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From: Irving Kayton <kayton@kayton.com>
Subject: *KSR v. Teleflex*

Unfortunately, the analysis of the *KSR v. Teleflex* Supreme Court decision and unanimous opinion by the inventor with many years of litigation experience was based upon his or her reading through heavily tinted rose-colored glasses.

Teleflex is an unmitigated disaster for all inventors, because the previously well-settled and rational law on obviousness under §103 has been replaced by utter uncertainty. As a consequence of *Teleflex,* no one can ever know whether a patent is valid under §103 until the highest appellate court that will hear the case has ruled.

Moreover, prosecution of applications will become a battlefield defined by uncertain standards resulting in unpredictable outcomes -- resulting in greatly lengthened prosecution periods and increased prosecution expenses.

Obviousness under §103 is a subject that I have personally studied intensely since the inception of that section in 1952/53 and have written extensively on since 1966.

Two important and powerful segments of society will benefit greatly from *Teleflex.* Segment 1 is all infringers with deep pockets faced with patents owned by patentees of all kinds having the common attribute of shallow pockets. Segment 2 is all patent attorneys and agents, the need and demands for whose time in litigation, prosecution, and counseling will skyrocket, because, although the U.S. patent system is maimed, it is still the only game in town (except for trade secrets, which can be used only in special situations). Sarbanes-Oxley alone will require more patent attorney analysis of patent portfolio holdings of publicly-traded U.S. corporations than can be provided by all the U.S. patent attorneys and agents that now exist (or have ever existed).

For all who would like to read a detailed analytic history of obviousness, see my Chapter 5 in Volume 1 of the 8th Edition treatise, *Patent Practice.* The history begins with the *A&P* case in 1945 that resulted in the curative §103 of 1952/53 (which was written by the late Federal Circuit Judge Giles S. Rich, the late USPTO Board of Appeals chief judge, P.J. Federico, and the late Henry Ashton, president of the New York Patent Law Association). That chapter then traces the entire case law history of "obviousness" under §103 and deals with each and every case that the Supreme Court cited in *Teleflex* and the effects of those cases on the law.

One of the saddest results of *Teleflex* will be the inevitable diminution in the various recent, effective approaches to monetizing patent property. Patents,

which provide the much needed protection to encourage invention, had finally become assets of liquid financial value. Liquidity is now draining into the sewer of uncertainty and unpredictability.

The preceding discussion, in combination with my §103 chapter in *Patent Practice,* must not be viewed as railing against the moon. Rather, it is provided as a platform for formulating for inventors techniques needed to cope with the *Teleflex* hurricane of unpredictability in a nearly rudderless boat. Those techniques are the subject for another day.