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ANALOGOUS ART IN THE COURTS AND AT THE USPTO

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Talk Outline

- **Introduction**
  - Doctrinal Background & Analogous Art Hypotheses
- **Data on Analogous Art Doctrine's Prominence**
- **Current Doctrine & Its Tension with KSR**
- **Conclusions**

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Doctrinal Background: Nonobviousness & Analogous Art

- **§103: Nonobviousness Requirement for Patentability**
  - Claimed invention must not have been "obvious before the effective filing date … to a person having ordinary skill in the art to which the claimed invention pertains." 35 U.S.C. §103 (AIA version) (emphasis added).
  - Key gatekeeper for ensuring "substantiality" of patented invention
- **Analogous Art Doctrine**
  - Helps set scope of pertinent prior art for assessing obviousness.
    - To count for purposes of nonobviousness analysis, prior art must be "analogous art."

Loosening of Proof of Obviousness in *KSR v. Teleflex*, 550 U.S. 398 (2007)

- *KSR* rejected a "rigid approach" to nonobviousness analysis.
  - Per the Court, under "the 'teaching, suggestion, or motivation' test (TSM test)," "a patent claim is only proved obvious if 'some motivation or suggestion to combine the prior art teachings' can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art."
  - "[O]ur cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 407, 415 (2007) (emphasis added).

Hypothesis #1: Analogousness of Art Is Not Contested Much of the Time.

- **Sub-Hypotheses**
  - Clearly analogous references might commonly be the most useful/important for assessing nonobviousness.
  - All else equal, patent challengers would presumably prefer to use clearly analogous references.

Hypothesis #2: Analogous Art Doctrine's Prominence Likely Increased after *KSR*.

- **Sub-Hypotheses**
  - Pre-*KSR*: Stringency of TSM test often left relatively little room for separate work by analogous art doctrine.
  - Post-*KSR*: Looser approach to demanding TSM or "reason to combine" could lead to analogous art doctrine having significant, independent force.
    - This could be especially true if analogous art doctrine incorporates inventor-specific subjectivity that *KSR* does not permit after one determines the scope of pertinent art.

Title search: Analogous Art in the Courts and at the USPTO

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