THE FEDERAL CIRCUIT AND PATENTABILITY: AN EMPIRICAL ASSESSMENT OF THE LAW OF OBVIOUSNESS

R. POLK WAGNER†
LEE PETHERBRIDGE††

ABSTRACT

It is by now a cliché to suggest that the United States Court of Appeals for the Federal Circuit has weakened the standards for obtaining patents. In this article, we empirically assess that Court's performance on the ultimate question of patentability – the requirement that a patentable invention must be "nonobvious." Our findings suggest that the conventional wisdom may not be well-grounded, at least on this measure.

Nowhere is the Federal Circuit's controversial role as the locus of judicial power in the U.S. Patent system more evident than in the context of the doctrine of obviousness under 35 U.S.C. § 103. The determination of whether an invention was "obvious" to "a person having ordinary skill in the art" at the time the invention was made is the foundation of patentability – and thus at the very core of the patent bargain. And the issue's status as a question of law, as well as the spare statutory language, means that the law of obviousness is entirely a creation of the courts.

In the study reported here, we systematically examine the Federal Circuit's doctrine of obviousness. Using empirical data collected from a novel dataset spanning over fifteen years of jurisprudential pronouncements, we suggest that the Federal Circuit has developed a doctrine in this area that is relatively stable and appears reasonably predictable. Indeed, contrary to much recent commentary, these results suggest that the Federal Circuit's doctrinal toolkit – especially the much-discussed (and oft-maligned) "teaching, suggestion, or motivation" test for combinations of references – has not had a significant observable effect on the results of obviousness cases at that Court.

Although this study falls short of painting a complete picture of the Federal Circuit's performance with respect to patentability, the view that emerges is of a modern jurisprudence of obviousness that is more stable, more consistent, and more flexible than has been heretofore understood. These results, then, should give pause to those who argue for a radical reshaping of the Federal Circuit's doctrine under 35 U.S.C. § 103.

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† Professor of Law, University of Pennsylvania Law School.

†† Associate Professor of Law, Loyola Law School, Los Angeles.