“Well, isn’t that about as obvious as it comes?”

The Art of Assessing Obviousness

Section 103: Inside the PTO KSR Guidelines

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Section 103: Inside the PTO KSR Guidelines

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Graham Factors (pp. 17-18):

- Scope and content of the prior art are to be determined;
- Differences between the prior art and the claims at issue are to be ascertained;
- the POSITA in the pertinent art resolved; and
- Secondary considerations surrounding the origin of the subject matter sought to be patented.
The examiner’s obviousness rejection should contain the following:

1. An understanding of technology underlying both the invention and the prior art.
2. A determination of what is actually disclosed by the prior art.
3. Claim elements mapped to specific disclosures in the prior art.
4. All elements addressed.
5. A detailed explanation regarding the combination used in the rejection.
6. Reasonable rationales to combine provided.

TAKE AWAY: Review the obviousness rejection and identify whether the rejection follows the practices of the Patent Office.
Patent Office’s KSR Guidelines

A. Combining prior art elements according to known methods to yield predictable results

B. Simple substitution of one known element for another to obtain predictable results

C. Use of known technique to improve similar devices (methods, or products) in the same way

D. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results
E. “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success

F. Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art

G. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention
Exercise – How to Respond

A person of ordinary skill in the art would have found it obvious at the time the invention was made to have combined the teachings of Smith in view of Jones. The well known elements described are merely a combination of old elements, in the combination, each element merely would have performed the same function as it did separately, and person of ordinary skill in the art would have recognized that the results of the combination were predictable.
Tools to Traverse the Examiner’s Obviousness Rejection, the Examiner’s Reason to Combine, and the Reasonable Expectation of Success concerning the combined teachings of the prior art
1. Does the obviousness rejection identify all claim limitations.

If just one claim limitation is not accounted for, then the examiner has failed to present a prima facie case of obviousness.
2. Teaching Away.

Option 1: (Reversals)

In *KSR*, the Supreme Court held that “when the prior art teaches away from combining the certain known elements, discovery of a successful means of combining them more likely to be nonobvious. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

Option 2: (Affirmances)

Whether a reference teaches away from a claimed invention is a question of fact. See *In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005).
3. More than a simple substitution.

The Supreme Court stated that in cases involving more than the simple substitution of one known element for another, or the mere application of a known technique to a piece of prior art ready for the improvement, it will be necessary to “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417-418 (2007).
4. What rational underpinnings are present for the reason to combine the teaching of the references?

There has to be some underlying pieces of evidence within the record that are the “rational underpinnings” for the reason to combine in the manner presented in the obviousness rejection.

A proposed modification that changes the principle of operation of a device disclosed in a primary reference, or which requires substantial reconstruction of the device, might support a conclusion of obviousness if the Examiner identifies a persuasive reason why one of ordinary skill in the art might have undertaken the modification. However, if the degree of modification that would have been required is significant, then proposed modification would not have been a “mere substitution of one element for another known in the field.” See *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).
6. Examiner’s modifications defeats the purpose of a reference, a reference becomes inoperable, renders a reference unsatisfactory for its intended purpose.

In relying on a combination of prior art references, the examiner’s proposed modification cannot render a prior art reference unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).
7. Pure Hindsight Reconstruction.

Option 1: Admit that examination is done in hindsight and the examiner’s basis for the rejection went beyond what would be permissible.

Option 2: Attack the rejection as being one of hindsight rejection since all the examiner has done is reconstruction the claimed invention.

Option 3: Sound like a Justice, explain the whole law and explain sympathetically to the examiner that he cannot help but fall into the hindsight trap.
8. Knowledge alone is not a good enough rationale to combine the teachings of the prior art, i.e., “because such a modification was within the knowledge of a person of ordinary skill in the art.”

Examiner’s says “its obvious to try”

No evidence or explanation in the record that would lead to this solution.
RETRACING IN THE LIGHT OF KNOWLEDGE
AT THE TIME OF THE FILING/INVENTION
IS OKAY
9. The Examiner reasoning to combine the references generates a problem in order to solve the problem.

In order to reach the claimed invention with the ground of rejection, the examiner creates the problem in the primary reference in order to solve the problem with the secondary reference that did not exist within the primary reference, but for the Examiner wanting to modify the primary reference with the secondary reference in order to reject the claim.
10. Examiner using one structure for two claimed elements.

*Lantech, Inc. v. Keip Machine Co.*, 32 F.3d 542 (Fed. Cir. 1994)(in infringement context, a single conveyor held to not meet claim element requiring at least two conveyors).

*In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999)(claim requiring three separate means not anticipated by structure containing two means where one of the two means was argued to meet two of the three claimed means).
11. The Rambling Examiner.

Examination “shall be complete with respect . . . to the patentability of the invention as claimed.” 37 C.F.R. 1.104(a)(1) (emphasis added). “When a reference is complex . . ., the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 C.F.R. 1.104(c)(2) (emphasis added). It is unclear from the record how the teachings and disclosures of the prior art references are being applied by the Examiner to reject the currently pending claims. Quotation of an unidentified portion of Hara that does not pertain to any of the claim limitations coupled with a citation to the entire reference, does not designate the particular part of the reference relied upon as nearly as practicable.

“[T]he Board's primary role is to review adverse decisions of examiners including the findings and conclusions made by the examiner.” Ex parte Frye, 94 USPQ2d 1072, 1077 (BPAI 2010) (precedential). See also 37 C.F.R. 41.50(a)(1) (“The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner”). Where, as in the instant case, the Examiner has provided a general discussion of the prior art without reference to elements disclosed in the prior art or to the limitations in the claims, the Examiner has failed to comply with Rules 1.104(a)(1) and (c)(2) and fails to establish a record for our review. Accordingly, the Examiner fails to make a prima facie case of obviousness.

12. The Examiner is using prophetic language in the reference to support the rejection.

Notwithstanding the relatively ambitious language appearing in the Smith patent [usually in the summary of the invention or at the end of the specification], Smith never expressly discloses that the apparatus would be suitable for use in conveying objects lying on their sides (as is intimated by the Examiner).
13. Examiner is speculating.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 1054-55 (CCPA 1976).
15. Sparse technical disclosure.

A reference relied on to prove unpatentability must be so clear and explicit that those skilled in the art will have no difficulty in ascertaining its meaning. See *In re Turlay*, 304 F.2d 893, 899 (CCPA 1962).
16. Modifying the modifying reference is indicative of hindsight reconstruction and ex post facto reasoning.

The Examiner has to modify the secondary reference, usually with a third reference, in order to reach a claim limitation with the combination of the primary and secondary references.

Look for A in view of B further in view of C where C is being used to modify B not A.

Such a technique to render obvious a claim was considered hindsight reconstruction.
17. *Per se* rule of obviousness.

*In re Ochiai,* 71 F.3d 1565, 1572 (Fed. Cir. 1995) (“The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention—including all its limitations—with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO Examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any rules of obviousness, just as those precedents themselves expressly declined to create such rules.”)
18. Analogous art (a difficult issue to argue because KSR expanded it).

The test for whether a prior art reference is “analogous” was recently summarized by the Federal Circuit as:

1. whether the art is from the same field of endeavor, regardless of the problem addressed.

2. if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

_In re Klein_, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (quoting _In re Bigio_, 381 F.3d 1320, 1325 (Fed. Cir. 2004)).
“Teaching Moments”
“Teaching Moments”

*Smith & Nephew, Inc. v. Rea, 721 F.3d 1371 (Fed. Cir. 2013)*

While the substantial evidence standard of review requires a deferential approach to the findings of the PTAB, that does not preclude the Federal Circuit from reversing the PTAB based on analytical errors identified when the facts are largely undisputed.
“Teaching Moments”

Randall Mfg. v. Rea, 733 F.3d 1355 (Fed. Cir. 2013)

When supported by AMPLE, AMPLE evidence from the record, common knowledge and common sense must be consulted when considering whether a claimed invention would have been obvious to a person of ordinary skill in the art.
“Teaching Moments”

*Institut Pasteur & Univ. Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337 (Fed. Cir. 2013)

Obviousness requires that a person of ordinary skill in the art have reasonably expected success in achieving the known goal. The expectation-of-success analysis must match the desire goal and not switch to a different goal that may be less challenging but also a less worthwhile pursuit.
“Teaching Moments”


“Physical capability alone does not render obvious that which is contraindicated,” *id.* at 4. “Don’t pull it when it says push it.”

The proper inquiry for all obviousness rejections is whether it would have been obvious to modifying the prior art to arrive at the claim invention’s function; not whether the prior art could be capable of performing the function. The former requires evidence in the record demonstrating that it would be obviousness to modify; an examiner’s or the Board’s belief (personal view) is insufficient to establish the prima facie case.
Reaffirming the importance of evaluating objective evidence of nonobviousness in the obviousness analysis

Objective evidence of nonobviousness is too often treated as “secondary considerations.”
48 days & three decisions later


Apple v. ITC
Take Away- Deal With It

• The Federal Circuit stated that “[t]he ultimate conclusion of obviousness is a legal conclusion to be reached after weighting all of the evidence on both sides.”
Leo Pharma v. Rea

Take Away – It is not considered as an afterthought

• Whether, in light of the prior art references and objective indicia of nonobviousness, the claimed invention would have been obvious to a person of ordinary skill in the art at the time just before the time of invention.
Leo Pharma v. Rea

Given the evidence, Leo’s inventors recognized and solved a problem that:

• the prior art did not recognize and
• was not solved for over a decade.
Leo Pharma v. Rea

The Federal Circuit viewed that the POSITA would need to recognize the problem by running months of tests, once recognized turn to the prior art an attempt to develop a new formulation to address the problem. If this was so easy, then it would have been done within months of the publication of the prior art.
Rambus v. Rea

Take Away – It just needs to be reasonably commensurate

Rambus presented Industry articles that stated

– “operat[es] with a 250–MHz clock and transfer[s] a byte of data on each clock edge”

– “by using both edges of a 250–MHz clock,”… “will deliver a tenfold increase in component throughput”
**Rambus v. Rea**

**Claim**

- providing a first portion of data to the memory device synchronously with respect to a rising edge transition of an external clock signal; and

- providing a second portion of data to the memory device synchronously with respect to a falling edge transition of the external clock signal.

**Articles**

- “operat[es] with a 250–MHz clock and transfer[s] a byte of data on each clock edge”

- “by using both edges of a 250–MHz clock,”… “will deliver a tenfold increase in component throughput”
When presented with secondary consideration evidence, tribunals need to deal with it contemporaneously with all other evidence, and not be so strict about the evidence being directly related to the claimed subject matter.
Questions?