

McCombs, Goryunov and Bowser in Reuters: ‘New Patent Office Obviousness Guidance’

April 2, 2024 David McCombs, Jonathan Bowser

PRACTICES Patent Office Trials, Intellectual Property

Haynes Boone Partners [David McCombs](#), [Eugene Goryunov](#) and [Jon Bowser](#) authored an article in *Reuters* discussing the U.S. Patent and Trademark Office’s recently published “Updated Guidance for Making a Proper Determination of Obviousness.”

Read an excerpt below:

The U.S. Patent and Trademark Office (USPTO) recently published an Updated Guidance for Making a Proper Determination of Obviousness. 89 Fed. Reg. 14,449 (Feb. 27, 2024). The updated guidance is not intended to change the law; rather, it serves as a reminder of the flexible approach to obviousness that is mandated by the U.S. Supreme Court’s decision in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

The guidance does not have the force and effect of law at this time, but it provides practical insight into the USPTO’s approach to obviousness for practitioners involved in prosecution and post-grant validity challenges.

The Court in *KSR* explained that the obviousness inquiry articulated in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), demands flexibility. But flexibility can have a fluid meaning. The focus of the guidance, therefore, is to harmonize decisions from the U.S. Court of Appeals for the Federal Circuit that explore and clarify the metes and bounds of the obviousness inquiry. The guidance explains that the *KSR* flexibility applies at least to the scope and content of the prior art; whether a reference is analogous art; and motivation to combine prior art references.

To read the full article in *Reuters*, [click here](#).