
The WilmerHale Obviousness Report – A Client Alert Special Edition

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Since the Supreme Court's landmark decision in *KSR Int'l v. Teleflex Inc.* in April 2007, the Federal Circuit has decided nearly 80 cases (precedential and non-precedential but not including summary affirmances) that substantively address the issue of obviousness. In an effort to shed light on how the Federal Circuit has reacted to *KSR*'s admonishment against rigid application of the TSM test (and its statements concerning the "obvious to try" concept), we have carefully tracked and analyzed the Federal Circuit's post-*KSR* decisions on the issue of obviousness. The tables that follow provide a breakdown of these cases by holding, affirmance or reversal, and patented subject matter. The cases are divided into three broad categories: (1) Life Sciences and Chemical Arts; (2) Computers, Software, and Electronic Arts; and (3) Mechanical Arts and Miscellaneous Cases. Each major category is further broken down into additional industrial subcategories. Aggregate results follow each table and section.

Although the following tables provide much more industry-specific detail, a number of overall statistics and other trends are worth highlighting:

- In roughly half of Life Sciences and Chemical Arts Cases (51.2%) and Computers, Software, and Electronic Arts Cases (50%), the validity of the claims was upheld on appeal, whereas in 80% of Mechanical Arts or Miscellaneous Cases, the claims were invalidated

as obvious.

- Within the pharmaceutical subcategory, new chemical entity (NCE) cases were the most likely to result in a non-obviousness holding at 75%; in stark contrast, 71.4% of non-NCE pharmaceutical cases resulted in an obviousness holding.
- In 45 of 79 cases (57%), the Federal Circuit held the claim(s) at issue obvious versus 34 cases (43%) in which the court held that the claim(s) had not been proven obvious.
- Of the 79 cases, only 21 decisions (26.6%) were reversals in chief of the district court decision on obviousness, whereas 58 decisions (73.4%) were affirmances.
- Among the 21 reversals were 14 decisions (66.7%) that held the claim(s) obvious in contravention of the decision below (including each of the six instances in which the Federal Circuit reversed a jury verdict).

WilmerHale will continue to monitor developing trends in the obviousness case law and share those insights with its clients.

Life Sciences and Chemical Arts Cases

Biotechnology Cases

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Applera Corp. v. Illumina, Inc.</i> , 2010 U.S. App. LEXIS 6250 (Mar. 25, 2010)	Non-obvious	Affirmed	Methods of sequencing DNA
<i>In re Chapman</i> , 595 F.3d 1330 (Feb. 24, 2010)	Non-obvious	Reversed (remanded)	Divalent antibody fragments
<i>In re Kubin</i> , 561 F.3d 1351 (Apr. 3, 2009)	Obvious	Affirmed	DNA molecules encoding NAIL protein
<i>Amgen Inc. v. F.</i>	Non-obvious	Affirmed	EPO production

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Hoffmann-La Roche, Ltd.</i> , 580 F.3d 1340 (Sept. 15, 2009)	(obviousness-type double patenting)		using recombinant DNA
<i>Ecolab, Inc. v. FMC Corp.</i> , 569 F.3d 1335 (June 9, 2009)	Obvious	Reversed	Use of paracetic acid as sanitizer in beef and poultry
<i>In re DBC</i> , 545 F.3d 1373 (Nov. 3, 2008)	Obvious	Affirmed	Neutriceutical compositions comprising rind of the mangosteen fruit
<i>In re Swanson</i> , 540 F.3d 1368 (Sept. 4, 2008)	Obvious	Affirmed	Method for analysis of analytes
<i>Pharmastem Therapeutics, Inc. v. Viacell, Inc.</i> , 491 F.3d 1342 (July 9, 2007)	Obvious (2-1)	Reversed	Compositions and methods for treating persons with compromised blood and immune systems with hematopoietic stem cells
3 Holdings of Non-obviousness (37.5%) 3 Reversals (37.5%, 2 holding obvious) 5 Holdings of Obviousness (62.5%) 5 Affirmances (62.5%)			

Medical Device Cases

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Spine Solutions, Inc. v. Medtronic Sofamor Danek USA, Inc.</i> , 2010 U.S. App. LEXIS 18818 (Fed. Cir. Sept. 9, 2010)	Non-obvious	Affirmed	Intervertebral implants
<i>Trimed, Inc. v. Stryker Corp.</i> , 608 F.3d 1333 (June 9, 2010)	Non-obvious	Reversed (remanded)	Implantable device to set bone fractures
<i>Hearing Components, Inc. v. Shure Inc.</i> , 600 F.3d 1357 (Apr. 1, 2010)	Non-obvious	Affirmed	Hearing aid components
<i>Pressure Prods. Med. Supplies v. Greatbatch Ltd.</i> , 599 F.3d 1308 (Mar. 24, 2010)	Non-obvious	Affirmed	Introducer for catheters
<i>Therasense, Inc. v. Becton, Dickinson & Co.</i> , 593 F.3d 1289 (Jan. 25, 2010), <i>reh'g en banc granted</i> (Apr. 26, 2010)	Obvious	Affirmed	Glucose measuring device for diabetics

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Therasense, Inc. v. Becton, Dickinson & Co.</i> , 593 F.3d 1325 (Jan. 25, 2010)	Obvious	Affirmed	Glucose measuring device for diabetics
<i>Smith & Nephew, Inc. v. Arthrex, Inc.</i> , 355 Fed. Appx. 384 (Dec. 2, 2009)	Non-obvious	Affirmed	Method of placing and securing a suture anchor in bone
<i>Fresenius USA, Inc. v. Baxter Int'l, Inc.</i> , 582 F.3d 1288 (Sept. 10, 2009)	Obvious	Reversed	Hemodialysis machine with touchscreen interface
<i>Cordis Corp. v. Boston Sci. Corp.</i> , 561 F.3d 1319 (Mar. 31, 2009)	Non-obvious	Affirmed	Intravascular stents
<i>Kinetic Concepts, Inc. v. Blue Sky Med. Group, Inc.</i> , 554 F.3d 1010 (Feb. 2, 2009)	Non-obvious (2-1)	Affirmed	Reduced/negative pressure for wound healing
<i>Boston Scientific Scimed, Inc. v. Cordis, Corp.</i> , 554 F.3d 982 (Jan. 15, 2009)	Obvious	Reversed	Intravascular stents
<i>Lexion Med., LLC v. Northgate Techs., Inc.</i> , 292 Fed. Appx. 42 (Aug. 28, 2008)	Obvious	Affirmed	Method/apparatus for heating and humidifying gas used to inflate abdomen during laparoscopic surgery

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Voda v. Cordis Corp.</i> , 536 F.3d 1311 (Aug. 18, 2008)	Non-obvious	Affirmed	Catheters
<i>Ormco Corp. v. Align Tech., Inc.</i> , 498 F.3d 1307 (Aug. 24, 2007)	Obvious	Affirmed	Computer-aided design and manufacture of custom orthodontic appliances
<p>8 Holdings of Non-obviousness (57.1%) 3 Reversals (21.4%, 2 holding obvious)</p> <p>6 Holdings of Obviousness (42.9%) 11 Affirmances (78.6%)</p>			

Pharmaceutical Cases

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Daiichi Sankyo Co., Ltd. v. Matrix Labs., Ltd.</i> , 2010 U.S. App. LEXIS 18820 (Fed. Cir. Sept. 9, 2010)	Non-obvious	Affirmed	Olmesartan medoxomil (Benicar®, Benicar HCT®, and Azor®)
<i>Eli Lilly & Co. v. Teva Pharms. USA, Inc.</i> , 2010 U.S. App. LEXIS 18236 (Fed. Cir. Sept. 1, 2010)	Non-obvious	Affirmed	Raloxifene (Evista®)
<i>King Pharms., Inc. v. Eon</i>	Obvious	Affirmed	Methods of

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Labs., Inc.</i> , 2010 U.S. App. LEXIS 15947 (Aug. 2, 2010)			administration of metaxalone (Skelaxin®)
<i>Sun Pharm. Indus. v. Eli Lilly & Co.</i> , 2010 U.S. App. LEXIS 15552 (July 28, 2010)	Obvious (obviousness-type double patenting)	Affirmed	Method of using gemcitabine (Gemzar®) for treating cancer
<i>Purdue Pharma Prods. L.P. v. Par Pharm., Inc.</i> , 2010 U.S. App. LEXIS 11246 (June 3, 2010)	Obvious	Affirmed	Controlled-release tramadol formations for daily dosing (Ultram® ER)
<i>Boehringer Ingelheim Int'l GmbH v. Barr Labs., Inc.</i> , 2010 U.S. App. LEXIS 1624 (Jan. 25, 2010), <i>reh'g en banc denied</i> (May 7, 2010)	Non-obvious (2-1) (obviousness-type double patenting)	Reversed	Pramipexole (Mirapex®)
<i>Ortho-Mcneil Pharm, Inc. v. Teva Pharms. Indus., Ltd.</i> , 344 Fed. Appx. 595 (Aug. 26, 2009)	Obvious	Affirmed	Combination tramadol and acetaminophen (Ultracet®)
<i>Bayer Schering Pharma AG v. Barr Labs., Inc.</i> , 575 F.3d 1341 (Aug. 5, 2009)	Obvious (2-1)	Affirmed	Drospirenone formulation for oral contraception (Yasmin®)

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Procter & Gamble Co. v. Teva Pharms. USA, Inc.</i> , 566 F.3d 989 (May 13, 2009)	Non-obvious	Affirmed	Risedronate (Actonel®)
<i>Sanofi-Synthelabo v. Apotex, Inc.</i> , 550 F.3d 1075 (Dec. 12, 2008)	Non-obvious	Affirmed	Clopidogrel (Plavix®) – racemate separation
<i>In re Omeprazole Patent Litig. v. Apotex Corp.</i> , 536 F.3d 1361 (Aug. 20, 2008)	Non-obvious	Affirmed	Omeprazole (Prilosec®)
<i>Eisai Co. Ltd. v. Dr. Reddy's Labs., Ltd.</i> , 533 F.3d 1353 (July 21, 2008)	Non-obvious	Affirmed	Rabeprazole (Aciphex®)
<i>Daiichi Sankyo Co., Ltd. v. Apotex, Inc.</i> , 501 F.3d 1254 (July 11, 2008)	Obvious	Reversed	Method for treating bacterial ear infections with ofloxacin (Floxin®)
<i>Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.</i> , 520 F.3d 1358 (Mar. 31, 2008)	Non-obvious	Affirmed	Topiramate (Topamax®)

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Pfizer, Inc. v. Teva Pharms. USA, Inc.</i> , 518 F.3d 1353 (Mar. 7, 2008)	Obvious (obviousness-type double patenting)	Reversed	Celecoxib (Celebrex®)
<i>Aventis Pharma Deutschland GmbH v. Lupin, Ltd.</i> , 499 F.3d 1293 (Sept. 11, 2007)	Obvious	Reversed	Ramipril free of other isomers (Altace®)
<i>Forest Labs., Inc. v. Ivax Pharms., Inc.</i> , 501 F.3d 1263 (Sept. 5, 2007)	Non-obvious	Affirmed	(+)-enantiomer of citalopram (Celexa®)
<i>Metoprolol Succinate Patent Litig. v. KV Pharm. Co.</i> , 494 F.3d 1011 (July 23, 2007)	Obvious (2-1) (obviousness-type double patenting)	Affirmed	Metoprolol succinate (Toprol-XL®)
<i>Takeda Chem. Indus. v. Alphapharm Pty., Ltd.</i> , 492 F.3d 1350 (June 28, 2007)	Non-obvious	Affirmed	Pioglitazone (Actos®)

Case Name	Holding	Affirmance/Reversal	Subject Matter
10 Holdings of Non-obviousness (52.6%) 4 Reversals (21.1%, 3 holding obvious) 9 Holdings of Obviousness (47.3%) 15 Affirmances (78.9%) 3 New Chemical Entity Obviousness Holdings (25%) 9 New Chemical Entity Non-Obviousness Holdings (75%) 3 NCE Reversals (25%, 2 holding obvious) 9 NCE Affirmances (75%) 5 Non-NCE Holdings of Obviousness (71.4%) 2 Non-NCE Holdings of Obviousness (28.6%)			

Chemical Arts (Non-Pharmaceutical) Cases

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Sud-Chemie, Inc. v. Multisorb Techs.</i> , 554 F.3d 1001 (Jan. 30, 2009)	Non-obvious	Reversed	Desiccant containers
<i>In re Basell Poliolefine Italia S.P.A.</i> , 547 F.3d 1371 (Nov. 13, 2008)	Obvious (obviousness-type double patenting)	Affirmed	Method for copolymerizing unsaturated hydrocarbons

All Biological/Biomedical/Chemical Arts

22 Holdings of Non-obviousness (51.2%) 11 Reversals (25.6%, 7 holding obvious)
21 Holdings of Obviousness (48.8%) 32 Affirmances (74.4%)

Computers, Software, and Electronic Arts Cases

Computer/Software/Internet Cases

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Dow Jones & Co. v. Abilene</i> Ltd., 606 F.3d 1338 (May 28, 2010)	Obvious	Affirmed	Customized web pages based on signal info
<i>Verizon Servs. Corp. v. Cox Fibernet Va., Inc.</i> , 602 F.3d 1325 (Apr. 16, 2010)	Obvious	Affirmed	Packet-switched telephony
<i>i4i L.P. v. Microsoft Corp.</i> , 598 F.3d 831 (Mar. 10, 2010), <i>reh'g en banc denied</i> (Apr. 1, 2010)	Non-obvious	Affirmed	Method of editing custom computer language
<i>Perfect Web Techs., Inc. v. InfoUSA, Inc.</i> , 587 F.3d 1324 (Dec. 2, 2009)	Obvious	Affirmed	E-mail methods
<i>Lucent Techs. v. Gateway, Inc.</i> , 580 F.3d 1301 (Sept. 11, 2009)	Non-obvious	Affirmed	Method of entering information without using keyboard
<i>z4 Techs., Inc. v. Microsoft Corp.</i> , 507 F.3d 1340 (Nov. 16, 2007)	Non-obvious	Affirmed	Antipiracy software

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Verizon Servs. Corp. v. Vonage Holdings Corp.</i> , 503 F.3d 1295 (Sept. 26, 2007)	Non-obvious	Affirmed	Telephony-related methods
<p>4 Holdings of Non-obviousness (57.1%) 0 Reversals (0%)</p> <p>3 Holdings of Obviousness (42.9%) 7 Affirmances (100%)</p>			

Electronic Arts Cases

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Vizio, Inc. v. ITC</i> , 605 F.3d 1330 (May 26, 2010)	Non-obvious	Affirmed	Digital television technology/MPEG
<i>Honeywell Int'l, Inc. v. United States</i> , 609 F.3d 1292 (May 25, 2010)	Non-obvious	Reversed	Passive night vision goggles/optics
<i>Power-One, Inc. v. Artesyn Techs., Inc.</i> , 599 F.3d 1343 (Mar. 30, 2010)	Non-obvious	Affirmed	Point-of-load power regulators
<i>Siemens AG v. Seagate Tech.</i> , 369 Fed. Appx. 118 (Mar. 9, 2010)	Obvious	Affirmed	Magnetoresistive sensors

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Monolithic Power Sys. v. O2 Micro Int'l Ltd.</i> , 558 F.3d 1341 (Mar. 5, 2009)	Obvious	Affirmed	Power inverter circuitry for laptop computers
<i>Asyst Techs., Inc. v. Emtrak, Inc.</i> , 544 F.3d 1310 (Oct. 10, 2008)	Obvious	Affirmed	System for tracking articles
<i>Scanner Techs. Corp. v. Icos Vision Sys. Corp. N.V.</i> , 528 F.3d 1365 (June 19, 2008)	Obvious	Affirmed	Processes to inspect electronic components
<i>Black & Decker, Inc. v. Robert Bosch Tool Corp.</i> , 260 Fed. Appx. 284 (Jan. 7, 2008)	Non-obvious	Affirmed	Combination of a radio and a battery charger
<i>In re Translogic Tech., Inc.</i> , 504 F.3d 1249 (Oct. 12, 2007)	Obvious	Affirmed	Multiplexers
<p>4 Holdings of Non-obviousness (44.4%) 1 Reversal (11.1%)</p> <p>5 Holdings of Obviousness (55.6%) 8 Affirmances (88.9%)</p>			

All Computer/Software/Internet/Electronic Arts

8 Holdings of Non-obviousness (50%) 1 Reversal (6.3%)

8 Holdings of Obviousness (50%) 15 Affirmances (93.6%)

Mechanical Arts and Miscellaneous Cases

Mechanical Arts Cases

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Lucky Litter LLC v. ITC</i> , 2010 U.S. App. LEXIS 20621 (Fed. Cir. Oct. 6, 2010)	Obvious	Reversed	Self-cleaning cat litter box
<i>Geo M. Martin Co. v. Alliance Mach. Sys. Int'l LLC</i> , 2010 U.S. App. LEXIS 17377 (Fed. Cir. Aug. 20, 2010)	Obvious	Affirmed	Bundle breaker with compliance structures
<i>Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contrs. USA, Inc.</i> , 2010 U.S. App. LEXIS 17181 (Aug. 18, 2010)	Non-obvious	Reversed (remanded)	Apparatus for conducting offshore drilling
<i>Wyers v. Master Lock Co.</i> , 2010 U.S. App. LEXIS 15271 (July 22, 2010)	Obvious	Reversed	Hitch pin locks to secure trailers to automobiles
<i>Rolls-Royce, PLC v. United Techs. Corp.</i> , 603 F.3d 1325 (May 5, 2010)	Non-obvious	Affirmed	Swept fan blades for turbofan jet engine
<i>B-K Lighting, Inc. v. Fresno</i>	Obvious	Affirmed	Adjustable mount for

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Valves & Castings, Inc.</i> , 2010 U.S. App. LEXIS 8770 (Apr. 28, 2010)			sealed light fixtures
<i>Alloc, Inc. v. Pergo, Inc.</i> , 366 Fed. Appx. 173 (Feb. 18, 2010)	Obvious	Affirmed	Mechanical joints for flooring panels
<i>Gemtron Corp. v. Saint-Gobain Corp.</i> , 572 F.3d 1371 (July 20, 2009)	Non-obvious	Affirmed	Refrigerator shelves
<i>Sundance, Inc. v. Demonte Fabricating Ltd.</i> , 550 F.3d 1356 (Dec. 24, 2008)	Obvious	Reversed	Retractable segmented covering systems
<i>In re Icon Health & Fitness, Inc.</i> , 496 F.3d 1374 (Aug. 1, 2007)	Obvious	Affirmed	Treadmill with folding base
<i>Frazier v. Layne Christensen Co.</i> , 239 Fed. Appx. 604 (June 29, 2007)	Obvious	Affirmed	Method for improved water well production
<p>3 Holdings of Non-obviousness (27.3%) 4 Reversals (36.4%, 3 holding obvious)</p> <p>8 Holdings of Obviousness (72.7%) 7 Affirmances (63.6%)</p>			

Miscellaneous Cases

Case Name	Holding	Affirmance/Reversal	Subject Matter
<i>Media Techs. Licensing, LLC v. Upper Deck Co.</i> , 596 F.3d 1334 (Mar. 1, 2010)	Obvious (2-1)	Affirmed	Sports memorabilia card
<i>Crocs, Inc. v. ITC</i> , 598 F.3d 1294 (Feb. 24, 2010)	Non-obvious	Reversed	Breathable footwear pieces
<i>Ritchie v. Vast Res., Inc.</i> , 563 F.3d 1334 (Apr. 24, 2009)	Obvious	Reversed	Borosilicate rods
<i>Rothman v. Target Corp.</i> , 556 F.3d 1310 (Feb. 13, 2009)	Obvious	Affirmed	Nursing garment with invisible breast support for nursing mothers
<i>Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.</i> , 555 F.3d 984 (Feb. 9, 2009)	Obvious	Reversed	Candles
<i>Leggett & Platt, Inc. v. VUTEk, Inc.</i> , 537 F.3d 1349 (Aug. 21, 2008)	Obvious	Affirmed	Method and apparatus for printing ink on a rigid, deformable substrate
<i>Muniauction, Inc. v. Thomson Corp.</i> , 532 F.3d 1318 (July 14, 2008)	Obvious	Reversed	Electronic (business) methods for conducting original issuer auctions of financial instruments
<i>Agrizap, Inc. v. Woodstream Corp.</i> , 520 F.3d 1337 (Mar.	Obvious	Reversed	Method and apparatus for

Case Name	Holding	Affirmance/Reversal	Subject Matter
28, 2008)			electrocuting pests
<i>In re Trans Tex. Holdings Corp.</i> , 498 F.3d 1290 (Aug. 22, 2007)	Obvious	Affirmed	System of inflation-adjusted deposit and loan accounts
<p>1 Holding of Non-obviousness (11.1%) 5 Reversals (55.6%, 4 holding obvious)</p> <p>8 Holdings of Obviousness (88.9%) 4 Affirmances (44.4%)</p>			

All Mechanical Arts and Miscellaneous Cases

4 Holdings of Non-obviousness (20%) 9 Reversals (56.3%, 7 holding obvious)

16 Holdings of Obviousness (80%) 7 Affirmances (43.7%)