

How to Evaluate and Respond to Legal Arguments Based on Case Law
Part II – Workshop (Design Example)
Blank Worksheet

The purpose of this workshop is to consider how legal arguments that cite case law in response to an examiner's rejection can be evaluated and addressed. The workshop examples are hypothetical and include a partial claim set, a rejection under 35 U.S.C. 103, and applicant's reply to that rejection. The rejections are streamlined for the purposes of this training in that they do not point to the particular portion of the references where the relevant teaching may be found; thus they should not be considered to be model rejections. The examples span a range of technological subject matter, but the issues for discussion are common across technologies.

This training is intended to enhance the quality of examination by providing guidance in evaluating case law based arguments, and in clearly stating the examiner's position on the record. This training is not designed to teach examiners how to write rejections. Specifically, although the examples in this training employ obviousness rejections, this is not obviousness training. Rather, because most examiners deal with 35 U.S.C. 103 frequently, obviousness is being used as a vehicle for considering attorney responses to rejections.

Any other patentability issues that may be raised by these hypothetical claims are not relevant to this workshop, and should not be a focus of discussion. During actual examination, however, examiners would be expected to follow compact prosecution practices and provide rejections, objections, or clarifying remarks as appropriate for a complete Office action.

For this workshop, assume that all applications are being examined under the first-inventor-to-file provisions of the America Invents Act (AIA/FITF), and that each rejection is part of a non-final first action on the merits.

NOTE: When relevant arguments are properly presented in response to a rejection, the examiner must consider the response. Thereafter, if the examiner concludes that it is more likely than not that the claim is unpatentable (the preponderance standard), the rejection should be maintained; otherwise it should be withdrawn. Although the examples in this workshop sometimes point out particular flaws in an attorney's response to a rejection, the question of whether to maintain or withdraw a rejection should always be answered in view of the fact that the examiner may reject only when a *prima facie* case of unpatentability is established. Each time that an examiner makes or maintains a rejection, he or she has the responsibility to ensure that the claim is unpatentable under the preponderance standard in view of all relevant arguments and evidence that are present at that time. See, for example, MPEP 2142.

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Design Workshop Example A

Claim:

The ornamental design for a DOUGHNUT as shown.

Description:

Figures 1, 2, and 4, reproduced below, are representative of the claimed design.

Each of the seven sides of the star shape are identical and the bottom is flat and unadorned.

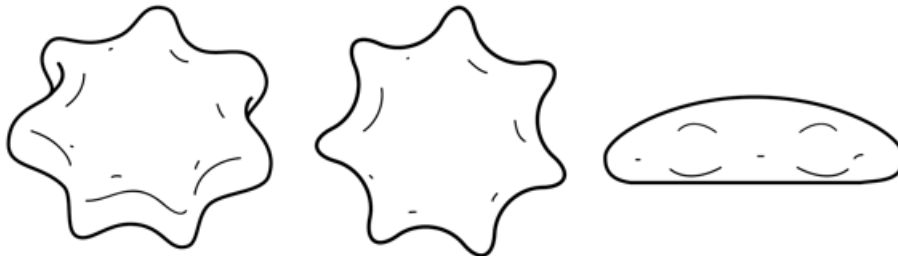


Fig. 1

Fig. 2

Fig. 4

The Examiner's rejection:

[Practice Note: Assume that the Jones reference teaches the basic characteristics of the design and is therefore an appropriate reference under In re Rosen, 673 F.2d 388 (1982).]

The claim is rejected under 35 U.S.C. 103 as being unpatentable over Jones in view of Smith.

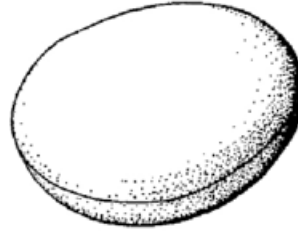
Although the invention is not identically disclosed or described as set forth in 35 U.S.C. § 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

The food blend product of Jones has design characteristics which are basically the same as the claimed design showing: a seven point star with rounded points and with each of the seven sides being identical.

The claimed design is different from Jones in that: (1) it is thicker from top to bottom relative to its width, (2) it has outwardly rounded sides and (3) the top surface is rounded, while the bottom surface is flat.



A perspective view of the Star-Shaped Food Blend Product of Jones



A perspective view of the Hamburger Bun of Smith.

The hamburger bun of Smith shows a food product that, like the claimed design, is thicker from top to bottom relative to its width, and has outwardly rounded sides, a top surface that is rounded, and a bottom that is flat.

It would have been obvious for a person of ordinary skill in the art, as of the effective filing date of the claimed invention, to create a proportionately thicker star shaped product, round the sides and add a rounded top surface as suggested by Smith. A person of ordinary skill would have been motivated to modify the food blend product of Jones as suggested by Smith because the Jones and Smith references are so related that the appearance of features shown in one would suggest the application of those features to the other. The resulting design would have had an appearance strikingly similar to the claimed design, and over which the claimed design would have no patentable distinction.

The Attorney's Response:

The Examiner has failed to provide a *prima facie* case of obviousness. A rejection under 35 U.S.C. § 103 would be appropriate if a designer of ordinary skill would have been motivated to modify a primary reference by deleting features thereof or by interchanging with or adding features from pertinent secondary references. In order for secondary references to be considered, there must be some suggestion in the prior art to modify the basic design with features from the secondary references. See *In re Borden*, 90 F.3d 1570, 1572 (Fed. Cir. 1996). The long-standing test for properly combining references has been "...whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." See *In re Glavas*, 230 F.2d 447, 450 (CCPA 1956). See also *In re Carter*, 673 F.2d 1378 (CCPA 1982); *In re Harvey*, 12 F.3d 1061 (Fed. Cir. 1993); *In re Cho*, 813 F.2d 378 (Fed. Cir. 1987); *Apple Inc. v. Samsung Elecs. Co. Ltd.*, 678 F.3d 1314 (Fed. Cir. 2012).

Furthermore, the cited secondary reference (Smith) is not from an analogous art. When a modification to a primary reference involves a change in configuration, both the primary and secondary references must be from analogous arts. *In re Glavas*, 230 F.2d 447 (CCPA 1956). See also *In re Butera*, 1 F.3d 1252 (Fed. Cir. 1993) (unpublished decision).

Additionally, the claimed ornamental design for a doughnut has met with commercial success which is evidence of nonobviousness. Secondary considerations, such as commercial success and copying of the design by others, are relevant to the evaluation of obviousness of a design claim. Evidence of nonobviousness may be present at the time a *prima facie* case of obviousness is evaluated or it may be presented in rebuttal of a prior obviousness rejection. See *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326 (Fed. Cir. 2014); *Crocs Inc. v. International Trade Commission*, 598 F.3d 1294 (Fed. Cir. 2010). See also MPEP 1504.03, subsection III.

For all of the above reasons, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

Questions:

Q1. What arguments does the attorney make that the examiner has failed to establish a *prima facie* case of obviousness?

A1.

Q2. Is it necessary for the examiner to review all of the cases cited regarding obviousness before replying to the attorney in the next Office action?

A2.

Q3. With respect to the non-analogous art argument, does the attorney cite any cases that the examiner is not obligated to follow because they are not precedential decisions?

A3.

Q4. To what extent must the examiner consider the attorney's argument regarding commercial success as evidence of nonobviousness?

A4.

Q5. What if the attorney had merely cited case law without any explanation of how it applied to the examiner's rejection, and without pointing out any supposed errors in the examiner's rejection?

A5.

Design Workshop Example B

Claims:

The ornamental design for a PORTION OF A DISPLAY SCREEN WITH ICON as shown and described.

Description:

The Figure is a front view of a PORTION OF A DISPLAY SCREEN WITH ICON showing the new design.

The broken lines illustrate a display screen and form no part of the claim.



The Examiner's rejection:

The claim is rejected under 35 U.S.C. 103 as being unpatentable over the computer generated icon of **Nelson** in view of the trademark design of **BANG!**.



Nelson



BANG!

Both the computer generated icon shown in the Nelson design and the claimed design share a similar overall appearance and essentially have the same design characteristics: a rectangular word bubble with rounded corners and a triangular tail. While the design shown in **Nelson** is a word bubble having a solid shape and with the tail on the bottom, right of the word

bubble, the claimed design shows the word bubble formed as an outline, with the tail on the bottom, left. However, the **BANG!** design teaches a word bubble formed as an outline with the tail on the bottom, left.

It would have been obvious for a person of ordinary skill in the art, as of the effective filing date of the claimed invention, to create an icon having an outline-appearance as suggested by BANG! and to move the tail of Nelson to the left side of the bottom of the word bubble, also as taught by BANG!. A person of ordinary skill would have been motivated to modify the Nelson icon as suggested by BANG! because the Nelson and BANG! references are so related that the appearance of features shown in one would suggest the application of those features to the other. The resulting design would have had an appearance basically the same as the claimed design, and over which the claimed design would have no patentable distinction.

The body of the word bubble of the claimed design is somewhat narrower than the design of Nelson, and the corners slightly less rounded, however these differences are not considered to be patentably distinguishing characteristics.

The Attorney's Response:

Applicant respectfully traverses the rejection of the claim under 35 U.S.C. § 103 as allegedly being unpatentable over Nelson in view of BANG!. First, a *prima facie* case of obviousness has not been established. Second, it would not have been obvious for a designer of ordinary skill in the art to rearrange and alter the elements in the cited art to meet the claim.

“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. ... [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 9th Ed. (March 2014). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries ... [include determining the scope and content of the prior art and]...[ascertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141 (II). In addition, objective evidence of nonobviousness such as a long-felt need for the invention, the failures of others to meet this need, the commercial success of the claimed invention, any copying of the invention, or unexpected results must be considered. *Mendenhall v. Astec Industries Inc.*, 14 USPQ2d 1134 (E.D. Tenn. 1988).

In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141 (III). Here, no *prima facie* case of obviousness has been established for at least

the reasons that the Office has neither properly determined the scope and content of the prior art, nor properly ascertained the differences between the prior art and the claim.

In this case, it would not have been obvious to rearrange and alter the elements in the cited reference to meet the claim. One may obtain a design patent for “any new, original and ornamental design for an article of manufacture,” provided that the claimed design satisfies the patentability requirements, including 35 U.S.C. § 103. 35 U.S.C. §171; *see, e.g., In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996). “In the design patent context, the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (citing *In re Rosen*, 673 F.2d 388, 390, 213 (C.C.P.A. 1982)). Moreover, this inquiry “focuses on the visual impression of the claimed design as a whole and *not on selected individual features.*” *Borden*, 90 F.3d at 1574 (citing *Petersen Mfg. Co. v. Central Purchasing, Inc.*, 740 F.2d 1541, 1548-49 (Fed. Cir. 1984)) (emphasis added).

Establishing “whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design” involves a two-step process. *Apple, Inc. v. Samsung Elec. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012). First, there must be a primary reference which is “in existence” where “the design characteristics [...] are basically the same as the claimed design.” *Durling*, 101 F.3d at 103. Second, “other references may be used to modify [the primary reference] to create a design that has the same overall visual appearance as the claimed design.” *Apple, Inc.*, 678 F.3d at 1329 (quoting *Durling*, 101 F.3d at 103). The “secondary references [, however,] may only be used to modify the primary reference if they are so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Durling*, 101 F.3d at 103 (alternation in original) (internal quotation marks and citation omitted). Additionally, the “teaching of prior art designs may be combined only when the designs are ‘so related that the appearance of certain *ornamental features* in one would suggest the application of those features to the other.’” *Borden*, 90 F.3d at 1575 (emphasis added).

Here, the Examiner has used impermissible hindsight, and asserted that one of ordinary skill in the art would combine elements of the primary and secondary references to arrive at the claimed design. But, one of ordinary skill in the art would not spontaneously replace the solid appearance of the Nelson reference with the outline appearance of BANG!.

In particular, the BANG! reference is a completely different design than the Nelson reference. Indeed, the two designs have significantly different shapes and markedly different overall appearances:

As shown above, the shape of the Nelson design differs significantly from the BANG! shape, which is elliptical. Moreover, the two designs are very different, because the shape of the tail in BANG! is curved and because the BANG! design includes text within the body of the

word bubble shape, unlike the claimed design and the Nelson design. Furthermore, the BANG! design includes contrasting color, which does not appear in either the claimed design or the Nelson design.

For at least the reasons discussed above, the secondary BANG! reference is not so related to the primary Nelson reference as to suggest the application of its features to the Nelson reference as asserted in the Office action. Therefore one of ordinary skill in the art would not have looked to BANG! to modify the Nelson reference, because BANG! is not “so related the appearance of certain ornamental features in one would suggest the application of those features to the other.” See *Durling*, 101 F.3d at 103. Accordingly, the Office Action fails to set forth a prima facie case of obviousness based on Nelson in view of BANG!. Thus, the rejection is improper and the claim should be allowed.

Questions:

Q1. What arguments does the attorney make that the examiner has failed to establish a *prima facie* case of obviousness?

A1.

Q2. Is the attorney correct that prior art designs may only be combined when the designs are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other?

A2.

Q3. How can the examiner respond to the argument that BANG! design is not so related in appearance to the Nelson design that it would be obvious to modify the ornamental appearance of Nelson based on BANG!?

A3.

Q4. Does the attorney cite any cases that the examiner is not obligated to follow because they are not precedential decisions?

A4.