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

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A Judge on the Court of Appeals for Federal Circuit, in oral argument, posed the above title question to counsel. The question reflects the apparent state of affairs within the Patent Office concerning the issue of obviousness. This paper will identify what a proper obviousness rejection should contain in order for the Patent Office to discharge its burden of producing a prima facie case of obviousness. Next, the seven rationales that the Patent Office has been training the Patent Examining Corps on will be provided along with the actual citation to KSR that is the basis for the rationale. Also, the paper classifies common issues revolving around a stated obviousness rejection and will provide strategies to counter the examiner’s prima facie case of obviousness. This paper will discuss recent corrections the Federal Circuit has given to the Patent Trial and Appeal Board concerning obviousness. Finally, the paper will report on the Federal Circuit’s apparent reaffirmance of the importance of evaluating objective evidence of nonobviousness in the obviousness analysis.

The intent of this paper is to be a take-away guide for immediate use in the practice of traversing an examiner’s obviousness rejection.

Procedural Mechanics of the Obviousness Rejection

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.
The Patent Academy trains new examiners to follow these steps for setting up a prima facie case of obviousness (e.g., A in view of B):

1. What the primary reference A teaches (item to item matching).
2. What the primary reference A lacks.
3. What the secondary reference B teaches (identify teaching of missing claimed element) (if necessary).
4. How the primary reference A is modified.
5. It would have been obvious to one of ordinary skill in the art at the time of the invention to (explain the modification).

The Patent Academy trainers inform the examiners that their obviousness rejections should answer the following questions:

1. What does the prior teach? Describe what each teaches separately. (What does Reference A teach? What does Reference B teach?)
2. What is/are the difference(s) in the claim over the applied reference(s)? (The difference between the instant claims and the prior art that Reference A does not teach, but Reference B does teach)
3. What is the modification of the applied reference(s) to arrive at the claimed subject matter; and
4. Why would the modification have been obvious to one of ordinary skill in the art at the time the invention was made?

Accordingly, practitioners should review the obviousness rejection and identify whether the rejection follows the practices of the Patent Office. If not, then the practitioner should identify the procedural deficiency in the response to the rejection; and if need be, raise the issue to the supervisor.

**Patent Office’s KSR Guidelines**

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), stated that “[R]ejections on
obviousness cannot be sustained by mere conclusory statements; instead, there must be some
articulated reasoning with some rational underpinning to support the legal conclusion of

Exemplary rationales that may support a conclusion of obviousness include:

(A) Combining prior art elements according to known methods to yield predictable results;

In *KSR*, the Supreme Court held that “[t]he combination of familiar elements according to
known methods is likely to be obvious when it does no more than yield predictable
results.” *KSR*, 550 U.S. at 416.

(B) Simple substitution of one known element for another to obtain predictable results;

In *KSR*, the Supreme Court held that “when a patent claims a structure already known in
the prior art that is altered by the mere substitution of one element for another known in
the field, the combination must do more than yield a predictable result.” *KSR*, 550 U.S.
at 416.

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

In *KSR*, the Supreme Court held that “if a technique has been used to improve one device,
and a person of ordinary skill in the art would recognize that it would improve similar
devices in the same way, using the technique is obvious unless its actual application is
beyond his or her skill.” *KSR*, 550 U.S. at 417.

(D) Applying a known technique to a known device (method, or product) ready for improvement
to yield predictable results;

In *KSR*, the Supreme Court held that “if a technique has been used to improve one device,
and a person of ordinary skill in the art would recognize that it would improve similar
devices in the same way, using the technique is obvious unless its actual application is
beyond his or her skill.” *KSR*, 550 U.S. at 417.

(E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a
reasonable expectation of success;

In *KSR*, the Supreme Court held that “[w]here there is a design need or market pressure
to solve a problem and there are a finite number of identified, predictable solutions, a
person of ordinary skill has good reason to pursue the known options within his or her
technical grasp. If this leads to the anticipated success, it is likely the product not of
innovation but of ordinary skill and common sense. In that instance the fact that a
combination was obvious to try might show that it was obvious under § 103.” *KSR*, 550
U.S. at 421.
(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;

In *KSR*, the Supreme Court held “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative — a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417.

(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.

In *KSR*, the Supreme Court stated that:

Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents. … There is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis. But when a court transforms the general principle into a rigid rule that limits the obviousness inquiry, as the Court of Appeals did here, it errs.

*KSR*, 550 U.S. at 419.

**Other KSR pronouncements that the Patent Office uses to support the obviousness rejection.**

*Person of Ordinary Skill in the Art*

In *KSR*, the Supreme Court held that “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR*, 550 U.S. at 421.

*Familiar Items - Obvious Uses*

Familiar items may have obvious uses beyond their primary purpose. *KSR*, 550 U.S. at 420 (“Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill in the art will be able to fit the teachings of multiple patents like pieces of a puzzle.”)
Countering the examiner’s obviousness rejection.

“Section 103 forbids issuance of a patent when ‘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.’” KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). See also KSR, 550 U.S. at 406-407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”)

In KSR, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” id. at 415, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in Graham reaffirmed the ‘functional approach’ of Hotchkiss, 11 How. 248.” KSR, 550 U.S. at 415 (citing Graham, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” Id. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” Id.

The Supreme Court stated that there are “[t]hree cases decided after Graham [that] illustrate the application of this doctrine.” Id. at 416. “In United States v. Adams, … [t]he Court
recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 416. “Sakraida and Anderson’s-Black Rock are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 417.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve 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.” *Id.* The Court explained:

> Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

*Id.* at 418. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out 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 of ordinary skill in the art would employ.” *Id.*

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). There is no legally recognizable essential gist or heart of the invention. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548 (Fed.Cir.1983), *cert. denied*, 469 U.S. 851 (1984). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Id.* at 1551, 1553.

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**Shorthand for the above - Examiner erred because of error in findings of fact (it is not present in the references)**
A claim is unpatentable under 35 U.S.C. § 103(a) 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.” The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406-07 (2007)(“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”).

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. The key to supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). *See also KSR*, 550 U.S. at 418.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). There is no legally recognizable essential gist or heart of the invention. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Id.* at 1551, 1553.

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.
It is elementary that to support an obviousness rejection “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

2. Teaching Away.

Option 1:

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). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). “When a piece of prior art ‘suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant’ the piece of prior art is said to ‘teach away’ from the claimed invention.” Medicem, S.A. v. Rolabo, S.L., 437 F.3d 1157, 1165 (Fed. Cir. 2006) (quoting In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994)). Additionally, a reference may teach away from a use when that use would render the result inoperable. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1354 (Fed. Cir. 2001).

This has resulted in a situation in which the Examiner has erroneously failed to take into account the teachings of the reference as a whole, including portions that, as we have herein found, teach away from the claimed invention. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987) (error to not consider prior patent in its entirety, i.e., as a whole, including portions that would lead away from the invention).

Option 2 is presented in order to remember In re Fulton and factor that holding into the practitioner’s argument.

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). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, … would be led in a direction divergent from the path that was taken by the applicant.” In re Haruna, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (quoting Tec Air, Inc. v. Denso Mfg. Mich., Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999)). “When a piece of prior art ‘suggests that the line of development flowing from the reference’s
disclosure is unlikely to be productive of the result sought by the applicant” the piece of prior art is said to ‘teach away’ from the claimed invention.” Medichem, S.A. v. Rolabo, S.L., 437 F.3d 1157, 1165 (Fed. Cir. 2006) (quoting In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994)). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983). However, “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed….” In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

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). The Supreme Court provided such instruction because the Court noted that “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” KSR, 550 U.S. at 418-19. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” Id. at 418 (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)

Example:

This case is not seen as being an obvious combination of prior art elements or simple substitution of one known element for another, leading to predictable results, or any other indicator of potential obviousness. Rather the extensive amount of modification needed is suggested nowhere in the cited art, and is born from the use of impermissible hindsight reconstruction in view of Appellant’s Specification.
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. For instance, in *KSR*, the Court found at the time of pedal design there existed a marketplace that created incentive to convert mechanical pedals to electronic pedals. Absence of rational underpinnings means that the reasoning to combine is conclusory. “(T)here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).


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). Rather, the Examiner’s reasoning will appear to demonstrate little more than “that each of [the elements of the claimed subject matter] was, independently, known in the prior art,” *Id.* at 418, an approach rejected by the Supreme Court. *See also In re Ratti*, 270 F.2d 810, 813 (CCPA 1959) (“This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principles under which the [primary reference] construction was designed to operate.” (Emphasis added)). In *Ratti*, the modification suggested by the examiner changed the basic principle of sealing from attaining sealing through a rigid, press-fit, interface between the components, to attaining sealing by providing a resilient interface between the components. *Id.* at 811-13. This modification fundamentally changed the technical basis of how a seal performed its sealing function and how a sealed interface was attained.

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). *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) (Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious).

As such, argue that suggested combination of references would require a substantial reconstruction and redesign of the elements shown in reference A as well as a change in the basic principles under which the reference A construction was designed to operate.

Example:

On the basis of our findings above, Appellants’ position is well taken. Specifically, we find that the sound attenuation panels of Henry and Michele rely on a perforated or porous outer sheet to provide continuous communication between the honeycomb core cells and the atmosphere adjacent to the noise to be attenuated. Accordingly, affixing a solid, imperforate structure as taught by Dean to the perforated or porous sheet of the sound attenuation panel of either Henry or Michele would render the sound attenuation panel unsuitable for its intended purpose, and thus would not have been obvious. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) (Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious).

The Examiner’s proposal to provide the ice protection system as a metal wire mesh is unsound for two reasons. First, there is no teaching in the applied references to do so. 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). Second, even if the conducting layer were made of a metal wire mesh, Dean’s heating apparatus further utilizes multiple layers of insulation and adhesive, and a metallic grounded layer, which would block the perforations of the sound attenuation panel outer sheet, thus rendering the sound attenuation panel unsuitable for its intended purpose. As pointed out by Appellants, Dean’s heating apparatus would not operate as intended if any of those layers were
perforated to provide continuous communication between the honeycomb core cells and the atmosphere adjacent to the noise to be attenuated. In light of the above, we agree with Appellants that the combination of the heating apparatus of Dean with the sound attenuation panel of either Henry or Michele in a manner to arrive at the subject matter of claims 1 and 10 would not have been obvious.

7. Pure Hindsight Reconstruction (a difficult one to persuade with; best to pair hindsight with another strategy, e.g., more than a simple substitution, defeats the purpose of a reference, a reference becomes inoperable, renders a reference unsatisfactory for its intended purpose).

Option 1 with example:

“Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant’s invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor.” In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). As such, the fact finder must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.” KSR, 550 U.S. at 421(citing the warning in Graham, 383 U.S. at 36, against the “temptation to read into the prior art the teachings of the invention in issue”).

In this case, the Examiner has not articulated a reasonable basis with rational underpinnings as to how the two references of Smith and Jones could be combined to render the claimed subject matter prima facie obvious. For example, it is unclear the rational basis for combining the two references and leaving one piece adjustable along the axis longitudinally, while supplying another piece that is adjustable not longitudinally but in a perpendicular fashion. The only suggestion for providing two pieces with different adjustability appears to come from Applicant’s own disclosure. It is improper to base a conclusion of obviousness upon facts gleaned only through hindsight. See, e.g., W.L. Gore and Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Option 2 with example:

“To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.”
By using knowledge gleaned only from Appellant’s claimed solution, the Examiner improperly relied on hindsight to determine the scope and content of the prior art relevant to obviousness. Reconstructing the Appellant’s invention only with the benefit of hindsight is insufficient to establish a prima facie case of obviousness. It has not been shown that a person of ordinary skill would reasonably be expected to seek the teachings of reference A and apply it to reference B without the benefit of hindsight.

Option 3 (note the holding of Lear Siegler, the practitioner factor in that holding):

The determination of the content of the prior art under Graham must be done with a view of the prior art at the time of invention to avoid impermissible hindsight. “It is difficult but necessary that the decision maker forget what he or she has been taught … about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art….,” W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). However, while the requirement for a teaching, suggestion, or motivation (the TSM test) to combine known elements in order to show that the combination would have been obvious may be “a helpful insight,” it cannot be used as a rigid and mandatory formula. KSR, 550 U.S. at 419. Moreover, the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment. See Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889 (Fed. Cir. 1984).

8. Does the Examiner reasoning to combine the references generate a problem in order to solve the problem?

Frequently overlooked; it looks like this. Claim is directed to a unitary structure. The primary reference discloses the structure except instead of it being unitary, little pieces fit into a big piece. The secondary reference teaches an analogous unitary structure; but it does not have all of the structure as called for in the claim. The examiner’s reason to combine is to eliminate the risk of rendering the big piece inoperable due to a loss of the little pieces. There is no evidence in the record of a problem of pieces being lost.
The problem with this reasoning is that the examiner has specifically created this problem of losing pieces in order to solve it and provide a reason for combining the references; here prevent the loss of little pieces. Again, a lack of evidence leads to a lack of rational underpinnings to support the conclusion of obviousness. In order to reach the claimed invention with the ground of rejection, the examiner creates the problem 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.

9. **Examiner using one structure for two claimed elements.**

Consistent with the principle that all limitations in a claim must be considered to be meaningful, it is improper to rely on the same structure in the Smith reference as being responsive to two different elements (wall and openable panel in the wall) in claim 1. *See, 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).

10. **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.” No evidence or explanation in the record that would lead to this solution.**

Example:

Even assuming for sake of argument that a person of ordinary skill in the art knew that a generally trapezoidal shaped block may be used to create a curved retaining wall, such knowledge alone is not an adequate rationale for the proposed modification. A person of ordinary skill in the design of landscaping blocks may have knowledge of numerous modifications or methods permitting Smith’s landscaping blocks to be used to create a curved retaining wall. The rationale fails to explain, of the numerous possible modifications and methods, what would have led a person of ordinary skill in the art to modify Smith’s blocks to have a generally trapezoidal shape. Absent such an explanation, we see no reason other than
hindsight that a person of ordinary skill in the art would have modified Smith’s block to have a generally trapezoidal shape.

11. The Rambling Examiner.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992); see also In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The Examiner’s explanation of the rejection consists of nothing more than a series of essentially unconnected discussions of selected teachings of references followed by a conclusory statement of obviousness. The determination as to whether there was an apparent reason to combine the known elements of A, B, C, and D in the manner claimed requires an analysis regarding the teachings of A, B, C, and D, and the knowledge of a person having ordinary skill in the art. However, the Examiner has not provided an analysis as to how the known elements of A, B, C, and D would be combined in the manner called for in the claims.

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 (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.

Example:

We agree with Appellants that the only reason that the Examiner uses both Smith and Jones to modify Adams is a hindsight reconstruction of the claimed subject matter. The Examiner posits the replacement of Adams’s rod or Bowden cable by the use of metal cable 24 of Smith. But the Examiner is not finished. He must further modify this cable mechanism to meet the claim limitation of helical winding around the motor shaft. In the past, when per se rules of obviousness were used in rejections in the Patent and Trademark Office, the further modification of a modifying reference was looked upon as a sure sign of hindsight. While per se rules of obviousness have gone from the scene, we think this rule is still indicative of a rejection that lacks a rational underpinning.

17. Per se rule of obviousness.

Option 1 with Example:

When determining whether a claim is obvious, an Examiner must make “a searching comparison of the claimed invention – including all its limitations – with the teachings of the prior art.” In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Reliance solely on a per se rule of obviousness is improper. Id. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 417-18 (2007).

The Examiner finds that Rogers does not disclose the indicia having a longitudinal length of a first pair, which is less than the longitudinal length of a second pair. Stated otherwise, Rogers does not describe the second pair of indicia as being taller than the first pair of indicia.
Nevertheless, the Examiner concludes that the recited differences in the heights of the indicia are not a patentable distinction.

The Examiner relies on *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984) and incorrectly finds the Appellant’s fastening system would not perform differently than the balloon indicia of Roger and as such the height of the second pair of indicia is not a patentable distinction.

This analysis substitutes a *per se* rule of obviousness, namely, that different size as a general proposition is not a patentable distinction, for an apparent reason to modify Roger’s indicia underpinned by a careful consideration of the facts. No comparison is provided between the facts of *Gardner* and the facts of the underlying application to explain how the holding of *Gardner* applies to the claims on appeal. As such the Examiner’s proposed reason why the height of the indicia is not a patentable distinction is not persuasive of the obviousness of the subject matter of claim 1.

Option 2:

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.

*In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

Option 3:
Per se rules directed to the alleged obviousness of a claimed invention are looked upon with disfavor. See, In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (reliance on per se rules of obviousness that eliminate the need for fact-specific analysis of claims and prior art is legally incorrect.)

18. Analogous art (a difficult issue to argue because KSR expanded it).

Option 1 (demonstrates the difficulty):

The determination of the scope and content of the prior art includes determining whether prior art references are “analogous.” Whether a reference in the prior art is “analogous” is a fact question. In re Clay, 966 F.2d 656, 658 (Fed. Cir. 1992) citing Panduit Corp. v. Dennison Mfg., 810 F.2d 1561, 1568 n.9 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (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. Id., citing In re Deminski, 796 F.2d 436, 442 (Fed. Cir. 1986); In re Wood, 599 F.2d 1032, 1036 (CCPA 1979). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” In re Clay, 966 F.2d at 659.

Option 2 (extends what is analogous art):

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. In other words, “familiar items may have obvious uses beyond their primary purposes.”

In re ICON Health & Fitness, Inc., 496 F.3d 1374, 1379-80 (Fed. Cir. 2007) (citations omitted).

Moreover, in making a determination with regard to obviousness, we should not limit ourselves to looking only at the problem Appellant was trying to solve. The question is not whether the combination was obvious to Appellant, but whether it was obvious to a person of ordinary skill in the art. Thus, “[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for

Non-analogous art summarized by the Federal Circuit as:
1. whether the art is from the same field of endeavor, regardless of the problem addressed and,
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)*)

**Option 3:**

The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.

*In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).* References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’ in other words, common sense in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting *In re Wood, 599 F.2d 1032, 1036 (CCPA 1979)*)).

*In re Kahn, 441 F.3d 977, 986-87 (Fed. Cir. 2006).*

**Teaching Moments from the Federal Circuit**

*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.

*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.
When the Examiner says it is common sense to do something, challenge the Examiner to provide the evidence, and cite to this case and the amount of evidence that was present to support the determination the common knowledge and common sense renders obvious the claimed feature in dispute.

_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. _Id._ at 1346 referring to _KSR_ at 550 U.S. at 421 (asking if there is a “design need or market pressure to solve” a problem and if that same problem is one having “identified, predictable solutions”) (emphasis added). An analytical error can be based on the PTAB misreading a reference.

_In re Giannelli_, 2014 WL 104029 (Fed. Cir., Jan. 13, 2014) – Likely, everyone personally agrees that the claim is likely unpatentable (there has got to be prior art out there); however, the evidence of record must demonstrate that – personal views are no substitute for evidence and analysis. “Physical capability alone does not render obvious that which is contraindicated,” _id._ at 4. Is the Federal Circuit back-pedaling from _In re Schreiber_, 128 F.3d 1473 (Fed. Cir. 1997) (Oil can dispensing popcorn case)?

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.

“[A]s we are reversing the Board’s obviousness conclusion, it is hard to see how these claims could have been anticipated by the cited [piece of prior art].” Is “teaching away” analysis becoming applicable to anticipation? Is the Federal Circuit backing away from its precedent that whether a reference teaches away from the claimed invention is irrelevant to an anticipation analysis?
Reaffirming the importance of evaluating objective evidence of nonobviousness in the obviousness analysis

Objective evidence of nonobviousness is too often treated as “secondary considerations.” Credit to this proposition goes to Judge Reyna’s separate opinion concurring-in-part and dissenting-in-part to the majority’s decision in Apple Inc. v. International Trade Comm., 725 F.3d 1356 (Fed. Cir. 2013). While the Apple majority disagreed in a footnote with Judge Reyna’s characterization of objective evidence of nonobviousness being the “best” evidence, the majority appeared to have concurred with Judge Reyna’s position that the so-called “secondary considerations” identified in Graham should not be relegated to a “second class” of evidence.

The Federal Circuit within the timeframe of 48 days in late summer of 2013 revigorated interest in the importance of Graham’s fourth factor, i.e., “secondary considerations as commercial success, long felt but unsolved needs, failure of other, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” This interest was fully discussed in Leo Pharmaceutical Prod., Ltd. v. Rea, 726 F.3d 1346 (Fed. Cir. 2013). However, Leo Pharma was not the only case within the late summer of 2013 that delved into the issue of secondary considerations, to which the Federal Circuit appears to have renamed as “objective indicia of nonobviousness.” One case before Leo Pharma, the Apple-ITC case above (decided a week earlier), and one case after, Rambus, Inc. v. Rea, 731 F.3d 1248 (Fed. Cir. 2013) (decided a month later), also dealt with how the Federal Circuit perceived the tribunal below not adequately giving the evidence submitted by the Patent Owner a full review. This paper reports these three cases, in order of release, and what the Federal Circuit considered about the manner the tribunal below handled the evidence submitted by the Patent Owner.

Apple Inc. v. International Trade Comm. – Deal with it.

1 See page 1375.
3 Of note, this term of art has roots in Federal Circuit’s decision of In re Kubin, 561 F.3d 1351, 1355 (Fed. Cir. 2009) which paraphrased Graham’s fourth factor as “objective evidence of nonobviousness.” In re Kubin, Federal Circuit cited directly to Graham in re Kubin; yet Graham does not use such a term in characterizing the fourth factor of the Graham analysis. The Supreme Court in 2007 did not rename Graham’s fourth factor as “objective evidence of nonobviousness” or “objective indicia of nonobviousness.” It would be interesting to see how the Court perceives the Federal Circuit’s paraphrasing of this Graham factor. The Court, in KSR, did not fully address this factor since Teleflex did not show “secondary factors to dislodge the determination that claim 4 is obvious.” KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 426 (2007).
This case involved smartphone touchscreens. In particular, the ability to detect multiple touches at once. The ITC concluded that the combination of SmartSkin and Rekimoto rendered obvious claim 10. The Federal Circuit concluded that the ITC’s fact findings regarding SmartSkin and Rekimoto were supported by substantial evidence. The Federal Circuit saw error in the manner the ITC handled Apple’s secondary consideration evidence. The Federal Circuit identified that the ITC failed to follow its precedent concerning that all four Graham factors must be considered before the conclusion of obviousness can be drawn. In the Federal Circuit’s view, the ITC appear to solely rely on the first three Graham factors first, rendered its conclusion of obviousness, then moved to, at best, insubstantially address Apple’s secondary consideration evidence. 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.” The Federal Circuit did not say that Apple’s evidence overcame the showing within the first three Graham factors. Instead, Federal Circuit said Apple presented compelling secondary consideration evidence that may have rebutted a strong showing under the first three Graham factors. The error, in the view of the Federal Circuit, was not to grapple with Apple’s evidence. As such, the Federal Circuit remanded to the ITC this aspect of the case to deal with it.

Leo Pharma v. Rea – It is not considered as an afterthought.

This case involved pharmaceutical compositions for treating certain skin conditions. The particular composition comprised three components: a vitamin D analog (“vitamin D”), a corticosteroid (“steroid”), and a solvent. The appeal was from the Board’s affirmance of the Examiner’s rejection where the claim had been amended to narrower the scope to a composition comprising a vitamin D analog, a corticosteroid, and a solvent, wherein the composition was storage stable and non-aqueous. For the topic of this paper, the manner that the Federal Circuit and the Board handled the claim construction of storage stable and non-aqueous is not a concern. What is of concern is how the Board and the Federal Circuit handled Leo’s secondary consideration evidence, i.e., “the objective indicia of nonobviousness.”

The Federal Circuit determined that the record did not present any unresolved issues of fact. As such, the Federal Circuit determined that the sole issue before it was: “whether, in light

4 *Apple Inc. v. ITC*, 725 F.3d at 1365.
5 Apple presented evidence of praise, copying, and commercial success, all of which had a nexus to the “patented multitouch functionality.” *Id.* at 1366.
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.”

The Federal Circuit determined that the Board essentially concluded Leo’s claimed invention was simply a combination of elements found in the prior art. The Federal Circuit disagreed with the Board’s conclusion. The Federal Circuit noted that the Leo’s inventors “recognized and solved a problem with the storage stability of certain formulations – [1.] a problem that the prior art [of record] did not recognize and [2.] a problem that was not solved for over a decade.” The Federal Circuit made this determination based on the evidence submitted by Leo during the reexamination of its patent.

As to the points above, Leo presented several studies that essentially discouraged the combination of a vitamin D with steroid because of stability issues with vitamin D a low pH. While the prior art of record attempted to combine a vitamin D to a steroid, the prior art of record failed to disclose or address the stability problems when combining these components into one formulation. The Federal Circuit noted that Leo conducted experiments on the prior art of record and those experiments demonstrated that none of those compositions exhibited storage stable properties. Further, each of the prior art compositions contained either water or an ingredient that degraded the storage stability of the vitamin D and steroid combination.

Since the prior art of record neither recognized nor disclosed the stability problem, the record on appeal showed no reason for a person of ordinary skill in the art to attempt to improve upon the prior art. The Federal Circuit viewed that the person of ordinary skill in the art would: 1.) first have needed to recognize the problem and 2.) to discover the problem this ordinary artisan would have needed to spend time testing – then 3.) only after recognizing the problem, turn to the prior art to attempt development of a new formulation to address the stability problem. This progression, in combination with the record and the large time span between the references’ disclosures lead the Federal Circuit to determine that if it was so easy to do this, then someone would have done within the months after publication of the prior art references; instead the “invention does not appear for more than a decade.”

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6 Leo Pharmaceutical Prod., Ltd. v. Rea, 726 F.3d 1346, 1353 (Fed. Cir. 2013).
7 Leo Pharma. Prod., Ltd., 726 F.3d at 1353.
8 Leo Pharma. Prod., Ltd., 726 F.3d at 1354.
Given their understanding of the record, the Federal Circuit concluded that “[b]y brushing aside the storage stability issue, the Board erred by collapsing the obviousness analysis into a hindsight-guided combination of elements.”9 The Federal Circuit identified “several reasons within the record that a person of ordinary skill in the art would not been motivated to try, let alone make, the claimed invention.”10

The Federal Circuit determined that the Board’s motivation to combine certain references was straightforward hindsight because one of the references was available for 22 years before Leo’s patent was filed. Moreover, even when a reference of record published the side effects of steroid induce atrophy, no one sought to improve the primary reference by adding vitamin D to its steroid compound.

Turning to the “non-aqueous” claim element, the Federal Circuit found that substantial evidence did not support the Board’s finding that a person of ordinary skill in the art would add the vitamin D disclosed in the secondary references to the primary reference’s composition of a steroid and solvent. The Federal Circuit determined that the primary reference’s disclosure taught away from the Board’s posited combination, or at a minimum, provided no evidence of motivation to combine the primary reference with solvents.

Accordingly, given the “divergent compositions with express disclaimers of the other’s contents,” the Federal Circuit determined that the compositions described in the prior art references “for the same therapeutic purpose does not rise to the level of a motivation to combine.”11 Without more, the Federal Circuit, given the amount of indicia of nonobviousness present in the record, held the Board erred by using hindsight to determine that adding the prior art’s vitamin D analog to the primary reference’s formulation would have been obvious. In addition, the Federal Circuit determined that substantial evidence did not support the Board’s determination that the claimed invention would have been obvious to try.

Turning to the amount of indicia of nonobviousness, the Federal Circuit determined that the Board appeared to consider this evidence as an afterthought. The Federal Circuit used this opportunity to reiterate its precedent that “consideration of the objective indicia is part of the whole obviousness analysis.”12

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9 Leo Pharma. Prod., Ltd., 726 F.3d at 1354.
10 Leo Pharma. Prod., Ltd., 726 F.3d at 1354-55.
11 Leo Pharma. Prod., Ltd., 726 F.3d at 1356.
12 Leo Pharma. Prod., Ltd., 726 F.3d at 1358. (Emphasis original.)
During the reexamination proceeding, Leo submitted “extensive experimental evidence” of unexpected results that the Federal Circuit determined contradicted the Board’s finding of obviousness. In particular, Leo submitted the results of tests performed on the prior art’s compositions and these tests demonstrated degradation of the vitamin D and the steroid. Leo further tested an improvement by replacing the teach reference’s solvent with the one disclosed in the primary reference and there was still degradation in the steroid component. Given this evidence, the Federal Circuit held that there was a strong indication that the claimed invention’s combination of known elements yielded more than just predictable results.

In addition to the unexpected results evidence, Leo submitted commercial success evidence of Leo’s commercial embodiment of the claimed invention. Leo also submitted evidence that the commercial embodiment was the first FDA approval drug to combine vitamin D and steroids into a single combination. While such approval is not dispositive, the Federal Circuit stated that it is relevant to evaluating the objective indicia of nonobviousness.

The record also showed evidence of long felt but unsolved need. The Federal Circuit noted the span of years from the first disclosure of persons skilled in the art being aware of the benefits of using both vitamin D and steroids and the eventual preparation of a successful composition combining these two components into one stable composition.

Given the record, the Federal Circuit reversed the Board’s obviousness determination.

*Rambus Inc. v. Rea* – It just needs to be reasonably commensurate.

This case involved memory circuits; in particular, dynamic random-access memory (DRAM). It was identified that conventional memory transfers all of the data upon request, asynchronously. Such a transfer can tie up a computer for a time and can slow down computer operations. The patent at issue uses a synchronous memory system to transfer the data. In conventional synchronous systems, the data transmission to memory ties up the computer system for a full clock cycle. In comparison, the patent at issue discloses separating “the data into multiple portions and then transfer a portion during the rising edge of the clock signal and a portion during the falling edge of the clock signal.”13

An *inter partes* reexamination was initiated by the PTO and the examiner finally rejected claims. The Board upheld the examiner’s rejection. Rambus appealed.

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The Federal Circuit held that the Board correctly construed certain claim terms in dispute, and thus affirmed the Board’s finding that certain claims were anticipated. However, the Federal Circuit agreed with Rambus that the Board committed error in its obviousness decision and thus the Federal Circuit vacated the Board’s obviousness decision. This paper focuses on the Board’s handling of Rambus’s objective evidence of nonobviousness.

The Federal Circuit disagreed with the Board that Rambus’s objective evidence of nonobviousness lacked a nexus to the claimed invention. The Federal Circuit determined that the press releases submitted by Rambus should have been addressed by the Board since the press releases reference aspects of the claims on appeal; in particular, the dual-edge data transfer. The Federal Circuit determined that this evidence was directed to long felt need and industry praise.

The Federal Circuit informed the Board that its strict requirement of commensuration between the claim and evidence was improper. The Federal Circuit reiterated its legal authority that the objective evidence of nonobviousness needs only be reasonably commensurate with the scope of the claims. The Federal Circuit found that certain media articles were reasonably commensurate with the claims and “[t]he Board did not point to any contrary evidence, and we have not found any in the record.”

The Federal Circuit found that substantial evidence did not support the Board’s finding that Rambus’s licensing evidence lacked a nexus to the claims. The Federal Circuit determined that the Board’s determination “that this [licensing] evidence lacked a nexus because ‘competitors have many reasons for taking licenses which are not necessarily related to unobviousness’” lacks any supportive evidence.

Conclusion drawn from Apple, Leo Pharma, and Rambus

Given these three cases, 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.

14 Rambus Inc., 731 F.3d at 1257.
15 Rambus Inc., 731 F.3d at 1257.