

Obviousness Goes Back to the Future

Mark J. Abate
and
Calvin Wingfield

Goodwin Procter LLP
599 Lexington Avenue
New York, NY 10022

January 2008

Table of Contents

	<u>Page</u>
I.Pre-KSR Supreme Court Cases on Obviousness.....	1
A.Hotchkiss v. Greenwood, 52 U.S. (11 How.) 248 (1851).....	1
B.Great A. & P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950). 1	1
C.Graham v. John Deere Co., 383 U.S. 1 (1966).....	2
D.U.S. v. Adams, 383 U.S. 39 (1966).....	4
E.Anderson’s-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57 (1969).....	5
F.Sakraida v. Ag Pro, Inc., 425 U.S. 273 (1976).....	6
II.KSR Int’l Co. v. Teleflex Inc., --- U.S. ----, 127 S.Ct. 1727 (2007).....	7
II.Post-KSR Federal Circuit Cases on Obviousness.....	11
A.Takeda Chem. Indust., Ltd. v. Alphapharm Pty., Ltd., 492 F.3d 1350 (Fed. Cir. 2007).....	11
B.Syngenta Seeds, Inc. v. Monsanto Co., 231 Fed. App’x. 954 (Fed Cir. 2007)..	12
C.Aventis Pharma. Deutschland GmbH v. Lupin, Ltd., 499 F.3d 1293 (Fed. Cir. 2007).....	12
D.PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342 (Fed. Cir. 2007)	13
E.Daiichi Sankyo Co. v. Apotex, Inc., 501 F.3d 1254, 2007 WL 2615498 (Fed. Cir. 2007).....	15
F.In re Sullivan, 498 F.3d 1345 (Fed. Cir. 2007).....	16
G.Leapfrog Enters., Inc. v. Fisher-Price, Inc., 485 F.3d 1157 (Fed Cir. 2007).....	17
H.In re ICON Health and Fitness, Inc., 496 F.3d 1374 (Fed. Cir. 2007).....	17
I.In re Translogic Tech., Inc., 504 F.3d 1249, 2007 WL 2965979 (Fed. Cir. 2007)	18
J.In re Trans Texas Holding Corp., 498 F.3d 1290 (Fed. Cir. 2007).....	18

III. Post-KSR District Court Cases and Patent Office Guidelines on Obviousness.....19

I. Pre-KSR Supreme Court Cases on Obviousness

A. *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851)

1. The patent was directed to an improvement in making door and other knobs of clay and porcelain. The Court held the patent invalid in view of prior art knobs made of wood.

2. Established general condition of patentability: “[F]or unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilful mechanic, not that of the inventor.” *Id.* at 267.

3. “[T]he novelty consisted in the substitution of the clay knob in the place of one made of metal or wood, as the case might be. And in order to appreciate still more clearly the extent of the novelty claimed, it is proper to add, that this knob of potter's clay is not new, and therefore constitutes no part of the discovery. If it was, a very different question would arise; as it might very well be urged, and successfully urged, that a knob of a new composition of matter, to which this old contrivance had been applied, and which resulted in a new and useful article, was the proper subject of a patent. The novelty would consist in the new composition made practically useful for the purposes of life, by the means and contrivances mentioned. It would be a new manufacture, and none the less so, within the meaning of the patent law, because the means employed to adapt the new composition to a useful purpose was old, or well known. But in the case before us, the knob is not new, nor the metallic shank and spindle, nor the dovetail form of the cavity in the knob, nor the means by which the metallic shank is securely fastened therein. All these were well known, and in common use; and the only thing new is the substitution of a knob of a different material from that heretofore used in connection with this arrangement. Now it may very well be, that, by connecting the clay or porcelain knob with the metallic shank in this well-known mode, an article is produced better and cheaper than in the case of the metallic or wood knob; but this does not result from any new mechanical device or contrivance, but from the fact, that the material of which the knob is composed happens to be better adapted to the purpose for which it is made. The improvement consists in the superiority of the material, and which is not new, over that previously employed in making the knob. But this, of itself, can never be the subject of a patent. No one will pretend that a machine, made, in whole or in part, of materials better adapted to the purpose for which it is used than the materials of which the old one is constructed, and for that reason better and cheaper, can be distinguished from the old one; or, in the sense of the patent law, can entitle the manufacturer to a patent.” *Id.* at 265-66.

B. *Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950)

1. The patent was directed to a cashier's counter equipped with a three-sided frame which moved groceries deposited within the frame to the checking clerk. The lower courts found that all elements of the “invention” were in the prior art, but held the patent not invalid. The Court reversed, holding the patent invalid.

2. “[T]he key to patentability of a mechanical device that brings old factors into cooperation is present or lack of invention.” *Id.* at 150-51.

a. “The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentability invention.” *Id.* at 151.

b. “The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics.” *Id.* at 152.

3. “Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. . . . A patent for combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men.” *Id.* at 152-53.

4. “The Court of Appeals . . . lean[ed] heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability. . . . [E]very element here claimed (except extension of the counter) was known to prior art. When, for the first time, those elements were put to work for the supermarket type of stores, although each performed the same mechanical function for them that it had been known to perform, they produced results more striking, perhaps, than in any previous utilization. To bring these devices together and apply them to save the time of customer and checker was a good idea, but scores of progressive ideas in business are not patentable, and we conclude on the findings below that this one was not.” *Id.* at 153.

C. Graham v. John Deere Co., 383 U.S. 1 (1966)

1. The patents were directed to a plow with a spring clamp used to lessen damage to the plow caused by obstructions in soil. The Fifth Circuit held patent non-obvious and thus not invalid in view of the prior art and the Eighth Circuit held patent invalid. The prior art Glencoe reference contained all of the mechanical elements of the “invention” and disclosed the identical mechanical operation of the “invention”, but in Glencoe the position of some elements in the patent were reversed. The Court held the patents invalid in view of the prior art because person of ordinary skill would understand that there is no mechanical distinction between Glencoe and the patent.

2. Since the Court last addressed patent validity in *Great A. & P. Tea Co.*, Congress had enacted a new standard for patent validity, the “test of obviousness”: “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.” § 103 of the Patent Act of 1952; 35 U.S.C. § 103. *See* 383 U.S. at 3, 13.

a. “*Hotchkiss* has required a comparison between the subject matter of the patent, or patent application, and the background skill of the calling. It has been from this comparison that patentability was in each case determined.” *Id.* at 12.

b. “The first sentence of [§ 103] is strongly reminiscent of the language in *Hotchkiss*. Both formulations place emphasis on the pertinent art existing at the time the invention was made and both are implicitly tied to advances in that art. The major distinction is that Congress has emphasized ‘nonobviousness’ as the operative test of the section, rather than the less definite ‘invention’ language of *Hotchkiss* that Congress thought had led to ‘a large variety’ of expressions in decisions and writings.” *Id.* at 14.

c. “Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented. That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.’ H.R.Rep., supra, at 7; S.Rep., supra, at 6.” *Id.* at 14-15.

d. “Congress intended by the last sentence of §103 to abolish the test it believed this Court announced in the controversial phrase ‘flash of creative genius.’” *Id.* at 15.

3. Established framework for obviousness analysis:

a. “[T]he § 103 condition . . . lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.* at 17-18.

b. Secondary considerations “focus attention on economic and motivational rather than technical issues and are, therefore, more susceptible of judicial treatment than are the highly technical facts often present in patent litigation” and “may also serve to ‘guard against

slipping into the use of hindsight’ and to resist the temptations to read into the prior art the teachings of the invention in issue.” *Id.* at 36.

4. “We find no nonobvious facets in the ‘798 arrangement. The wear and repair claims were sufficient to overcome the patent examiner’s original conclusions as to the validity of the patent. However, some of the prior art, notably Glencoe, was not before him. There the hinge plate is below the shank but, as the courts below found, all of the elements in [the ‘798 patent](#) are present in the Glencoe structure. Furthermore, even though the position of the shank and hinge plate appears reversed in Glencoe, the mechanical operation is identical. The shank there pivots about the underside of the stirrup, which in Glencoe is above the shank. In other words, the stirrup in Glencoe serves exactly the same function as the heel of the hinge plate in ‘798. The mere shifting of the wear point to the heel of the ‘798 hinge plate from the stirrup of Glencoe-itself a part of the hinge plate-presents no operative mechanical distinctions, much less nonobvious differences.” *Id.* at 25-26.

D.U.S. v. Adams, 383 U.S. 39 (1966)

1. The patent was directed to a “wet battery,” which varied from prior art in that it contained water rather than the acids typically used in batteries and its electrodes were magnesium and cuprous chloride rather than zinc and silver chloride. The Court held the patent not invalid in view of the prior art.

2. “The Government concludes that wet batteries comprising a zinc anode and silver chloride cathode are old in the art; and that the prior art shows that magnesium may be substituted for zinc and cuprous chloride for silver chloride. Hence, it argues that the ‘combination of magnesium and cuprous chloride in the Adams battery was not patentable because it represented either no change or an insignificant change as compared the prior battery designs.’ And, despite ‘the fact that, wholly unexpectedly, the battery showed certain valuable operating advantages over other batteries (these advantages) would certainly not justify a patent on the essentially old formula.’” *Id.* at 48.

a. “There are several basic errors in the Government’s position. First, the fact that the Adams battery is water-activated sets his device apart from the prior art.” *Id.* at 48.

b. The Court contrasted the facts in Adams against the facts of a prior case, *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327 (1945), where “the patentee developed rapidly drying printing link.” The Court noted that in *Sinclair* “[a]ll that was needed to produce such an ink was a solvent which evaporated quickly upon heating. Knowing that the boiling point of a solvent is an indication of its rate of evaporation, the patentee merely made selections from a list of solvents and their boiling points. This was no more than ‘selecting the last piece to put into the last opening in a jig-saw puzzle.’ Here, however, the Adams battery is shown to embrace elements having an interdependent functional relationship. It begs the question, and overlooks the holding of the Commissioner and the Court of Claims, to state merely that magnesium and cuprous chloride were individually known battery components. If such a combination is novel, the issue is whether bringing them together as taught by Adams was obvious in the light of the prior art.” *Id.* at 49-50 (citations omitted).

c. “Nor is the Government’s contention that the electrodes of Adams were mere substitutions of pre-existing battery designs supported by the prior art. If the use of magnesium for zinc and cuprous chloride for silver chloride were merely equivalent substitutions, it would follow that the resulting device-Adams’-would have equivalent operating characteristics. But it does not. The court below found, and the Government apparently admits, that the Adams battery ‘wholly unexpectedly’ has shown ‘certain valuable operating advantages over other batteries’ while those from which it is claimed to have been copied were long ago discarded. Moreover, most of the batteries relied upon by the Government were of a completely different type designed to give intermittent power and characterized by an absence of internal action when not in use. Some provided current at voltages which declined fairly proportionately with time. Others were so-called standard cells which, though producing a constant voltage, were of use principally for calibration or measurement purposes. Such cells cannot be used as sources of power. For these reasons we find no equivalency.” *Id.* at 50-51.

3. Held patent non-obvious because:

a. “[T]he operating characteristics of the Adams battery have been shown to have been unexpected and to have far surpassed then-existing wet batteries. Despite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them as did Adams required that a person reasonably skilled in the prior art must ignore that (1) batteries which continued to operate on an open circuit and which heated in normal use were not practical; and (2) water-activated batteries were successful only when combined with electrolytes detrimental to the use of magnesium. These long-accepted factors, when taken together, would, we believe, deter any investigation into such a combination as is used by Adams. This is not to say that one who merely finds new uses for old inventions by shutting his eyes to their prior disadvantages thereby discovers a patentable innovation. We do say, however, that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness.” *Id.* at 714-15.

b. “We have seen that at the time Adams perfected his invention noted experts expressed disbelief in it. Several of the same experts subsequently recognized the significance of the Adams invention, some even patenting improvements on the same system. Furthermore, in a crowded art replete with a century and a half of advancement, the Patent Office found not one reference to cite against the Adams application.” *Id.* at 715.

E. Anderson’s-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57 (1969)

1. The patent was directed to an asphalt paving machine that essentially combined two known components into one machine. The district court held patent invalid and the Court of Appeals reversed. The Court held the patent invalid over the prior art.

2. “Each of the elements combined in the patent was known in the prior art. It is urged that the distinctive feature of the patent was the element of a radiant-heat burner. But it seems to be conceded that the burner, by itself, was not patentable. And so we reach the question whether the combination of the old elements created a valid combination patent.” *Id.* at 59.

3. “The District Court said: ‘All that plaintiff (respondent) has done is to construct four elements known in the prior art on one chassis.’ That is relevant to commercial success, not to invention. The experts tendered by respondent testified that they had been doubtful that radiant heat would solve the problem of the cold joint. But radiant heat was old in the art. The question of invention must turn on whether the combination supplied the key requirement.” *Id.* at 59.

4. “There is uncontested evidence that the presence of the radiant-heat burner in the same machine with the other elements is not critical or essential to the functioning of the radiant-heat burner in curing the problem of the cold joint. For it appears that a radiant-heat burner operating in a tandem fashion would work as well. The combination of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a ‘new or different function,’ within the test of validity of combination patents. A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. It is, however, fervently argued that the combination filled a long felt want and has enjoyed commercial success. But those matters ‘without invention will not make patentability.’” *Id.* at 60.

5. “We conclude that while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented. We conclude further that to those skilled in the art the use of the old elements in combination was not an invention by the obvious-nonobvious standard. Use of the radiant-heat burner in this important field marked a successful venture. But as noted, more than that is needed for invention.” *Id.* at 62-63.

F. Sakraida v. Ag Pro, Inc., 425 U.S. 273 (1976)

1. The patent was directed to a water flush system to remove cow manure from the floor of a dairy barn. The district court held patent invalid “being a combination patent, all of the elements of which are old” and the Court of Appeals reversed. *Id.* at 274. The Court held the patent invalid over the prior art.

2. “The District Court found, and respondent concedes, that none of the 13 elements of the Dairy Establishment combination is new, and many of those elements, including storage of the water in tanks or pools, appear in at least six prior patented systems. The prior art involved spot delivery of water from tanks or pools to the barn floor by means of high pressure hoses or pipes. That system required supplemental hand labor, using tractor blades, shovels, and brooms, and cleaning by these methods took several hours. The only claimed inventive feature of the Dairy Establishment combination of old elements is the provision for abrupt release of the water from the tanks or pools directly onto the barn floor, which causes the flow of a sheet of water that washes all animal waste into drains within minutes and requires no supplemental hand labor. As an expert witness for respondent testified concerning the effect of Dairy Establishment’s combination: ‘(W)ater at the bottom has more friction than this water on the top and it keeps moving ahead and as this water keeps moving ahead we get a rolling action of this water which produced the cleaning action. . . . You do not get this in a hose. . . . (U)nless that

water is continuously directed toward the cleaning area the cleaning action almost ceases instantaneously. . . .” *Id.* at 276-77.

3. “The scope of the prior art was shown by prior patents, prior art publications, affidavits of people having knowledge of prior flush systems analogous to respondent’s, and the testimony of a dairy operator with 22 years of experience who described flush systems he had seen on visits to dairy farms throughout the country. Our independent examination of that evidence persuades us of its sufficiency to support the District Court’s finding ‘as a fact that each and all of the component parts of this patent . . . were old and well-known throughout the dairy industry long prior to the date of the filing of the application for the Gribble patent. . . . What Mr. Gribble referred to . . . as the essence of the patent, to-wit, the manure flush system, was old, various means for flushing manure from dairy barns having been used long before the filing of the application’ Indeed, respondent admitted at trial ‘that the patent is made up of a combination of old elements’ and ‘that all elements are individually old’ Accordingly, the District Court properly followed our admonition in *Great A. & P. Tea Co. v. Supermarket Corp.*, . . . ‘Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. . . . A patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. . . .’” *Id.* at 280-81.

4. “We cannot agree that the combination of these old elements to produce an abrupt release of water directly on the barn floor from storage tanks or pools can properly be characterized as synergistic, that is, ‘result(ing) in an effect greater than the sum of the several effects taken separately.’ Rather, this patent simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations. Such combinations are not patentable under standards appropriate for a combination patent. Under those authorities this assembly of old elements that delivers water directly rather than through pipes or hoses to the barn floor falls under the head of ‘the work of the skilful mechanic, not that of the inventor.’ Exploitation of the principle of gravity adds nothing to the sum of useful knowledge where there is no change in the respective functions of the elements of the combination; this particular use of the assembly of old elements would be obvious to any person skilled in the art of mechanical application.” *Id.* at 282 (citations omitted).

5. “Though doubtless a matter of great convenience, producing a desired result in a cheaper and faster way, and enjoying commercial success, Dairy Establishment ‘did not produce a “new or different function” . . . within the test of validity of combination patents.’ These desirable benefits ‘without invention will not make patentability.’” *Id.* at 282-83 (citations omitted).

II. *KSR Int’l Co. v. Teleflex Inc.*, --- U.S. ----, 127 S.Ct. 1727 (2007)

A. The patent was directed to an adjustable pedal containing a pedal sensor for use in an automobile with a computer-controlled throttle. The district court granted summary judgment of invalidity, holding the patent invalid because it would have been obvious in view of the prior art.

The Federal Circuit reversed because the prior art lacked an explicit teaching, suggestion or motivation (“TSM”) that would lead a person of ordinary skill in the art to combine references. The Court held the patent invalid over the prior art held that *Graham* factors is the test for obviousness, not the TSM test. *Id.* at 1734-35.

B. “We begin by rejecting the rigid approach of the Court of Appeals. Throughout this Court’s engagement with the questions of obviousness, our cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here. To be sure, *Graham* recognized the need for ‘uniformity and definiteness.’ Yet the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*. To this end, *Graham* set forth a broad inquiry and invited courts, where appropriate, to look at any secondary consideration that would prove instructive.” *Id.* at 1739 (citations omitted).

C. “Neither the enactment of § 103 nor the analysis in *Graham* disturbed this Court’s earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art. For over a half century, the Court has held that a ‘patent for a combination which only unites old elements with no change in their respective functions... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.’ This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739 (citations omitted).

1. The Court cited *Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950), *U.S. v. Adams*, 383 U.S. 39 (1966), *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976) as illustrative of “application of this doctrine.”

2. “The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson’s-Black Rock* are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

6. “Following these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should

be made explicit. As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of this challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1740-41 (citations omitted).

D. The TSM test “captured a helpful insight”: “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 1741.

1. Application of the TSM test as a “rigid and mandatory formula[] ... is incompatible with our precedent.” *Id.* at 1741.

7. “There is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis. But when a court transforms the general principle into a rigid rule that limits the obviousness inquiry, as the Court of Appeals did here, it errs.” *Id.* at 1741.

8. *Compare In re Winslow*, 365 F.2d 1017, 1020 (C.C.P.A. 1966) (with respect to combination claims, “We think the proper way to apply the 103 obviousness test to a case like this is to picture the inventor as working in his shop with the prior art references – which he is presumed to know – hanging on the walls around him.”) and *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556 n.3 (Fed. Cir. 1985) (Markey, J.) (“Only God works from nothing. Men must work with old elements.”) (*citing* Markey, *Why Not the Statute?*, 65 JPOS 331 (1983)).

E. “In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103. One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 1741-42.

1. “The first error of the Court of Appeals in this case was to foreclose this reasoning by holding that courts and patent examiners should look only to the problem that patentee was trying to solve. ... Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1741-42.

9. “The second error of the Court of Appeals lay in its assumption that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem ... Common sense teaches, however, that familiar items

may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. ... A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 1742.

10. “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation, but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.” *Id.* at 1742.

11. “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. ... Rigid preventative rules that deny factfinders recourse to common sense, however are neither necessary under our case law nor consistent with it.” *Id.* at 1742-43.

12. “[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.” *Id.* at 1740.

F. “The District Court was correct to conclude that, as of the time Engelgau designed the subject matter in claim 4, it was obvious to a person of ordinary skill to combine Asano with a pivot-mounted pedal position sensor. There then existed a marketplace that created a strong incentive to convert mechanical pedals, to electronic pedals, and the prior art taught a number of methods for achieving this advance. The Court of Appeals considered the issue to narrowly... The proper question to be asked was whether a pedal designer of ordinary skill, facing the wide range of needs created by development in the field of endeavor, would have seen a benefit to upgrading Asano with a sensor. In automotive design, as in many other fields, the interaction of multiple components means that changing one component often requires the other to be modified as well.” *Id.* at 1744.

1. “For a designer starting with Asano, the question was where to attach the sensor. The consequent legal question, then, is whether a pedal designer of ordinary skill starting with Asano would have found it obvious to put the sensor on a fixed pivot point. The prior art discussed above leads us to the conclusion that attaching the sensor where both KSR and Engelgau put it would have been obvious to a person of ordinary skill.” *Id.* at 1744.

13. “Like the District Court, finally, we conclude Teleflex has shown no secondary factors to dislodge the determination that claim 4 is obvious.” *Id.* at 1745.

14. “Where, as here, the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate.” *Id.* at 1745-46.

II. Post-KSR Federal Circuit Cases on Obviousness

A. *Takeda Chem. Indust., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350 (Fed. Cir. 2007)

1. The patent was directed to a Type 2 diabetes drug with fewer unfavorable side effects. The chemical compound that serves as the basis for the claimed invention was known prior to the invention, but was merely “one of hundreds of millions” of compounds disclosed in a prior reference. The district court held the patent not invalid over prior art. The Federal Circuit affirmed.

2. Using TSM for chemical compounds is consistent with the legal principles enunciated in *KSR*: “While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation (‘TSM’) test in an obviousness inquiry . . . the Court indicated that there is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis. As long as the test is not applied as a rigid or mandatory formula, that test can provide helpful hindsight to an obviousness inquiry. Thus, in case involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed invention.” *Id.* at 1356-57.

3. Alphapharm argued the prior art would have led POSITA to choose compound b as lead compound and, upon selecting that compound, it would have been obvious to POSITA to make two chemical changes: homologation, i.e., replacing the methyl group with an ethyl group, and “ring-walking” or moving the ethyl substituent to another position on the ring.

4. POSITA would not have selected compound b as lead compound.

a. Compound b one of “hundreds of millions” disclosed in prior art and one of fifty-four synthesized according to procedures described in patent.

b. Prior art taught away from using compound b. Sodha references identified three specific compounds that were deemed favorable and noted that compound b has negative side effects (“considerable increases in body weight and brown fat weight”).

c. Moreover, two Alphapharm witnesses admitted there was nothing in Sodha reference that would recommend that POSITA choose compound b over other compounds in the article that had the same efficacy rating.

d. Teaching away: “Rather than identify predictable solutions for antidiabetic treatment, the prior art disclosed a broad selection of compounds any one of which could have been selected as a lead compound for further investigation. Significantly, the closest prior art compound (compound b, the 6-methyl) exhibited negative properties that would have directed one of ordinary skill in the art away from that compound.” *Id.* at 1359.

e. Nothing in the prior art suggested making the specific molecular modifications to compound b necessary to achieve claimed compounds.

B.Syngenta Seeds, Inc. v. Monsanto Co., 231 Fed. App'x. 954 (Fed Cir. 2007)

1. The patent was directed to transgenic corn modified to produce an insecticidal protein bacillus thuringiensis (Bt). Specifically, the claimed invention was directed to a transgenic corn plant “wherein the foreign DNA nucleic acid coding sequence has a G+C content of at least 60%.” The jury found the patent invalid as obvious in view of the prior art. The Federal Circuit affirmed.

2. The prior art (Barton patent application) disclosed: (i) a bacterium that produces Bt; (ii) a method for improving Bt expression in plants by selecting codons that are preferred by the native plant; (iii) Bt has a high proportion of codons that are rich in A+T content compared to plants which generally have condons high in G+C content; and (iv) there is probably no need to substitute the entire DNA sequence to increase Bt expression, but substituting the entire DNA sequence to codons preferred by native plant might be expected to increase efficiency of the expression.

3. The court found the jury’s verdict consistent with the evidence and trial testimony, and thus affirmed the judgment. Specifically, there was expert testimony that, in view of Barton, “it would have been obvious to a person of skill in the art to make a Bt gene more closely resemble a corn gene by substituting condons that are rich in G+C for the condons of the native gene that code for the same amino acids.” *Id.* at 957. The jury was here free to credit that testimony and reject the patentees experts that Barton and other prior art taught away from the invention and that the inventor attained unexpected results. *Id.* at 957-959.

C.Aventis Pharma. Deutschland GmbH v. Lupin, Ltd., 499 F.3d 1293 (Fed. Cir. 2007)

1. The patent was directed to pharmaceutical compound ramipril in a “formulation substantially free of other isomers.” The district court held patent not invalid. The Federal Circuit reversed.

2. The active compound in earliest ACE inhibitors, dating back to 1960s, was BPP_{5a}, has six stereocenters, all of which are in the S configuration. 1980 article where Merck scientists explained that the all-S (SSS) stereoisomer of enalapril was found to have 700 times the potency of the SSR stereoisomer. Smith patent disclosed the structure of ramipril. Ramipril has the same overall structure as enalapril, with one distinction: where ramipril has two linked five-sided carbon rings (a “5,5 fused ring system”) on the left side of the molecule, enalapril has only a single ring. The addition of the second ring gives rise to two more stereocenters than are present in enalapril; thus, ramipril has the same three stereocenters as enalapril, plus two new ones that span the fused ring system and are therefore known as “bridgehead” carbons, for a total of five as discussed above. Smith synthesis of a mixture of 5(S)-configuration ramipril and its SSSSR stereoisomer, which mixture came to be known as SCH 31925.

3. “In chemical arts, we have long held that ‘structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a prima facie case of obviousness.’” *Id.* at 1301 (citing *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d

1350, 1356 (Fed. Cir. 2007)). “The ‘reason or motivation’ need not be explicit; it is sufficient to show that the claimed and prior art compounds possess a sufficiently close relationship ... to create an expectation, in light of the totality of the prior art, the new compound will have ‘Similar properties’ to the old.” *Id.* at 1301.

a. “The analysis is similar where, as here, a claimed composition is a purified form of a mixture that existed in the prior art. Such a purified compound is not always *prima facie* obvious over the mixture; for example, it may not be known that the purified compound is present in or an active ingredient of the mixture, or the state of the art may be such that discovering how to perform the purification is an invention of patentable weight in itself. However, if it is known that some desirable property of a mixture derives in whole or in part from a particular one of its components, or if the prior art would provide a person of ordinary skill in the art with reason to believe that this is so, the purified compound is *prima facie* obvious over the mixture even without an explicit teaching that the ingredient should be concentrated or purified.” *Id.* at 1301.

4. The record suggests that when Dr. Smith synthesized SCH 31925, she understood that the 5(S) form of ramipril was the mixture's therapeutically active ingredient. Even if she did not, however, the prior art provides a sufficient reason to look to the 5(S) configuration. Further, the Merck article taught that the SSS configuration of enalapril is 700 times as potent as the SSR form. The close structural analogy between 5(S) and SSSSR ramipril and SSS and SSR enalapril would have led a person of ordinary skill to expect 5(S) and SSSSR ramipril to differ similarly in potency. Moreover, the Smith patent specifically taught that stereoisomers of ramipril can be separated by conventional chromatographic or fractional crystallization methods.

5. Aventis attempts to rebut this *prima facie* case of obviousness by arguing that purified 5(S) ramipril exhibited unexpected results in the form of increased potency. The prior art supporting *prima facie* obviousness included the SCH 31925 mixture, and so Aventis must show that 5(S) ramipril had unexpected results not over all of its stereoisomers, but over that mixture, which did not contain the RRSS form. And the potency of pure 5(S) ramipril is precisely what one would expect, as compared to a mixture containing other, inert or near-inert stereoisomers. Thus, the Federal Circuit held that Aventis failed to show unexpected results that would tend to rebut a *prima facie* case of obviousness.

D. PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342 (Fed. Cir. 2007)

1. The patents are directed to “a process for collecting a newborn infant’s umbilical cord blood at time of birth, testing it for suitability for later use, preserving it through cryopreservation, and infusing it into an adult individual . . . whose hematopoietic stem cells have been destroyed.” *Id.* at 1347. The jury found the patents not invalid in view of the prior art. The district court denied defendants’ motion for JMOL. The Federal Circuit reversed, holding the patents invalid as obvious over the prior art.

2. Defendants argue patents are invalid as obvious based on a combination prior art references. The prior art disclosed: (i) bone marrow transplants can result in hematopoietic

reconstitution; (ii) cord blood, like bone marrow but unlike adult blood, contains large numbers of progenitor cells; (iii) high concentration of primitive progenitor cells in cord blood suggests that in humans, as in mice, the cells responsible for hematopoiesis migrate at about the time of birth from fetal organs to bone marrow; and (iv) cryopreservation and storage of cord blood until need.

3. Federal Circuit agreed with defendants in that the prior art disclosed the elements of the claimed invention. The issue in case is whether the prior art would have given rise to a reasonable expectation of success in creating the claimed inventions. When arguing obviousness based on a combination of prior art references, “the burden falls on the patent challenger to show by clear and convincing evidence that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, and would have had a reasonable expectation of success in doing so.” *Id.* at 1360.

4. “While the inventors may have proved conclusively what was strongly suspected before—that umbilical cord blood is capable of hematopoietic reconstitution—and while their work may have significantly advanced the state of science . . . by eliminating doubt[,] . . . the mouse experiments and the conclusions drawn from them were not inventive in nature. Instead, the inventors merely used routine research methods to prove what was already believed to be the case. Scientific confirmation of what was already believed to be true may be a valuable contribution, but it does not give rise to a patentable invention.” *Id.* at 1363-64.

a. “[O]bviousness does not require absolute predictability of success. Indeed, for many inventions that seems quite obvious, there is no absolute predictability of success until the invention is reduced to practice.” *Id.* at 1364 (*quoting In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988)).

b. “An invention would not be invalid for obviousness if the inventor would have been motivated to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. Likewise, an invention would not be deemed obvious if all that was suggested ‘was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.’” *Id.* at 1364.

c. “The prior art suggested cryopreserving cord blood from a single infant and transplanting that blood into a patient to achieve hematopoietic reconstitution. PharmaStem does not suggest, and Dr. Bernstein’s testimony did not reveal, that there was an array of possible choices as to how to achieve that objective or that there were problems to be solved in implementing the prior art suggestion that were not adumbrated in the prior art. To the contrary, the joint specification indicates that each step of the cryopreservation and transplantation procedure had been spelled out in the prior art. PharmaStem does not claim that there was anything novel about the method by which it proposed to collect, cryopreserve, and transplant the cord blood.” *Id.* at 1364.

5. Federal Circuit reject PharmaStem's arguments regarding secondary considerations of nonobviousness.

a. PharmaStem argued the inventors were widely recognized as pioneers in the use of cord blood for hematopoietic reconstitution, including statements by the defendants and their representatives. The Federal Circuit stated there was no nexus between praise and inventive contribution of inventors, as opposed to their proofs, through lab work, that fetal blood contains large numbers of stem cells.

b. PharmaStem argued unexpected results. The Federal Circuit stated that the "surprise" was tied to the success of the human transplant, not to the results reported in the patents because the prior art already noted that stems were likely to be a valuable source of hematopoietic stem cells.

6. Dissent by Judge Newman.

a. The panel majority obviousness determination improperly utilizes hindsight: "The ultimate solution of a previously intractable problem can indeed appear to become apparent in hindsight after the final successful step is taken." *Id.* at 1374.

b. "Although my colleagues manage to reconstruct this extensive scientific effort as simple routine that is obvious to judges, the process of discovery in complex science make it particularly necessary to view the achievement in the context of the knowledge at the time the invention was made, and to judge it as it was judged by scientific peers at that time, with the assistance of the hard fact of commercial success in a field in which the need was great and success had long been eluded." *Id.* at 1367-68.

c. The majority "scours the prior art for clues that could fit the eventual achievement, and then rules that the achievement was obvious, no matter that it eluded the others whose work is now compiled by this court so as to invalidate the patents." *Id.* at 1368.

E. Daiichi Sankyo Co. v. Apotex, Inc., 501 F.3d 1254, 2007 WL 2615498 (Fed. Cir. 2007)

1. The patent was directed to a method for treating bacterial ear infections by topically administering the antibiotic ofloxacin into the ear. The district court held patent not invalid. The Federal Circuit reversed.

2. The issue in this case was the appropriate level of a person of ordinary skill in the art. The district court held a person of ordinary skill in the art to be "a pediatrician or general practitioner—those doctors who are often the 'first line of defense' in treating ear infections and who, by virtue of their medical training, possess basic pharmacological knowledge." Apotex argued that a person of ordinary skill in the art to be "a person engaged in developing new pharmaceuticals, formulations and treatment methods, or a specialist in ear treatments such as an otologist, otolaryngologist, or otorhinolaryngologist who also has training in pharmaceutical formulations."

3. “Factors that may be considered in determining level of ordinary skill in the art include: (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Id.* at 1256.

4. The Federal Circuit held that a person of ordinary skill in the art is a person engaged in developing pharmaceutical formulations and treatment methods for the ear or a specialist in ear treatments such as an otologist, otolaryngologist, or otorhinolaryngologist who also has training in pharmaceutical formulations because (1) the inventors were specialists in drug and ear treatments, not general practitioners or pediatricians and (2) the problem the inventors were trying to solve was to create a topical antibiotic compound – something pediatricians do not get involved with. *Id.* at 1257.

5. Trial testimony suggests that a person of ordinary skill in the art would have understood the relevance of the Ganz article which disclosed the successful use of ear drops containing ciprofloxacin to treat middle ear infections; ciprofloxacin, a gyrase inhibitor, was not subject to the drawbacks normally associated with local treatment of the ear with antibiotics, such as ototoxicity. Accordingly, in view of Ganz reference, it would have been obvious for a person of ordinary skill in the art to use ofloxacin, a gyrase inhibitor like ciprofloxacin, in ear drops to topically treat ear infections.

F. In re Sullivan, 498 F.3d 1345 (Fed. Cir. 2007)

1. The claimed invention is directed to an antivenom composition used to treat venomous bites from a rattlesnake. The Examiner rejected the claims as obvious over two prior art references. The Board affirmed the Examiner’s rejection. The Federal Circuit vacated the Board’s decision and remanded to the Board for consideration of rebuttal evidence presented by Applicant.

2. Sullivan teaches whole antibodies purified from horse serum for use against venom from rattlesnakes, but fails to teach the use of Fab fragments. Coulter discloses a method for producing Fab fragments in place of whole antibodies and collecting Fab fragments in a phosphate buffered saline which is a pharmaceutically acceptable carrier. The Federal Circuit stated “[i]t was not unreasonable for one skilled in the art of snake venom to consider that a Fab fragment of a whole antibody that neutralizes one type of venom might be used to neutralize the venom of another species.”

3. “It is well settled that the PTO ‘bears the initial burden of presenting a prima facie case of unpatentability.... However, when a prima facie case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability.’ Rebuttal evidence is “merely a showing of facts supporting the opposite conclusion.” Evidence rebutting a prima facie case of obviousness can include:

a. ‘evidence of unexpected results,’

b.evidence “that the prior art teaches away from the claimed invention in any material respect,” and

c.evidence of secondary considerations, such as commercial success and long-felt but unresolved needs.” *Id.* at 1351 (citations omitted).

4. When a patent applicant puts forth rebuttal evidence, the Board must consider that evidence. *See id.* at 1352. Applicant submitted declarations which purport to show an unexpected result from use of the claimed composition, how the prior art taught away from the composition, and how a long-felt need existed for a new antivenom composition. The court held the Board did not consider or review the declarations in any meaningful way, and thus remanded for the Board to consider the declarations.

G. Leapfrog Enters., Inc. v. Fisher-Price, Inc., 485 F.3d 1157 (Fed Cir. 2007)

1. The patent was directed to an interactive learning device to help children learn to read. The prior art before the court was the Bevan patent and Texas Instruments SRR. The Bevan patent disclosed an: electro-mechanical learning toy which, in pertinent part, comprises a housing with a phonograph record that plays sounds associated with puzzle pieces when the puzzle pieces are depressed. The Texas Instruments SRR disclosed an: electronic learning toy that allows for the insertion of a book into a device; when a user presses certain areas of the book’s pages, the sounds of the letters in the words are played together; did not include a reader that allowed the device to automatically detect the inserted book. The district court held the patent invalid. The Federal Circuit affirmed.

2. The Federal Circuit held the patented combination invalid as an adaptation of an old idea using newer technology that is commonly available and understood in the art: “[a]pplying modern electronics to older mechanical devices has been commonplace in recent years.” *Id.* at 1161. Leapfrog’s evidence of secondary considerations was inadequate to overcome the prima facie case of obviousness.

H. In re ICON Health and Fitness, Inc., 496 F.3d 1374 (Fed. Cir. 2007)

1. The patent was directed to a folding treadmill with spring to assist in stably remaining said tread base. The Patent Appeals Board found patent invalid over prior art. The Federal Circuit affirmed.

2. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *Id.* at 1379-80 (citing *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992))

3.. The relevant prior art included: Damark treadmill (disclosed all elements except gas spring); and Teague (dual-action spring used in Murphy bed having a counterbalancing mechanism intended to support the weight of the bed as it opens and closes).

4. Because the spring in Teague is directed to the same purpose of the spring in the claimed invention, the court found a person of ordinary skill in the art would naturally look to Damark and Teague and find a reason to combine them.

I. In re Translogic Tech., Inc., 504 F.3d 1249, 2007 WL 2965979 (Fed. Cir. 2007)

1. The patent was directed to a multiplexer that couples together multiple stages of 2:1 multiplexers in series. The relevant prior art was the Gorai and Weste references. Gorai discloses three-stage multiplexer circuit with four inputs and three control inputs, but does not disclose use of TGMs for each multiplexer stage. Weste discloses 2:1 TGM circuit to transfer a logic 0 or a logic 1 between the input and output. The Patent Appeals Board found patent invalid over prior art. The Federal Circuit affirmed.

2. “[O]bvious variants of prior art references are themselves part of the public domain. *Id.* at 1259. A person of ordinary skill in the art would have a thorough understanding of electrical switching systems and knowledge of actual electrical implementations of multiplexers such as the TGMs in Weste. TGMs were well known multiplexer circuits at time of invention.

J. In re Trans Texas Holding Corp., 498 F.3d 1290 (Fed. Cir. 2007)

1. The claimed inventions were directed to a system of inflation-adjusted deposit and loan accounts which purports to insulate the value of assets from inflationary fluctuations. The Examiner rejected the claims as obvious over the prior art. The Board affirmed the Examiner’s rejections. The Federal Circuit affirmed.

2. Mukherjee article discusses the decision of banks in Finland in the 1950s to adjust both their loans and deposits for inflation, on the basis of quarterly inspections of the cost-of-living index. Among other accounts, it describes “A” deposit accounts, which provided “100 per cent index compensation” for every one percent increase in the cost of living index. That is, for every one percent increase in the cost of living index, the capital was increased by one percent. Mukherjee also discloses that banks charged an inflation-adjusted “surcharge” on their loans in order to provide the funds needed for fully inflation-adjusted deposit accounts. It notes that “[t]he amount of the surcharge was usually fixed according to the proportion of the bank’s deposits benefiting by index adjustment, so that the bank could just balance its commitments.” However, Mukherjee does not contain an explicit recitation of the data-processor for account management. Musmanno patent demonstrates that it was notoriously well-known to employ

data-processors to manage plural accounts. Bodie article describes a “purchasing power annuity” linked to consumer price levels. Weiner discloses loans where the interest is repaid monthly and the principal in a lump sum.

3. Applicant argued that the elements of the claimed inventions were not disclosed in the prior art. The Federal Circuit agreed with the Board’s finding that the prior art disclosed all the elements of the claimed invention and that it would have been obvious to combine the known inflation-adjusted loan accounts of Mukherjee with the other prior art references.

III. Post-KSR District Court Cases and Patent Office Guidelines on Obviousness

A. *Warner Mfg. Co. v. Armstrong*, No. 05-CV-0612 PJS/JJG, slip op., 2207 WL 3521249 (D. Minn. Nov. 15, 2007)

B. *Panoptx Inc. v. Protective Optics Inc.*, No. C 06-7610 MHP, slip op., 2007 WL 3344453 (N.D. Cal. Nov. 9, 2007).

C. *Apple Computer, Inc. v. Burst.com, Inc.*, No. C 06-0019 MHP, slip op., 2007 WL 3342829 (N.D. Cal. Nov. 8, 2007).

D. *Bayer AG v. Dr. Reddy’s Labs., Ltd.*, --- F. Supp. 2d ----, 2007 WL 3120794 (D. Del. 2007)

E. *Eaton Corp. v. ZF Meritor LLC*, No. 03-74844, slip op., 2007 WL 2901692 (E.D. Mich. Oct. 4, 2007)

F. *Eaton Corp. v. ZF Meritor LLC*, No. 03-74844, slip op., 2007 WL 2822775 (E.D. Mich. Sept. 26, 2007)

G. *Levenger Co. v. Feldman*, --- F. Supp 2d ----, 2007 WL 2781062 (S.D. Fla. 2007)

H. *Sud-Chemie, Inc. v. Multisorb Techs., Inc.*, No. 3:03CV-29-S, slip op., 2007 WL 2669366 (W.D. Ky Sept. 7, 2007)

I. *PBI Performance Prods., Inc. v. NorFab Corp.*, --- F. Supp 2d ----, 2007 WL 2464507 (E.D. Pa. 2007)

J. *Foldfast, Inc. v. HSN, L.P.*, 504 F. Supp 2d 1313 (S.D. Fla. 2007)

K. *Asyst Techs., Inc. v. Empak, Inc.*, No. C 98-20451 JF (EAI), slip op., 2007 WL 2255220 (N.D. Cal. Aug. 3, 2007)

L. *Andersen Corp. v. Pella Corp.*, 500 F. Supp 2d 1192 (D. Minn. 2007)

M. *Friskit, Inc. v. RealNetworks, Inc.*, 499 F. Supp 2d 1145 (N.D. Cal. 2007)

N. *McNeil-PPC, Inc. v. Perrigo Co.*, --- F. Supp 2d ----, 2007 WL 1933931 (S.D.N.Y. 2007)

O. *Single Chip Sys. Corp. v. Intermec IP Corp.*, 495 F. Supp 2d 1066 (S.D. Cal. 2007)

P. Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526-35.