

Comments on "Updated Guidance for Making a Proper Determination  
of Obviousness," 89 FR 14449 (2/27/2024)

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**I. INTRODUCTION**

This publication is identified as a "Notice." The link to download the pdf version of the Notice is <https://www.govinfo.gov/content/pkg/FR-2024-02-27/pdf/2024-03967.pdf>

**II. COMMENTS**

The summary of the Notice states that it "serves as operable guidance for USPTO personnel when applying the law of obviousness." So this Notice is significant because it provides the legal basis the examining corps must follow to reject a claim.

One point from the Notice jumped out at me as worthy of comment. This point should be considered by members of the patent bar when discussing patentability with our clients, drafting specifications and claims, and challenging claim validity. This is the passage in the Notice regarding basis for motivation to modify prior art. This passage is in the subsection in the Notice titled "Flexible approach to providing a reason to modify the prior art," which states in relevant part:

In keeping with this flexible approach to providing a rationale for obviousness, the Federal Circuit has echoed *KSR* in identifying numerous possible sources that may, either implicitly or explicitly, provide reasons to combine or modify the prior art to determine that a claimed invention would have been obvious. These include “market forces; design incentives; the ‘interrelated teachings of multiple patents’; ‘any need or problem known in the field of endeavor at the time of invention and addressed by the patent’; and the background knowledge, creativity, and common sense of the person of ordinary skill.” *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013), quoting *KSR*, 550 U.S. at 418-21, 127 S. Ct. at 1741-42. Furthermore, the Federal Circuit has explained that a reason to optimize prior art parameters may be found in a PHOSITA’s desire to improve on the prior art. *In re Ethicon, Inc.*, 844 F.3d 1344, 1351 (Fed. Cir. 2017) (“The normal desire of artisans to improve upon what is already generally known can provide the motivation to optimize variables such as the percentage of a known polymer for use in a known device.”). The Federal Circuit has also clarified that a proposed reason to combine the teachings of prior art disclosures may be proper, even when the problem addressed by the combination might have been more advantageously addressed in another way. *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1197-98 (Fed. Cir. 2014) (“Our precedent, however, does not require that the motivation be the best option, only that it be a suitable option from which the prior art did not teach away.”) (emphasis in original).

This passage shows how broadly the courts and the USPTO now construe the possible reasons for modifying prior art. So patent practitioners should likewise broadly consider whether any of the following factors provide a motivation to modify prior art in a manner resulting in a claimed invention:

- market forces;
- design incentives;
- interrelated teachings of multiple patents;
- any need or problem known in the field of endeavor;
- background knowledge, creativity, and common sense of the person of ordinary skill; and
- general desire to optimize parameters.

Patent practitioners should take these considerations into account at the earliest opportunity along the path to patent protection.

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