

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

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that the claim is unpatentable (the preponderance standard), the rejection should be maintained; otherwise it should be withdrawn.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.

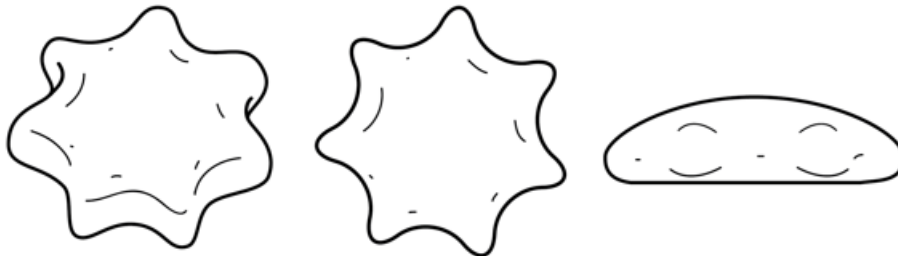


Fig. 1

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.

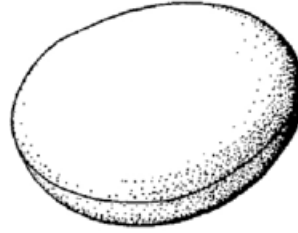
Although the invention is not identically disclosed or described as set forth in 35 U.S.C. § 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer 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. The attorney argues that there is no *prima facie* case of obviousness because the Smith reference is not analogous art to the claimed invention.

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. No. The examiner may rely on the discussion of case law relevant to obviousness in MPEP 1504.03.

In the absence of any attempt by the attorney to point out the supposed errors in the rejection as required by 37 CFR 1.111(b), the examiner may simply point out the failure to comply with the rule, and may maintain the rejection and make the next action final.

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. Yes. Recall that in general, precedential decisions that must be followed if they are relevant to the issue under consideration will be from the Supreme Court (look for “U.S.” or “S.Ct.” in the abbreviated name of the reporter), the Court of Appeals for the Federal Circuit (look for “Fed. Cir.” or “CAFC” preceding the year of the decision), or the Court of Customs and Patent Appeals (look for “Cust. & Pat. App.” or “CCPA” preceding the year of the decision). Although *In re Butera*, 1 F.3d 1252 (Fed. Cir. 1993) (unpublished decision) was decided by the Court of Appeals for the Federal Circuit, it is not a precedential decision as indicated by the notation “unpublished decision.”

Although this response does not cite any Board decisions, attorneys sometimes cite Board decisions in their responses. Board decisions are not binding precedent during examination. Although the MPEP may cite Board decisions, this generally occurs when there is no precedential court decision (Supreme Court, Federal Circuit, or Court of Customs and Patent Appeals) that addresses a particular issue, but the Office has adopted the Board’s reasoning about the issue as patent examination policy. When the MPEP cites a Board decision for a particular point, examiners should follow the Board decision as to that point. In such a situation, the reason to follow the Board decision is not that it is a precedential statement of the law, but rather because it represents patent examination policy as to a particular issue as evidenced by its inclusion in the MPEP. For example, *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int.

1992) is a Board decision cited in MPEP 1504.01(a). Even though *Strijland* is a Board decision and thus not binding legal precedent, the MPEP cites it because it reflects patent examination policy and there is no Supreme Court, Federal Circuit, or Court of Customs and Patent Appeals case law that is on point for the issue presented in *Strijland*.

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

A4. Assuming the specification does not contain any evidence of commercial success, the examiner should not give any weight to the allegations of commercial success which are unsupported by evidence, e.g., an appropriate affidavit or declaration. The examiner may simply cite to MPEP 716.01(c), subsection II and point out that mere arguments or conclusory statements of counsel cannot take the place of evidence in the record.

During prosecution of an actual application, an attorney may present more than one argument in support of the patentability of the claims. Just because the examiner determines that one argument is not persuasive does not necessarily mean that the rejection should be maintained. If another argument is made that is persuasive, the examiner should withdraw the rejection.

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. 37 CFR 1.111(b) requires that a response to a non-final Office action "be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action." MPEP 710.01 applies to a response that fails to point out the examiner's supposed errors such that the response does not comply with 37 CFR 1.111(b):

Thus, a reply to a non-final Office action that is *bona fide* but includes an omission may be treated by: (A) issuing an Office action that does not treat the reply on its merits but requires the applicant to supply the omission to avoid abandonment; or (B) issuing an Office action that does treat the reply on its merits (and which can also require the applicant to supply the omission to avoid abandonment)."

Generally speaking, it is in accordance with compact prosecution to proceed according to option B and treat a response on the merits whenever possible. Technology Centers may have specific guidance on this issue, and examiners who have questions should consult their SPEs. In this example, the examiner could briefly indicate that the response did not explain how the attorney believed the cited cases should be applied to the rejection at issue. The examiner could also state that because the response did not point out supposed errors in the examiner's rejection, it does

not comply with 37 CFR 1.111(b). If this were an actual case, attorney responses to any other rejections in the Office action would also have to be addressed. Then the next action could be made final in accordance with MPEP 706.07(a).

The term *bona fide* means “in good faith.” A response can be *bona fide* even if it fails to comply with 37 CFR 1.111(b). Examiners should consider a response to be *bona fide* unless there is evidence to the contrary. For example, a response that is nothing more than a disrespectful statement about the examiner would not be a *bona fide* response. Likewise, if the applicant had presented a previous response that had been treated as *bona fide* but incomplete, a subsequent response would not be *bona fide* if it neither attempted to rectify the error nor offered a reasonable argument that the previous response actually was complete. Examiners who have questions should consult their SPEs.

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. The secondary reference being relied upon in the rejection is not so related to the primary reference as to suggest the application of its ornamental features because the shape of the Nelson design differs significantly from the shape of BANG!:

- The body of BANG! is elliptical, not rectangular, and the tail is curved.
- BANG! includes text within the word bubble.
- BANG! includes a contrasting color.

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. Yes. See MPEP 1504.03(II)(A). It is not necessary for the examiner to read *In re Borden* or any other case that the attorney cites regarding applying secondary references.

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. The examiner should point out that the reason to look to BANG! is that it teaches a word bubble having an outline appearance.

The word bubble disclosed in BANG! is elliptical, not rectangular, and the tail is curved, consistent with the curved shape of the body, but the fact that the word bubble has a different shape does not prevent it from being relied upon to teach modifying the appearance of the word bubble shown in Nelson.

Furthermore, that BANG! discloses additional elements and features beyond what is included in the claimed design—language within the word bubble, shown in a contrasting color—does not impact the appearance of the word bubble itself.

Thus, with regard to the relevant issue, which is the appearance of the word bubble portion, the BANG! design discloses a word bubble, which would suggest the application of its features to the word bubble disclosed in Nelson.

During prosecution of an actual application, an attorney may present more than one argument in support of the patentability of the claims. Just because the examiner determines that one argument is not persuasive does not necessarily mean that the rejection should be maintained. If another argument is made that is persuasive, the examiner should withdraw the rejection.

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

A4. Yes. Recall that in general, precedential decisions that must be followed if they are relevant to the issue under consideration will be from the Supreme Court (look for “U.S.” or “S.Ct.” in the abbreviated name of the reporter), the Court of Appeals for the Federal Circuit (look for “Fed. Cir.” or “CAFC” preceding the year of the decision), or the Court of Customs and Patent Appeals (look for “Cust. & Pat. App.” or “CCPA” preceding the year of the decision). Thus, the Federal Circuit and CCPA decisions are precedential. The examiner should rely on the discussion of analogous art in the MPEP, and is not tasked with evaluating or responding to every decision cited.

In this example, *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 is a Supreme Court decision and many of the other cases cited (*In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996); *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996); and *Apple, Inc. v. Samsung Elec. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012)) are from the Court of Appeals for the Federal Circuit. The court, however, for *Mendenhall v. Astec Industries Inc.*, 14 USPQ2d 1134 (E.D. Tenn. 1988), is the United States District Court for the Eastern District of Tennessee as indicated by the abbreviation “E.D. Tenn.” so *Mendenhall* is not a precedential decision.

It is possible that the *Mendenhall* case is correct as to its statement of the law. However, because it would not be precedential, it would not have binding effect on examination. Thus, it would not lend strong support to the position being advanced in the attorney’s response.

The MPEP sometimes cites Board decisions. Generally, this occurs when there is no precedential court decision (Supreme Court, Federal Circuit, or Court of Customs and Patent Appeals) that addresses a particular issue, but the Office has adopted the Board’s reasoning about the issue as patent examination policy. When the MPEP cites a Board decision for a particular point, examiners should follow the Board decision as to that point. In such a situation, the reason to follow the Board decision is not that it is a precedential statement of the law, but rather because it represents patent examination policy as to a particular issue as evidenced by its inclusion in the MPEP. For example, *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992) is a Board decision cited in MPEP 1504.01(a). Even though *Strijland* is a Board decision and thus not binding legal precedent, the MPEP cites it because it reflects patent examination policy and there is no Supreme Court, Federal Circuit, or Court of Customs and Patent Appeals case law that is on point for the issue presented in *Strijland*.