedal arm position as said pedal arm (14) pivots about said pivot axis (26) between rest and applied positions where in the position of said pivot (24) remains constant while said pedal arm (14) moves in fore and aft directions with respect to said pivot (24).
The Consequence

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<td>First Named Inventor: Steven J. Engelgau, Royal Oak, MI all Inventors</td>
<td>Patent Number: 6,237,565</td>
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Title of Invention: Adjustable pedal assembly with electronic throttle control
Reach us

If you would like to contact us for any additional information, feel free to call... or reach us through e-mail at inbox@legaladvantage.net

Cheers,

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- Thank you!