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## Less Obvious? USPTO's New Post-*KSR* Guidelines Suggest a More Balanced Approach

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In 2007, after the Supreme Court decided *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) ("*KSR*"), the U.S. Patent and Trademark Office ("USPTO") published a set of Guidelines that listed at least seven ways in which a USPTO Examiner might find that an applicant's claims were obvious. 72 FR 57526. On September 1, 2010, the USPTO published updated Guidelines, highlighting case law developed after *KSR*, and listing not only reasons that claims might be obvious, but also some circumstances in which they might not. [Examination Guidelines Update: Developments in the Obviousness Inquiry After \*KSR v. Teleflex\*](#), 75 FR 53643-60.

The new Guidelines emphasize that Examiners "must provide a reasoned explanation as to why the invention as claimed would have been obvious," and are equally clear that "familiar lines of argument," e.g., a showing of unexpected results, a lack of reasonable expectation of success, and a teaching away from the claimed invention by the prior art, can still demonstrate the nonobviousness of a claimed invention. The Guidelines walk through a series of examples of cases decided post-*KSR* and identify "teaching points" from each case. The examples are grouped under the general categories of "combining prior art elements," "substituting one known element for another," "obvious to try" and "consideration of evidence."

For example, in discussing obviousness based on "combining prior art elements," the new Guidelines discuss a case in which the combination of known prior art elements could nonetheless have been nonobvious because one of the prior art references taught away from this very combination and the proposed reason for making it.

The Guidelines reiterate the principle that "substituting one known element for another" may be obvious, and "applies when one of ordinary skill in the art would have been technologically capable of making the substitution, and the result obtained would have been predictable." However, the Guidelines also make clear that this rationale likely would not apply where there was no reasonable expectation of success in obtaining the claimed invention, for example, by modifying a "lead compound" to obtain a claimed compound.

The new Guidelines emphasize that the "obvious to try" rationale is only proper when the following conditions are met: "there is a recognized problem or need in the art; there are a finite number of

identified, predictable solutions to the recognized need or problem; and one of ordinary skill in the art could have pursued these known potential solutions with a reasonable expectation of success." The Guidelines include examples demonstrating that this rationale should not be used to support a conclusion of obviousness where the "possible options were not either known or finite," or where unexpected results such as strong therapeutic advantages were achieved.

Under the topic of "consideration of evidence," the Guidelines advise that Examiners must consider all relevant rebuttal evidence timely presented by an applicant in reviewing a determination of obviousness.

However, not everything in the new Guidelines points Examiners in favor of an applicant. Numerous examples in the Guidelines point to claims that were found to be obvious. The Guidelines are explicit that the *KSR* rationale applies to both the predictable and unpredictable arts, and that "[t]he scope of analogous art is to be construed broadly and includes references that are reasonably pertinent to the problem that the inventor was trying to solve." Further, the Guidelines point out that obviousness might be shown if there is "some line of reasoning," even if not explicit, which would have led a skilled artisan to do what is claimed, e.g., to modify a "lead compound" in certain ways to arrive at a claimed compound.

The new Guidelines are lengthy, and full of examples, and may provide insight into how the USPTO will perform obviousness analyses. The Guidelines may also help practitioners present better nonobviousness arguments during prosecution of pending applications, reexaminations and appeals.

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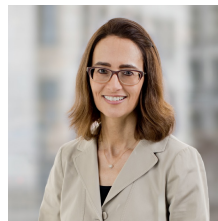
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