

GREER, BURNS & CRAIN, LTD.

An intellectual property law firm

**Examination Guidelines for Determining Obviousness under
35 U.S.C. Section 103 in view of the Supreme Court decision
in *KSR International Co. v. Teleflex Inc.***

Patrick G. Burns

**Amicus Curiae, No. 04-1350, Supreme Court of the United States
October 2006**

Patents, copyright, trademark, trade secret, unfair competition and related areas of the law

300 South Wacker Drive | Chicago, Illinois 60606 | T 312 360 0080 | F 312 360 9315 | mail@gbclaw.net

**Examination Guidelines for Determining
Obviousness Under 35 U.S.C. Section 103
in View of the Supreme Court Decision in
*KSR International Co. v. Teleflex Inc.***

- **When formulating an obviousness rejection, an examiner should expect that a person of ordinary skill in the art will exercise ordinary creativity, common sense and logic.**
- **Examiners should ensure that the written record includes findings of fact concerning the teaching of the applied references and when necessary, the general state of the art.**

- **Office personnel may rely on their own technical expertise to describe the knowledge and skills of a person of ordinary skill in the art.**
- **The TSM test can be used as a basis for making an obviousness rejection, but examiners should not conclude that an invention is unobvious simply because a rejection based on TSM cannot be made.**
- **Rationales for arriving at a conclusion of obviousness suggested by the Supreme Court's decision in *KSR* include:**
 - A. Combining prior art elements according to known methods to yield predictable results (see III.A. of the guidelines).**
 - B. Simple substitution of one known element for another to obtain predictable results (see III.B. of the guidelines).**

- C. Use of known technique to improve similar devices in the same way (see III.C. of the guidelines).**
- D. Applying a known technique to a known device ready for improvement to yield predictable results (see III.D. of the guidelines).**
- E. “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success (see III.E. of the guidelines).**
- F. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.**