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TSM Test for Obviousness Argued Before the Supreme Court

On November 28, 2006, the United States Supreme Court heard oral arguments regarding the case of *KSR International Co. v. Teleflex, Inc.* The case itself concerned a broadly worded patent claim that the United States Patent Office (USPTO) told the Supreme Court was invalid under Section 103 of the Patent Act and was issued in error. The patent at issue relates to an adjustable gas pedal assembly used in conjunction with an electronic control. Usually electronic sensors for engine control are mounted on the gas pedal; however the invention at issue mounts the sensors on the vehicle body itself—adjacent to the pedal. At issue in the case was whether, under U.S.C. § 103, a claim to such an invention would have been obvious to one skilled in the art.

The Supreme Court granted cert to determine if the Federal Circuit erred in holding that a claimed invention cannot be held obvious if it passes a “teaching-suggestion-motivation” (TSM) test that is a determination of whether the relevant prior art taught, suggested, or motivated a person of ordinary skill in the art to combine the prior art in the manner claimed. KSR argued that the TSM test is not supported by the language of §103 and furthermore that it runs contrary to Supreme Court precedent. U.S. Solicitor General Thomas Hungar, supported KSR’s position in his brief as Amicus Curiae when he stated that the TSM test, when used as the sole means of determining obviousness, was “contrary to the Patent Act, irreconcilable with the (Supreme) Court’s precedents and bad policy”.

Teleflex, the patent holder, argued that the TSM test is necessary to provide guidance for the lower courts, patent examiner and patent practitioners. The company further argued that the test provided a proper balance and weighs the competing interests of the patent owner and the owner’s competitors in the particular field of technology. Teleflex’s final argument was that the elimination of the TSM test would essentially amount to the elimination of 20 years of Federal Circuit precedent and would lead to uncertainty and inconsistency in patent determinations.

The Supreme Court at times expressed considerable confusion over the requirements of the TSM test, and Justice Scalia even went so far as to call it “gobbledygook”. Chief Justice Roberts described the test as “worse than meaningless” and only served to complicate the inquiring by adding a layer of “Federal Circuit jargon that lawyers can then bandy back and forth”. Justice Breyer wondered about the meaning of using “motivation” as a test and if there was a need to return to the actual language of the statute and determining whether an invention would have been obvious to one of ordinary skill in the art. With such strong language being used by at least three of the justices, and the far-reaching effects the elimination of the TSM test could have on the area of patent law, it will be interesting to see the determination of the court when the decision is issued in the Spring.

By: Richard Ito

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