

NOT SO OBVIOUS AFTER ALL:
KSR AND HINDSIGHT BIAS

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A Brief History

- *Hotchkiss v. Greenwood* (1851)
- *Cuno Eng'g Corp.* (1941)
- Patent Act of 1952: Section 103
- *Graham* (1966)

Combination Patents

The requirement of a synergistic effect:
“an effect greater than the sum of the
several effects taken separately.”

Sakraida (1976)

Secondary Effects were Secondary

“Though doubtless a matter of great convenience, producing a desired result in a cheaper and faster way, and enjoying commercial success, . . . [t]hese desirable benefits ‘without invention will not make patentability.’”

Sakraida (1976)

The Federal Circuit

- Elevation of the Secondary Factors
- Adoption of the TSM test
- Enforcement of the presumption of validity

Rejecting Synergistic Effect

“A requirement that an invention reflect ‘synergism’ or achieve a ‘synergistic result,’ before it may be held patentable appears nowhere in the statute, 35 U.S.C.”

Chore-Time Equipment (Fed.Cir. 1983)

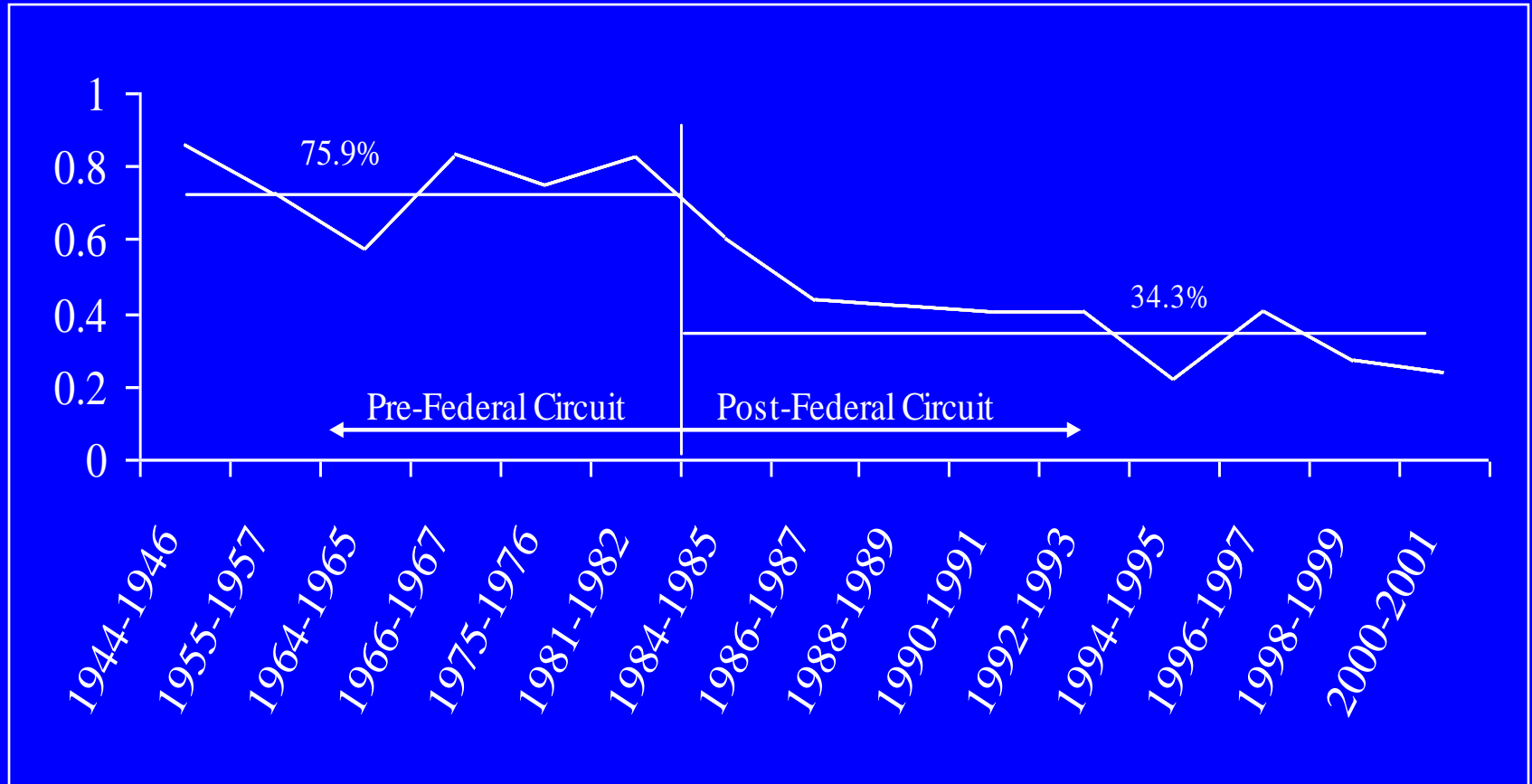
Rejecting Combo Patents

“The reference to a ‘combination patent’ is equally without support in the statute. . . .

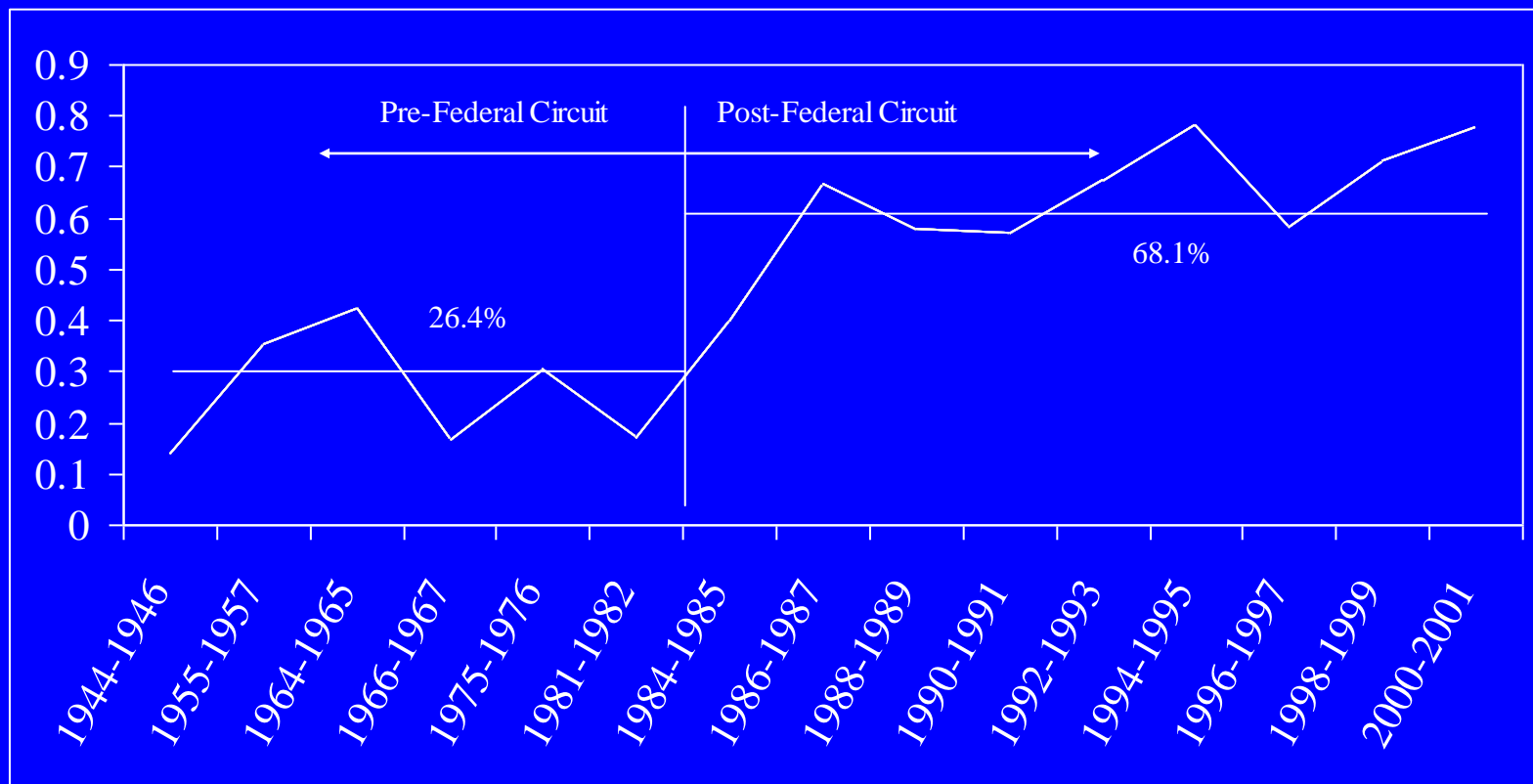
Reference to ‘combination’ patents is, moreover, meaningless. Virtually *all* patents are ‘combination patents,’ if by that label one intends to describe patents having claims to inventions formed of a combination of elements.”

Stratoflex (Fed. Cir. 1983)

Invalidity



Non-Infringement



Change is in the Air

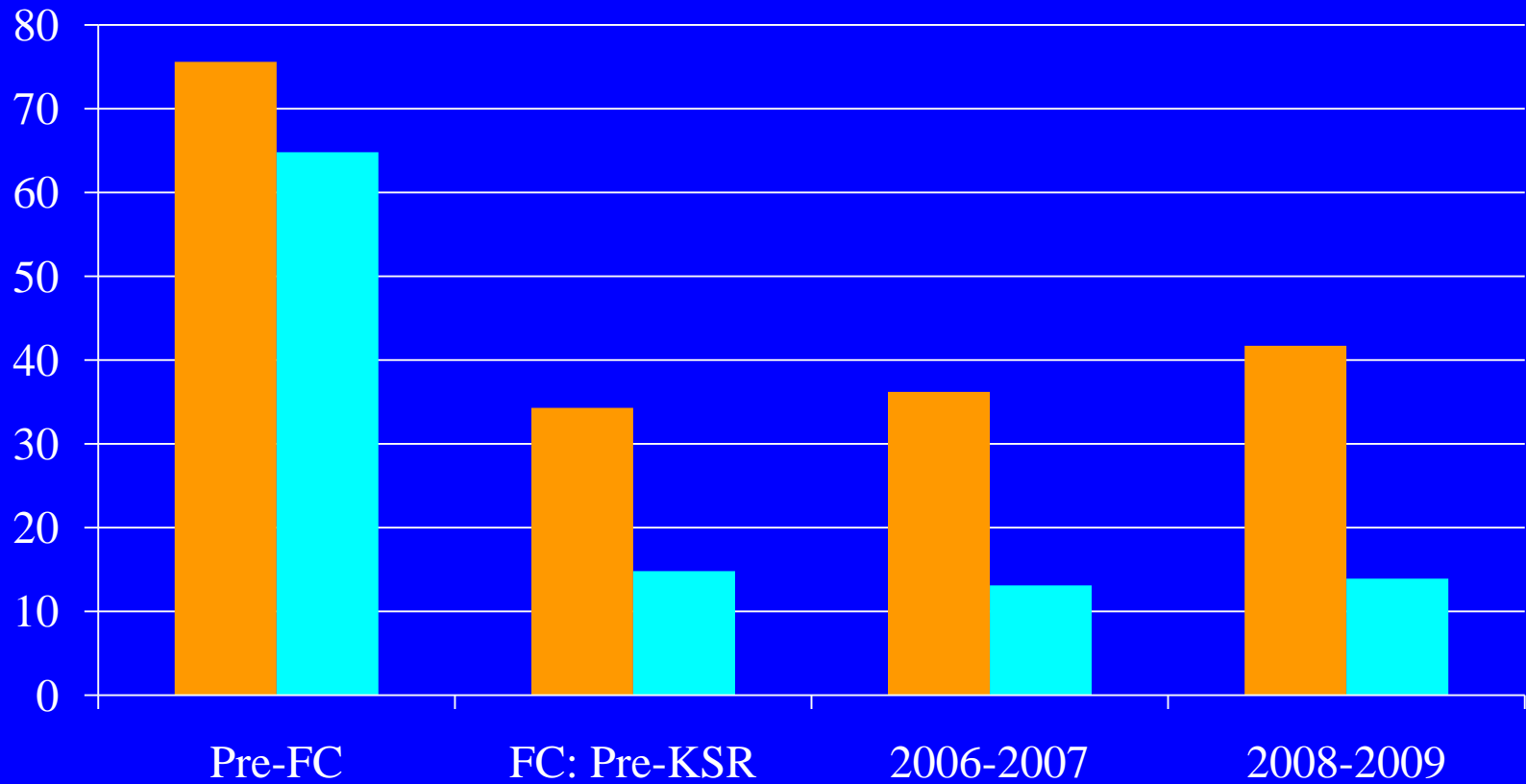
“Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense.”

Dystar Textilfarben v. C.H. Patrick Co. (Fed. Cir. Oct. 2006)

KSR v. Teleflex

- TSM not the exclusive test
- Sources for motivation
- Obvious to try may be obvious

KSR's Impact



Why Obviousness Matters

Invention

Level of Protection

A

0

B

1

C

2

D

3

The Fear of Hindsight

- *Graham*: “If free-flexing is the crucial difference”
- Professor Mandel’s work
 - How to pitch: 24% vs. 71%
 - Salty lure: 23% vs. 54%

The Myth of Hindsight Bias?

- Work with Christian Johnson
- Worries:
 - Survey did not duplicate real-world conditions
 - Denies hindsight's legitimate informational role

Hindsight's Legitimate Informational Role

- An innovation that was trivial or easy for a PHOSITA is obvious.
- An innovation that was sufficiently difficult for a PHOSITA that it would not have been brought forth but for the inducement of a patent is non-obvious.

Duplicate Mandel's Work

- Describe problem to be solved, prior art available, and ask if solution is obvious
- First group are not told whether, and if so how, problem was solved.
- Second group are told how problem was solved.
- Result: 48 percent vs. 70 percent obvious.

Imperfect Hindsight

- Respondents were told that a toothbrush was invented to solve the problem and were then given four possible solutions. Asked if each possible solution was obvious.
- For the “correct” solution, 38 percent found it to be obvious.

Engagement & Imperfect Hindsight

- Respondents were asked to write down their ideas on how to solve the problem based upon the prior art they were given.
- They were then presented with four possible solutions and asked if each would have been obvious.
- 58 percent found the “correct” solution obvious.

Key Results

- Imperfect hindsight yields same obviousness percentage as no hindsight
- Engagement yields same obviousness percentage as perfect hindsight