

## **Adjusting the Rearview Mirror - - Blocking Impermissible Hindsight Rejections**

By Warren D. Woessner<sup>1</sup>

Grounded in Graham v. Deere<sup>2</sup> and acknowledged in KSR International Co. v. Teleflex Inc.,<sup>3</sup> the prohibition against the use of "hindsight bias" or ex post reasoning in resolving the obviousness question would seem to be well-established. As summarized by the Supreme Court in KSR:

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See Graham, 383 U.S., at 36, 86 S. Ct. 684, 16 L. Ed. 2d 545 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight" (quoting Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 412 (CA6 1964))).<sup>4</sup>

As stated by the court In re Katz, 687 F.2d 450, 454 (C.C.P.A. 1982): "Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) only when such disclosure occurred more than one year prior to the date of the application." More succinctly stated in Katz: "[O]ne's own invention, whatever the form of disclosure to the public, may not be "prior art" against oneself, absent a statutory time bar."<sup>5</sup>

While it would such firm holdings by the courts<sup>6</sup> would make it both a simple matter for the practitioner, the Examiner, or the courts to identify obviousness rejections or appellate decisions based on hindsight, unfortunately this is far from the case. Hindsight bias is insidious, as it can become a part of the resolution of the obviousness question very early in the process. As set forth in Graham.<sup>7</sup>

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<sup>2</sup> Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966) (hereinafter "Graham").

<sup>3</sup> KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007) (hereinafter "KSR").

<sup>4</sup> For the purposes of this article "Impermissible Hindsight," "Hindsight Reconstruction" or simply "Hindsight" will be defined as the use of non-prior art generated by the inventor as prior art under § 102. Although this non-prior art is usually referred to as "knowledge of the claimed invention," it can include other information about the invention disclosed by the inventors prior to filing the application or in the specification.

<sup>5</sup> Id. [Emphasis in Original], citing In re Facius, 161 U.S.P.Q. 294 (C.C.P.A. 1969).

<sup>6</sup> Herein, the term "courts" will be used to refer collectively to the Board of Patent Appeals and Interferences (the "Board"), the C.C.P.A., the Court of Appeals for the Federal circuit (the "Federal Circuit") and the Supreme Court.

<sup>7</sup> 383 U.S. at 15-17.

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

If non-prior art information that originated from the applicant is included in the "scope and content of the prior art" that is used to support a rejection of the claims, applicant is in a difficult position. As recently and clearly stated by the Board in Ex parte Frye:

An appellant may attempt to overcome an Examiner's obviousness rejection...by submitting arguments and/or evidence to show that the Examiner made an error in either (1) the underlying finding of fact upon which the...conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of obviousness.<sup>8</sup>

As practitioners quickly learn, it is one matter to rebut a rejection based on a factual error or omission in the cited art ("the cited art does not disclose element (a) of claim 1") and quite another to convince an Examiner that his/her reasoning process is defective. Put another way, attacking the factual "differences" between the cited art and the invention is much easier than attacking the "scope and content" of the prior art, particularly when it is necessary to convince the Examiner that an important fact is not within the scope of the prior art in the first instance.

Getting the Examiner to acknowledge that a rejection is based on knowledge available only from non-prior art sources disclosing applicant's work may also be an easier task if the Examiner has specifically cited such disclosures in support of an obviousness rejection.<sup>9</sup> It becomes more difficult when the Examiner uses the claimed invention as a guide, not just to identify the elements of the invention, which is of course unavoidable and unobjectionable, but also to arrange the elements so that the claimed invention results. This is more than "Just the facts, ma'am," as Joe Friday might request, it is deriving the underlying reasoning that resulted in the claimed invention from the end-product.

If I hand by three-year-old grandson a "sunken puzzle" with an irregular boarder, he can fit in the pieces that have matching edges. It helps that a picture of the assembled puzzle is on the cover. If you hand an Examiner a claim with x elements, he/she can usually find the elements and arrange them to reproduce your claim if the Examiner uses the claim as the picture on the cover. The difference is that while the Examiner can use the picture on the cover to find the pieces,

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<sup>8</sup> Ex parte Frye, App. 2009-006013 (Bd. App. February 6, 2010) (precedential).

<sup>9</sup> For example, see Ex parte McDonald, Appeal No. 2010-002972 (Bd. App. June 8, 2010) in which the Board cited to a portion of the detailed description of the invention as supporting the Examiner's position that an analog of an old drug would be expected to have the same properties as the old drug.

he/she has to legally erase the picture from his/her mind before beginning to assemble the pieces. As stated In re Carroll:

In deciding obviousness, one must look at the prior art from the vantage point in time *prior* to when the invention was made; hindsight obviousness after the invention was made is not the test.<sup>10</sup>

Of course it can be extremely difficult to re-construct the Examiner's reasoning ex post facto, but in KSR, the Supreme Court at least held that there must be some foundation under an obviousness rejection apart from the fact that the elements of the invention were available to the art:

Rejections 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.<sup>11</sup>

It logically follows that the likelihood that the Examiner used the claims as a template by which to assemble the invention is directly proportional to (a) the number of prior art references required to provide all the claim elements and assembly instructions, and (b) the complexity of any individual reference, including the amount of extraneous or manifestly irrelevant material therein. This remains true in practice even though courts have held that the need to cite a large number of references does not *per se* weaken a *prima facie* case of obviousness. In fact, in KSR, the Court stated that "[o]ften it will be necessary for a court to look to unrelated teachings of multiple patents...to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent in issue."<sup>12</sup> The key word here is not "multiple," it is "interrelated." If the references are not interrelated, they may well be "non-analogous art" and the non-analogous art test is not dead. As stated In re Kahn:

[T]he "analogous art" test – has long been part of the primary Graham analysis articulated by the Supreme Court.... The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.<sup>13</sup>

In fact, the Kahn court recognized that an Examiner who must employ even arguably non-analogous art to support an obviousness rejection has probably engaged in hindsight reconstruction:

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<sup>10</sup> 601 F.2d 1184 (C.C.P.A. 1979). See also, In re Shaffer, 229 F.2d 476 (C.C.P.A. 1956).

<sup>11</sup> 121 S. Ct. at 1741. (quoting In re Kahn, 441 F.3d 977 (Fed. Cir. 2006)).

<sup>12</sup> Id. at 1740-1741.

<sup>13</sup> 441 F.3d 977 (Fed. Cir. 2006).

This test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and it is meant to defend against hindsight.<sup>14</sup>

Furthermore, apart from multiplicity *per se*, hindsight may well have been employed if the Examiner has extracted at least one element of the invention from a thicket of irrelevant material in a lengthy, complex publication or patent. The fact that a claimed product is within the broad field of the prior art and one might arrive at it by selecting specific items and conditions does not render the product obvious in the absence of some directions or reasons for making such selection.<sup>15</sup> Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it obvious.<sup>16</sup>

In other words, the need to "pick and choose" from the available prior art should set off a warning light that hindsight reconstruction was in use. As an early embodiment of the Fed. Cir. clearly stated in W.L. Gore and Associates v. Garlock, Inc.:

To imbue one of ordinary skill in the art with knowledge of the invention in suit when no prior art reference[s]...of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.<sup>17</sup>

Even though KSR made it clear that the teaching, motivation or suggestion (the "TSM test") to make the invention need not reside solely in the prior art, the Court did not disturb decades of jurisprudence holding that the claim cannot provide the rationale to combine elements from the prior art to recreate it. As stated in Gore, ...the Examiner not entitled to use the claim as a "frame" and to employ "individual naked parts of separate prior art references...as a mosaic to recreate a facsimile of the claimed invention."<sup>18</sup>

Even after KSR, the TSM test not only remains available to test obviousness rejections, but most Examiners still use the test as the framework for obviousness rejections. This opens the door for practitioners to argue that the Examiner is using Applicant's invention as either the "motivation" to make the invention or as evidence of a "reasonable expectation of success." In a recent

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<sup>14</sup> 441 F.3d at 987. See, e.g., Ex parte Haymond, 41 U.S.P.Q.2d 1217 (Bd. App. 1996) (parenteral feeding composition comprising triacetin). Examiner cited secondary references relating to injectable compositions containing triacetin as a vehicle. Injectable art found to be unrelated to parenteral nutrition. Rejection reversed.

<sup>15</sup> Ex parte Kuhn, 132 U.S.P.Q.2d 1958 (Bd. App. 1961).

<sup>16</sup> In re O'Farrell, 853 F.2d 894 (Fed. Cir. 1988).

<sup>17</sup> 721 F.2d 1550, 1553 (Fed. Cir. 1983).

<sup>18</sup> Id. at 1552. See also In re Warner, 379 F.2d 1011 (C.C.P.A. 1967) cert. den'd. 389 U.S. 1057 (1968). ("[W]e note that it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together isolated disclosures and teachings of the prior art so that the claimed invention may be rendered obvious.")

decision holding a jet engine feature unobvious, the Federal Circuit emphasized the use of the "new" TSM test to block hindsight reconstruction:

To preclude hindsight in this [103] analysis, this court flexibly seeks evidence from before the time of the invention in the form of some teaching, suggestion, or even mere motivation (conceivably found within the knowledge of an ordinary skilled artisan) to make the variation or combination.<sup>19</sup>

This language is remarkably similar in tone to that used by Chief Judge Markey in Gore v. Garlock twenty-seven years ago:

It is difficult but necessary that the decision maker forgot what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.<sup>20</sup>

Judges Markey, Davis and Miller had a lot more to work with than did the KSR panel, including a sophisticated new polymeric fabric (Gore-Tex®), gaps and negative teachings in the art and secondary considerations supporting patentability. Still both the Gore panel and the KSR Court cited In re Bergel, 292 F.2d 955 (C.C.P.A. 1961) as requiring some suggestion of the invention in the prior art, and at least as far as the need to disregard "siren hindsight" is concerned, the opinions are not inconsistent, with each other, or with the nearly century-old language of the Supreme Court in Diamond Rubber Co. v. Consolidated Rubber Tire Co.:<sup>21</sup>

Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not.

As Peter Allen wrote: "And don't throw the past away / You might need it some rainy day / Dreams can come true again / When everything old is new again."

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<sup>19</sup> Rolls-Royce, PLC, v. United Technologies Corp., App. No. 2009-1307 (Fed. Cir. May 5, 2010).

<sup>20</sup> 721 F.2d at 1553. Judge Markey also wrote that "objective evidence of nonobviousness...can often serve as insurance against the insidious attraction of the siren hindsight when [the decision maker] is confronted with the difficult task of evaluating the prior art." Id. The Supreme Court found no such "insurance" in KSR.

<sup>21</sup> 220 U.S. 428, 435 (1911).