Obviousness: Before and After

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Nonobviousness, codified in 35 U.S.C. § 103, has been called "the ultimate condition of patentability" because of its crucial function of weeding out patents on trivial inventions. This requirement asks decision-makers to determine if a patent claim would have been obvious to a person having ordinary skill in the art at the time the patent application was filed. The starting point for modern § 103 jurisprudence is Graham v. John Deere, a Supreme Court decision that appeared to divide evidence bearing on whether a patent claim is obvious into two general categories or tiers. In the first set of inquiries, sometimes referred to as the primary or "prima facie" case of obviousness, tribunals determine the content of relevant pre-patent materials, such as journal publications and other disclosures collectively known as the "prior art," and ascertain the differences between the prior art and the claim at issue. The second category, which the Court actually called "secondary considerations" and treated as a separate factor, includes real-world, and sometimes non-technical, facts such as commercial success of the product covered by the claims and the failure of others to address the problem ultimately solved by the patent. Although courts and commentators disagree vigorously over the relative weight and relevance of primary and secondary evidence, the Graham framework continues to play a central role in the law of § 103.

In this Article, I contend that Graham's primary-secondary heuristic has led to significant errors, and should be rejected in favor of a different approach. Among other problems, the Court's segmenting of the § 103 inquiry into technical and non-technical siloes is causing confusion and leading to mis-evaluations of probative value of certain obviousness evidence, in part by obscuring the significance of time for patent validity inquiries. I thus argue that Graham should be replaced with a framework that better accounts for the crucial role that the Patent Act attaches to the time of patent filing. I maintain that the logically salient way of organizing factual inquiries in § 103 cases is not the primary-secondary divide, but the distinction between evidence that comes into existence before the filing date of the patent application (ex ante) and evidence that appears after that date (ex post). I explain that the proposed categorization will facilitate the task of determining the relevance and weight of various pieces of obviousness evidence and result in more accurate validity determinations relative to the Graham regime. Lastly, I contend that, should we seek to modulate the nonobviousness requirement to increase incentives for post-filing experimentation and commercialization, this Article's framework provides a ready lever for implementing this reform.