



Legal Analysis and Writing

How to Evaluate and Analyze Legal Arguments Based on Case Law

Part II Workshop

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 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



Chemical Examples

Chemical Example A

Claim

1. A method of treating a skin disorder comprising topically administering, at the site of the disorder, a composition comprising:
 - a therapeutically effective dosage amount of indomethacin sufficient to inhibit prostaglandin synthesis, and
 - an amount of Compound A or a pharmaceutically acceptable salt of Compound A that is effective to transport the dosage amount of indomethacin percutaneously into the epidermis.



Chemical Example A (cont.)

The Examiner's rejection:

Claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over Diamond in view of Sanford.

Claim 1 is drawn to a method for treating a skin disease by topically administering a composition that comprises (a) indomethacin to inhibit prostaglandin synthesis, and (b) Compound A as a percutaneous transport agent.

Diamond teaches pharmaceutical compositions comprising Compound A and topically administrable drugs. More particularly, Diamond discloses that non-steroidal anti-inflammatory drugs (NSAIDs) can be transported through the skin when formulated together with Compound A and applied topically. Diamond teaches that such compositions are particularly useful in the field of dermatology. Diamond does not specifically disclose indomethacin.

Sanford teaches that indomethacin is a non-steroidal anti-inflammatory drug that is known to inhibit prostaglandin synthesis and to reduce pain. Sanford also discloses that indomethacin is useful for treatment of skin disorders.

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 choose indomethacin as taught by Sanford as the particular NSAID to be incorporated into the pharmaceutical composition of Diamond. A person of ordinary skill would have been motivated to do so because Diamond had taught that NSAIDs generally could be incorporated into topically administrable compositions comprising Compound A, and Sanford had confirmed that indomethacin was an NSAID known to be useful for treatment of skin disorders. Thus, in view of the teachings of Diamond and Sanford, there would have been a reasonable expectation that a composition comprising indomethacin and Compound A could be successfully prepared and used in a method for treating a skin disease.



Chemical Example A (cont.)

The Attorney's Response:

In order for a combination of references to render an invention obvious it must be apparent that their teachings can be combined. *In re Avery*, 518 F.2d 1228, 186 USPQ 161 (CCPA 1975). Obviousness cannot be established by combining teachings of the prior art to produce the claimed invention, absent some teachings, suggestion or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 2 USQ2d 1276 (Fed. Cir. 1987); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). When the incentive to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (BPAI 1986). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, *Berghauser v. Dann*, 204 USPQ 393 (D.D.C. 1979); *ACS Hospital Sys. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. *Ex parte Hiyamizu*, 10 USPQ2d 1393 (BPAI 1988). The same conclusion is true where the references expressly teach away from what the PTO contends is obvious from the references, *In re Grasseli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983), or where the examiner's proposed modification would render the prior art version unsatisfactory for its intended purpose, *Ex parte Rosenfeld*, 130 USPQ 113 (POBA 1961). Accord, *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *In re Kramer*, 18 USPQ2d 1415 (Fed. Cir. 1991) (unpublished decision). The references, viewed by themselves and not in retrospect, must suggest doing what applicants have done. *In re Shaffer*, 229 F.2d 476, 108 USPQ 326 (CCPA 1956); *In re Skoll*, 523 F.2d 1392, 187 USPQ 481 (CCPA 1975).





Chemical Example A (cont.)

The Attorney's Response (cont.):

The mere fact it is possible for two isolated disclosures to be combined does not render the result of that combination obvious absent a logical reason of record which justifies the combination. *In re Regel*, 526 F.2d 1399, 188 USPQ 136 (CCPA 1975). To properly combine two references to reach a conclusion of obviousness, there must be some teachings, suggestion or inference in either or both of the references, or knowledge generally available to one of ordinary skill in the art, which would have led one to combine the relevant teachings of the two references. *Ashland Oil v. Delta Resins & Refractories*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963).

The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular structural modification is "well known" and thus obvious. Subjective opinions are of little weight against contrary evidence. *In re Wagner*, 371 F.2d 877, 152 USPQ 552 (CCPA 1967). If the examiner seeks to rely upon a theory of chemistry for obviousness, he must provide evidentiary support for the existence and meaning of that theory. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979). Unless the Applicants question the accuracy of a statement of the Examiner unsupported by the art of record, or by presenting evidence to contradict it, it will probably be accepted as true on appeal. *In re Shapleigh*, 248 F.2d 96, 115 USPQ 129 (CCPA 1957). Data in the specification showing the claimed article possesses characteristics not possessed by the prior art should be accepted as accurate, notwithstanding the contrary opinion expressed *sua sponte* by the Board of Appeals. *In re Ehringer*, 347 F.2d 612, 146 USPQ 31 (CCPA 1965), (shock-resistant, vibration-resistant and non-sag filament wire).



Chemical 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 the cited cases before replying to the attorney in the next Office action?
3. Does the attorney cite any cases that the examiner is not obligated to follow because they are not precedential decisions?

Chemical 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?





Chemical 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?

None. The attorney has merely submitted a list of case law without any explanation of how it applies to the facts of the case being examined. Nevertheless, it is clearly an attempt to respond to the Office action. Therefore, it would not be proper for the examiner to hold the case abandoned for failure to respond.

Chemical Example A (cont.)

Questions to be Explored

2. Is it necessary for the examiner to review the cited cases before replying to the attorney in the next Office action?





Chemical Example A (cont.)

Questions to be Explored

2. Is it necessary for the examiner to review the cited cases before replying to the attorney in the next Office action?

No. 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).**”





Chemical 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.



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.



Chemical Example A (cont.)

Questions to be Explored

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



Chemical Example A (cont.)

Questions to be Explored

3. 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).





Chemical Example A (cont.)

(cont.)

The court for *Berghauer v. Dann*, 204 USPQ 393 (D.D.C. 1979) is the United States District Court for the District of Columbia as indicated by the abbreviation "D.D.C." so *Berghauer* is not a precedential decision that would be binding on the Office. Although *In re Kramer*, 18 USPQ2d 1415 (Fed. Cir. 1991) (unpublished decision) was decided by the Court of Appeals for the Federal Circuit, it is also not a precedential decision as indicated by the notation "unpublished decision." Finally, the "*Ex parte*" decisions (*Ex parte Skinner*, 2 USPQ2d 1788 (BPAI 1986); *Ex parte Hiyamizu*, 10 USPQ2d 1393 (BPAI 1988); and *Ex parte Rosenfeld*, 130 USPQ 113 (POBA 1961)) are all USPTO Board decisions and are therefore not precedential.

It is possible that these cases are correct as to their statements of the law. However, because they are not precedential, they have no binding effect on examination. Thus, they do 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 Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) is a Board decision cited in MPEP 2173.05(s). It reaffirms that claims are to be complete in themselves whenever possible, but permits references to figures or tables in claims "only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim." Even though *Fressola* 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.





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

Chemical Example B

Claim

1. A pharmaceutical composition comprising cytotoxic drug X and polyol Y as a stabilizing agent, wherein polyol Y is present in an amount of up to about 75% by weight.
2. The pharmaceutical composition of claim 1, wherein polyol Y is present in an amount of about 50% by weight.
3. The pharmaceutical composition of claim 1, wherein polyol Y is present in an amount of about 25% by weight.



Chemical Example B (cont.)

The Examiner's rejection (assume this is an AIA/FITF case):

Claim 1 is rejected under 35 USC 103 as being unpatentable over Smith in view of Jones.

Claim 1 is drawn to a pharmaceutical composition comprising cytotoxic drug X and up to about 75% by weight of polyol Y as a stabilizing agent. Claims 2 and 3 depend from claim 1 and further limit the amount of polyol Y to about 50% and about 25%, respectively.

Smith teaches pharmaceutical compositions comprising cytotoxic drug X and a polyol as a carrier. Smith does not teach that the polyol should be specifically polyol Y, or that the polyol acts as a stabilizing agent. Smith is silent as to the amount of polyol to be included.

Jones teaches that polyols, including specifically polyol Y, are useful for stabilizing pharmaceutical compositions comprising cytotoxic drugs.

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 include polyol Y in an amount of up to about 75% by weight in a pharmaceutical composition comprising cytotoxic drug X. A person of ordinary skill would have been motivated to choose polyol Y as the specific polyol to include in the cytotoxic drug composition of Smith because Jones had taught that polyol Y was useful as a stabilizing agent for cytotoxic drug compositions. As for the amounts of polyol Y required by the claims, a person of ordinary skill in the art would have been motivated to adjust the amount of polyol Y in order to obtain a workable product that is stable. It is noted that no criticality has been demonstrated in the specification with regard to the amounts recited in the claims.

Chemical Example B (cont.)

The Attorney's Response:

The Examiner has failed to provide a *prima facie* case of obviousness in view of the limitations on the amount of polyol Y in claims 1-3. The Examiner has acknowledged that the cited references fail to teach inclusion of polyol Y in the specific amounts or ranges required by the claims. However, the Examiner has concluded that these formulations would have been suggested in view of Smith's teaching that polyols may be included as a carrier and Jones's teaching that polyol Y may be used to stabilize compositions comprising cytotoxic drugs. There is no reasonable basis for concluding that one of ordinary skill would have modified the Smith compositions to include polyol Y in the specific amounts or ranges required by the claims.

The MPEP clearly states that "only result-effective variables can be optimized." MPEP § 2144.05(II)(B). "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *Id.*

As stated in MPEP § 2144.05(II)(B), the Examiner "should not succumb to hindsight claims of obviousness" on the rationale that "researchers can only vary all parameters or try each of numerous possible choices until one possibly arrives at a successful result, where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful." *The Procter & Gamble Co. v. Teva Pharma. USA, Inc.*, 566 F.3d 989, 996-97 (Fed. Cir. 2009). "[P]atents are not barred just because it was obvious to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *Id.* at 997. Smith and Jones each fail to provide any guidance that would support a theory of optimization of the amount of polyol Y in connection with any particular outcome or secondary effect. As a result, there is no basis to presume that this parameter is subject to routine optimization, and even less so to presume that optimization would have led to the stabilized compositions as now claimed.

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



Chemical 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. Does the attorney argue that there would have been no reason to include polyol Y in the cytotoxic drug composition taught by Smith?
3. Citing MPEP 2144.05(II)(B), the attorney asserts that the MPEP “clearly states that ‘only result-effective variables can be optimized.’ ” Is that an accurate statement about the MPEP?
4. The attorney cites the *Procter & Gamble* case. What can we learn about that case from the MPEP?
5. Does the current revision of MPEP 2144.05(II)(B) support the attorney’s contention that the examiner’s rejection was improper because the references do not identify the amount of polyol Y as a result-effective variable with regard to stability of the composition?



Chemical 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?



Chemical 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 attorney argues that there would have been no reason to arrive at the claimed amounts of polyol Y because polyol Y was not recognized in the prior art as a result-effective variable with respect to stabilization.

Chemical Example B (cont.)

Questions to be Explored

2. Does the attorney argue that there would have been no reason to include polyol Y in the cytotoxic drug composition taught by Smith?





Chemical Example B (cont.)

Questions to be Explored

2. Does the attorney argue that there would have been no reason to include polyol Y in the cytotoxic drug composition taught by Smith?

No, the attorney does not make an argument that there would have been no reason to include polyol Y as taught by Jones in the drug composition of Smith. The only argument is with regard to the claimed amounts. When responding to the argument, the examiner should begin by pointing out that **by failing to argue that there would have been no reason to include polyol Y in the composition, the attorney appears to concede that there is reason to include polyol Y. The only issue to be addressed concerns the amount of polyol Y.**

Chemical Example B (cont.)

Questions to be Explored

3. Citing MPEP 2144.05(II)(B), the attorney asserts that the MPEP “clearly states that ‘only result-effective variables can be optimized.’ ” Is that an accurate statement about the MPEP?





Chemical Example B (cont.)

Questions to be Explored

3. Citing MPEP 2144.05(II)(B), the attorney asserts that the MPEP “clearly states that ‘only result-effective variables can be optimized.’ ” Is that an accurate statement about the MPEP?

No. The current version of the MPEP does not include that statement in MPEP 2144.05(II)(B). Furthermore, an electronic search of the MPEP for the quoted phrase reveals that it is not in any other section of the current edition either. However, the quoted phrase appears in the original eighth edition dated August 2001, and it could also have appeared in earlier editions. **The attorney cannot properly rely on a statement from an earlier version of the MPEP.** The fact that a statement appeared in an earlier version of the MPEP, but is not in the current version, should at least cause the examiner to consider the possibility that it may no longer be completely accurate.



Chemical Example B (cont.)

Questions to be Explored

4. The attorney cites the *Procter & Gamble* case. What can we learn about that case from the MPEP?





Chemical Example B (cont.)

Questions to be Explored

4. The attorney cites the *Procter & Gamble* case. What can we learn about that case from the MPEP?

The attorney asserts that the *Procter & Gamble* case is cited in MPEP 2144.05(II)(B). **That is not accurate, at least as to the current version of the MPEP. In fact, it does not appear to be accurate as to earlier versions either.**

However, an electronic MPEP search for “Procter” reveals that the case is indeed cited in current MPEP 2143(I)(B), example 10. (In fact, it was first incorporated into the MPEP in August 2012, eighth edition, revision 9.) The MPEP cites the *Procter & Gamble* case in the context of the substitution rationale for obviousness in view of *KSR*. It is a case that has to do with lead compounds for obviousness rejections based on structurally similar chemical compounds. It also is relevant to so-called secondary considerations and obviousness rejections. **Neither of those issues appears to apply to the rejection made by the examiner in this case.**



Chemical Example B (cont.)

Questions to be Explored

5. Does the current revision of MPEP 2144.05(II)(B) support the attorney's contention that the examiner's rejection was improper because the references do not identify the amount of polyol Y as a result-effective variable with regard to stability of the composition?





Chemical Example B (cont.)

Questions to be Explored

5. Does the current revision of MPEP 2144.05(II)(B) support the attorney's contention that the examiner's rejection was improper because the references do not identify the amount of polyol Y as a result-effective variable with regard to stability of the composition?

No. MPEP 2144.05(II)(B) states that the reason that an earlier case, *In re Antonie*, had concluded that a variable must be shown to be result-effective before optimization can be the basis of a conclusion of obviousness was that "obvious to try" was not a valid rationale for obviousness. As explained in that section of the MPEP, *KSR* teaches us that under the right circumstances, "obvious to try" can indeed be the basis for a proper conclusion of obviousness. The attorney's argument fails to account for *KSR*, which is a Supreme Court case. MPEP 2144.05(II)(B) states:

Thus, after *KSR*, the presence of a known result-effective variable would be one, but not the only, motivation for a person of ordinary skill in the art to experiment to reach another workable product or process.





Chemical Example B (cont.)

(cont.)

The argument does not provide a reasonable basis to conclude that the examiner failed to establish a *prima facie* case of obviousness.

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.





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



Electrical Examples

Electrical Example A

Claim

1. An apparatus for managing nodes in a network comprising:
 - a cryptography system for encrypting data to be transmitted through the network, and
 - a network reservation system for identifying a plurality of next nodes in the network based on a destination for the encrypted data, wherein the plurality of next nodes are indirectly connected to a source node from which the encrypted data is sent to the destination via at least one other node, the destination being among the plurality of next nodes, andwherein the network reservation system further selectively implements pre-reserved paths along the plurality of next nodes for transmitting the encrypted data.



Electrical Example A (cont.)

The Examiner's rejection

[Practice Note: The first two limitations of Claim 1 ("a cryptography system for encrypting" and "a network reservation system for identifying") invoke 35 U.S.C. 112(f). Assume that the Office action includes a statement noting this claim interpretation and identifying the structure in the specification that performs the associated function for each limitation in accordance with best practices.]

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Seger in view of Mason.

Seeger teaches a cryptography system configured to encrypt data to be transmitted through a network to form encrypted data, wherein the encrypted data is transmitted through a plurality of next nodes without decryption until the encrypted data arrives at the destination.

Seeger fails to disclose the setting of the pre-reserved paths or routes for transmitting data.

Mason teaches selectively implementing pre-reserved paths along a plurality of next nodes for transmitting data in a switch network. Mason further states that such selective implementation of pre-reserved paths is useful for enhancing the efficiency of the network.

It would have been obvious for a person of ordinary skill in the art at the time of the effective filing date of the claimed invention to use the pre-reserved paths of Mason in the cryptography system of Seeger for the purpose of providing a more efficient system as suggested by Mason.



Electrical Example A (cont.)

The Attorney's Response:

The Examiner rejected claim 1 as obvious under 35 U.S.C. § 103 over *Seeger* in view of *Mason*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fritch*, 972 F.2d 1260, 1262 (Fed. Cir. 1992). When the incentive to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (BPAI 1986). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, *Berghauser v. Dann*, 204 USPQ 393 (D.D.C. 1979). No *prima facie* case of obviousness has been established where the examiner's proposed modification would render the prior art version unsatisfactory for its intended purpose. *In re Kramer*, 18 USPQ2d 1415 (Fed. Cir. 1991) (unpublished decision).

In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Court set out a framework for applying the statutory language of §103. *KSR Int'l v. Teleflex* 550 U.S. 398 (2007). The analysis is objective:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham*, at 17-18.

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.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex*; *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).





Electrical Example A (cont.)

The Attorney's Response (cont.):

“[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.” *KSR Int'l. v. Teleflex*. “An invention may be a combination of old elements disclosed in multiple prior art references.” *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1321 (Fed. Cir. 2005). “The mere recitation of the words ‘common sense’ without any support adds nothing to the obviousness equation.” *Mintz v. Dietz & Watson*, 679 F.3d 1372, 1377 (Fed. Cir. 2012). “This court has consistently pronounced that all evidence pertaining to the objective indicia of nonobviousness must be considered before reaching an obviousness conclusion.” *See, e.g., In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litigation.*, 676 F.3d 1063, 1076 (Fed. Cir. 2012).

The rejection should be withdrawn.



Electrical 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 the cited cases before replying to the attorney in the next Office action?
3. Does the attorney cite any cases that the examiner is not obligated to follow because they are not precedential decisions?

Electrical 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?





Electrical 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?

None. The attorney has merely submitted a list of case law without any explanation of how it applies to the facts of the case being examined. Nevertheless, it is clearly an attempt to respond to the Office action. Therefore, it would not be proper for the examiner to hold the case abandoned for failure to respond.

Electrical Example A (cont.)

Questions to be Explored

2. Is it necessary for the examiner to review the cited cases before replying to the attorney in the next Office action?





Electrical Example A (cont.)

Questions to be Explored

2. Is it necessary for the examiner to review the cited cases before replying to the attorney in the next Office action?

No. 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).**”





Electrical 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.



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.



Electrical Example A (cont.)

Questions to be Explored

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



Electrical Example A (cont.)

Questions to be Explored

3. 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).

The court for *Berghauser v. Dann*, 204 USPQ 393 (D.D.C. 1979) is the United States District Court for the District of Columbia as indicated by the abbreviation "D.D.C." so *Berghauser* is not a precedential decision. Although *In re Kramer*, 18 USPQ2d 1415 (Fed. Cir. 1991) (unpublished decision) was decided by the Court of Appeals for the Federal Circuit, it is also not a precedential decision as indicated by the notation "unpublished decision." Finally, *Ex parte Skinner*, 2 USPQ2d 1788 (BPAI 1986) is a USPTO Board decision and is therefore not precedential.





Electrical Example A (cont.)

(cont.)

It is possible that these cases are correct as to their statements of the law. However, because they are not precedential, they have no binding effect on examination. Thus, they do 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 Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) is a Board decision cited in MPEP 2173.05(s). It reaffirms that claims are to be complete in themselves whenever possible, but permits references to figures or tables in claims "only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim." Even though *Fressola* 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.



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

Electrical Example B

Claim

1. A semiconductor chip redistribution layer comprising an electrical conductor path, the electrical conductor path comprising copper and one additional conductive material, wherein the additional conductive material is present in an amount of at least 0.5% by weight of the electrical conductor path.
2. The semiconductor chip redistribution layer of claim 1, wherein the additional conductive material is tantalum.
3. The semiconductor chip redistribution layer of claim 1 or 2, wherein the electrical conductor path has a tensile strength of more than 100 MPa.



Electrical Example B (cont.)

The Examiner's rejection

Claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over James in view of Thomas.

Claim 1 is drawn to a semiconductor chip redistribution layer comprising an electrical conductor path. The electrical conductor path must include copper and one additional conductive material, and the additional conductive material must make up at least 0.5 % by weight of the electrical conductor path. Claim 2 depends from claim 1 and further limits the additional conductive material to tantalum. Claim 3 depends from claim 1 or claim 2 and requires that the electrical conductor path have a tensile strength of more than 100 MPa.

James teaches that alloys of copper and tantalum may be used as the electrical conductor path of a redistribution layer for semiconductor chips. James does not state that tantalum should make up at least 0.5 % by weight of the electrical conductor path.

Thomas teaches alloys of copper and tantalum that are 0.5-1.5% tantalum by weight, and that such alloys have a tensile strength of 200-300 MPa.

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 use a copper-tantalum alloy as taught by Thomas in the redistribution layer of James. James had taught that copper-tantalum alloys in general were useful in formulating redistribution layers for semiconductor chips. Because no criticality has been demonstrated for the claimed weight percent of tantalum, a person of ordinary skill would reasonably have selected the alloys of Thomas for use in the electrical conductor path of James. Furthermore, a person of ordinary skill would reasonably have expected that the stated tensile strength of the Thomas alloys would have made them advantageous for use in redistribution layers for the purpose of making the layers stronger and less likely to break.



Electrical Example B (cont.)

The Attorney's Response:

In order to assess the question of obviousness, it is USPTO policy that appropriate factual findings are required; see the 2010 KSR Guidelines published in the Federal Register (Vol. 75, No. 169, page 53645, left hand column). In particular, it has to be considered whether the prior art would actually discourage and teach away from the claimed invention. See *Crocs, Inc. v. U.S. Int'l Trade Comm'n*, 598 F.3d 1294 (Fed. Cir. 2010), cited in the 2010 KSR Guidelines (Federal Register, Vol. 75, No. 169 on page 53647).

The specification of the present patent application explains the art-recognized method for decreasing the probability of breakages of the conductive path of the redistribution layer, and cites several references that teach this method. For example, the Haverty reference cited in the specification teaches that persons of ordinary skill in the art recognize that the optimum way to compensate for the mechanical stress occurring in the redistribution layer is to incorporate rubber-elastic elevations in specific forms or shapes. Further, the specification describes that according to Haverty, there is a known general electronic component having metal-coated elevations formed of a rubber elastic, silicone-based elastomer by a printing process.

Thomas acknowledges a correlation between tensile strength and the relative amount of tantalum in a copper-tantalum alloy.

However, before the effective filing date of the claimed invention a person of ordinary skill in the art would have had no reason to use the copper alloys with high ultimate tensile strength described by Thomas as a material of an electrical conductor path. In particular, regarding material properties, Haverty proposes to use rubber-elastic elevations for compensating for mechanical stress. Hence, in view of Haverty, the combination of James and Thomas does not provide a predictable result for a person of ordinary skill in the art. A predictable result is necessary for a rejection for non-obviousness, so the rejection under 35 U.S.C. 103 should be withdrawn, in accordance with the 2010 KSR Guidelines published in the Federal Register (Vol. 75, No. 169, page 53647, right-hand column, first and second paragraph).

For these reasons, claims 1-3 would not have been not obvious to a person of ordinary skill before the effective filing date of the claimed invention. Reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 is respectfully requested.



Electrical 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. What support does the attorney provide for the arguments?
3. Do the 2010 KSR Guidelines and the *Crocs* case support the attorney's position?

Electrical 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?



Electrical 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 attorney's argument is that the examiner has failed to consider all of the relevant prior art, including the Haverty reference that was discussed in the specification. The attorney's position is that a proper consideration of the teachings of Haverty leads to the conclusion that PHOSITA would not have used the alloy of Thomas in the redistribution layer of James, because Haverty teaches away from such a combination. The attorney also states that the result obtained from using the alloy of Thomas in the redistribution layer of James would not have been predictable, and concludes that the rejection was not proper for this reason.



Electrical Example B (cont.)

Questions to be Explored

2. What support does the attorney provide for the arguments?



Electrical Example B (cont.)

Questions to be Explored

2. What support does the attorney provide for the arguments?

The attorney cites the 2010 KSR Guidelines in support of the ideas that (1) the examiner is required to make factual findings; (2) an obviousness rejection based on a combination of references is not proper if the prior art teaches away from such a combination; and (3) the result obtained from combining prior art references must have been predictable. With regard to teaching away, the attorney further relies on the *Crocs* case.

Electrical Example B (cont.)

Questions to be Explored

3. Do the 2010 KSR Guidelines and the *Crocs* case support the attorney's position?





Electrical Example B (cont.)

Questions to be Explored

3. Do the 2010 KSR Guidelines and the *Crocs* case support the attorney's position?

In order to answer this question, the examiner should begin with the MPEP. The 2010 KSR Guidelines have been incorporated into MPEP 2143. The attorney also pointed out that the *Crocs* case was discussed in the 2010 KSR Guidelines; that case is discussed as Example 4 in MPEP 2143(I)(A).

The attorney is correct that the examiner is required to make factual findings. In response, **the examiner should point out that he has done so by citing the relevant teachings of the James and Thomas references.**

Although it is true that a prior art teaching away can be a convincing argument that a claimed invention would not have been obvious, in this case **the prior art does not actually teach away from the examiner's proposed combination. A teaching of one way to accomplish a goal, in this case reduced likelihood of breakage of the redistribution layer, is not a teaching that there would be no other ways to accomplish the same goal.** The examiner should respond by citing MPEP 2123 and 2143.01(I).





Electrical Example B (cont.)

(cont.)

As for the *Crocs* case, the discussion in MPEP 2143(I)(A) does not suggest that the art-recognized method of Haverty should be considered a teaching away from any other method of reducing breakage. There is no need for the examiner to retrieve and read the *Crocs* case in order to respond to the attorney's arguments; it is appropriate for the examiner to rely on the MPEP's discussion of *Crocs*.

The attorney argues that the rejection should be withdrawn because a "predictable result is necessary." However, the examiner's statement of the rejection had explained why PHOSITA would reasonably have expected that the alloy of Thomas could be used in the redistribution layer of James. **There is no requirement for absolute predictability. A reasonable expectation of success is sufficient to establish obviousness. In responding to the attorney's argument, the examiner should point out that per MPEP 2143.02, a reasonable expectation of success is sufficient to support a prima facie case of obviousness.**

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.



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



Mechanical Examples

Mechanical Example A

Claim

1. An armband comprising:
 - a first pouch configured to securely hold a smartphone while enabling usage thereof; and
 - a second pouch configured to contain an auxiliary power supply, wherein said auxiliary power supply and said smartphone are configured to be in operative communication, wherein said armband is made substantially of leather and provides protection against impact, abrasion and other hazards to a forearm when worn.



Mechanical Example A (cont.)

The Examiner's rejection

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Sampson in view of Harinaka.

Sampson teaches an armband comprising a pouch configured to hold a smartphone or other electronic device. The armband of Sampson may optionally comprise a second pouch in operative communication with the first pouch to hold additional items such as an auxiliary power supply. The armband of Sampson is made of synthetic material such as Neoprene or Kevlar. Sampson does not teach that the armband may be made of leather.

Harinaka teaches that a variety of protective wearable gear may be made of leather, including protective sleeves. The protective gear of Harinaka may also be configured to include pouches or pockets for carrying small items.

It would have been obvious for a person of ordinary skill in the art at the time of the effective filing date of the claimed invention to use leather as taught by Harinaka as the material for the armband of Sampson. A person of ordinary skill would have been motivated to do so, with a reasonable expectation of success, because leather was a well-known material for wearable protective gear as taught by Harinaka.



Mechanical Example A (cont.)

The Attorney's Response:

In order for a combination of references to render an invention obvious it must be apparent that their teachings can be combined. *In re Avery*, 518 F.2d 1228, 186 USPQ 161 (CCPA 1975).

Obviousness cannot be established by combining teachings of the prior art to produce the claimed invention, absent some teachings, suggestion or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). When the incentive to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (BPAI 1986). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, *Berghauser v. Dann*, 204 USPQ 393 (D.D.C. 1979); *ACS Hospital Sys. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of Claimed elements would have been obvious. *Ex parte Hiyamizu*, 10 USPQ2d 1393 (BPAI 1988). The same conclusion is true where the references expressly teach away from what the PTO contends is obvious from the references,

In re Grasseli, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983), or where the examiner's proposed modification would render the prior art version unsatisfactory for its intended purpose, *Ex parte Rosenfeld*, 130 USPQ 113 (POBA 1961). *Accord, In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *In re Kramer*, 18 USPQ2d 1415 (Fed. Cir. 1991) (unpublished decision). The references, viewed by themselves and not in retrospect, must suggest doing what applicants have done. *In re Shaffer*, 229 F.2d 476, 108 USPQ 326 (CCPA 1956); *In re Skoll*, 523 F.2d 1392, 187 USPQ 481 (CCPA 1975).

The mere fact it is possible for two isolated disclosures to be combined does not render the result of that combination obvious absent a logical reason of record which justifies the combination. *In re Regel*, 526 F.2d 1399, 188 USPQ 136 (CCPA 1975). To properly combine two references to reach a conclusion of obviousness, there must be some teachings, suggestion or inference in either or both of the references, or knowledge generally available to one of ordinary skill in the art, which would have led one to combine the relevant teachings of the two references. *Ashland Oil v. Delta Resins & Refractories*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).



Mechanical Example A (cont.)

The Attorney's Response (cont.):

The mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular structural modification is "well known" and thus obvious. Subjective opinions are of little weight against contrary evidence. *In re Wagner*, 371 F.2d 877, 152 USPQ 552 (CCPA 1967). If the examiner seeks to rely upon a theory of chemistry for obviousness, he must provide evidentiary support for the existence and meaning of that theory. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979).

Unless the Applicants question the accuracy of a statement of the Examiner unsupported by the art of record, or by presenting evidence to contradict it, it will probably be accepted as true on appeal. *In re Shapleigh*, 248 F.2d 96, 115 USPQ 129 (CCPA 1957). Data in the specification showing the claimed article possesses characteristics not possessed by the prior art should be accepted as accurate, notwithstanding the contrary opinion expressed *sua sponte* by the Board of Appeals. *In re Ehringer*, 347 F.2d 612, 146 USPQ 31 (CCPA 1965), (shock-resistant, vibration-resistant and non-sag filament wire).



Mechanical 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 the cited cases before replying to the attorney in the next Office action?
3. Does the attorney cite any cases that the examiner is not obligated to follow because they are not precedential decisions?

Mechanical 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?





Mechanical 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?

None. The attorney has merely submitted a list of case law without any explanation of how it applies to the facts of the case being examined. Nevertheless, it is clearly an attempt to respond to the Office action. Therefore, it would not be proper for the examiner to hold the case abandoned for failure to respond.

Mechanical Example A (cont.)

Questions to be Explored

2. Is it necessary for the examiner to review the cited cases before replying to the attorney in the next Office action?





Mechanical Example A (cont.)

Questions to be Explored

2. Is it necessary for the examiner to review the cited cases before replying to the attorney in the next Office action?

No. 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).**”





Mechanical 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).

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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.



Mechanical Example A (cont.)

Questions to be Explored

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



Mechanical Example A (cont.)

Questions to be Explored

3. 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).

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Mechanical Example A (cont.)

(cont)

It is possible that these cases are correct as to their statements of the law. However, because they are not precedential, they have no binding effect on examination. Thus, they do not lend strong support to the position being advanced in the attorney's response.

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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

Mechanical Example B

Claim

1. A microscope slide handling system comprising:
 - a plurality of slide supports, each support comprising a surface to support a microscope slide and a heating element that underlies the surface so as to transfer heat to a microscope slide resting on the surface;
 - at least one reagent dispenser that can dispense a liquid reagent onto a microscope slide on one of the slide supports;
 - a movable carriage that causes the reagent dispenser to be aligned over a desired microscope slide on one of the slide supports, so that reagent dispensed out of the reagent dispenser drops onto an underlying microscope slide on one of the slide supports; and
 - a control system programmed with instructions for applying reagents and heat to a plurality of microscope slides bearing biological samples, wherein the control system issues commands to cause relative motion between the reagent dispenser and a microscope slide on one of the slide supports so that the reagent dispenser is aligned over the microscope slide on one of the slide supports and issues commands to cause the heating elements to heat at specified times, the control system controlling heating of one heating element to a different temperature than another.



Mechanical Example B (cont.)

The Examiner's rejection

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Varma in view of Reynolds.

Varma teaches a microscope slide handling system that comprises a program which includes instructions for selectively applying heat to a plurality of microscope slides. The microscope slides may be used for biological samples. Varma also teaches a plurality of slide supports that contain heating elements as claimed, as well as a control system to cause the heating elements to heat at times and temperatures specified by the program. Varma states that the program may be configured such that the various heating elements may be at different temperatures from each other. The microscope slide handling system of Varma may be used when specimens mounted on slides are to be stained, and this process involves delivery of liquid reagents to the slides.

Varma does not teach a reagent dispenser with a moveable carriage as a component of the microscope slide handling system.

Reynolds teaches an automated dispensing apparatus for dispensing chemical reagents and other liquids onto one or more members of an array of substrates, as well as methods particularly adapted for dispensing precise quantities of chemical reagents onto a receptive membrane, such as to form a diagnostic test strip. The dispensing apparatus of Reynolds includes a movable carriage that aligns the reagent dispenser over a desired substrate, in accordance with a control program, so that the reagent is delivered onto a desired substrate.

It would have been obvious for a person of ordinary skill in the art at the time of the effective filing date of the claimed invention to incorporate the dispensing apparatus of Reynolds into the microscope handling system of Varma. A person of ordinary skill would have been motivated to do so, with a reasonable expectation of success, for the purpose of automating the process of staining biological specimens on slides, while ensuring delivery of an accurate amount of the staining reagent.

Mechanical Example B (cont.)

The Attorney's Response:

The Examiner rejected claim 1 under 35 U.S.C. § 103 as obvious over Varma in view of Reynolds reference. The applicant respectfully asserts that the Examiner has improperly combined non-analogous references in the present rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters*, 214 USPQ 735 (BPAI 1979). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). However, a claimed invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The *KSR* court stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because 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." *Id.* Specifically, there must be some articulated reasoning with a rational underpinning to support a conclusion of obviousness; a conclusory statement will not suffice. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Indeed, the factual inquiry determining whether to combine references must be thorough and searching, and it must be based on objective evidence of record. *In re Lee*, 61 USPQ2d 1430, 1436 (Fed. Cir. 2002).

Furthermore, there must be some reason to combine references other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, F.3d 994, 999 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)).

In addition, non-analogous art cannot properly be pertinent prior art under 35 U.S.C. §103. *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981). For the teachings of a reference to be prior art under 35 U.S.C. § 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the particular problem with which the invention pertains. *In re Horne*, 203 USPQ 969, 971 (CCPA 1979).

Mechanical Example B (cont.)

The Attorney's Response:

The determination of whether a reference is from a non-analogous art is set forth in a two-step test given in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567 (Fed. Cir. 1984). In *Union Carbide*, the court found that the first determination was whether “the reference is within the field of the inventor’s endeavor.” If it is not, one must proceed to the second step “to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.” In regard to the second step, *Bott v. Four Star Corp.*, 218 USPQ 358 (E.D. Mich. 1983), determined that “analogous art is that field of art which a person of ordinary skill in the art would have been apt to refer in attempting to solve the problem solved by a proposed invention.” In addition, a relevant area of art “should be where one of ordinary skill in the art would be aware that similar problems exist.” *Id.*

Based on the foregoing two-part non-analogous art test, the Reynolds reference does not qualify as analogous art. In regard to the first step of the *Union Carbide* test, the apparatus for making a diagnostic test strip of Reynolds is clearly not in the field of Applicant’s endeavor. That is, a diagnostic test strip is not related to a stained microscope slide.

In regard to the second step of the *Union Carbide* test, the diagnostic test strip of the Reynolds reference is not reasonably pertinent to the problem with which the Applicant was involved. The present application is related to a handling system for microscope slides. See the specification at page 1, lines 5-8. Test strips have absorbent substrates that are designed to be contacted with a test sample, and to provide some information about the properties or components of the sample. Microscope slides, on the other hand, are non-absorbent and merely act as a base on which to mount the biological specimen so that it can be examined under a microscope. Thus a person seeking to solve a problem in the field of microscope slides would not look to a teaching concerning absorbent test strips. A person of ordinary skill in the art “would have been apt to refer [to the art] in attempting to solve the problem solved by a proposed invention.” *Bott*, 218 USPQ 358.

Accordingly, the Reynolds reference is non-analogous art. Applicant respectfully requests that the Examiner remove the Reynolds reference from consideration. Because the Reynolds reference cannot properly be relied on as prior art, and because the Varma reference does not teach or suggest the invention as claimed, Applicant respectfully requests that the Examiner withdraw the rejection and allow claim 1.



Mechanical 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 there are two ways to establish that a reference is analogous art to the claimed invention, namely (1) that the reference is within the field of the applicant's endeavor, or (2) that the reference is reasonably pertinent to the particular problem with which the applicant was involved?
3. How can the examiner respond to the argument that Reynolds is not analogous art to the claimed invention because Reynolds relates to an absorbent test strip rather than to a non-absorbent microscope slide?
4. Does the attorney cite any cases that the examiner is not obligated to follow because they are not precedential decisions?



Mechanical 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?



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

Mechanical Example B (cont.)

Questions to be Explored

2. Is the attorney correct that there are two ways to establish that a reference is analogous art to the claimed invention, namely (1) that the reference is within the field of the applicant's endeavor, or (2) that the reference is reasonably pertinent to the particular problem with which the applicant was involved?



Mechanical Example B (cont.)

Questions to be Explored

2. Is the attorney correct that there are two ways to establish that a reference is analogous art to the claimed invention, namely (1) that the reference is within the field of the applicant's endeavor, or (2) that the reference is reasonably pertinent to the particular problem with which the applicant was involved?

Yes. See MPEP 2141.01(a). It is not necessary for the examiner to read *Union Carbide* or any other case that the attorney cites regarding analogous art.

Mechanical Example B (cont.)

Questions to be Explored

3. How can the examiner respond to the argument that Reynolds is not analogous art to the claimed invention because Reynolds relates to an absorbent test strip rather than to a non-absorbent microscope slide?





Mechanical Example B (cont.)

Questions to be Explored

3. How can the examiner respond to the argument that Reynolds is not analogous art to the claimed invention because Reynolds relates to an absorbent test strip rather than to a non-absorbent microscope slide?

The examiner should point out that the reason to look to Reynolds is that it teaches a delivery system for a liquid reagent that may be used in conjunction with an array of substrates. The claimed invention also involves an array of substrates to which a liquid reagent is to be delivered. **The fact that the substrates themselves differ does not impact the system that delivers the liquid reagent.** Thus, with regard to the relevant issue, which is how to deliver the liquid reagent, the Reynolds is reasonably pertinent to the problem faced by the inventor of the claim under examination.

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.



Mechanical 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?



Mechanical 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.

The court for *Bott v. Four Star Corp.*, 218 USPQ 358 (E.D. Mich. 1983), is the United States District Court for the Eastern District of Michigan as indicated by the abbreviation "E.D. Mich." so *Bott* is not a precedential decision. Furthermore, *Ex parte Wolters* is a USPTO Board decision and is therefore not precedential.





Mechanical Example B (cont.)

(cont.)

It is possible that these cases are correct as to their statements of the law. However, because they are not precedential, they have no binding effect on examination. Thus, they do 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 Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) is a Board decision cited in MPEP 2173.05(s). It reaffirms that claims are to be complete in themselves whenever possible, but permits references to figures or tables in claims "only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim." Even though *Fressola* 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.



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



Design Example

Design Example

Claim

1. The ornamental design for a DOUGHNUT as shown.

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



FIG 1

FIG 2

FIG 4

Figures 1, 2, and 4 are perspective, top, and front side views that illustrate the claimed design for a doughnut of a five-pointed star having obtuse angles between rounded off points and a gently curved top and flat bottom surfaces.

Design Example (cont.)

The Examiner's rejection

[Practice Note: Assume that the Hare 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 Hare in view of Corn.

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.

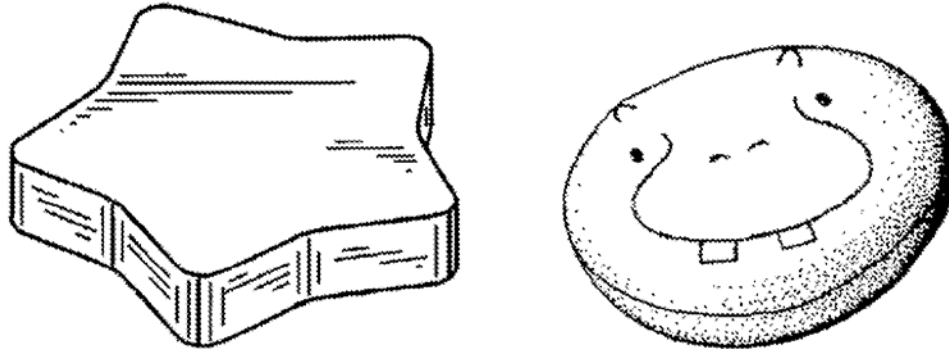
The food blend product of Hare has design characteristics which are basically the same as the claimed design showing: a five point star with obtuse inner angles and rounded points on the "legs."



Design Example (cont.)

The Examiner's rejection (cont.)

The claimed design is different from Hare 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.



Hare's Figure 7 is a perspective view from above of a star-shaped food blend product, and Corn's Figure 4 is a perspective view from above illustrating a hamburger bun decorated to evoke an image of a hippopotamus.



Design Example (cont.)

The Examiner's rejection (cont.)

The hamburger bun of Corn 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 Corn. A person of ordinary skill would have been motivated to modify the food blend product of Hare as suggested by Corn because the Hare and Corn 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 (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 (Corn) 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 (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 (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 (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 Corn reference is not analogous art to the claimed invention.

Design Example (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 (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 (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 (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 Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) is a Board decision cited in MPEP 2173.05(s). It reaffirms that claims are to be complete in themselves whenever possible, but permits references to figures or tables in claims “only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim.” Even though *Fressola* 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.



Design Example (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 (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 (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 (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 (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))**



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