

## [Obviousness Under KSR: A Road Paved with Inequitable Conduct](#)

Noting that the [KSR v. Teleflex](#) decision had immediate effect of making patents more difficult to obtain — allowances of patent applications declined 43% in the first quarter of this year alone — Robert Yeager of the law firm K&L Gates LLP discusses these matters in a recently published “Legal Backgrounder” by the [Washington Legal Foundation](#).

Mr. Yeager discusses how the U.S. Supreme Court’s KSR decision, and the PTO’s implementation of it, could lead to a significant increase in claims that successful applicants obtained patents through inequitable conduct.

The PTO’s summary in the [Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 In View of the Supreme Court Decision in KSR](#) of how to make a determination of obviousness sums up the situation thusly:

In short, the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or *common sense*.

That last factor – common sense – is a subjective hammer to reject claims for obviousness without the need for messy facts. Once the PTO has established the Graham factual findings and concluded that the claimed invention would have been obvious, the burden then shifts to the applicant. The applicant’s response will be in arguments that the PTO erred in making its findings and may include one or more declarations that refute the PTO’s conclusion.

Mr. Yeager foresees that the use of declarations to challenge the PTO’s findings on obviousness will tempt applicants to overreach — leading to inequitable conduct charges.

The [Backgrounder can be downloaded on WLF’s website here](#).