



KSR Summary

TC 3700



Agenda

- Brief Overview of *KSR*
- Example cases



KSR Summary:

- The factual inquiries in *Graham* are still the basis for determining obviousness under 35 U.S.C. 103.
- The Supreme court, in the *KSR* decision, found that the Federal Circuit's Teaching, Suggestion, Motivation (TSM) test improperly transformed the general principles of the obviousness analysis into a rigid rule.
- In view of the guidance provided by the Supreme Court in *KSR*, an examiner must continue to articulate a reason or rationale to support an obviousness rejection.



KSR Summary:

- **The TSM test can be used as a basis for making an obviousness rejection, but examiners should not conclude that an invention is unobvious simply because a rejection based on TSM cannot be made.**
- **Examiners should ensure that the written record includes findings of fact concerning the teachings of the applied references, and when necessary, the general state of the art to support the obviousness rejection being made.**



KSR Summary:

- **One or more of the rationales set forth in the following slides may be relied upon to support a conclusion of obviousness.**
 - Note that the list of rationales provided therein is not intended to be an all-inclusive list.
- **A key to supporting any rejection under 35 U.S.C 103 is the clear articulation of the reasons why the claimed invention would have been obvious.**



KSR Summary:

- **Rationales for arriving at a conclusion of obviousness suggested by the Supreme Court's decision in *KSR* include:**
 - (A) Combining prior art elements according to known methods to yield predictable results;**
 - (B) Simple substitution of one known element for another to obtain predictable results;**
 - (C) Use of known technique to improve similar devices in the same way**



KSR Summary:

- **Rationales for arriving at a conclusion of obviousness suggested by the Supreme Court's decision in *KSR* include:**
 - (D) Applying a known technique to a known device ready for improvement to yield predictable results**
 - (E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success**



KSR Summary:

- **Rationales for arriving at a conclusion of obviousness suggested by the Supreme Court's decision in *KSR* include:**
 - (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;**
 - (G) The TSM test**