HISTORIAN'S CORNER

"As Time Goes By - Obviousness under the Judicial Microscope"

by Dale Carlson

As our eighty-fifth annual Waldorf-Astoria dinner in honor of the Federal Judiciary approaches, we have an opportunity to reflect on statements made a decade ago, at the seventy-fifth dinner, by two distinguished federal judges. Those statements appear to have a bearing on the current battle being waged between KSR and Teleflex in the Supreme Court over the proper methodology for determining obviousness of a claimed invention.

Back at the time of our seventy-fifth gathering, Marty Goldstein was our Association's President. Marty had the vision, and what he would have been the first to admit as the plain good fortune, to have both Judge Giles Rich and Judge William Conner as speakers before the crowd gathered in the Grand Ballroom that night. Both of those judges are past Presidents of our Association.

When Judge Rich took the podium, he recalled his fond memories of some forty NYIPLA gatherings at the Waldorf, including the gathering at which Judge Learned Hand spoke. He also recalled his contributions to the development of patent law of which he was most proud. Notably, he pointed to his drafting of the statute on nonobviousness embodied in Section 103 of the 1952 Patent Act.

Judge Rich observed that, prior to Section 103's implementation, there existed only "vague and undefinable judge-made law requiring the presence of 'invention'. In other words, to be patentable, an invention had to be an 'invention,' a rather difficult bit of law to administer."

Judge Rich credited our Association's Committee on Patent Law and Practice, of which he was a member at the time, with conceiving replacing the requirement for "invention" with a specific nonobviousness provision not present in the judge-made requirement. He praised our Association's Past President Henry Ashton as being "the king-pin in organizing, chairing and managing the bar's participation in the drafting of the new Patent Act...".

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When Judge Conner took the podium, he posed a keen rhetorical question: "Can you think of any other instance in legal history where one of the authors of a statute later interprets and applies it, as a judge of a court having exclusive jurisdiction of appeals in all cases involving the statute?" Doubtless the answer is "no".

What does this mean as far as the current controversy relating to the obviousness standard is concerned? It means that a drafter of the obviousness standard played a key role in construing it during decades on the bench of the Federal Circuit and its predecessor court, the CCPA.

This sequential legislative and judicial role, performed by a single individual during the course of his career, is particularly significant when one considers that the Patent Act has no true "legislative history" to turn to. The reason is that the Act passed through Congress by means of a "consent calendar" without debate on the floors of Congress. For some semblance of a legislative history, one can turn to the "Reviser's Notes" about the legislation, prepared retrospectively by the Patent Office's Pat Federico in collaboration with Judge Rich.

In KSR v. Teleflex, the Supreme Court is now weighing what role, if any, the Federal Circuit's "teaching, suggestion or motivation" test (the so-called TSM test) should have in an obviousness determination. In a well-reasoned Amicus Brief filed in that case, our Association asserted that the TSM test plays a key role in lending certainty and predictability to the construction of the obviousness standard. Lacking that objectivity, there is an increased risk of hindsight analysis based on a knowledge of the subject invention.

One can hope that the Supreme Court carefully considers our Association's position. One can also hope that the justices carefully consider the contributions of Judge Rich to the development of the TSM test, and the special significance of those contributions in light of the expertise he brought to the bench as co-author of the underlying statute being construed. We should know for sure the view of the high court by the time of our eighty-fifth Waldorf gathering. Hope to see you there!