

OCTOBER 4, 2006

DyStar Textilfarben GmbH & Co Deutschland KG v. C.H. Patrick Co.

No. 06-1088, Federal Circuit (*Michel, Rader, Schall*)

Although this court customarily discusses a motivation to combine as part of the first Graham factor, the scope and content of the prior art, motivation to combine is also inextricably linked to the level of ordinary skill. If, as is usually the case, no prior art reference contains an express suggestion to combine references, then the level of ordinary skill will often predetermine whether an implicit suggestion exists.

On October 3, 2006, the Federal Circuit reversed the district court's denial of defendant Bann's motion for judgment as a matter of law notwithstanding the jury verdict that U.S. Patent No. 5,586,992, which related to a method of dyeing textile materials with catalytically hydrogenated leuco indigo, was not invalid for anticipation, obviousness or lack of enablement. The Federal Circuit stated:

DyStar argues that this court's "suggestion test" for obviousness requires the cited references themselves to contain a suggestion, teaching, or motivation to combine them, and that it must be explicitly stated.... Absent such a teaching, urges DyStar, the invention of claim 1 of the '992 patent cannot be obvious.

DyStar's argument misreads this court's cases and misdescribes our suggestion test, echoing notions put forth recently by various commentators and accepted in major reports.... Contrary to some interpretations, we stated explicitly that evidence of a motivation to combine need not be found in the prior art references themselves, but rather may be found in "the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved." When not from the prior art references, the "evidence" of motive will likely consist of an explanation of the well-known principle or problem-solving strategy to be applied....

It is difficult to see how our suggestion test could be seen as rigid and categorical given the myriad cases over several decades in which panels of this court have applied the suggestion test flexibly. Obviousness is a complicated subject requiring

sophisticated analysis, and no single case lays out all facets of the legal test. DyStar’s argument and the above-cited commentary highlight the danger inherent in focusing on isolated dicta rather than gleaning the law of a particular area from careful reading of the full text of a group of related precedents for all they say that is dispositive and for what they hold....

Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense. [A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the “improvement” is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even common-sensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references.... In situations where a motivation to combine is based on these principles, the invention cannot be said to be nonobvious. Our precedent on this point, moreover, is consistent with the Supreme Court’s holdings in *Graham* and three other obviousness decisions predating the establishment of this court....

Although this court customarily discusses a motivation to combine as part of the first *Graham* factor, the scope and content of the prior art, motivation to combine is also inextricably linked to the level of ordinary skill. If, as is usually the case, no prior art reference contains an express suggestion to combine references, then the level of ordinary skill will often predetermine whether an implicit suggestion exists. Persons of varying degrees of skill not only possess varying bases of knowledge, they also possess varying levels of imagination and ingenuity in the relevant field, particularly with respect to problem-solving abilities. If the level of skill is low, for example that of a mere dyer, as DyStar has suggested, then it may be rational to assume that such an artisan would not think to combine references absent explicit direction in a prior art reference. If, however, as we have held as a matter of law, the level of skill is that of a dyeing process designer, then one can assume comfortably that such an artisan will draw ideas from chemistry and systems engineering—without being told to do so.

For more information on these issues or other intellectual property law matters, please contact **Lawrence M. Sung, Ph.D.** at lsung@nixonpeabody.com or 202-585-8221.

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