

No. 23-768

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IN THE  
**Supreme Court of the United States**

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VANDA PHARMACEUTICALS INC.,  
*Petitioner,*

v.

TEVA PHARMACEUTICALS USA, INC., ET AL.,  
*Respondents.*

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**On Petition for a Writ of Certiorari  
to the United States Court of Appeals  
for the Federal Circuit**

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**BRIEF OF PROFESSOR CHRISTOPHER M.  
TUROSKI AND THE NATIONAL ASSOCIATION  
OF PATENT PRACTITIONERS AS *AMICI  
CURIAE* IN SUPPORT OF PETITIONER**

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**INTEREST OF *AMICI CURIAE*<sup>1</sup>**

*Amicus curiae* Professor Christopher Turoski is a law professor and legal scholar with expertise in patent law. He is the Director and Assistant Professor of Patent Law Programs at the University of Minnesota Law School and author of several treatises on patent law subjects.

*Amicus curiae* The National Association of Patent Practitioners (NAPP) is a nonprofit trade association focused on fostering professionalism in the patent practitioner community, enhancing day-to-day practice of practitioners, and aiding patent agents and patent attorneys in staying current in matters relating to practice before the United States Patent and Trademark Office and foreign jurisdictions.

*Amici* both have an interest in the proper interpretation of the Patent Act of 1952 and the administration of patent laws across the Nation. They submit this amicus brief to address the important issues raised by this case on the content and application of the obviousness standard used to invalidate patents.

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<sup>1</sup> Pursuant to Rule 37.6, *amicus curiae* affirms that no counsel for a party authored this brief in whole or in part, and no one other than *amicus curiae* or his counsel made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Rule 37.2, counsel of record for all parties received notice of *amicus curiae*'s intention to file this brief. Counsel for all parties indicated that no party objected to the filing of this amicus brief.

## SUMMARY OF ARGUMENT

A critical limitation on patenting a claimed invention is that the invention would not have been obvious to a person having ordinary skill in the art at the time. This obviousness requirement is found in § 103 of the Patent Act. 35 U.S.C. § 103. As this Court has explained, Congress adopted § 103 in 1952 to codify the judicial precedents on obviousness that this Court had laid down for nearly 100 years preceding the Act. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). That longstanding precedent leading to the 1952 Act culminated into a standard under which an invention based on a combination of known elements is obvious when the invention was “plainly indicated” or “plainly foreshadowed” to a skilled artisan by the prior art. See, e.g., *Textile Machine Works v. Louis Hirsch Textile Machines, Inc.*, 302 U.S. 490, 497–98 (1938); *Altoona Publix Theatres, Inc. v. Am. Tri-Ergon Corp.*, 294 U.S. 477, 486 (1935). And since the codification of those pre-1952 judicial precedents in § 103, this Court has interpreted the standard for obviousness under § 103 consistent with the case law preceding the 1952 statute. See *Graham*, 383 U.S. at 36 (concluding the challenged claims were “clearly evident from the prior art”); *id.* at 25 (concluding “a person having ordinary skill \* \* \* would immediately see” the supposed invention).

As the Petition explains, however, the Federal Circuit has departed from the historic and longstanding standard codified in § 103 and continued in the Court’s cases on obviousness. The Federal Circuit holds, as it did in the case below, that an invention based on a combination of known elements is obvious when one skilled in the art would have been

motivated to combine those elements and would have a “reasonable expectation of success” in reaching the same result. Pet. App. 5a, 15a. A “reasonable expectation” is far afield of a plain indication or plain foreshadowing, the standard in the pre-1952 judicial precedents.

*Amici curiae* submit this brief to provide a historic overview of this Court’s obviousness jurisprudence to show the development of the obviousness requirement and to illustrate how far the Federal Circuit has departed from governing judicial precedents. The issue is one of exceptional importance. Obviousness is a bedrock defense to claims of patent infringement, and the Federal Circuit—the sole court charged with establishing legal uniformity of the patent laws—should not be permitted to depart from this Court’s jurisprudence. The rise of *inter partes* review proceedings only serves to emphasize the importance of the obviousness standard, as it is one of the primary grounds on which the Patent Trial & Appeal Board can invalidate issued patents. 35 U.S.C. § 311(b). The Court should grant the petition.

## ARGUMENT

As stated in the decision below, the Federal Circuit assesses the obviousness of patent claims, where the various components are known in the prior art, by determining whether there was a motivation to combine the elements and the “prior art would have given a skilled artisan a reasonable expectation of success” of achieving the patented claims. Pet. App. 8a. The court explained that “[o]bviousness does not require certainty—it requires a reasonable expectation of success.” *Id.* at 15a. That is, the party

challenging the patent “did not need to show that” the invention “*would* have” been achieved, “just that it would have been reasonable to expect it.” *Id.* at 15a–16a. A review of the history of the obviousness requirement, and this Court’s precedents, shows that the Federal Circuit’s “reasonable expectation of success” inquiry has departed from the Court’s longstanding precedents.

**I. UNDER THE PRE-1952 “INVENTION” STANDARD, A PATENT COULD NOT BE WITHIN THE ABILITY OF ALL SKILLED ARTISANS, PLAINLY INDICATED, OR PLAINLY FORESHADOWED.**

The obviousness requirement ultimately established in § 103 can be traced back to this Court’s decision in *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1850). See *Graham*, 383 U.S. at 11 (“This Court formulated a general condition of patentability in 1851 in *Hotchkiss v. Greenwood* \* \* \*”). The patent at issue in *Hotchkiss* concerned a supposedly new improvement “in making door and other knobs of all kinds of clay used in pottery, and of porcelain.” 52 U.S. (11 How.) at 264. The only new aspect to the patent was “the substitution of a knob of a different material”; every other aspect had been previously disclosed. *Id.* at 265. The Court held that this substitution of material did not entitle the inventor to a patent. According to the Court, “unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required \* \* \* than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention.” *Id.* at 267. The Court explained that “the improvement” at



issue “is the work of the skillful mechanic, not that of the inventor.” *Id.* This spawned the so-called “invention” standard.

This invention standard became a foundational aspect of patentability, and decisions of this Court regularly grappled with it. For instance, in *Loom Co. v. Higgins*, 105 U.S. 580 (1881), the Court confronted a patent on “improvements in looms for weaving pile fabrics.” *Id.* at 581. The claimed device was challenged as not “show[ing] any invention.” *Id.* at 591. But the Court rejected that contention, stating that the challenge “would be sound if the combination claimed by [the patent owner] was an obvious one for attaining the advantages proposed.” *Id.* According to the Court, this would be shown if the subject matter recited by the patent claims was “one which would occur to *any* mechanic skilled in the art.” *Id.* (emphasis added). But the patent claims’ subject matter was not one that would occur to all skilled artisans. Accordingly, “the combination of elements” resulting in the patent, “even if those elements were separately known before, was invention sufficient to form the basis of a patent.” *Id.* at 592. Thus, the key to patentability under the invention standard turned on whether the subject matter recited by the patent claims was something plain to any person having skill in the art.

Not long after *Loom*, the Court reiterated the “invention” standard. The Court affirmed the invalidation of two patents because the subject matter recited in the claims “would occur to *any* mechanic engaged” in the field of endeavor. *Slawson v. Grand Street, P.P. & F.R. Co.*, 107 U.S. 649, 653 (1883) (emphasis added). The Court explained that “an idea which would naturally and spontaneously occur to *any*

skilled mechanic or operator in the ordinary progress of manufactures” is not one that can be patented. *Id.* at 654 (quoting *Altantio Works v. Brady*, 107 U.S. 192, 200 (1883)) (emphasis added).

The following year the Court once again addressed the “invention” requirement. In *Phillips v. Detroit*, 111 U.S. 604 (1884), the Court affirmed the invalidation of a patent where the “improvement \* \* \* consist[ed] \* \* \* in simply taking a material well known and long used in the making of pavements \* \* \* and with them constructing a pavement in a method well known and long used.” *Id.* at 607. This supposed improvement lacked the requisite invention, according to the Court, because “the patent was within the mental reach of *any one* skilled in the art to which the patent relates.” *Id.* (emphasis added). It required “only the use of ordinary judgment and mechanical skill.” *Id.*

The Court continued addressing the “invention” requirement well into the following century. In *Saranac Automatic Machine Corp. v. Wirebounds Patents Co.*, 282 U.S. 704 (1931), the patents at issue dealt with machines for making box blanks. *Id.* at 705–06. The various components of the patent claims had all been disclosed previously in one way or another. *Id.* at 710. But the Court concluded that the inventor could not show the “invention” necessary to have a patent. The advancement supposedly made by the patent, according to the Court, was “obvious, involving only the adaption of familiar mechanical means for holding cleats and sides in place, and requiring no more than the mechanical skill of the calling.” *Id.* at 711. In fact, given the disclosures available at the time of the invention, “failure to adapt these obvious means to the solution of the problem,” the Court explained,

“would \* \* \* have evidenced a want of ordinary mechanical skill and familiarity with them.” *Id.* at 713. That is, the advancement merely displayed “the expected skill” of those in the field of endeavor—all skilled artisans in the field should have reached that advancement. *Id.* The Court used this standard later that same Term in *DeForest Radio Co. v. General Electric Co.*, 283 U.S. 664 (1931), asking whether the subject matter of the patent claims “involved the inventive faculty or was but the expected skill of the art.” *Id.* at 682.

The Court elaborated on the standard some years later in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477 (1935). There, the Court explained that “[a]n improvement to an apparatus or method, to be patentable, must be the result of invention, and not the mere exercise of the skill of the calling or an advance *plainly indicated* by the prior art.” *Id.* at 486 (emphasis added). According to the Court, the supposed improvement claimed by the patent in *Altoona* was “plainly foreshadowed” by the prior art, and, therefore, the invention was “the product of skill, not invention.” *Id.* Accordingly, the patent was invalid.

The Court echoed the invention standard a year later in *Textile Machine Works v. Louis Hirsch Textile Machines, Inc.*, 302 U.S. 490. According to the Court, the machine at issue “was plainly not invention.” *Id.* at 497. The Court explained that the “addition of a new and useful element to an old combination may be patentable.” *Id.* at 497. However, “the addition must be the result of invention rather than the mere exercise of the skill of the calling, and *not one plainly indicated* by the prior art.” *Id.* at 497–98 (emphasis

added). The advance claimed by the patent at issue “was plainly foreshadowed” by the prior art and, therefore, unpatentable. *Id.* at 498.

The Court reached a similar result using the same invention standard in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84 (1941), concluding that the device at issue there “was not the result of invention but a ‘mere exercise of the skill of the calling,’ an advance ‘plainly indicated by the prior art.’” *Id.* at 88.<sup>2</sup> In the course of its decision, the Court in *Cuno* refused to permit “any relaxation of the rule of the *Hotchkiss* case.” *Id.* at 92.

Numerous other cases followed this same reasoning. For instance, the Court in *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, 324 U.S. 320 (1945), concluded that the subject matter recited by the patent claims “was perfectly plain to an expert.” *Id.* at 327. Accordingly, the patent “lack[ed] the very essence of an invention.” *Id.*

In sum, for nearly 100 years, the Court applied an “invention” standard to determine whether something was patentable. That standard looked to whether the subject matter recited by the claims was merely the expected work of any skilled artisan in the field, or whether it revealed the work of an inventor. And that turned on whether the advancement was plainly indicated or foreshadowed by the prior art—something all skilled artisans in the field would have achieved—

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<sup>2</sup> In *Cuno*, the Court stated that a new device “must reveal the flash of creative genius not merely the skill of the calling.” 314 U.S. at 91. This “flash of creative genius” gloss, however, was eliminated with the passage of § 103 of the Patent Act. See *infra*, n.4.

or not. Stated differently, the standard turned on whether the advancement was “obvious” to one of skill in the relevant art.

**II. SECTION 103 AND THIS COURT’S CASES CARRY FORWARD THE “INVENTION” STANDARD FOR OBVIOUSNESS, NOT A “REASONABLE EXPECTATION OF SUCCESS” STANDARD.**

In the Patent Act of 1952, Congress added a new condition of patentability—§ 103 non-obvious subject matter. See *Graham*, 383 U.S. at 12–13. Section 103 provided that:

“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.”

*Graham*, 383 U.S. at 13 (quoting 35 U.S.C. § 103 (1952)).<sup>3</sup> Even though “Congress has emphasized ‘nonobviousness’ as the operative test of the section, rather than the less definite ‘invention’ language of *Hotchkiss*,” *id.* at 14, this Court concluded that Congress intended § 103 “merely as a codification of

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<sup>3</sup> Section 103 has been amended a number of times since its passage in 1952, but the amendments have largely altered some wording and have not changed the core substantive requirements. Amendments in the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29 § 3(c), 125 Stat. 284, 287 (2011), have not altered the Federal Circuit’s approach to the obviousness standard. See, e.g., *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1363 n.3 (Fed. Cir. 2023).

judicial precedents embracing the *Hotchkiss* condition,” *id.* at 17.<sup>4</sup>

Looking to *Hotchkiss*, the Court set forth the inquiry for assessing obviousness under § 103. See *Graham*, 383 U.S. at 12, 17. The Court explained that “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.” *Id.* at 17. “Against this background,” the Court stated, “the obviousness or nonobviousness of the subject matter is determined.” *Id.* Then, in assessing the patents at issue in the case, the Court in *Graham* echoed the same “invention” standard reflected in *Hotchkiss*’s progeny. For instance, in finding one of the patents invalid as obvious, the Court concluded that “[c]ertainly a person having ordinary skill in the prior art,” given the state of the art, “would immediately see that the thing to do was what Graham did.” *Id.* at 25. Similarly, the Court found the second patent at issue in *Graham* obvious because the claims of the “patent are *clearly evident* from the prior art as it stood at the time of the invention.” *Id.* at 36 (emphasis added).

In the companion case to *Graham*, moreover, the Court concluded that the patent at issue was not obvious because the invention contravened “long-

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<sup>4</sup> The last sentence of § 103 provided that “[p]atentability shall not be negated by the manner in which the invention was made.” *Graham*, 383 U.S. at 13 (quoting 35 U.S.C. § 103 (1952)). The Court explained that with this sentence “Congress intended \* \* \* to abolish the test it believed this Court announced in the controversial phrase ‘flash of creative genius’ used in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84 (1941).” *Graham*, 383 U.S. at 15.

accepted factors” in the prior art. *United States v. Adams*, 383 U.S. 39, 52 (1966). That is, the invention was not one that any skilled artisan would have predicted from the prior art.

The Court continued emphasizing *Hotchkiss* and its progeny in cases that followed *Graham*, *Adams*, and the 1952 Act. For instance, in *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), the Court emphasized the conclusion in *Graham* that § 103 “was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition.” *Anderson’s-Black*, 396 U.S. at 62 (quoting *Graham*, 383 U.S. at 17). And the combination of old elements in that case did not satisfy § 103 because “to those skilled in the art the use of the old elements in combination was not an invention.” *Id.* 62–63.

Again, in *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976), the Court emphasized the principle from *Hotchkiss* that “some ‘invention’” is necessary “to be entitled to patent protection.” *Id.* at 279. The Court further reiterated that the *Hotchkiss* “standard was enacted in 1952 by Congress in 35 U.S.C. § 103 ‘as a codification of judicial precedents.’” *Id.* And the Court concluded that the arrangement of already known elements in the patent was “‘the work of the skillful mechanic, not that of the inventor.’” *Id.* at 282 (quoting *Hotchkiss*, 52 U.S. (11 How.) at 267). The “assembly of old elements,” in other words, “would be obvious to any person skilled in the art of mechanical application.” *Id.* (emphasis added).

The Court’s most recent discussion of the obviousness requirement in § 103 comes from *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). There, the Court confirmed that “[i]n *Graham* \* \* \* the

Court set out a framework for applying the statutory language of § 103, language itself based on the logic of the earlier decision in *Hotchkiss* \* \* \* and its progeny.” *Id.* at 406. In *KSR*, the Court rejected the Federal Circuit’s use of the “teaching, suggestion, or motivation test (TSM test)” as a necessary basis for assessing obviousness. *Id.* at 407, 415. The Court explained that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*.” *Id.* at 415. In doing so, the Court emphasized that a combination of known elements is likely to be obvious when it does no more than “yield a predictable result” to one of skill in the art. *Id.* at 416. After looking at *Sakraida* and *Anderson’s-Black Rock*, the Court stated that to assess obviousness, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417. Whether the improvement merely evidences a predictable use from prior art elements restates the pre-1952 cases stating that an advancement is obvious when it is plainly indicated or foreshadowed by the prior art.

Critically, none of this Court’s cases before § 103’s enactment in 1952, nor after, has used “reasonable expectation of success” as the basis for assessing obviousness. This Court has consistently evaluated obviousness by asking whether the supposed invention was within the skill of any person of ordinary skill in the art—that is, plainly indicated or plainly foreshadowed by the prior art to a skilled artisan. See, e.g., *Altoona*, 294 U.S. at 486; *Textile Machine*, 302 U.S. at 498; *Cuno*, 314 U.S. at 88. Or, as the *KSR* Court put it, an invention is obvious if it is a “predictable use of prior art elements” to one of skill in the art.



The Federal Circuit’s “reasonable expectation of success” standard cannot be squared with this Court’s jurisprudence. See Pet. 15–16. The Court has consistently said that obviousness turns on whether an invention would be plainly indicated or plainly foreshadowed by the prior art, be the predictable result of the prior art, or fall within the ability of all skilled artisans in the field. Asking only whether a skilled artisan might reasonably expect success in achieving an advancement unnecessarily lowers the standard for obviousness. *Id.* The Court should not permit the Federal Circuit to persist in crafting its own obviousness test, especially in the face of over 150 years of precedent. The time has come for the Court to correct the Federal Circuit’s course and ensure the court of appeals applies the invention standard set forth by Congress and this Court.

### CONCLUSION

For the foregoing reasons, the petition should be granted.

Respectfully submitted,

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