

Commentators on *KSR* are all over the map. In just one article, Tony Mauro, *Supreme Court Adopts New Standard on Patent Litigation*, Legal Times (May 1, 2007), both reports on his post-decision interview with the Chief Judge of the Federal Circuit as well as providing seemingly opposite spectrum quotations from commentators. Co-counsel for *KSR* and former Supreme Court Clerk Ken Bass is quoted as saying that *KSR* leaves patent litigation in a state of total disarray," while Stephen B. Maebius said that the Court "*wanted to avoid a radical upsetting of the apple cart.*"

An Expected Reversal, Ever Since Grant of *Certiorari*: In fact, as early as 2004, when the *certiorari* petition was first reviewed by the patent community in this petition involving a once obscure non-precedential opinion it was clear that claimed combination of an old gas pedal with an old electronic engine was unpatentable no matter whether a strict or lenient standard of patentability was applied. The only mystery as to the outcome was whether the Court would grant *certiorari*.

(It would have been truly astounding for the Court to have *affirmed* a holding of § 103 nonobviousness on the merits in an appeal from a Circuit Court, something the Court the Court has *never* done in the entire history of this section of the statute . Exceptionally, a validity ruling by the Court of Claims was affirmed in *U. S. v. Adams*, 383 U.S. 39 (1966).)

An Aberrant Lower Court Test for Obviousness: Insofar as the test for obviousness is concerned, more than a year ago the mainstream Federal Circuit view had *sub silentio* repudiated any rigid *explicit* TSM (teaching-suggestion-motivation) requirement as there has always been an *implicit* motivation test that is consistent with Supreme Court case law. *See In re Kahn*, 441 F.3d 977, 985-88 (Fed. Cir. 2006) (Linn, J.). In reversing *KSR*, the Court expressly noted and quoted with approval from *Kahn*: "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". *KSR* (quoting *Kahn*, 441 F.3d at 988). Quite clearly, whether the test of obviousness as in *Kahn* or *KSR* is utilized, the gas pedal patent in controversy fails to pass muster.

The Legal Times Interview with the Chief Judge of the Federal

Circuit: The moderate tenor of the Supreme Court's opinion is in sharp contrast to the extremely harsh criticism voiced by several justices at the argument last November as accurately portrayed in the article. Indeed, the article notes that [t]he criticism at oral argument was so pointed in November that Federal Circuit Chief Judge Paul Michel defended his court publicly in comments to *Legal Times*.

Once again speaking to the press [o]n Monday, following the ruling, [Chief Judge] Michel sa[id], It is extremely helpful to have a single opinion [from the Court.] I'm very happy to have that; it will make it very much easier to apply. Michel added that under his reading of the opinion, the teaching, suggestion or motivation test remains part of the calculation of obviousness, but it gives us forceful instruction on the manner in which the test is to be applied.

The Court's Pointed Reference to *DyStar*: Genesis for much of the criticism aimed at the Federal Circuit at the oral argument last November may be traced to the argument-eve opinion of the Court that elaborated on an evolved TSM test in *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356 (Fed. Cir. 2006)(Michel, C.J.). The Court in *KSR*, citing precedent including *DyStar*, 464 F.3d at 1367, noted that this argumentative defense of the Federal Circuit obviously was responsive to the pending *KSR* case: ?We note the Court of Appeals has since [grant of review in *KSR*] elaborated a broader conception of the TSM test than was applied in the instant matter. After citing *DyStar*, the expressly Court refused to dignify *DyStar* with any merits discussion: *DyStar*, of course, [is] not now before us and do[es] not correct the errors of law made by the Court of Appeals in this case. The extent to which [it] may describe an analysis more consistent with our earlier precedents and our decision here is a matter for the Court of Appeals to consider in its future cases. What we hold is that the fundamental misunderstandings identified above led the Court of Appeals in this case to apply a test inconsistent with our patent law decisions.

DyStar also represents a precedential nullity as a junior panel opinion to any earlier precedent unless that prior precedent is overruled *en banc*. (Not only was *DyStar* a panel opinion, but the majority opinion spoke for only two members of the Court. The third member of the panel, the author of the *KSR* opinion below, concurred in the result only.)

To be sure, the *Kahn* opinion *could also have* been classified by the Court along with *Dystar* as not now before us, but *Kahn* was an exposition of existing case law that the Court obviously chose to embrace, even expressly quoting from that case with approval.

En Banc Reconsideration of Precedent: *KSR* and the concurrently decided *Microsoft* cases require the *en banc* attention of the Court to address several of its precedents. One case law doctrine on shaky (at best) ground as a result of *KSR* is the virtually per se patentability standard for new biotechnology entities of *In re Deuel*, 51 F.3d 1552 (Fed.Cir.1995)(Lourie, J.) which had already been the subject of extreme controversy, *In re Fisher*, 421 F.3d 1365, 1381-82 (Fed. Cir. 2005)(Rader, J., dissenting); *Deuel* is expressly criticized in *KSR* (on other grounds). As a result of *Microsoft*, the court surely must reexamine its failure to give *en banc* reconsideration to the scope of 35 USC § 271(f) as per *Union Carbide Chemicals & Plastics Tech. Corp. v. Shell Oil Co.*, 434 F.3d 1357, 1358-59 (Fed. Cir. 2006)(Lourie, J., joined by Michel, J., Linn, J., dissenting from denial *en banc*)(criticizing panel holding that §271(f) governs method/process inventions,? 425 F.3d 1366, 1380 (2005)).

Patent piñatas, Targets for *Certiorari* Grant: The philosophy has been expressed that the grant of *certiorari* in patent cases is a good thing in that it shows patents to be important to society. Yet, to the extent that the existence of ripe piñata targets of *certiorari* opportunity with obvious flaws exist, it could more readily be said that some situations such as *KSR* and *Microsoft* represent needless opportunities to show the patent system in a bad light. The list of piñatas now includes the remarkable *Voda v. Cordis* as the latest addition.

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