

PREDICTABLE RESULTS: The New Standard for Obviousness

To obtain a United States patent the invention must meet three requirements: new, useful, and unobvious. See 35 U.S.C. §§101-103. The third requirement of patentability has been the subject of much debate resulting in the April 30, 2007 decision of United States Supreme Court to better define obviousness. See *KSR International, Inc. v. Teleflex, Inc.*, No. 04-1350, 550 U.S. ___ (2007).

"A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." See 35 U.S.C. §103. Because of the absence of a clear line of demarcation between obvious and unobvious and because examiners would often make determinations of

obviousness with "hindsight reconstruction," the United States Court of Appeals for the Federal Circuit ("CAFC") created a bright line standard in 1999. This standard is referred to as "teaching, suggestion, or motivation" test ("TSM test"). *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The TSM test states that if "some motivation or suggestion to combine the prior art teachings" can be expressly found in the prior art, the invention is obvious. This test placed the burden on examiners to "prove" during patent examination that there was some explicit teaching, motivation or suggestion to combine the prior art references. Unhappy with the CAFC's rigid standard, the Supreme Court accepted an invitation to review it.

The Supreme Court held that the TSM test is far too rigid and violative of the flexible nature of its original obvious-

ness test. To re-establish flexibility for determining obviousness to combine known elements by a patentee or applicant, the courts and patent examiners must examine (1) interrelated teachings of multiple patents; (2) the effects of demands known by the design community or in the present marketplace; and (3) the background and knowledge by a person having ordinary skill in the art. To facilitate this analysis, the court or patent examiner "need not seek out precise teachings directed to the specific subject matter" but should also take into account "inferences and creative steps that a person of ordinary skill in the art would employ." Consequently, "the combination of familiar elements according to known methods is likely obvious when it does no more than yield predictable results" regardless if applied within or, outside the same technical field. Furthermore, the mere substitution of one element for another known in the field must do more than yield a predictable result. By contrast, "when the prior

art teaches away from combining certain known elements, discovery of a successful means to combine them is more likely to be nonobvious."

In sum, the KSR decision has restored a flexible standard in lieu of a rigid bright line standard. Consequently, if an examiner is not initially convinced that the invention represents an innovation over the prior art, it is an uphill battle to convince them otherwise. This is why a practitioner who can persuasively convey an invention's substantive novelty has been and will be so important to the prosecution of a patent application.



U.S. SUPREME COURT

LEGAL DOCUMENTS: The Cost of Poor Grammar. By Mark H. Plager

The failure to proof-read or the failure to utilize the correct preposition in a patent can cost you a multi-million dollar infringement claim. In the case of *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371 (Fed. Cir. 2004), the inventor substituted "to" in lieu of "at" in the claim element "heating the resulting batter-coated dough to a temperature in the range of about 400° to 850° F." U.S. Pat. 4,761,290, claim 1. The consequence of this error was that to infringe the claim, the dough itself was cooked within the range

of 400° to 850° F, not the oven temperature was within that range. Because the alleged infringer did not bring the dough to that temperature no infringement was found. Despite the inventor arguing that such an interpretation was illogical because to actually cook the dough to 400° to 850° F would result in burnt unuseable dough, the Court read the claim as written.

Courtesy of our friends to the North, we have learned the value of a misplaced comma in a contract termination provision. See *Rogers Cable Communications Inc.- Application regarding Termination and Assignment of the Support Structure Agreement with Aliant Inc.*, No. 8690-R28-200512534 (Canadian Radio-Television Comm. 7/28/2006). The contract was intended to span a minimum

period of five years, with five year renewals unless terminated one year in advance of the renewal. To purportedly express this understanding the contract stated: "[the contract] shall be effective from the date it is made and shall continue in force for a period of five (5) years from the date it is made, and thereafter for successive five (5) year terms, unless and until terminated by one year prior notice in writing by either party." Because an additional comma was included before the clause "unless and until terminated by one year prior notice in writing by either party," Aliant was permitted to terminate an otherwise five year contract with one year advance notice. This termination cost Rogers \$2.3 million dollars because termination permitted Aliant to obtain services at a lower rate because the service rates signifi-

cantly decreased after the signing of the agreement.

Closer to home, the City of Anaheim learned a valuable lesson in legal document drafting. Because of an ambiguity created by the City of Anaheim to accommodate the Walt Disney Company, the new owner of the Anaheim Angels changed the team name to the Los Angeles Angels of Anaheim. The stadium contract between Disney and the city merely provided the term "Anaheim" shall be used as part of the Angels Baseball Club name. The contract was drafted in this fashion to purportedly accommodate Disney's indecision to name the team "Anaheim Angels" or "Angels of Anaheim" to resemble their then existing other local sports franchise, The Mighty Ducks of Anaheim. When Disney sold the team, the Angels new owner Arte Moreno changed the name to Los Angeles Angeles of Anaheim for marketing reasons and comply with the requirement

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THERE IS MORE TO THE COPYRIGHT ACT THEN JUST INFRINGEMENT By Mark H. Plager

As everyone knows, the Copyright Act grants exclusive property rights to artists and authors to do or prevent any of the following with their original works fixed in a tangible medium. Specifically Section 106 grants artists and authors complete autonomy to reproduce, distribute, perform, display or prepare derivative works of their original works. See 17 U.S.C. 106. These rights were expanded in 1990 with the Congressional Amendment known as the Visual Artists Rights Act (VARA).

VARA codified in the United States what was previously known as the Berne Convention for the Protection of Literary and Artistic Works. This codification recognized the existence of artist moral or spiritual rights in a piece of visual artwork. Specifically, an artist's right of attribution as well as the right to prevent mutilation of such visual arts was incorporated into the Copyright Act. 17 U.S.C. 106A.

Within the right of attribution, authors not only have the right to have their work specifically attributed to them, but also the right to prevent the attribution of works that he/she did not create, or have been altered without their consent.

The second prong of VARA prevents the intentional distortion, mutilation, destruction or other modification of a work. The impact of this right was when a landlord sought to remove a sculpture from his building. *Carter v. Helmsley-Spear, Inc.* 861 F. Supp. 303 (S.D.N.Y. 1994), rev'd 71 F.3d 77 (2d Cir. 1995). Initially the trial court prevented the removal pursuant to VARA. However, the appellate determined that the sculpture was a work made-for-hire pursuant to a written contract thereby entitling the landlord to treat the work as his own to the artist's exclusion.

To avoid the impact of VARA and the protection of moral rights granted therein it is strongly recommended that you obtain a written contract with the artists wherein the artist expressly: (1) assigns his copyright; (2) declare the work is a work made-for-hire; (3) waive her right of attribution; (4) waive her right of integrity; and (5) waive the entirety of her moral rights. 17 U.S.C. 101 and 106A(e).

GRAMMAR cont'd

of using "Anaheim" in the team's name. The Superior Court of California upheld this name change last year despite zealous prosecution by the City of Anaheim.

Consequently, when a legal document is prepared, read it carefully before signing it. If you have a question, believe there is an ambiguity, or find a grammatical problem tell your attorney. Once signed, the legal document cannot be corrected in the middle of litigation.

