## *KSR:* Filling Holes in Prosecution History

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U.S. v. Adams, 383 U.S. 39, 52 (1966), holds that unexpected results may be used to overcome evidence of obviousness. But unexpected results that are not urged before the Patent and Trademark Office (PTO) may carry no weight with the courts. Indeed, the companion case, Graham v. John Deere, 383 U.S. 1, refuses to consider an advantage over close prior art because "Graham did not urge before the Patent Office the greater 'flexing' qualities… which he so heavily relied on in the courts." *Id.* at 23.

A related problem is presented in KSR Intern. Co. v. Teleflex Inc., 127 S.Ct. 1727, 1745 (2007), which states, "We need not reach the question whether the failure to disclose Asano during the prosecution of Engelgau voids the presumption of validity given to issued patents, for claim 4 is obvious despite the presumption. We nevertheless think it appropriate to note that the rationale underlying the presumption — that the PTO, in its expertise, has approved the claim — seems much diminished here."

Thus, that Court presumably endorses the district court's finding, despite arguments challenging its relevance, "that if Asano had been cited to the Examiner, he would have found the combination of Asano and Smith to be obvious, just as he found [another combination] to be obvious." Teleflex Inc. v. KSR Intern. Co., 298 F.Supp.2d 581, 595 (E.D.Mich. 2003).

The Circuit opinion finds, "where the factual bases of an examiner's decision to allow a claim have been undermined — as in other cases where prior art not before the examiner is brought to light during litigation — a court's responsibility is not to speculate what a particular examiner would or would not have done…, but rather to assess independently the validity of the claim…. Such determination must take into account the

statutory presumption of patent validity." Teleflex, Inc. v. KSR Intern. Co., 119 Fed.Appx. 282, 289 (Fed. Cir. 2005) (nonprecedential, quoting Torpharm Inc. v. Ranbaxy Pharms., Inc., 336 F.3d 1322, 1329-30 (Fed. Cir. 2003)).

The United States, as amicus, supported the ultimate rejection of that view, writing, "the prior art — specifically the Asano patent, which respondents had not provided to the PTO — revealed the placement of a mechanical throttle control on an adjustable gas pedal assembly's support bracket. …. The district court correctly concluded a person having ordinary skill — in this case, a mechanical engineer familiar with pedal assembly design and presumed to know the prior art — would have recognized the advantage of incorporating an electronic sensor into Asano's adjustable gas pedal assembly and placing the electronic sensor at the very same location as the mechanical linkage." 2006 WL 2453601, at *28-29.

The government therein acknowledges Asano as a patent but fails to mention that it is a *U.S.* patent. Whether Teleflex was aware of it prior to filing is unclear, but Asano was clearly available to the examiner(s) who presumably had the level of skill flagged in the government's brief. If it was relevant, it should have been found, cited, and applied; *see, e.g.,* the Manual of Patent Examining Procedure 2141.01(a) (8th Ed. 2001, rev'd Aug. 2006) (Analogous and Nonanalogous Art). Yet neither that brief nor any of three court opinions references those duties, much less considers that they may have been fulfilled.

As quoted above, the Supreme Court, 127 S. Ct. at 1745, finds failure to cite Asano as diminishing the presumption of validity but nevertheless credits the examiner's expertise . A diminished presumption would also be appropriate if, instead of positing expertise, one were to posit incompetence.

Is it not equally plausible that a suitably skilled examiner, presumably aware of

Asano, could find it irrelevant — perhaps for reasons advanced by Teleflex but rejected in litigation? Had such a view been documented, courts could, of course, conclude otherwise but not easily.

Where things stood, "Nothing in the declarations proffered by Teleflex prevented the District Court from reaching the careful conclusions underlying its order for summary judgment in this case." 127 S.Ct. at 1746. Had the examiner documented a contrary conclusion, it would have been more difficult, if not impossible, to find summary judgment appropriate.

The question is: How can others avoid being in the same unpleasant situation? The most effective way is to be aware of the prior art at the time of filing, to anticipate arguments that allowed KSR to prevail, and to rebut them in the specification. Failing to do diminishes the capacity to overcome prior art — and may foreclose it as in *Graham,*383 U.S. at 23 (quoted above).

When Teleflex became aware of Asano is unclear, but many firms do not search prior to filing. Some are apparently motivated by a belief that knowledge of prior art increases the risk of willful infringement. How well grounded such beliefs are is also unclear, but the risks may have been reduced in In re Seagate Technology, LLC, 497 F.3d 1360 (Fed. Cir. 2007) (en banc). That particular basis for finding willful infringement did not arise, however. In any event, those concerned about willful infringement should weigh carefully that concern against the risk of invalidity resulting from failure to find and distinguish prior art during prosecution.

Possibly aside from firms, relatively unconcerned about invalidity, that file multiple patents for defensive purposes only, all who file must heed the lessons of *KSR.* That seems especially compelling for non-practicing entities that need not worry about possible infringement. With only expenses to consider, when the costs of distinguishing

prior art are seen to outweigh the risk of invalidity, their main question might be: Why file at all?

[I appreciate the reactions of Thomas G. Field III, Intellectual Property Counsel, Saint-Gobain, to an earlier draft, but nothing said here should be attributed to him.]