

**DUMB INVENTORS REJOICE: HOW *DAIICHI SANKYO V. APOTEX* VIOLATED
THE FEDERAL PATENT STATUTE**

By NICHOLAS J. GINGO*

INTRODUCTION

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With those two lines, the Federal Circuit Court of Appeals quietly reissued its opinion in *Daiichi Sankyo Co. v. Apotex, Inc.* last autumn. At the time the opinion did not cause much of a stir in the patent community, but it should have had practitioners up in arms. *Daiichi* not only created a three-way split of authority within the Federal Circuit but it also violated section 103(a) of the Patent Act.²

That section was enacted by Congress in 1952 to codify a one-hundred-year-old common law concept known as the nonobviousness requirement.³ It required that, in addition to the previously codified requirements for patentability, an invention would not have been obvious to an average person in the field in order for the invention to qualify for patent protection.⁴

A little more than a decade later, the Supreme Court in *Graham v. John Deere Co.* elaborated on this provision by holding that a court must determine if an invention is obvious in light of the factual background consisting of: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the pertinent art.⁵

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¹ *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1254 (Fed. Cir. 2007).

² 35 U.S.C. § 103(a) (2004).

³ See S. Rep. No. 82-1979 (1952); H.R. Rep. No. 82-1923 (1952).

⁴ Pub. L. No. 82-593, 66 Stat. 792 (codified at 35 U.S.C. § 103(a) (2004)).

⁵ 383 U.S. 1, 15 (1966).

More recently, the Supreme Court reaffirmed this approach in *KSR International Co. v. Teleflex Inc.*⁶ In *KSR* the Court specifically addressed the Federal Circuit's test for determining whether an invention was obvious or not.⁷ Generally, under the Federal Circuit's nonobviousness test, an invention was only obvious if some motivation or suggestion to create the invention was found in the prior art, the nature of the problem to be solved or the knowledge of a person having ordinary skill in the art.⁸ The Supreme Court in *KSR*, however, found that the Federal Circuit had applied the test in a way that had focused too heavily on the prior art and had failed to consider the creativity and knowledge of the person having ordinary skill in the art.⁹

After *KSR*, the Federal Circuit followed the Supreme Court's instruction and issued a string of opinions where it applied its nonobviousness test more broadly, often finding that the patents at issue were obvious because a person having ordinary skill in the art would have been motivated to create the invention based solely on that person's creativity and knowledge.¹⁰

With this post-*KSR* increase in the court's focus on the creativity and knowledge of the person having ordinary skill in the art, the resolution of the level of ordinary skill necessarily becomes much more important to the ultimate nonobviousness determination.¹¹ Unfortunately, the Federal Circuit has provided very little guidance for determining the level of ordinary skill, and has only exacerbated the problem with its recent decision in *Daiichi*.

⁶ 127 S. Ct. 1727, 1739 (2007).

⁷ *Id.* at 1735.

⁸ *Id.* at 1734.

⁹ *Id.* at 1741-2.

¹⁰ *See, e.g.*, *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1262 (Fed. Cir. 2007); *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007); *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1370 (Fed. Cir. 2006); *Alza Corp. v. Mylan Lab., Inc.*, 464 F.3d 1286, 1295 (Fed. Cir. 2006).

¹¹ *See, e.g.*, *DyStar*, 464 F.3d at 1370 (noting that a broader array of inferences will be available to the average worker in the field where the level of ordinary skill in the art is high).

The Federal Circuit first articulated a five-factor test for determining the level of ordinary skill in the art in 1983.¹² Shortly thereafter the Federal Circuit planted the seed for what would eventually blossom into an intracircuit split¹³ when it appeared to add an additional factor—the inventor’s education level—to its level of ordinary skill test.¹⁴ Then, most recently, this factor was put at center stage when it was the only one that the Federal Circuit considered in its determination of the level of ordinary skill in the art in *Daiichi*.¹⁵

This paper argues that the Federal Circuit’s test for determining the level of ordinary skill in the art, as applied in *Daiichi*, was contrary to section 103(a) of the Patent Act,¹⁶ and that the Federal Circuit should return to its original five-factor test, removing the inventor’s level of skill as a sixth factor. By focusing solely on that sixth factor, the test in *Daiichi* conflicted with the first sentence of 35 U.S.C. § 103(a),¹⁷ because it changed the question of nonobviousness from a question of whether an invention would have been obvious to a person having the *ordinary* level of skill in the art to a question of whether an invention would have been obvious to a person having the *inventor’s* level of skill in the art. The test also conflicted with the second sentence of 35 U.S.C. § 103(a),¹⁸ which prohibits limiting the patentability of an invention by the way in which it was made, because it made an invention’s potential nonobviousness dependant upon its inventor.

Returning to its original five-factor test for determining the level of ordinary skill in the art and completely excluding the inventor’s skill level from the analysis would not only bring the

¹² *Orthopedic Equip. Co., Inc. v. United States*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

¹³ *Compare, e.g., Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (considering inventor’s skill level as a possible factor in determining the level of ordinary skill in the art, but noting that it is not conclusive), *with Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (noting that the inventor’s level of skill is irrelevant to the determination of the level of ordinary skill in the art).

¹⁴ *Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983).

¹⁵ *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007).

¹⁶ 35 U.S.C. § 103(a) (2004).

¹⁷ 35 U.S.C. § 103(a) (2004).

¹⁸ *Id.*

test back in line with both sentences of 35 U.S.C. § 103(a)¹⁹, but it would also resolve what has now become a three-way intracircuit split within the Federal Circuit case law.²⁰

Part I of this Article will discuss the developments in nonobviousness law that have put an increased emphasis on the level of ordinary skill in the art. First, Part I will trace the development of the nonobviousness requirement, beginning with its initial articulation by the Supreme Court in *Hotchkiss v. Greenwood* in 1850,²¹ through its codification by Congress in the 1952 Patent Act,²² its subsequent interpretation by the Supreme Court in *Graham* in 1966²³ and its reiteration and clarification by the Supreme Court in *KSR* in 2006.²⁴ Then, Part I will discuss how *KSR*²⁵ and the Federal Circuit's post-*KSR* nonobviousness decisions have placed an increased emphasis on the level of ordinary skill in the art²⁶ and why this is problematic in light of the Federal Circuit's poorly defined test for determining the level of ordinary skill.

Part II of this Article will trace the evolution of the Federal Circuit's test for determining the level of ordinary skill in the art from its adoption to its application in *Daiichi*.²⁷ First, Part II will discuss the initial adoption of the test by the Federal Circuit in 1983²⁸ and its early changes

¹⁹ *Id.*

²⁰ *Compare, e.g., Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007) (considering only the inventor's skill level in determining the level of ordinary skill in the art), *with Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (considering inventor's skill level as a possible factor in determining the level of ordinary skill in the art, but noting that it is not conclusive), *and Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (noting that the inventor's level of skill is irrelevant to the determination of the level of ordinary skill in the art).

²¹ 52 U.S. 248 (1850).

²² Pub. L. No. 82-593, 66 Stat. 792 (codified at 35 U.S.C. §§ 100 et. seq. (2004)).

²³ *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1 (1966).

²⁴ *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

²⁵ *Id.*

²⁶ *Compare, e.g., Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007) (considering only the inventor's skill level in determining the level of ordinary skill in the art), *with Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (considering inventor's skill level as a possible factor in determining the level of ordinary skill in the art, but noting that it is not conclusive), *and Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (noting that the inventor's level of skill is irrelevant to the determination of the level of ordinary skill in the art).

²⁷ *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007).

²⁸ *Orthopedic Equip. Co., Inc. v. United States*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

in that same year.²⁹ Then, Part II will identify the two lines of cases that developed within the Federal Circuit with respect to the inclusion of the skill level of the inventor as a factor over the ensuing two decades.³⁰ Finally, Part II will address the Federal Circuit's decision in *Daiichi*³¹ and how it diverges from both lines of already inconsistent Federal Circuit case law by considering only the inventor's level of skill in determining the level of ordinary skill in the art.

Part III of this Article will discuss why the Federal Circuit's test as applied in *Daiichi*³² is not only inconsistent with previous Federal Circuit case law³³, but also conflicts with section 103(a) of the Patent Act.³⁴ Specifically, this Part will show that the current test is inconsistent with both sentences of 35 U.S.C. § 103(a)³⁵ and thus must be changed.

Finally, Part IV of this Article will recommend the changes that should be made to the Federal Circuit's test for determining the level of ordinary skill in the art. In particular, this Part will suggest that the Federal Circuit return to its original five-factor test and specifically remove the inventor's level of skill from the analysis. Resolving the current intracircuit split in this way will bring the test back into harmony with section 103(a) of the Patent Act.³⁶

²⁹ See, e.g., *Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (introducing the inventor's level of skill as a possible factor); *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Cir. 1983) (including the inventor's level of skill in the list of factors).

³⁰ Compare, e.g., *Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (considering the inventor's level of skill as a possible factor in the determination of the level of ordinary skill in the art) and *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Cir. 1983) (including the inventor's level of skill in the list of factors) with *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (noting that the inventor's level of skill is irrelevant to the determination of the level of ordinary skill in the art).

³¹ *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007).

³² *Id.*

³³ E.g., *Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (considering inventor's skill level as a possible factor in determining the level of ordinary skill in the art, but noting that it is not conclusive); *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (noting that the inventor's level of skill is irrelevant to the determination of the level of ordinary skill in the art).

³⁴ 35 U.S.C. § 103(a) (2004).

³⁵ *Id.*

³⁶ *Id.*

I. NONOBVIOUSNESS THROUGH THE YEARS: THE LEVEL OF ORDINARY SKILL IN THE ART'S INCREASING IMPORTANCE TO THE ULTIMATE ANALYSIS

The nonobviousness requirement for patentability first began to take shape in *Hotchkiss v. Greenwood*, an 1850 Supreme Court opinion.³⁷ The invention in *Hotchkiss* was a knob, for use on a cabinet or door, for example, made from potter's clay rather than the previously used metal or wood.³⁸ In the lower court the patent holder argued for an instruction that, if the construction of the knob had required skill and invention, then the patent was valid. The Circuit Court for the District of Ohio rejected this request and instead charged the jury with instructions that the patent was invalid if “no more ingenuity or skill [was] required to construct the knob in this way than that possessed by an ordinary mechanic acquainted with the business . . .”³⁹ On appeal, the Supreme Court upheld this instruction, reasoning that it was correct in light of the fact that, in order for an invention to be patentable, it had to exhibit a requisite minimum degree of skill and ingenuity beyond that of a skilful mechanic.⁴⁰ This additional requirement for patentability, that an otherwise new and useful invention must be more than just the work of the ordinary mechanic, was adopted and applied by other courts for more than a century before it was finally codified by Congress in 1952.⁴¹

The Patent Act of 1952, which is still in force today, read in part:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.⁴²

³⁷ 52 U.S. 248 (1850).

³⁸ *Id.* at 264.

³⁹ *Id.* at 265.

⁴⁰ *Id.* at 267.

⁴¹ See S. Rep. No. 82-1979 (1952); H.R. Rep. No. 82-1923 (1952) (observing that “[s]ection 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts.”)

⁴² Pub. L. No. 82-593, 66 Stat. 792 (codified at 35 U.S.C. § 103(a) (2004)).

The similarity between the statutory language and the language of *Hotchkiss* a century earlier was admittedly intentional, as Congress explicitly recognized in the legislative history of the Act that it was paraphrasing the common law nonobviousness requirement.⁴³ Congress went on to note that, in doing so, it was attempting to bring order and consistency to this area of patent law, as the expression of the requirement had been made in a “large variety of ways in the decisions of courts and in writings” during its common law evolution.⁴⁴ However, it remained to be seen whether Congress had accurately codified the common law.

In 1966, the Supreme Court in *Graham* addressed Congress’ distillation of the nonobviousness requirement.⁴⁵ The two companion cases presented in *Graham* questioned what effect the 1952 Patent Act had upon “traditional statutory and judicial tests of patentability and what definitive tests [were] now required.”⁴⁶ One patent at issue was for a device designed to absorb shock from plow shanks as they moved through rocky soil, and the second patent was for a hold-down cap to be used on spray bottles, such as insecticide, during shipping.⁴⁷ Both patents had undergone various types of nonobvious analyses in the lower courts, which had been developed in response to the 1952 Patent Act.⁴⁸ The Supreme Court ultimately granted certiorari to provide the lower courts with some direction for performing a proper nonobviousness analysis under the new federal statute.⁴⁹

⁴³ S. Rep. No. 82-1979 (1952); H.R. Rep. No. 82-1923 (1952)

⁴⁴ *Id.*

⁴⁵ *Graham v. John Deere Co. of Kans. City*, 383 U.S. 1 (1966).

⁴⁶ *Id.* at 3.

⁴⁷ *Id.* at 4.

⁴⁸ *Id.*

⁴⁹ *Id.* at 5.

The Court initially noted that Congress had succeeded in codifying the additional requirement for patentability first posited in *Hotchkiss*.⁵⁰ It then went on to outline the appropriate method for determining if an invention was obvious.⁵¹

The Supreme Court explained that, to determine if an invention is obvious, a court must first conduct three factual inquiries.⁵² Specifically, a court needs to: (1) determine the scope and content of the prior art; (2) ascertain the differences between the prior art and the claims at issue; and (3) resolve the level of ordinary skill in the art.⁵³ Then, in light of the factual background created by these three inquiries, the court must determine the obviousness or nonobviousness of the subject matter.⁵⁴ Finally, the Court noted that some “secondary considerations,” such as commercial success, long-felt but unsolved needs and the failure of others to solve the problem at hand, might “. . . be relevant as indicia of obviousness or nonobviousness.”⁵⁵

In explaining this test, the Supreme Court recognized that the nonobviousness decision would not be an easy one, but that the difficulties that would arise would be no more daunting than those faced by courts in other areas of the law.⁵⁶ Ultimately, the Court was confident that Congress’ stated goals of creating uniformity and consistency in patent law would be readily accomplished if the lower courts would follow the specified method for making the nonobviousness decision.⁵⁷ For the next forty years, the Supreme Court was content to leave the nonobviousness analysis in the hands of the lower courts. Then, in 2007, the Court in *KSR v.*

⁵⁰ *Id.* at 15.

⁵¹ *Id.* at 17-8.

⁵² *Id.* at 17.

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ *Id.* at 17-8.

⁵⁶ *Id.* at 18.

⁵⁷ *Id.*

Teleflex decided to revisit the subject of nonobviousness in order to insure that the lower courts were still following the method laid out in *Graham*.⁵⁸

The patent at issue in *KSR* was for an automobile pedal assembly combined with an electronic sensor that sensed the pedal's position and transmitted that information to the throttle control computer.⁵⁹ In determining if the patent was invalid as obvious, the Court of Appeals for the Federal Circuit applied its "teaching, suggestion, or motivation" test ("TSM test").⁶⁰ The TSM test was originally posited by the Court of Claims and Patent Appeals in 1961⁶¹, and was subsequently adopted by the Federal Circuit⁶² shortly after its creation in 1982.⁶³ In theory, under the TSM test, an invention was only obvious if some motivation or suggestion to create the invention was found in the prior art, the nature of the problem to be solved or the knowledge of a person having ordinary skill in the art.⁶⁴ This test, according to the Supreme Court in *KSR*, was not problematic.⁶⁵ What was problematic, however, was how the test had been applied in *KSR* at the Federal Circuit.⁶⁶

Thus, in *KSR* the Supreme Court held that the Federal Circuit had erred in its application of the TSM test by focusing too heavily on the content of the prior art, particularly issued patents and published articles, in its search for the teaching, suggestion or motivation that might render

⁵⁸ *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

⁵⁹ *Id.* at 1734.

⁶⁰ *Id.*

⁶¹ *Id.* at 1741.

⁶² See *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983).

⁶³ For discussions of the creation and history of the Federal Circuit generally, see, e.g., Frank P. Cihlar & Jack C. Goldstein, *A Dialogue About Potential Issues in the Patent Jurisdiction of the Court of Appeals for the Federal Circuit*, 10 Am. Pat. L. Ass'n Q.J. 284 (1982); Howard T. Markey, *The Phoenix Court*, 10 Am. Pat. L. Ass'n Q.J. 227 (1982); Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. Rev. 1 (1989); Daniel J. Meador, *Origin of the Federal Circuit - A Personal Account*, 41 Am. U. L. Rev. 581 (1992); Paul M. Janicke, *To Be Or Not To Be: The Long Gestation of the United States Court of Appeals for the Federal Circuit*, 69 J. Antitrust L. 645 (2002).

⁶⁴ *Id.* at 1734.

⁶⁵ *Id.*

⁶⁶ *Id.*

the claimed invention obvious.⁶⁷ Instead, the Court reaffirmed the “broad” and “flexible” approach of *Graham*, in contrast to the Federal Circuit’s rigid application of its “teaching, suggestion, or motivation” test.⁶⁸ The Supreme Court then went on to note that, just as the TSM test stated in theory, the requisite motivation could also come from the knowledge and creativity of a person having ordinary skill in the art.⁶⁹ Thus, the Supreme Court in *KSR* made it easier for a court to find an invention obvious using the TSM test, since the motivation to create it could come from more than just explicit statements in the prior art.

In response to the Supreme Court’s admonishment in *KSR*, the Federal Circuit issued a string of nonobviousness decisions where it applied the TSM test more broadly than it had before *KSR*, often finding an invention obvious based on a teaching, suggestion or motivation to create the invention found solely within the knowledge and creativity of a person having ordinary skill in the art.⁷⁰ For example, in *In re Translogic Technology, Inc.*, the Federal Circuit held that a person having ordinary skill in the art would have been motivated his own knowledge and creativity to combine a previously known electronic device with a previously known method of arranging different electronic devices to create the invention, an arrangement of those specific electronic devices.⁷¹ In doing so, the court noted that the obviousness analysis did not require “precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person having ordinary skill in the art would employ.”⁷²

⁶⁷ *Id.*

⁶⁸ *Id.* at 1739.

⁶⁹ *Id.* at 1741.

⁷⁰ *See, e.g.*, *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1262 (Fed. Cir. 2007); *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007); *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1370 (Fed. Cir. 2006); *Alza Corp. v. Mylan Lab., Inc.*, 464 F.3d 1286, 1295 (Fed. Cir. 2006).

⁷¹ 504 F.3d at 1262.

⁷² *Id.*

With this increased emphasis on the “inferences and creative steps” of a person having ordinary skill in the art in the Federal Circuit’s post-*KSR* jurisprudence, the way in which the level of ordinary skill is determined becomes much more critical. If the level of ordinary skill in the art is high, then a person having that ordinary level of skill will necessarily be more creative, and thus more inventions will be obvious to that person, than if the level of ordinary skill were lower.⁷³ However, this increased focus on the level of ordinary skill in the art is problematic because the Federal Circuit’s test for determining the level of ordinary skill has been in a state of flux since its adoption in 1983.⁷⁴

II. INCONSISTENT FROM START TO FINISH: THE EVOLUTION OF THE FEDERAL CIRCUIT’S TEST FOR RESOLVING THE LEVEL OF ORDINARY SKILL IN THE ART

The Federal Circuit’s test for determining the level of ordinary skill in the art was first adopted in early 1983, and within the year, it had become the subject of an intracircuit split.⁷⁵ One line of cases argued that the inventor’s skill level might be helpful in determining the ordinary level of skill in the art, but that it was certainly not determinative.⁷⁶ The other line of cases held that the inventor’s skill level had no bearing on the “ordinary” level of skill in the art and thus had no place in the consideration.⁷⁷ The Federal Circuit had an opportunity to resolve

⁷³ See, e.g., *DyStar*, 464 F.3d at 1370 (noting that a broader array of inferences will be available to the average worker in the field where the level of ordinary skill in the art is high).

⁷⁴ Compare, e.g., *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007) (considering only the inventor’s skill level in determining the level of ordinary skill in the art), *with Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (considering inventor’s skill level as a possible factor in determining the level of ordinary skill in the art, but noting that it is not conclusive), *and Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (noting that the inventor’s level of skill is irrelevant to the determination of the level of ordinary skill in the art).

⁷⁵ Compare, e.g., *Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (considering the inventor’s level of skill as a possible factor in the determination of the level of ordinary skill in the art) *and* *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Cir. 1983) (including the inventor’s level of skill in the list of factors) *with Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (noting that the inventor’s level of skill is irrelevant to the determination of the level of ordinary skill in the art).

⁷⁶ See, e.g., *Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983); *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Cir. 1983).

⁷⁷ See, e.g., *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985).

this split in 2007, but instead chose to apply the test in a way that diverged from both lines of previous case law when it considered *only* the inventor's skill level in resolving the level of ordinary skill in the art.⁷⁸

The Federal Circuit's test for determining the level of ordinary skill in the art initially developed over the course of four months in 1983. In March of that year, the Federal Circuit in *Orthopedic Equipment Co. v. United States* adopted a five-factor test that had initially been developed by the U.S. Court of Claims and Patent Appeals.⁷⁹ The invention at issue in *Orthopedic v. United States* was a system for use by businesses, such as retail stores and restaurants, where employees input customer orders into pre-programmed electronic order-taking machines.⁸⁰ One of the questions the court answered on appeal was whether certain claims in the patent were obvious and thus invalid.⁸¹ The court noted that, in order to address that question, it first had to determine the level of ordinary skill in the in art.⁸² The court explained that a number of factors can demonstrate the level of ordinary skill, including : (1) the various prior art approaches employed; (2) the types of problems encountered in the art; (3) the rapidity with which innovations are made; (4) the sophistication of the technology involved; and (5) the educational background of those actively working in the field.⁸³ In light of appellee's evidence, including prior art patents and the testimony and educational qualifications of workers in the art, the Federal Circuit ultimately affirmed the district court's finding regarding the level of ordinary skill in the art, as well as its holding that the claims were invalid for obviousness.⁸⁴

⁷⁸ *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007).

⁷⁹ *Orthopedic Equip. Co., Inc. v. United States*, 702 F.2d 1005, 1011 (Fed. Cir. 1983) (*citing* *Jacobson Bros., Inc. v. United States*, 512 F.2d 1065 (Ct.Cl.1975)).

⁸⁰ *Orthopedic v. United States*, 702 F.2d at 1006.

⁸¹ *Id.*

⁸² *Id.* at 1008.

⁸³ *Id.* at 1011.

⁸⁴ *Id.* at 1013.

Two months later, in *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, the Federal Circuit cited its previous recitation of the factors for determining the level of ordinary skill in the art from *Orthopedic v. United States*, but also appeared to add an additional factor—the education level of the inventor.⁸⁵ The patent at issue was for a knee immobilizer with adjustable Velcro straps.⁸⁶ In analyzing the validity of the patent, the district court identified the ordinary level of skill in the art as that of “an engineer having at least a few years of design experience working in the field of developing orthopedic soft goods” and ultimately found the patent invalid as obvious.⁸⁷ On appeal, the patent holder argued that the district court had set the level of skill at an unnecessarily high level with no evidentiary support.⁸⁸ However, the Federal Circuit noted that the patent holder pointed “to no evidence in the record establishing that the district court’s finding [was] clearly erroneous, although the inventor himself was not an engineer.”⁸⁹ The court then restated the test for determining the level of ordinary skill in the art from *Orthopedic v. United States*, and added that “[a]lthough the educational level of the inventor may be a factor to consider in determining the level of ordinary skill in the art, it is by no means conclusive.”⁹⁰ Ultimately, the court sustained the district court’s determination of the level of ordinary skill (and the patent’s invalidity for being obvious) based on the testimony of the patent-holding company’s president, as well as the experts on both sides, regarding the education level of those in the field, and gave no weight to the inventor’s actual level of education.⁹¹

⁸⁵ *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983).

⁸⁶ *Id.* at 1379.

⁸⁷ *Id.* at 1382.

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.*

Despite the fact that the court in *Orthopedic v. All Orthopedic*⁹² had not actually considered the inventor's level of skill to determine the level of ordinary skill in the art, the decision did appear to have created a six-factor version of the original test. This divergence was confirmed on July 25, 1983, when the court issued two opinions on the same day that articulated different versions of the test to determine the level of ordinary skill in the art.

In *Environmental Designs Ltd v. Union Oil Co. of California*, while considering the invalidity due to obviousness of a patent for a process to remove sulfur from effluent gas, the Federal Circuit cited to *Orthopedic v. All Orthopedic* for the test to determine the level of ordinary skill in the art.⁹³ In doing so, the court included the inventor's skill level directly in the list of factors.⁹⁴ Ultimately the court held that the level of ordinary skill in the art was that of a person with an extensive background in sulfur chemistry, without actually considering the inventor's skill level, but the *Orthopedic v. United States* five-factor test had nonetheless gained an additional factor.⁹⁵

However, this was not the case in another Federal Circuit opinion issued that same day. In *Stratoflex, Inc. v. Aeroquip Corp.*, while considering the same questions of invalidity due to nonobvious that were addressed in *Environmental Designs*, the Federal Circuit panel cited not to *Orthopedic v. All Orthopedic*, but to *Orthopedic v. United States*, for the test to determine the level of ordinary skill in the art.⁹⁶ Although the court did not explicitly list the factors to be considered, it only cited to cases that had used the five-factor test and did not consider the inventor's skill level in determining the ordinary level of skill in the art.⁹⁷

⁹² *Id.*

⁹³ *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Circ. 1983).

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Stratoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530, 1538 (Fed. Cir. 1983).

⁹⁷ *Id.*

For the next several years, the Federal Circuit continued to waver back and forth between the five-factor and six-factor tests.⁹⁸ Then, in 2007, the Federal Circuit had the opportunity to finally resolve this split in *Daiichi Sankyo v. Apotex*.⁹⁹ But, by determining the level of ordinary skill in the art based solely on the education and skill level of the inventors,¹⁰⁰ the court instead created a third line of case law that not only diverged from the first two, but was also contrary to section 103(a) of the Patent Act.¹⁰¹

III. A LOST OPPORTUNITY AND A STATUTORY VIOLATION: *DAIICHI SANKYO V. APOTEX*

The Federal Circuit's decision in *Daiichi* was counter to all of the court's previous case law, because it not only considered the inventor's level of skill, but it also made that factor determinative of the level of ordinary skill in the art. Even more problematic than that, however, is that the decision in *Daiichi* was contrary to section 103(a) of the Patent Act.

A. DIVERGENCE FROM CASE LAW

The patent at issue in *Daiichi* was for a method of treating bacterial ear infections using a topical administration of antibiotic ofloxacin.¹⁰² Following a bench trial, the district court held that the patent was not invalid and was infringed.¹⁰³

⁹⁸ See, e.g., *Stewart-Warner Corp. v. City of Pontiac, Mich.*, 767 F.2d 1563 (Fed. Cir. 1985) (stating no particular test, but noting that the nonobviousness determination is not concerned with the inventor's level of skill but with the level of ordinary skill in the art); *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448 (Fed. Cir. 1985) (stating no particular test but noting that the actual inventor's level of skill was irrelevant to the nonobviousness inquiry); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986) (including the inventor's level of skill in the list of factors for determining the level of ordinary skill in the art); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955 (Fed. Cir. 1986) (omitting the inventor's level of skill from the list of factors for determining the level of ordinary skill in the art); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1991) (including inventor's skill level in the list of factors for determining the level of ordinary skill in the art); *In re GPAC Inc.*, 57 F.3d 1573 (Fed. Cir. 1995) (omitting inventor's skill level from the list of factors for determining the level of ordinary skill in the art); *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554 (Fed. Cir. 1997) (stating no particular test but affirming district court's jury instructions for determining the level of ordinary skill in the art that did not include the inventor's level of skill); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000) (omitting inventor's skill level from the list of factors for determining the level of ordinary skill in the art).

⁹⁹ *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007).

¹⁰⁰ *Id.*

¹⁰¹ 35 U.S.C. § 103(a) (2004).

¹⁰² *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254 (Fed. Cir. 2007).

¹⁰³ *Id.* at 1255.

The district court’s analysis was based on a finding that the level of ordinary skill in the art at the time of the invention was that of a pediatrician or general practitioner of medicine with “basic pharmacological knowledge.”¹⁰⁴ In light of that level of ordinary skill, the district court dismissed a key piece of prior art because it was not within the knowledge of a person having that level of skill in the art.¹⁰⁵ Then, the court held that the invention would not have been obvious to a person having ordinary skill in the art in light of the remaining prior art.¹⁰⁶

On appeal, the Federal Circuit held that the district court’s method for determining the level of ordinary skill in the art had been improper and had in turn tainted the rest of the nonobviousness analysis.¹⁰⁷ The Federal Circuit noted that the district court should have considered the factors from *Environmental Designs* to determine the level of ordinary skill in the art.¹⁰⁸ In doing so, the Federal Circuit appeared to be moving away from its previous line of cases decrying the use of the inventor’s level of skill at all¹⁰⁹ and instead resolving the split in favor of the line of cases in which the inventor’s level of skill was a part of the ordinary level of

¹⁰⁴ *Id.* at 1256.

¹⁰⁵ *Id.* at 1258.

¹⁰⁶ *Id.* at 1256.

¹⁰⁷ *Daiichi*, 501 F.3d at 1257.

¹⁰⁸ *Id.* at 1256. In making its determination of the level of ordinary skill in the art, the district court had begun its analysis using the *Environmental Designs* factors but, because the parties had not submitted anything more than “conclusory arguments” on the subject, the it had ultimately abandoned the factors and instead looked to a prior decision by the Federal Circuit which had held that for a patent on a method of medical treatment, the person skilled in the art was a general practitioner. The Federal Circuit found that this was improper because the level of skill in the art had not been in dispute in that case and thus, those findings had been merely dicta and were not binding.

¹⁰⁹ See, e.g., *Stewart-Warner Corp. v. City of Pontiac, Mich.*, 767 F.2d 1563 (Fed. Cir. 1985) (stating no particular test, but noting that the nonobviousness determination is not concerned with the inventor’s level of skill but with the level of ordinary skill in the art); *Standard Oil Co. v. Am. Cyanamid Co.* 774 F.2d 448 (Fed. Cir. 1985) (stating no particular test but noting that the actual inventor’s level of skill was irrelevant to the nonobviousness inquiry); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955 (Fed. Cir. 1986) (omitting the inventor’s level of skill from the list of factors for determining the level of ordinary skill in the art); *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554 (Fed. Cir. 1997) (stating no particular test but affirming district court’s jury instructions for determining the level of ordinary skill in the art that did not include the inventor’s level of skill); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Circ. 2000) (omitting inventor’s skill level from the list of factors for determining the level of ordinary skill in the art).

skill analysis.¹¹⁰ However, the Federal Circuit then diverged from that line of cases as well, which had explicitly held that the inventor’s skill level was not conclusive, when it focused exclusively on the education level of the inventors in making its own determination of the level of ordinary skill in the art.¹¹¹

The Federal Circuit noted that the inventors were not general practitioners or pediatricians, but were specialists in drug and ear treatments, holding positions as a university professor in otorhinolaryngology, a clinical development department manager involved with new drug development and clinical trials and a research scientist engaged in the development of antibiotics, respectively.¹¹² Further, the court observed, the patent described animal testing and the development of a compound, both of which would have been outside the knowledge and ability of a general practitioner.¹¹³ Then, after making these observations, and with no consideration of the remaining *Environmental Designs* factors, the court held that the level ordinary skill in the art was “that of a person engaged in developing pharmaceutical formulations and treatment methods for the ear or a specialist in ear treatments such as an otologist, otolaryngologist or otorhinolaryngologist who also has training in pharmaceutical formulations”—an amalgamation of the actual skill levels of all three inventors.¹¹⁴

This increased level of ordinary skill in the art was important because the Federal Circuit next reconsidered the prior art reference that the district court had dismissed as being outside of

¹¹⁰ See, e.g., *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986) (including the inventor’s level of skill in the list of factors for determining the level of ordinary skill in the art); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1991) (including inventor’s skill level in the list of factors for determining the level of ordinary skill in the art);

¹¹¹ *Daiichi*, 501 F.3d at 1257.

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Id.* It should be noted that the author does not disagree with the courts’ ultimate conclusion with respect to the level of ordinary skill in the art, but with how the court reached that conclusion (i.e., only considering the skill level of the inventors).

the knowledge of the person having ordinary skill in the art.¹¹⁵ The Federal Circuit determined that this prior art could now be considered, because it would have been within the knowledge of a person having this newly-increased skill level.¹¹⁶ In light of this newly-available prior art, the court determined that the patent at issue would have been obvious to a person having ordinary skill in the art at the time of the invention and was thus invalid.¹¹⁷

By focusing solely on the inventor's level of skill in determining the level of ordinary skill in the art, the Federal Circuit in *Daiichi* diverged from both of its previous lines of case law and in doing so squandered an important opportunity to resolve its intracircuit split. Contrary to the *Orthopedic v. United States* line of cases, *Daiichi* considered the inventor's level of skill in making the determination of the level of ordinary skill in the art, and contrary to the *Orthopedic v. All Orthopedic* line of cases, *Daiichi* made this consideration determinative. Even more problematic than its inconsistency with previous case law, however, is the fact that the decision in *Daiichi* violated section 103(a) of the Patent Act.

B. VIOLATION OF 35 U.S.C. § 103(A)

The Federal Circuit's test for determining the level of ordinary skill in the art, as applied in *Daiichi*, violated both sentences of 35 U.S.C. § 103(a).¹¹⁸ The decision violated the first sentence because the test gauged only the inventor's level of skill, and it violated the second sentence because the test made the patentability of the invention at issue dependant on how it was made. This Part will examine these two issues in turn.

The Federal Circuit's test for determining the level of ordinary skill in the art, as applied in *Daiichi*, violated the first sentence of 35 U.S.C. § 103(a) which reads:

¹¹⁵ *Id.* at 1258.

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 1259.

¹¹⁸ 35 U.S.C. § 103(a) (2004).

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having *ordinary* skill in the art to which said subject matter pertains.¹¹⁹

By considering only the inventor's level of skill in determining the level of ordinary skill in the art, the Federal Circuit's test in *Daiichi* effectively rewrote this sentence to read:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having *the inventor's* skill in the art to which said subject matter pertains.

The problem is that the inventor's skill level will rarely, if ever, be that of the ordinary worker in the field. An inventor is commonly defined as someone who creates something for the first time by imaginative and ingenious thinking and experimentation.¹²⁰ The word "ordinary," on the other hand, implies something routine or usual.¹²¹ Thus, the level of ordinary skill would be the routine or usual level of skill, or the level of skill reflected in the normal order of events. Therefore it is nonsensical to base the determination of the level of *ordinary* skill on the inventor's generally *extraordinary* skill level. The Federal Circuit itself made this argument multiple times in the line of cases that opposed the inclusion of the inventor's skill level as a factor in the level of ordinary skill in the art test.¹²² As the court in *Standard Oil Co. v. Am. Cyanimid Co.* put it:

¹¹⁹ *Id.* (emphasis added).

¹²⁰ <http://www.merriam-webster.com/dictionary/inventor>

¹²¹ <http://www.merriam-webster.com/dictionary/ordinary>

¹²² See, e.g., *Stewart-Warner Corp. v. City of Pontiac, Mich.*, 767 F.2d 1563 (Fed. Cir. 1985) (stating no particular test, but noting that the nonobviousness determination is not concerned with the inventor's level of skill but with the level of ordinary skill in the art); *Standard Oil Co. v. Am. Cyanamid Co.* 774 F.2d 448 (Fed. Cir. 1985) (stating no particular test but noting that the actual inventor's level of skill was irrelevant to the nonobviousness inquiry); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955 (Fed. Cir. 1986) (omitting the inventor's level of skill from the list of factors for determining the level of ordinary skill in the art); *In re GPAC Inc.*, 57 F.3d 1573 (Fed. Cir. 1995) (omitting inventor's skill level from the list of factors for determining the level of ordinary skill in the art); *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554 (Fed. Cir. 1997) (stating no particular test but affirming district court's jury instructions for determining the level of ordinary skill in the art that did not include the inventor's level of skill); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000) (omitting inventor's skill level from the list of factors for determining the level of ordinary skill in the art).

The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of *ordinary* skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something—call it what you will—which sets them apart from the workers of *ordinary* skill A person of ordinary skill in the art is . . . one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.¹²³

Further, even in those previous Federal Circuit cases that did consider the inventor's skill level, including the first one to do so, *Orthopedic v. All Orthopedic*, the court consistently advised that the factor not be viewed as conclusive.¹²⁴ Even the court in *Environmental Designs*, while citing *Orthopedic v. All Orthopedic* and including the inventor's level of skill in its consideration, explicitly observed:

The important consideration lies in the need to adhere to the statute, *i.e.*, to hold that an invention would or would not have been obvious, as a whole, when it was made, to a person of “ordinary skill in the art”—not to the judge, or to a layman, or to those skilled in remote arts, or to geniuses in the art at hand.¹²⁵

The test applied by the Federal Circuit in *Daiichi* considered only the inventor's skill level in determining the level of ordinary skill in the art. Since, by definition, an inventor would tend to have an extraordinary level of skill, considering only this factor would not actually yield the level of *ordinary* skill level in the art. Thus, the Federal Circuit's test for determining the level of ordinary skill in the art, as applied in *Daiichi*, violated the first sentence of 35 U.S.C. § 103(a).

¹²³ Standard Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 454 (Fed. Cir. 1985).

¹²⁴ See, e.g., *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382 (Fed. Cir. 1983) (noting that the inventor's level of skill is a factor but is by no means conclusive); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1991) (observing that in making the nonobviousness determination, the court must determine what is objectively obvious to a person having the ordinary level of skill in the art at the time of the invention, not what would have been subjectively obvious to the inventor at the time of the invention).

¹²⁵ *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Cir. 1983).

The Federal Circuit's test, as applied in *Daiichi*, also violated the second sentence of 35 U.S.C. § 103(a), which reads: "Patentability shall not be negated by the manner in which the invention was made."¹²⁶ This sentence was added by Congress in 1952 as an explicit statement that whether an invention "resulted from long toil and experimentation or a flash of genius" was immaterial to its ultimate patentability, despite what federal courts, including the Supreme Court, had previously held.¹²⁷ However, the Federal Circuit in *Daiichi* violated this prohibition by creating a test that made patentability entirely dependent on the identity of the inventor.

If the inventors in *Daiichi* had not been researchers, but instead had been general practitioners who had merely stumbled upon the invention, the Federal Circuit would have determined that the level of ordinary skill in the art was that of a general practitioner, based solely on consideration of the inventors' skill level. Then, from that point on, the nonobviousness analysis at the Federal Circuit would have been identical to that done at the district court. The key piece of prior art would not have been within the knowledge of the person having ordinary skill in the art and the invention would have been nonobvious and patentable.

However, because the inventors were highly skilled and educated researchers, the Federal Circuit instead found that the level of ordinary skill was that of a highly skilled and educated researcher. In light of that level of ordinary skill, the key piece of prior art was brought back into consideration and the invention was unpatentable as obvious.

Thus, the same invention that was found to be unpatentable by the Federal Circuit in *Daiichi* would have been patentable if it had been made by less skilled inventors. Its patentability

¹²⁶ 35 U.S.C. § 103(a) (2004).

¹²⁷ See 35 U.S.C. § 103 1952 Notes (2004).

was limited by the manner in which it was made, a clear violation of the second sentence of 35 U.S.C. § 103(a).¹²⁸

IV. RECOMMENDING A RETURN TO THE FEDERAL CIRCUIT'S ORIGINAL FIVE-FACTOR TEST IN ORDER TO SATISFY 35 U.S.C. § 103(A)

As described in Part I, the Federal Circuit's post-*KSR* jurisprudence has made the level of ordinary skill in the art central to the ultimate question of nonobviousness and the court must now provide some meaningful guidance in that area. After *Daiichi*, the Federal Circuit will have several alternatives available to it in the next case that it hears involving the level of ordinary skill in the art. The court could follow *Daiichi* and consider only the inventor's level of skill, it could develop an entirely new test, or it could return to the six-factor test from *Environmental Designs*. However, its best option is to return to its original five-factor test, as first adopted in *Orthopedic v. United States*, and explicitly remove the inventor's skill level from the consideration. To do so would not only resolve the current intracircuit split, but would also ensure that the test conforms to 35 U.S.C. § 103(a).

The court could continue to apply the test in *Daiichi*, considering only the inventor's level of skill. However, this would violate section 103(a) of the Patent Act for the reasons outlined in Part III above.

Alternatively, the court could develop an entirely new ordinary skill in the art test. But this would essentially create a four-way split within the Federal Circuit regarding the proper test for resolving the level of ordinary skill, leading to more confusion in the lower courts.

The court could also go back to the previous six-factor test from *Environmental Designs*. However, this would allow for the possibility of a *Daiichi*-like outcome. If the court were to

¹²⁸ This would become even more apparent if the Federal Circuit were to make the leap to determining nonobviousness from the perspective, not of the person having the inventor's level of skill, as it did in *Daiichi*, but from the perspective of the inventor. In that case, nearly every invention would be obvious, even those discovered in a flash of genius –the only exception would be those inventions that were discovered by complete accident!

give the inventor's skill level a disproportionate amount of weight, the test would still violate 35 U.S.C. § 103(a) in the same way that *Daiichi* did, even if the factor were not considered dispositive. The test would no longer determine the ordinary level of skill, and the patentability of the invention would be dependant upon the way in which the invention was made.

Instead, the court should resolve the current intracircuit split in favor of the original five-factor test that was adopted in *Orthopedic v. United States*. Doing so would ensure that the Federal Circuit's test could not be applied in a way that would violate section 103(a) of the Patent Act. By removing the inventor's level of skill from the level of ordinary skill in the art analysis, the five-factor test would result in a more objective and realistic determination of the ordinary skill level in the art, as required by the first sentence of 35 U.S.C. § 103(a). Additionally, it would not condition an invention's patentability on the method in which the invention was made, as required by the second sentence of 35 U.S.C. § 103(a).

The five-factor test would better conform with the first sentence of 35 U.S.C. § 103(a), because the factors that make up that test, which include (1) the various prior art approaches employed, (2) the types of problems encountered in the art, (3) the rapidity with which innovations are made, (4) the sophistication of the technology involved, and (5) the educational background of those actively working in the field¹²⁹ are much more objective than the inventor's skill level alone. Thus they would lead to a more realistic analysis of the actual ordinary level of skill across the field of art, which might vary significantly from the individual inventor's skill level.¹³⁰

¹²⁹ *Orthopedic Equip. Co., Inc. v. United States*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

¹³⁰ Furthermore, even in those rare cases where the inventor did possess the ordinary level of skill in the field, these five factors alone could still be used to determine the level of ordinary skill in the art with no risk of violating 35 U.S.C. § 103(a).

The five-factor test would also satisfy the second sentence of 35 U.S.C. § 103(a). It would remove any possibility that the ordinary skill level might be determined by reference to the inventor's level of skill, which would make the nonobviousness (and therefore patentability) of an invention dependant upon the method by which the invention was made. The objective nature of the factors would help to define a background level of skill in the art that would not fluctuate with the individual inventor's skill level.

The efficacy of this test has already been demonstrated in the previously-discussed line of cases in which the Federal Circuit refused to consider the inventor's level of skill. In all of those cases, the court was able to ascertain the level of ordinary skill in the art with enough clarity to make the ultimate nonobviousness determination without resorting to the consideration of the inventor's level of skill and while remaining completely within the bounds of section 103(a) of the Patent Act.