

Legal Analysis and Writing

How to Evaluate and Analyze Legal Arguments Based on Case Law

Part II Workshop

Design Example - December 2017

UNITED STATES
PATENT AND TRADEMARK OFFICE



Overview of Workshop

- Focuses on evaluating/applying case law as necessary, consistent with the [Examiner Performance and Appraisal Plan](#) (PAP) for GS-12 and above
 - Discuss the importance of properly evaluating/applying case law
 - Work through hypothetical examples to connect case law citations to USPTO policy and to determine the appropriate response
- **This training is not designed to teach examiners how to write rejections.** Obviousness is being used as a vehicle in this training for considering attorney responses to rejections because most examiners deal with 35 U.S.C. 103 frequently. This, however, is not obviousness training.



Workshop Goals

- Understand how to read and evaluate Applicant's arguments based on case law citations
- Bring consistency to responding to Applicant's arguments based on case law to improve clarity of the record in alignment with the [Enhanced Patent Quality Initiative](#) (EPQI)
- Identify key points to consider when preparing to respond to Applicant's arguments based on case law citations

Workshop Format

- Read hypothetical discipline-specific examples including at least one claim, an Examiner's rejection, and Applicant's arguments
- Evaluate Applicant's arguments
 - For each hypothetical example, we will use a **worksheet** to step through an analysis of the Applicant's arguments
- Discuss techniques for evaluating and analyzing Applicant's arguments based on case law

Design Examples

Design Example A

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.

Claim:

The ornamental design for a DOUGHNUT as shown.

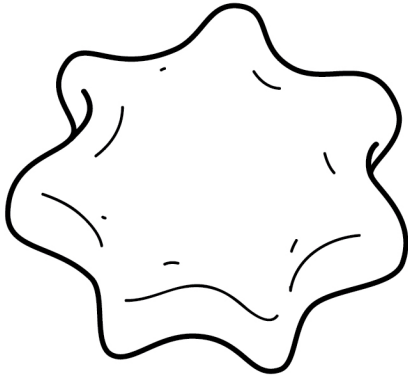


Fig. 1

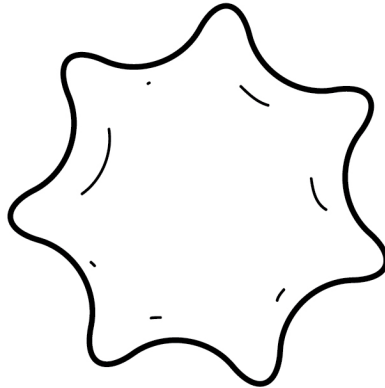


Fig. 2

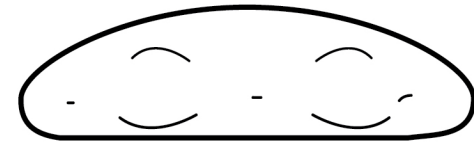


Fig. 4



Design Example A (cont.)

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.



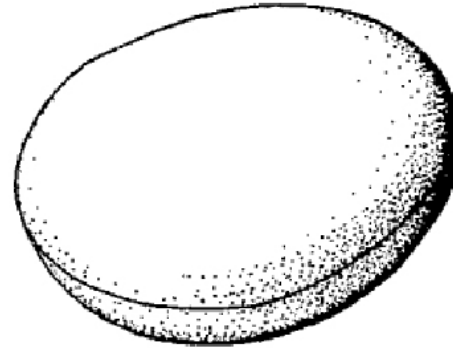
Design Example A (cont.)

The Examiner's rejection (cont.)

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.

Design Example A (cont.)

The Examiner's rejection (cont.)

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.



Design Example A (cont.)

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.



Design Example A (cont.)

Questions to be Explored

1. What arguments does the attorney make that the examiner has failed to establish a *prima facie* case of obviousness?
2. 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?
3. 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?
4. To what extent must the examiner consider the attorney's argument regarding commercial success as evidence of nonobviousness?
5. 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?



Design Example A (cont.)

Questions to be Explored

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



Design Example A (cont.)

Questions to be Explored

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

The attorney argues that there is no *prima facie* case of obviousness because the Smith reference is not analogous art to the claimed invention.

Design Example A (cont.)

Questions to be Explored

2. 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?



Design Example A (cont.)

Questions to be Explored

2. 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?

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.



37 CFR 1.111(b) - Reply By Applicant or Patent Owner to a Non-final Office Action

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing **which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action** [emphasis added]. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.



Design Example A (cont.)

Questions to be Explored

3. 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?



Design Example A (cont.)

Questions to be Explored

3. 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?

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*.



Design Example A (cont.)

Questions to be Explored

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



Design Example A (cont.)

Questions to be Explored

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

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.



Design Example A (cont.)

Questions to be Explored

5. 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?



Design Example A (cont.)

Questions to be Explored

5. 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?

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)."



Design Example A (cont.)

(cont.)

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.



Takeaway

- **Applicant's response included many case law citations**
 - Failed to discuss how the case law citations applied to the facts of the application under examination
 - No need to specifically address the cited case law
 - However, should acknowledge attorney's argument (see *MPEP 707.07(f)*)
 - State on the record that the response fails to link the legal concepts to the facts of the application under examination
- **Mere arguments or conclusory statements of counsel cannot take the place of evidence in the record (MPEP 716.01(c)(II))**

Design Example B

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.

Claim:

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



Design Example B (cont.)

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!

Design Example B (cont.)

The Examiner's rejection (cont.)

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.



Design Example B (cont.)

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).



Design Example B (cont.)

The Attorney's Response (cont.):

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.



Design Example B (cont.)

Questions to be Explored

1. What arguments does the attorney make that the examiner has failed to establish a *prima facie* case of obviousness?
2. 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?
3. How can the examiner respond to the argument that the 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!?
4. Does the attorney cite any cases that the examiner is not obligated to follow because they are not precedential decisions?



Design Example B (cont.)

Questions to be Explored

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



Design Example B (cont.)

Questions to be Explored

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

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.



Design Example B (cont.)

Questions to be Explored

2. 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?



Design Example B (cont.)

Questions to be Explored

2. 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?

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.

Design Example B (cont.)

Questions to be Explored

3. 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!?



Design Example B (cont.)

Questions to be Explored

3. 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!?

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.

Design Example B (cont.)

Questions to be Explored

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



Design Example B (cont.)

Questions to be Explored

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

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.



Design Example B (cont.)

(cont.)

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*.



Takeaway

- Evaluate applicant's response in light of current law and policy as stated in the MPEP (or guidance memoranda for recent developments)
 - When determining whether the arguments are persuasive, note the MPEP sections identified as relevant to applicant's arguments
- Link the relevant legal concepts discussed in the MPEP to the facts of the application under examination

Key Points When Preparing to Respond to Applicant's Arguments

- Evaluate, analyze, and **acknowledge** all arguments and/or evidence of record, including arguments based on case law, when deciding whether to maintain or withdraw a rejection. See MPEP 2145.
- Be sure to "answer the substance" of any argument made by applicant in traversal of the rejection. See MPEP 707.07(f).

Key Points When Preparing to Respond to Applicant's Arguments (*cont.*)

- Refer to the MPEP (or guidance memoranda for recent developments) for information about how to understand and apply case law. You are not expected to do legal research beyond the MPEP and guidance memoranda.
 - Rely on the MPEP if an applicant's traversal is inconsistent with the MPEP or applicable guidance memoranda. If the cited case law is not mentioned in the MPEP (See Appendix II), review the section of the MPEP that addresses the topic and formulate a response to the traversal based on the MPEP.
 - Confirm that any MPEP citation in the traversal is current and accurate before deciding to withdraw the rejection.



Key Points When Preparing to Respond to Applicant's Arguments (*cont.*)

- Consult your SPE or other TC practice specialist if you have question about case law or current Office policy. If you choose to read case law, desktop access is available at <http://iplaw.bna.com/iprc/>.

Responding to Applicant's Arguments

- The next phase of this training will address in detail how to respond effectively to applicant's arguments
- For the hypothetical scenarios discussed in this training, if the rejection is repeated, consider applicant's traversal and respond to the substance of it, in accordance with MPEP 707.07(f)
 - For details on how to respond to various other arguments, see MPEP 2145: Consideration of Applicant's Rebuttal Arguments
 - See also form paragraphs 7.37-7.38 et seq., which address different traversal scenarios
- For example, a reply to the particular response in Example A can be made using form paragraph 7.37 indicating that the argument is not persuasive followed by form paragraph 7.37.11 that states:
 - Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.



Questions?

- If you have questions about the training materials, please contact the Legal Analysis and Writing (LAW) POCs listed on the LAW microsite
<http://ptoweb.uspto.gov/patents/exTrain/responding-to-legal-arguments.html>
- If you have questions about a particular application on your docket, please contact your SPE

Time Code

Training Time Code: ATRAIN-0000-090101