

## USPTO Updates Examination Guidelines for Determination of Obviousness

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The U.S. Patent and Trademark Office (USPTO) has issued an update to its obviousness guidelines for examiners, to be used when applying the law of obviousness under 35 U.S.C. § 103 (the Guidelines).

The U.S. Supreme Court decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), placed a renewed emphasis on the factual inquiries of *Graham v. John Deere*, 383 U.S. 1 (1966), and rejected the application of a strict prior teaching-suggestion-motivation test (the TSM test) in determining obviousness under 35 U.S.C. § 103. The recently updated Guidelines recognize that this renewed emphasis on the principles of *Graham* and the abrogation of the strict TSM test have clearly impacted the examination of patent applications, but the Guidelines also suggest that the obviousness inquiry has remained the same, to a significant extent, since the *KSR* decision.

The Guidelines review case law developments on a number of issues that arise when the examiners consider the obviousness of an invention. In particular, the Guidelines review Federal Circuit cases on combining prior art elements, substituting one known element for another, establishing the obvious-to-try rationale, and considering evidence submitted by applicants. The Guidelines also offer a summary table for each cited case, available in the *Federal Register* at <http://edocket.access.gpo.gov/2010/pdf/2010-21646.pdf>.

While the Guidelines do not have the force of law, they will be used by examiners in conjunction with the Manual of Patent Examining Procedure in determining whether or not a claimed invention is obvious.

For practitioners, the USPTO notes in the Guidelines that familiar approaches used to demonstrate nonobviousness still apply, including teaching away from the claimed invention by the prior art, lack of a reasonable expectation of success, and unexpected results.

If you have any questions or would like more information on any of the issues discussed in this LawFlash, please contact any of the following Morgan Lewis attorneys:

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