

Jafari Law Group, Inc.

IP NOW-December 2006

In Defense of M-S-T: The Federal Circuit's Decision in *Dyestar v. C.H. Patrick*

The U.S. Court of Appeals for the Federal Circuit issued an opinion in the *Dyestar Textilfarben v. C.H. Patrick Co. and Bann Quimica* decision that defended the use of the “motivation-suggesting teaching” (hereinafter: “M-S-T”) test in order to determine a finding of obviousness in the matter of patented inventions. The opinion is of particular interest because it is seemingly drafted in direct response to the Supreme Court granting certiorari for the *KSR v. Teleflex* appeal, which has now been decided in favor of KSR and perhaps has forever altered the application of the M-S-T test.

In *Dyestar v. C.H. Patrick*, the plaintiff patent holder had patented an improvement to the process of dyeing textile materials with catalytically hydrogenated leuco. The improvement centered on the removal of two of the six steps traditionally used in the process: stabilizing the leuco indigo solution into a paste or powdered form, and then reconstituting the solution in a preparation tank. The patent holder successfully alleged that the defendants had infringed on 4 claims of the patent as the jury declined to hold the patent claims invalid for lack of enablement, anticipation or obviousness. The defendants then filed a motion for judgment as a matter of law asserting the patent should be held invalid for issues of obviousness. This motion was denied by the district court, upon which defendants appealed.

In its analysis of the case, the Federal Circuit notes that pursuant to 35 U.S.C. §103(a), a determination of obviousness rests on “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains”. The Supreme Court interpreted the issue in *Graham v. John Deer* and determined that there were four factors upon which obviousness depended: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations. The Federal Circuit articulated a secondary requirement to the first factor when it stated that “when all claim limitations are found in a number of prior art references, the fact finder must determine what the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references”. The M-S-T test, the Court explained, was its way of evaluating the “motivation to combine”, factor. The Court acknowledged the criticism of the test— that it is seen by some as a rigid categorical rule—but was quick to point out that it explained in *Motorola, Inc. v. Interdigital Tech Corp.*, that “there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather the suggestion to combine may come from prior art, as filtered through the knowledge of one skilled in the art”.

Though the court addressed each factor for obviousness, as laid out in *Graham*, the crux of the its analysis was contained in its discussion on the scope and content of the prior art, and more specifically whether or not there was evidence that the prior art would teach an ordinary artisan in the field of indigo dyeing process design to attempt to stabilize any leuco indigo solution for addition directly into the dyebath. The court looked at three factors to determine the outcome of this issue. First, they felt the prior art involving indigo reduction by other methods included all limitations recited by claim 1 of the patent owner's patent. Second, the Court rejected the patent owners assertion that contemporaneous prior art taught away from a combination of prior art and therefore taught away from the claimed process. The court pointed out specifically with respect to this issue that it will not read into a reference “a teaching away from process”, where no such language exists.

Finally, the Court examined if the prior art contained a motivation to combine. The Court noted that that the patent owner misread the court's cases and misdescribed the MST test echoing a 2003 Federal Trade Commission report which claimed that the test was a requirement for "specific and definitive prior art references with clear motivation of how to combine those references". Further, the Court not only dismissed the patent owner's use of the Court's language in both 1999's *In re Dembiczak* and 2000's *Ruiz v. A.B. Chance* to support his position, but went through a thorough examination of its decision in both cases. Interestingly enough, the results in both cases were highly scrutinized by the Supreme Court in the *Teleflex* case, and it seems as though the Federal Court took this opportunity to defend its opinion in each. The court explained that it explicitly stated that "evidence of a motivation to combine need *not* be found in the prior art references themselves, but rather may be found in the "knowledge of one of ordinary skill in the art or...from the nature of the problem to be solved"". The Court further expounds upon the issue by stating that "our suggestion test is in actuality quite flexible" and in reality only requires the use of common sense and common knowledge. The Court continued its defense of the M-S-T test against the criticisms that it is too narrowly tailored by declaring that even implicit motivation to combine exists when "the improvement is technology-independent and the combination of references results in a product or process that is more desirable... because the desire to enhance commercial opportunities by improving a product or process is universal...there exists in these situations a motivation to combine prior references even absent any hint of suggestion in the references themselves."

Using the aforementioned standards as the benchmark, the Court ultimately held that to a person of ordinary skill in the art, it would have been obvious in light of the prior art to stabilize catalytically hydrogenated leuco indigo solution through vacuum conditions and to introduce the solution directly into the dyebath. As such, all claims of the patent owner were invalidated and rendered the alleged issues of anticipation and lack of enablement moot, and the trial court's denial of judgment as a matter of law was reversed.

By: Richard Ito

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