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**DETERMINING “OBVIOUSNESS”:  
A NEW, LESS CERTAIN  
METHODOLOGY PRESCRIBED  
BY *KSR* DECISION**

by  
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*K & L Gates LLP*



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# **DETERMINING "OBVIOUSNESS": A NEW, LESS CERTAIN METHODOLOGY PRESCRIBED BY *KSR* DECISION**

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## **INTRODUCTION**

Following its landmark decision in *Graham v. John Deere*, 383 U.S. 1 (1966), in which the Supreme Court laid down the methodology for determining obviousness under 35 U.S.C. § 103, the Court remained silent on the subject for over 40 years.<sup>1</sup> The Court again addressed the methodology question in 2007 when it decided *KSR v. Teleflex*, 550 U.S. 398 (2007). At the time, the U.S. Court of Appeals for the Federal Circuit was still reeling from several reversals by the Supreme Court in the first decade of this century. Perhaps motivated by the possibility of another reversal in *KSR*, the circuit "tidied up" its application of the traditional "teaching-suggestion-motivation" (TSM) test.<sup>2</sup> The high court acknowledged this effort but nonetheless proceeded to jettison TSM in its unanimous *KSR* decision. In *KSR*, the Supreme Court also resurrected the discredited "obvious to try" concept and

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<sup>1</sup>The Supreme Court applied the *Graham* factors in *Dann v. Johnston*, 425 U.S. 219, 227-29 (1976).

<sup>2</sup>See *DyStar Textilfarben GmbH and Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356 (Fed. Cir. 2006) and *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286 (Fed. Cir. 2006).

thereby added more factual inquiries to the familiar *Graham* litany, but did not indicate just how these inquiries should be blended in a methodology that courts can apply.<sup>3</sup>

This CONTEMPORARY LEGAL NOTE was initially intended to tackle that "blending" task, but we could not get past the first, seemingly benign, *Graham* inquiry of determining the scope and content of the prior art. A closer look at *KSR* makes it apparent that the demotion of the TSM test from its position of exclusivity in Federal Circuit obviousness jurisprudence has had effects beyond the elimination of a bright line test on the issue. TSM had been the focal point of the Federal Circuit's quest to eliminate hindsight in assessing obviousness and was a key factor in the selection of prior art to be considered within the scope of the prior art under *Graham*. In other words, if a prior art reference was not linked to another basic reference by TSM, the outlying reference would not be within the scope of the prior art for *Graham* purposes. With TSM gone as its doorkeeper, the factor considering scope of the prior art abruptly became defined by distinctly amorphous boundaries.

This paper first explains how *KSR* derailed the conventional determination of the scope of the prior art and then attempts to harmonize *Graham* and *KSR* into a workable new methodology for analyzing obviousness.

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<sup>3</sup>See Yeager, "Determining Obviousness – *Graham* plus *KSR*?" IPLaw360, Guest Column, Jan. 19, 2010.

## **I. DETERMINING THE SCOPE AND CONTENT OF THE PRIOR ART**

### **A. The Expansive Effect of *KSR* on the Scope of the Art Analysis**

Determining the scope and context of the prior art is the first of the *Graham* inquiries. Soon after it was created, the Federal Circuit addressed the meaning of the scope of the prior art. In *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535 (Fed. Cir. 1983), the court said that it includes art that is "reasonably pertinent to the particular problem with which the invention was involved." This test had become known as the "analogous art test." See *Dann v. Johnston*, 425 U.S. 219, 227-29 (1976).

In order to guard against the courts applying hindsight in the selection of prior art references that would be available in an obviousness determination, the Federal Circuit later promoted the TSM test to assist in fixing the "scope of the prior art." The court feared that defining the "problem" in terms of the patentee's solution revealed improper hindsight in the selection of prior art relevant to obviousness. See *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881-82 (Fed. Cir. 1998). By requiring compliance with the TSM standard, the Federal Circuit asked not merely what the references disclose, but whether a person of ordinary skill in the art (herein "POSITA") would have consulted a particular reference in assessing obviousness at the time the invention was made. TSM, therefore, picked up where the analogous art test left off and was the touchstone for determining the

scope of the art for a *Graham* analysis. *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006).

The *KSR* decision greatly diminishes the importance of the TSM test, certainly as it relates to defining the scope of the prior art for obviousness determinations. The Supreme Court found error in looking only to the problem the patentee was trying to solve and thereby narrowing the prior art under consideration. According to the Court:

Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.

*KSR* at 420. The broadening effect of this quoted language is palpable and leaves the boundaries of the pertinent prior art flexible to say the least.

## **B. The Scope of the Art under the *KSR* Paradigm**

The Federal Circuit's predecessor court, the Court of Customs and Patent Appeals (CCPA), employed a graphic analogy for determining obviousness; the CCPA had the POSITA sitting in a room with all of the prior art tacked up on the walls around him. *In re Winslow*, 365 F.2d 1017 (CCPA 1966). After completing his review of the art, the POSITA would either immediately perceive the invention or not. The analogy would not be apt after *KSR* because the prior art to be "tacked up" cannot be identified with any certainty.<sup>4</sup>

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<sup>4</sup>Indeed, the Federal Circuit's early cases on obviousness were unequivocal on what references should be within the scope of the prior art:

It remains for the Federal Circuit to provide guidance on selection of prior art for inclusion in any obviousness analysis, but given the firmness of the Supreme Court in *KSR* against the adoption of any formulaic approach, no immediate action by the Federal Circuit should be expected. It is more likely that the Federal Circuit will proceed ad hoc to decide upon the prior art items deserving of consideration. Without the benefit of signposts from *KSR*, the focus likely will be on the broadly defined "field of endeavor." Indeed, the Federal Circuit recently saw the scope of the prior art inquiry as whether the art is "analogous."<sup>5</sup> That question devolved into (1) whether the art is from the same field of endeavor and (2) if not, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *Wyers, supra.* (citing *Comaper Corp. v. Antec Inc.*, 596 F.3d 1343, 1351 (Fed. Cir. 2010)). Any close questions on whether or not a piece of prior art should be considered will favor inclusion.

## **II. DETERMINING THE DIFFERENCES BETWEEN THE CLAIMED INVENTION AND THE PRIOR ART**

The second *Graham* inquiry addresses "differences." The question is: What is the "prior art" that forms one leg of the comparison? Fundamentally,

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References are within the scope of the prior art if the problem presented and overcome by the reference is basically the same problem presented and overcome by the invention in question.

*Shelcore, Inc. v. Durham Industries, Inc.*, 745 F.2d 621, 625 (Fed. Cir. 1984).

<sup>5</sup>*Wyers et al. v. Master Lock Company*, WL \_\_\_\_\_ (July 22, 2010) (No. 2009-1412).

unless the claimed invention is novel in the sense of Section 102, the issue of obviousness does not arise. Section 103 speaks of the invention not being "identically disclosed or described as set forth in section 102" as the predicate for a consideration of obviousness. This statutory language strongly suggests that the prior art under consideration in the *Graham* inquiry for "differences" is constituted by the individual items of art, not their collective teachings, that *fail* to identically disclose the invention.

This proposition is supported by the Federal Circuit's well-developed jurisprudence of applying TSM. The teaching-suggestion-motivation to combine references was sought to justify modifying a reference or merging its teachings with the teachings of another, but in all cases it was an individual reference whose teachings were first established as being in the prior art.

With the TSM test now deemphasized, the modification or merger of references must come, under the Supreme Court's obviousness doctrine, when the court views the "background" of the factual inquiries and decides the legal issue of obviousness. To this point, the prior art being compared for "differences" under *Graham* consists of individual prior art references.

This inquiry therefore requires the finder of fact to focus upon the differences between the disclosure of each item of prior art, found to be within the scope of the prior art, and the claimed invention. The isolation of these differences will be the predicate for the next factual inquiry under *Graham* in which the level of skill in the art is ascertained. There we will see the need to

resolve whether a creative POSITA would have been capable of seizing upon and applying these differences at the time the invention was made.

### **III. ASCERTAINING THE LEVEL OF SKILL (AND THE CAPABILITIES OF) THE PERSON OF ORDINARY SKILL – WHO IS NOW MORE SKILLFUL THAN BEFORE**

The third *Graham* inquiry addresses the person of ordinary skill in the art. Before the Federal Circuit was created, the regional circuits held their own views of the POSITA and they ranged from a person of modest enlightenment to someone who could be considered something of a dullard. These courts all struggled with the meaning of the modifier "ordinary" in describing the skill level of this hypothetical creature of statute.

The Federal Circuit never seemed overly concerned with pigeon-holing the POSITA, probably because the TSM test created a bright line for the application of Section 103. If an invention is either obvious or not, depending upon the presence of a TSM for combining references, the nature and characteristics of the POSITA seem less important and were treated as such by the Federal Circuit.

About the most the Federal Circuit did to inform on the skill of the POSITA was to list, in a kind of résumé form, the factors to be considered in determining the "level" of skill under *Graham*:

- (1) educational level of the inventor;
- (2) the type of problems encountered in the art;

- (3) prior art solutions to these problems;
- (4) the rapidity with which inventions were made;
- (5) the sophistication of the technology; and
- (6) the education level of active workers in the field.

*Environmental Designs v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 1043 (1984). After analyzing these factors, most courts, usually led by trial counsel, found the level of skill in the art to be, for example, a \_\_\_\_\_ engineer with a \_\_\_\_\_ degree in \_\_\_\_\_ and \_\_\_\_\_ years of experience in the field of \_\_\_\_\_. Little attention was devoted to what the POSITA would have been expected to do with the art before him.

In *KSR*, we see a POSITA emerging, not as a mere routinier, but a person of ingenuity. ("A person of ordinary skill is also a person of ordinary creativity, not an automaton.") *See KSR* at 421. We are told that a POSITA will not restrict his problem solving to prior art designed to solve the same problem. He will range beyond, as common sense dictates, to obvious uses outside of the primary purpose. He will also organize the teachings of multiple patents to fit together like pieces of a puzzle. The days of the POSITA wearing blinders are clearly over. It seems that the Supreme Court's "ordinary mechanic" of *Hotchkiss*<sup>6</sup> has come a long way.

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<sup>6</sup>*Hotchkiss v. Greenwood*, 51 (11 How.) 248 (1850).

Moreover, the analysis must go further in order to gain an understanding of the degree of ingenuity that should be expected from the person. Based upon the credentials set out in *Environmental Designs*, the fact finder must review the prior art to determine and articulate, in response to specific inquiries on a verdict sheet, the skill set possessed by the hypothetical artisan in his particular field. The establishment of the POSITA's capabilities is vital to the final query where the court views the claimed invention, taken as a whole, against the background of the *Graham/KSR* inquiries.

It must be remembered that when that "background" is arrayed before the court, the prior art has not yet been combined. The combination of items of prior art, if it should occur, will be done on the basis of the known capabilities of the POSITA as established under the level of skill inquiry.

#### **IV. ADDRESSING THE INQUIRIES FOR "OBVIOUS TO TRY"**

After completing the three traditional *Graham* inquiries, as modified by *KSR*, and before viewing the so-called "secondary considerations" under *Graham*, it is a good place to consider "obvious to try." In its revival of the "obvious to try" concept, the Court in *KSR* set out the conditions for application of the concept as follows:

- There is a problem to be solved;
- There are a finite number of identified, predictable solutions; and
- A POSITA has good reason to pursue the known options.

The first step in ascertaining the presence of these conditions is to specify the problem that was solved by the claimed invention. This subject will have been addressed to some extent in evaluating factors (2) and (3) under *Environmental Designs, supra*.

The best source for identifying the problem that was solved is the patentee's specification. To a lesser extent, the prosecution history may reveal useful information as well. It is to be understood that these sources are cast in the patentee's own words and may be subject to criticism for lack of objectivity. Nonetheless, any statement by the patentee in the written record can be tested by the traditional tools of cross-examination and contrary expert testimony. By the close of the evidence, whether at trial or in prosecution in the PTO, there should be a sufficient record from which should emerge the nature and extent of the problem to be solved by the claimed invention.

By delving into matters contained within the patent document and file history in furtherance of an obviousness determination, our methodology risks invoking the long-held concerns of the courts and commentators about the danger of using the patent in suit as a "roadmap" to reach a hindsight-driven conclusion that the invention would have been obvious. *See, e.g., Ruiz v. A.B. Chance*, 234 F.3d 654 (Fed. Cir. 2000). The short answer to this seeming contradiction in classic dogma is that the Supreme Court requires that the conditions for "obvious to try" be examined and the threshold condition relates to the problem solved by the invention. Alternatively, it may be possible to

divine the problem that was solved by inspection of the prior art. But clearly the easiest, most direct, and probably most reliable source for the answer is the patent documents.

Accused infringers will attempt to capitalize on the "roadmap" quality of the patent documents to distort a test of obviousness that by statute is timed for examination just prior to the invention – there is no escaping that tactic. Courts will have to be vigilant to restrict the use of the patent documents to the specific inquiry at hand – the problem the invention was supposed to solve.

One fact pattern that may arise in the "problem to be solved" inquiry is the somewhat rare circumstance where no forethought is given to problem solving – the invention came about through pure accident or some other unintended event. There is nothing in the patent law that excludes serendipity from the range of protection offered to the inventor. In fact, the second sentence of Section 103 states: “Patentability shall not be negated by the manner in which the invention was made.”<sup>7</sup>

Thus, even the patentee may be effectively barred by circumstance from claiming in the patent documents that the invention was made in the course of addressing of a particular problem in the art. If that situation arises, then the doctrine of "obvious to try" should be inapplicable on its face.

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<sup>7</sup>This sentence was intended to minimize the effect of Justice Douglas' unfortunate reference to a requirement for a "flash of genius" in *Cuno Engineering Corp. v. Automatic Equip. Co.*, 314 U.S. 84 (1941)

After ascertaining the problem to be solved, there remain two further inquiries to determine whether "obvious to try" is in play. Whether there are a finite number of identified, predictable solutions and whether a POSITA has good reason to pursue the known options must be resolved. It is difficult to imagine how these inquiries may be answered purely on the basis of prior art documents. As for the first inquiry, it may be evident from the prior art that a particular solution to a problem is taught, but whether the solution is "predictable" would likely be the subject of expert testimony. As for the POSITA's inclination to pursue a known solution, that plainly is in a subjective realm and would require extrinsic evidence.

## **V. THE SECONDARY CONSIDERATIONS**

Arguably the most compelling sources of evidence on the issue of obviousness are to be found in the so-called secondary considerations noted by the Supreme Court in *Graham*. One of the early proponents of this type of evidence for an obviousness determination was Judge Learned Hand, who referred to the factors later enumerated in *Graham* (e.g., commercial success, long-felt need, failure of others) as "signposts." *See Reiner v. I. Leon Co.*, 285 F.2d 501 (2d Cir. 1960), *cert. denied* 366 U.S. 929 (1961).<sup>8</sup>

With the establishment of the Federal Circuit, assessment of the secondary considerations became a mandatory exercise for the lower courts. In

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<sup>8</sup>*See also* Judge Hand's statement of the "most reliable test" for appraising an inventor's contribution to the art "is to look at the situation before and after it appears." *Safety Car Heating & Lighting Co. v. Gen. Elec. Co.*, 155 F.2d 937, 939 (2d Cir. 1946).

a speech to a conference of district court judges in 1979,<sup>9</sup> Chief Judge Markey of the CCPA (later of the Federal Circuit) spoke of these items of evidence as being "secondary in time, not in importance." He went on to say:

In my view it is both incongruous and unjust to refuse to even consider these so-called secondary items of evidence.

*Id.*

Indeed, in the hands of the Federal Circuit, the classic three factual inquires of *Graham* became four, the fourth being the secondary considerations of nonobviousness. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000). The *Ruiz* panel stated:

Our precedents clearly hold that secondary considerations, when present, must be considered in determining obviousness.

*Id.* at 667. Chief Judge Michel in the *Dystar* case, *supra*, at 1, which was decided shortly before *KSR*, spoke of "four groups of factual findings in determining obviousness, the fourth being any relevant secondary considerations."<sup>10</sup>

Despite this history of secondary considerations becoming an integral, essential part of the obviousness determination, it is interesting to note that there is no support for mandatory consideration in *Graham*. The Supreme Court's words are:

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<sup>9</sup>80 F.R.D. 203, 212 (1979).

<sup>10</sup>The Federal Circuit affirmed the independent nature of secondary consideration evidence in the recent case of *Pressure Products Medical Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d 1308 (Fed. Cir. 2010).

Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc. *might be utilized* to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries *may* have relevancy.

*Graham*, 383 U.S. at 17.

We now turn to the *KSR* decision. Early in the opinion, Justice Kennedy quoted the language above with approval. If the permissive nature of the *Graham* treatment of secondary considerations had troubled the Court during this landmark modification of the methodology for determining obviousness, surely Justice Kennedy would have made some comment. Instead, it left the *Graham* language intact.

When Justice Kennedy reached the analysis of the district court's treatment of secondary considerations, he said simply:

Like the District Court, finally, we conclude Teleflex has shown no secondary factors to dislodge the determination that claim 4 is obvious.

*KSR* at 426.

The use of the word "dislodge" in this context suggests that a conclusion of obviousness was reached by the district court *before* the evidence of secondary considerations was taken up. If, indeed, the Court accepted such procedure, it would signal approval of a methodology in which the first three *Graham* inquiries are to be considered and, as *Graham* states, "[a]gainst this background the obviousness or nonobviousness of the subject matter is determined." In that case, the evidence of secondary considerations would be

just that – secondary – and available to *dislodge* a conclusion of obviousness already reached.

The Federal Circuit may have picked up on the "dislodge" nuance in *KSR*. Writing for a unanimous panel in *Rolls-Royce, PLC v. United Technologies*,<sup>11</sup> Chief Judge Rader stated: "The secondary considerations cement the district court's conclusion of non-obviousness." *Id.* at 1340.

The word "cement" in context, like the word "dislodge," suggests that a conclusion on the issue of obviousness was reached before the secondary factors were considered, and properly so. It will be interesting to see if *Rolls-Royce* signals a move by the Federal Circuit away from placing the secondary considerations on an equal footing with the three *Graham* factual inquiries.

## **VI. AGAINST THIS BACKGROUND ...**

When all of the information developed by the factual inquires the Supreme Court mandated is arrayed, the issue of obviousness or nonobviousness is to be decided, initially by the trial court. That decision will be most credible if there is no indication that the court lapsed into hindsight. But how is the decision reached?

There are a number of factors that may aid in the decision-making:

(1) What is the evidence of skilled persons "who have been there?" A witness who was working in the field at the time the invention was made can

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<sup>11</sup>603 F.3d 1325 (Fed. Cir. 2010) (unobvious decision below affirmed).

provide useful evidence on obviousness. If that person, despite being thoroughly qualified himself, testifies that he did not see the solution until the patent emerged, there is the power of ego that makes him reluctant to make such an admission. Credibility normally attaches to such testimony.

(2) Was there a missing substance or development which, upon becoming available, allowed the invention to be realized almost immediately? When pure oxygen, which was available only in small quantities for use by airmen during World War II, became available in tonnage quantities thereafter, the basic oxygen steelmaking process soon followed. This sort of chronology tends to suggest obviousness.

(3) Were there indications of surprise or lack of understanding when the invention first became known? When the U.S. Army Signal Corps, which was responsible for electrical and electronic developments for the Defense Department first reviewed the basic patents on producing printed circuits, they did not understand the technology despite the patent's explanation. When the person in charge of runway construction for the U.S. Air Force met the inventor of the paving machine in the famous *Anderson's Black Rock* case, he had the inventor removed from his office. Evidence of disbelief is powerful on the issue of obviousness.

(4) Do any of the relevant prior art references "teach away" from the solution settled on by the inventor?<sup>12</sup> Where the teachings of the prior art undermine the very reason being proffered as to why a POSITA would have combined known elements, a strong inference of nonobviousness arises.<sup>13</sup>

These types of incidents provide useful insights on the obviousness of an invention. Such dramatic evidence will not be available in every case and, indeed, its absence in a setting that otherwise demands it being brought forward may itself inform the obviousness ruling.

Above all, however, a court must look to the capabilities of the POSITA at the time of the invention for indications that the POSITA could make the leap between the prior art and the claimed invention. It falls on trial counsel to supply this evidence – pro and con – in order to persuade the court of a position on this most difficult question.

## CONCLUSION

The foregoing represents our approach for organizing and resolving the factual inquiries set out by the Supreme Court in defining the methodology for determining obviousness under Section 103. The *KSR* decision rocked the *Graham* boat a bit more than originally perceived, but with the guidance of a watchful trial judge, the necessary inquiries can be managed and the background provided will be more elaborate than before.

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<sup>12</sup>Judge (now Chief Judge) Rader emphasized this factor in his opinion in the Federal Circuit's recent decision in *Crocs Inc. v. ITC*, 598 F.3d 1294, 1311 (Fed. Cir. 2010).

<sup>13</sup>*In Re Chapman*, 595 F.3d 1330, 1337 (Fed. Cir. 2010).