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## Supreme Court Grant of Certiorari Could Change Tests for "Obviousness"

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The US Supreme Court has granted certiorari to review the Federal Circuit's decision in [Teleflex, Inc. v. KSR Int'l](#), 119 Fed. Appx. 282, 283 (Fed. Cir. 2005). The case concerns when a combination is "obvious," and reflects tension between the Federal Circuit's "motivation" test and a long line of Supreme Court cases.

The Supreme Court cases, starting in 1850, suggest the following test for obviousness:

Given the known characteristics/functions of the elements of an invention, would ordinary artisans expect that the combination of these elements would result in what the patentee/applicant accomplished?

The Supreme Court's most recent decision, *Sakraida v. Ag Pro, Inc.*, 425 U.S. 274 (1976), approvingly quotes the statement in *Great A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 152 (1950), 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."

The Federal Circuit test, on the other hand, requires the prior art to provide a motivation for making the claimed combination. A brief filed by the Solicitor General in support for the petition for certiorari said that the Federal Circuit "has transformed one means of establishing obviousness...—proof that the prior art provided a teaching, suggestion or motivation for combining prior art references—into an inflexible requirement for determining obviousness," and has thus "extend[ed] patent protection to non-innovative combinations of familiar elements."

This case has the potential to significantly change both the test applied by the US Patent and Trademark Office when deciding to grant a patent, and that applied by the US courts not only in deciding whether to grant summary judgment of invalidity but also in applying an "obviousness" standard after trial and on appeal.

Links to the Federal Circuit's decision and related amicus briefs:

[Federal Circuit Decision](#)

Brief for the United States as Amicus Curiae on Behalf of the Solicitor General

Brief of 24 Intellectual Property Law Professors as Amici Curiae in Support of Petitioner

Brief of the Progress & Freedom Foundation as Amicus Curiae in Support of the Petition for a Writ of Certiorari

Brief of Cisco Systems Inc., Microsoft Corp Inc., Hallmark Cards, Inc., V.F. Corp. and Fortune Brands, Inc. as Amici Curiae in Support of Petitioner

For more information on this and other intellectual property matters, please contact:

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