Restructuring the Obviousness Analysis

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The great question of patent law, obviousness, is a muddle. Applicants, competitors, and decision-makers engage in mental contortion to ascertain whether an invention is too obvious to deserve patent protection. In view of these challenges, commentators have set forth various proposals, such as altering the presumption of validity, allowing applicants to elect more rigorous examination, and shifting the focus to ask whether a patent would have been necessary to induce innovation.

An evaluation of obviousness should recognize that the constraints of prosecution are vastly different from those of litigation. Just as the purposes of interpreting claim language differ during prosecution and litigation, the circumstances of assessing obviousness vary at these distinct times as well. The goal of providing timely and cost-effective prosecution limits the amount of time examiners can spend determining obviousness. As a result, they have used the analogous arts test as a rough gauge of obviousness during prosecution. Unfortunately, the Federal Circuit has not provided much guidance on how to apply the analogous arts test, resulting in a highly subjective doctrine.

While this uncertainty may be tolerable during prosecution, where we forgive time-pressed examiners for relying on common sense among other things, courts should be held to higher standards. In particular, courts should no longer be permitted to rely on the outdated and unpredictable analogous arts test. During litigation, more time and resources can be spent on the obviousness assessment. At that time, decision-makers should ascertain common practices in the field of invention and whether the invention is obvious in light of them. This restructuring of the obviousness analysis at the courts should result in a more accurate determination of obviousness where it matters most.