

# OBVIOUSNESS IN U.S. PATENT LAW

**Summary** According to 35 U.S.C. 103, a claim may not be allowed if at least one element is altered by the mere substitution of another known in the field, and the combination is not more than a predictable result.

**Law** A patent for a claimed invention may not be obtained ... if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a POSITA to which the claimed invention pertains.

## GRAHAM FACTORS

The framework for determining obviousness is stated in *Graham v. John Deere Co.* The *Graham* factors are factual inquiries for initial assessment of obviousness.



(A) Determining the scope and content of the prior art



(B) Ascertaining differences between the claimed invention and prior art



(C) Resolving the level of ordinary skill in the pertinent art



Secondary considerations of non-obviousness

## SECONDARY CONSIDERATIONS

The examiner must consider objective evidence of non-obviousness, also referred to as "secondary considerations," when properly presented by applicants. See MPEP 716.01(a). Evidence to dispute obviousness includes:



unexpected results



commercial success



long-felt need



failure of others



skepticism of experts



industry praise

## KSR

In *KSR International Co. v. Teleflex Inc.*, SCOTUS reaffirmed the framework for determining obviousness as set forth in the *Graham* factors. See **MPEP 2143** for the 7 *KSR* rationales of obviousness (e.g., combination of elements by known methods to yield predictable results, obvious to try given finite options, TSM).

## TSM

The TSM test is a rationale to determine obviousness. Under the TSM test, a claimed invention is obvious when there is a **teaching, suggestion, or motivation** to combine prior art teachings. TSM may be found in the prior art, the nature of the problem, or the knowledge of POSITA. The Supreme Court in *KSR* cautioned against an overly rigid application of TSM.