TechRoadmap Directions

Intellectual Property Issues of Interest to High Tech Companies

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in this issue

Welcome

As I write this on the Fourth of July, I picture you sitting around a pool, swirling the ice in your drink, perhaps reading a book or favorite magazine. In keeping with that image, **I offer you a "Foolish Fourth" patent**: a combination swizzle stick and "ophthalmic device" (reading glasses)!

Although combining two known technologies in a novel way is generally patentable, in this case, where the two technologies are inherently unrelated, we should really ask the patent office, **"Shouldn't this patent have been rejected as obvious"?** The Supreme Court has just decided to review just this sort of question. To see this patent and my comments, read "Obviously, a July 4th Patent."

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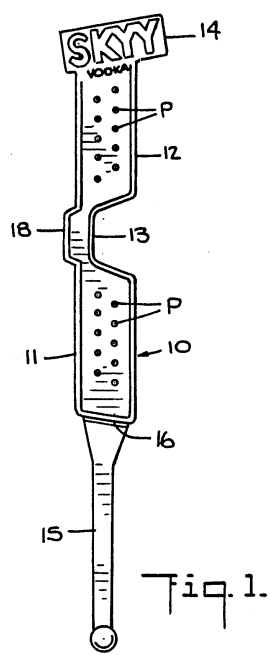
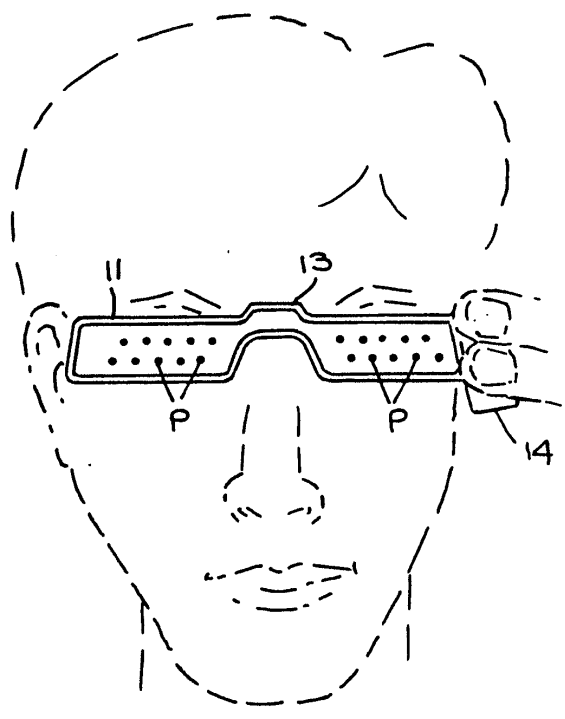
Obviously, a July 4th Patent

While exploring IP space in ophthalmic devices for a client, I came across US Patent 5,151,720. It's a short patent and I urge you to click the link to read or download the 4 page PDF file.



Two things about this patent immediately jumped out at me (well, three things if you count the perfect fit with today's holiday). First, there's the **unintended humor**. How else to react to lines like: *"But those who dine in **fashionable** restaurants often do not as a matter of personal vanity bring along a pair of spectacles, for wearing spectacles is regarded as **unglamorous**."* [emphasis added]



As you can see, fashionable and glamorous people will surely want to **wear their swizzle sticks on their faces** instead of ordinary reading glasses.

The second thing that struck me was **the obviousness of the so-called invention**. There is certainly nothing novel about the swizzle stick part of the device, nor, frankly, is there anything new about the "ophthalmic" device (but that's another story). So, while novel combinations of existing technologies are patentable, **I don't believe patent status should be extended to the arbitrary grafting together of two unrelated technologies**, as is clearly the case in this instance.

Giving patent status to this "invention" devalues every patent, encourages the flow of junk applications into the (overloaded) patent office, and runs counter the very purpose of our patent system. **Patents are intended to reward individuals who help advance the technical arts, not to lay a minefield for people who want to market new versions of old products.** If this patent is valid, where do we draw the line?

What song will the Supremes sing?

Coincidentally, the Supreme Court last week decided to review a Federal Circuit court patent decision that concerns when a combination is obvious. The basic "obviousness test", dating from an 1850 Supreme Court case is:

- Given the known characteristics/functions of the elements of an invention, *would ordinary artisans expect* that the combination of these elements would result in what the patentee/applicant accomplished?

but the Federal Circuit (and the PTO) have added the requirement that:

- the prior art must provide a **motivation** for making the claimed combination

A brief filed by the Solicitor General said that the Federal Circuit "has transformed one means of establishing obviousness ...--proof that the prior art provided a teaching, suggestion or motivation for combining prior art references--into an inflexible requirement for determining obviousness," and **has thus "extend[ed] patent protection to non-innovative combinations of familiar elements."**

I heartily agree with this sentiment; the "motivation to combine test" should be used only when the basic test (and common sense) fail to demonstrate the obviousness of the combination.

What Are Your Thoughts?

Is the answer to the question before the Supreme Court obvious to you? Have you ever been stymied in your product development activities by a "obvious" patent? Or have you every applied for a patent that just combined existing technologies without substantive modifications? (you can request anonymity if you answer "yes")

Let me know your experiences. Reply to this email or send me a note directly at bruceahz@techroadmap.com

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