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Client Alert

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USPTO Update to Examination Guidelines for Determining Obviousness

In light of several decisions issued by the U.S. Court of Appeals for the Federal Circuit since the U.S. Supreme Court issued its landmark decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), the United States Patent and Trademark Office (USPTO) recently issued an update to the examination guidelines it had issued in 2007 following the *KSR* decision.

In the 2007 guidelines, the USPTO noted that support for an obviousness determination under 35 U.S.C. § 103 was not limited to the teaching-suggestion-motivation test. The guidelines identified several rationales provided by the Supreme Court that may be used to support a determination of obviousness.

The recent update provides additional guidance for examiners and practitioners to determine obviousness or non-obviousness through "teaching points" derived from several Federal Circuit decisions. The update groups the decisions according to obviousness concepts including combining prior art elements, substituting one known element for another, the obvious to try rationale, and consideration of evidence.

"Now that a body of post-KSR case law is available to guide office personnel and practitioners as to the boundaries between obviousness and nonobviousness, this update can be used to compare and contrast situations in which claimed subject matter was found to have been obvious with those cases in which it was determined not to have been obvious," said Under Secretary of Commerce for Intellectual Property and Director of the USPTO David Kappos. "This update will be helpful to USPTO patent examiners, inventors and the patent bar because it reviews several cases from the Federal Circuit that have involved the application of the law of obviousness since the *KSR* case was decided by the Supreme Court."

The update provides some context into how the Federal Circuit and the USPTO are interpreting and applying the Supreme Court's decision in *KSR*. While some steadfast approaches to the obviousness issue, such as teaching away from the claimed invention, lack of a reasonable expectation of success, and unexpected results, may still apply, each determination of obviousness is fact specific.

The "Examination Guidelines Update: Development in the Obviousness Inquiry After *KSR v. Teleflex*" is available [here](#).

Please contact an intellectual property attorney at Armstrong Teasdale should you have any questions regarding an obviousness determination.

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