

From: Tom5brody [redacted]
Sent: Tuesday, November 23, 2010 6:46 PM
To: KSR_Guidance
Subject: Response to request for comments, in light of EXAMINATION GUIDELINES AFTER KSR.

November 23, 2010

Dear Commissioner,

This is in response to your request for comments, in light of the Examination Guidelines after KSR (Federal Register, vol. 75, No. 169, Sept. 1, 2010).

I recently published a comprehensive article on the influence of KSR on patent prosecution. I reviewed 150 file histories in the mechanical arts, and 150 file histories in biotechnology. I determined that, in both cases, about 90% of the obviousness rejections used the TSM-test. Hence, it can be concluded that KSR has not dissuaded examiners from using this test.

But more important, is that the Federal Circuit and the MPEP have failed to provide guidance as to the meaning of "expectation." One might find that an understanding of what is "expectation" and what is not "expectation" to be central to any discussion of obviousness. My article provides an analysis of what is "expectation." For my narrative on what is expectation and what is not expectation, I acquired guidance from one of my former philosophy professors at U.C. Berkeley.

To develop this point a bit further, the Examination Guidelines of Sept. 1, 2010, seem to imply that "expectation" is the same thing as "predictability." (See page 53657). But this is not the case. Expectation is not the same thing as prediction or predictability. My article teaches that these are different things. But my article does not detail the concept of what is "predictability." My article cites other sources, that is, textbooks in linguistics or philosophy, that distinguish between these two things.

I might suggest referring to, or incorporating, my article in any formalized version of your guidelines (Brody, T. (2010) Obviousness in patents following the U.S. Supreme Court's decision of *KSR International Co. v. Teleflex, Inc.* in *Journal Patent Trademark Office Society* 92:26-70).

Respectfully yours, *Tom Brody*

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