

## Post-KSR Treatment of “Problems” in the *Background of the Invention*\*

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### I. OVERVIEW

*KSR*<sup>1</sup> warrants reconsideration of the still too common practice of patent draftsmanship where applicants recite “problems” that their invention solves as part of the *Background of the Invention*.

Patent applicants all too often – and unnecessarily – create sophisticated “problems” that are identified in the specification; they identify these problems as facing workers skilled in the art. The “problems” are solved by the invention. Yet, given the “ordinary creativity” of the post-*KSR* worker in the art, perhaps the problem is then one that can be solved, making the invention obvious. See § II-A, *The “Known Problem” as Fatal to Patent Validity*. Often, the applicant cleverly develops a problem that *he* faced that is *different* from any problem suggested by the prior art. Yet, the Court crafts an objective test of obviousness that minimizes the value of the applicant’s subjective problem. See § II-B, *The Applicant’s Subjective Problem is not Controlling*.

What creates a special and immediate challenge for patent application draftsmanship is the *KSR* linkage between a “problem” that is be solved by the patentee and the common sense of a worker skilled in the art who is motivated by the problem to seek out an “obvious to try” solution. See § III, *“Obvious to Try” to Solve the “Problem”*.

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\*Draft dated June 14, 2007. Section III of this paper, “*Obvious to Try*” to Solve the “*Problem*”, is adapted from *Post-KSR Chemical Obviousness in Light of Pfizer v. Apotex* (June 12, 2007), § V-D, *KSR “Obvious to Try” Dictum*, pp. 34-35. Most of the more theoretical legal issues applicable to all aspects of this paper are considered in detail in this and other sections of this earlier paper.

This paper represents the personal views of the writer and does not necessarily reflect the views of any colleague, organization or client thereof.

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<sup>1</sup>*KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007)(Kennedy, J.).

Clearly, optimum best practices for United States patent draftsmanship should provide as a default practice a specification that is completely free from manufactured “problems” that heretofore have all too frequently populated the *Background of the Invention*. See § IV, *Future Best Practices*.

## **II. THE “PROBLEM” SOLVED BY THE INVENTION**

All too often, patent applicants needlessly include detailed “Background” sections, create “objects” and, particularly, set up “problems” in the prior art to be solved. *None of this verbiage is necessary* to meet statutory requirements of patentability.

### **A. The “Known Problem” as Fatal to Patent Validity**

Setting up a “problem” as a strawman in the “Background” may now in some cases prove fatal to patentability. Setting up a problem faced only by the applicant is also irrelevant:

“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.”<sup>2</sup>

### **B. The Applicant’s Subjective Problem is not Controlling**

#### **1. The Panel’s False Importance Attached to the Problem**

The panel below in *KSR* gave undue importance to the *applicant’s* problem that was identified in the patent. *Sub silentio* the panel followed the path of the overruled *Wright* case.<sup>3</sup> Only two years after *Wright*, it was overruled *en banc* in *Dillon*.<sup>4</sup>

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<sup>2</sup> *KSR*, 127 S.Ct. at 1741-42; emphasis added.

<sup>3</sup> *In re Wright*, 848 F.2d 1216 (Fed.Cir.1988)(Newman, J.).

<sup>4</sup> *In re Dillon*, 919 F.2d 688 (Fed. Cir. 1990)(*en banc*)(Lourie, J.).

In *Wright*, “[t]he Commissioner argue[d] that if it is obvious to combine the teachings of prior art references for *any* purpose, the[ ] [prior art references] may be combined in order to defeat patentability of the applicant's admittedly new structure. The PTO states that ‘a claimed invention may be unpatentable if it would have been obvious for reasons suggested by the prior art, even though those reasons may be different from the reasons relied upon by the inventor and may result in a different advantage.’”<sup>5</sup> The Solicitor argued “that it is irrelevant that Wright's structure was for a purpose, and has properties, that are neither obtainable from the prior art structures, nor suggested in the prior art. In this lies the PTO's error.”<sup>6</sup>

Focusing upon the failure of the prior art to address the *applicant's* problems, the panel in *Wright* reversed the obviousness rejection keyed to this rationale “[T]he question is whether what the inventor did would have been obvious to one of ordinary skill in the art *attempting to solve the problem upon which the inventor was working.*”<sup>7</sup>

But, not considered at all by the *KSR* panel below is the fact that within two years in *Dillon* the Federal Circuit in an *en banc* pronouncement had *overruled* the *Wright* panel opinion, restoring the general rule that obviousness is determined keyed to the objective problems known in the art:

“[I]t is not necessary in order to establish a *prima facie* case of obviousness that both a structural similarity between a claimed and prior art compound (or a key component of a composition) be shown and that there be a suggestion in or expectation from *the prior art* that the claimed compound or composition will have the same or a similar utility *as one newly discovered by applicant*. To the extent that [*In re Wright*, 848 F.2d 1216 (Fed.Cir.1988),] suggests or holds to the contrary, it is hereby overruled. In particular, the statement that a *prima facie* obviousness rejection is not supported if no reference shows or suggests the newly-discovered properties and results of a claimed structure is not the law.”<sup>8</sup>

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<sup>5</sup> *Wright*, 848 F.2d at 1218-19.

<sup>6</sup> *Wright*, 848 F.2d at 1219.

<sup>7</sup> *Id.*, emphasis added, citations omitted.

<sup>8</sup> *Dillon*, 919 F.2d at 693.

## **2. Supreme Court *Sub Silentio* Follows *Dillon***

Without citation of *Dillon*, the Supreme Court in *KSR* follows the same logic that the relevant problems are those objectively known to the industry and not an applicant’s particular problem:

“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 the patentee was trying to solve. 119 Fed.Appx., at 288. The Court of Appeals failed to recognize that the problem motivating the patentee may be only one of many addressed by the patent's subject matter. *The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art.* 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.”<sup>9</sup>

With the relevance of *Dillon* it is understandable that the Court failed to cite this case only by seeing that neither of the parties nor any of the numerous *amici* chose to cite *Dillon* in their several briefs at the Court, neither in the petition stage nor the merits stage.<sup>10</sup>

### **C. A “Problem” to be Solved is not Required by Statute**

All too often, patent applicants encumber their application with statements of a “problem”, a “gist” or “heart” of an invention or an “essential” element. None of this is statutory in nature as it is what is *claimed* that defines the subject matter.<sup>11</sup>

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<sup>9</sup> *KSR*, 127 S.Ct. at 1742; emphasis added.

<sup>10</sup> A Westlaw search on June 14, 2007 on the database ALLBRIEFS for [ti(KSR) and “re Dillon”] yielded no hits.

<sup>11</sup> *Allen Engineering Corp. v. Bartell Industries, Inc.*, 299 F.3d 1336,1345 (Fed. Cir. 2002)(Linn, J.) (“It is well settled that ‘there is no legally recognizable or protected ‘essential’ element, gist or ‘heart’ of the invention in a combination patent.’ *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961). Rather, ‘[t]he invention’ is defined by the claims.’ *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991).”).

There is no statutory requirement that the applicant have a “problem” that must be solved to have a patentable invention. For example, even an accidental discovery that is objectively nonobvious is patentable. Thus, by statute “[p]atentability shall not be negated by the manner in which the invention was made.”<sup>12</sup>

### III. “OBVIOUS TO TRY” TO SOLVE THE “PROBLEM”

It has *never* been a good idea for best practices patent application drafting to have a default policy of including a *Background of the Invention* section identifying a “problem” that the invention solves. Only in the most unusual situation is a contrary approach warranted. In view of *KSR*, however, the creation of a “problem” that is placed in the *Background of the Invention* may very well doom the invention to a conclusion of obviousness.

The *KSR* opinion contains loose language concerning whether an invention is “obvious to try” which places this arcane maxim center stage, grist for litigation and appellate resolution at the Federal Circuit.

The Federal Circuit panel in *KSR* made the mistake of uncritically citing the “obvious to try” maxim, which came back to bite the panel as it is quoted by the Supreme Court: “That it might have been obvious to try the combination of Asano and a sensor was likewise irrelevant, in the court's view, because [as per *Deuel*] ‘[o]bvious to try’ has long been held not to constitute obviousness.”<sup>13</sup> The Supreme Court scored the panel’s “obvious to try” maxim as part of “[t]he second error” of the panel.<sup>14</sup> This error “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.”<sup>15</sup>

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<sup>12</sup>35 USC § 103(a).

<sup>13</sup> *KSR*, 127 S.Ct. at 1379 (quoting panel opinion, 119 Fed.Appx. at 289, quoting *In re Deuel*, 51 F.3d 1552, 1559 (C.A.Fed.1995)(Lourie, J.)).

<sup>14</sup> *KSR*, 127 S.Ct. at 1742.

<sup>15</sup> *Id.* (citation omitted).

But, “[c]ommon 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. ... The idea that a designer hoping to make an adjustable electronic pedal would ignore [the] Asano [prior art reference] because Asano was designed to solve [a different] problem makes little sense. A person of ordinary skill is also a person of ordinary creativity, not an automaton.”<sup>16</sup> Tying this together with “obvious to try”, the Court immediately thereafter explained that “[t]he same constricted analysis led the [Federal Circuit panel] to conclude, in error, that a patent claim cannot be proved obvious merely by showing that the combination of elements was ‘obvious to try.’”<sup>17</sup>

Repudiating this analysis of “obvious to try”, the Supreme Court concluded that “[w]hen 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 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.”<sup>18</sup>

#### IV. FUTURE BEST PRACTICES

It has long been clear that the patent applicant jeopardizes the strength of his patent – and even jeopardizes the chance for allowance – by having a detailed *Background of the Invention* that explains “problems” to be solved or, even worse, contains “objects of the invention” with further elaborations.

In the wake of *KSR*, it is important as part of best practices to provide a clean, lean patent specification that avoids the creation of or identification of an applicant’s “problems” to be solved: There is no requirement in the statute that an applicant solve a particular problem, as the invention must only be *objectively* nonobvious.

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<sup>16</sup>*Id.*

<sup>17</sup>*Id.* (citation omitted).

<sup>18</sup>*Id.*