

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Boardside Chat: evaluating common arguments

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UNITED STATES
PATENT AND TRADEMARK OFFICE



Question/comment submission

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Topics:

1. Burden
2. Claim scope
3. Addressing the rejection
4. Analogous art
5. Teaching away
6. Obvious to try

Appellant's burden

- *Ex parte Frye*
 - the Board reviews the obviousness rejection for error based upon the issues identified by appellant.
- 37 C.F.R. § 41.37(c)(1)(iv)
 - A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

Claim scope

“The name of the game is the claim.”

– Giles S. Rich, *The Extent of the Protection and Interpretation of Claims— American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990).

In making any patentability determination, analysis must begin with the question, “*what is the invention claimed?*” because “[c]laim interpretation, . . . will normally control the remainder of the decisional process.”

- *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987)



Claim scope

Claim: "A structure including a plurality of metallic members which support a platform."

Rejection: Anticipated by Stewart

Argument: Stewart does not teach a structure as claimed because, as described in the Specification, the platform must be able to withstand a large load for an extended time period without failure when the structure is used in a hot, corrosive environment.

~~Effective?~~

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Claim scope

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Argument: Stewart does not teach a structure as claimed because, as described in the Specification, the platform must be able to withstand a large load for an extended time period without failure when the structure is used in a hot, corrosive environment.

Arguments must be commensurate in scope with the actual claim language.

In re Hiniker Co., 150 F.3d 1362, 1369 (Fed. Cir. 1998);
Superguide Corp. v. DirectTV Enter., Inc., 358 F.3d 870, 875 (Fed. Cir. 2004).



Claim scope

Claim:

15. A composition prepared by a method comprising:
contacting amorphous carbon with an aqueous solution consisting essentially of ferric sulfate and an acid to form promoted amorphous carbon; and
drying the promoted amorphous carbon under drying conditions to form the composition.

Argument: The reference does not disclose the steps of the process of claim 15.

~~Effective?~~

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Claim scope

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15. A composition prepared by a method comprising:

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drying the promoted amorphous carbon under drying conditions to form the composition.

Argument: The reference does not disclose the steps of the process of claim 15.

This argument is unpersuasive because “it is the patentability of the product claimed and not of the recited process steps which must be established.”

In re Brown, 459 F.2d 531, 535 (CCPA 1972).



Hypothetical claim

A system, comprising:

a vehicle battery;

a heater configured to regulate a temperature of the vehicle battery, the heater including a thermoelectric heater element; and

a controller configured to operate the heater.

Addressing the rejection

Rejection: Baker discloses a vehicle battery system, but does not disclose a heater and a controller. Hill discloses a heater and controller for a battery system. It would have been obvious to modify Baker's system by adding a heater and controller, as disclosed by Hill, to provide battery power in cold temperatures and increase battery life.

Argument: Baker does not disclose a heater or a controller.

~~Effective?~~

Addressing the rejection

Rejection: Baker discloses a vehicle battery system, but does not disclose a heater and a controller. Hill discloses a heater and controller for a battery system. It would have been obvious to modify Baker's system by adding a heater and controller, as disclosed by Hill, to provide battery power in cold temperatures and increase battery life.

Argument: Baker does not disclose a heater or a controller.

It is well settled that non-obviousness cannot be established by attacking references individually where the rejection is based on the teachings for a combination of references.

See In re Merck & Co., 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

Addressing the rejection

Rejection: Baker discloses vehicle battery system as claimed except Baker does not disclose a heater and a controller. Hill discloses a heater and controller for a battery system. It would have been obvious to modify Baker's system by adding a heater and controller, as disclosed by Hill, to provide battery power in cold temperatures and increase battery life.

Argument: The Examiner provides no reason for combining the references.

~~Effective?~~

Addressing the rejection

Rejection: Baker discloses vehicle battery system as claimed except Baker does not disclose a heater and a controller. Hill discloses a heater and controller for a battery system. It would have been obvious to modify Baker's system by adding a heater and controller, as disclosed by Hill, to provide battery power in cold temperatures and to increase battery life.

Argument: The Examiner provides no reason for combining the references.

The Examiner provided a reason, namely "to provide battery power in cold temperatures and to increase battery life."

Addressing the rejection

- If a rejection is based on obviousness you have to address the combination (do not argue the references individually)
- Address the rejection and any associated evidence specifically
 - In particular, remember to address the proffered rationale when challenging it

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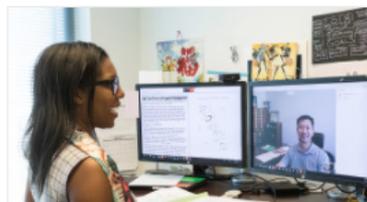
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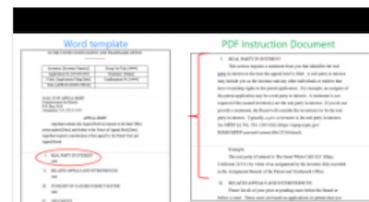
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Analogous art

Rejection: Claim is anticipated by Baker.

Argument: Baker is not analogous art.

~~Effective?~~

Analogous art

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“[T]he question whether a reference is analogous art is irrelevant to whether that reference anticipates.”

In re Schreiber, 128 F.3d 1473 (Fed. Cir. 1997); see also *State Contracting & Eng'g Corp. v Condotte Am., Inc.*, 346 F.3d 1057, 1068 (Fed. Cir. 2003); MPEP § 2131.05.



Analogous art

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Argument: Baker is not analogous art to Hill.



Analogous art

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The correct focus of the analogous art test is not whether the prior art references are analogous to each other, but whether the references are analogous to the claimed subject matter.

Ex parte Houtari, Appeal 2013-005825 (PTAB 2015) (citing *In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006)).



Analogous art

Rejection: Claim would have been obvious in view of Baker and Hill.

Argument: Baker is not in the same field of endeavor as the claimed subject matter and Hill is not reasonably pertinent to the problem the inventor faced.

~~Effective?~~

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Analogous art

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The test for whether art is analogous is a two-part test, and the argument combines the two prongs of the test.



Analogous art

The two criteria for evaluating whether a reference is sufficiently analogous to the invention are:

“(1) whether the art is from the same **field of endeavor**, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is **reasonably pertinent** to the particular problem with which the inventor is involved.”

In re Clay, 966 F.2d 656, 658-59 (Fed. Cir. 1992).

Analogous art

An effective argument would be that a reference is **outside Appellant's field of endeavor** and is **not reasonably pertinent to the problem** with which Appellant is concerned. For example:

- (1) The Specification describes the field of endeavor as adsorbents for cooling systems. In contrast, prior art describes its field of invention as relating to lubrication systems for use with internal combustion engines.
- (2) the Examiner fails to explain how the prior art is reasonably pertinent to solving the problem in a cooling system.

See Ex parte Baumann, Appeal 2019-006778 (PTAB 2020)

Teaching away

Rejection: Claim is anticipated by Baker.

Argument: Baker teaches away from the claimed subject matter.

~~Effective?~~

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Teaching away

Rejection: Claim is anticipated by Baker.

Argument: Baker teaches away from the claimed subject matter.

Teaching away is irrelevant to an anticipation analysis.

Celeritas Techs., Ltd. v. Rockwell Int'l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998); see also *Seachange Int'l, Inc. v. C-Cor, Inc.*, 413 F.3d 1361, 1380 (Fed. Cir. 2005).



Teaching away

Rejection: Claim would have been obvious over Baker and Hill.

Argument: Baker teaches away from the proposed combination because Baker teaches that the approach is inferior.

~~Effective?~~

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Teaching away

“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 416 (2007) (citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966))



Teaching away

- “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.”

In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994)

- “The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not **criticize, discredit, or otherwise discourage** the solution claimed.”

In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004)

Teaching away

Claim: A method for recoating an optical article using vapor deposition

Rejection: Obvious over Martin which discloses removing a previously applied anti-soiling coating

Argument: Martin teaches away because Martin discloses durability of optical coating applied by vapor deposition is poor and describes spraying, casting, rolling or immersing as suitable techniques.

 **Effective**

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Teaching away

Martin teaches that the durability of anti-soiling coatings applied by vapor deposition to dry rub abrasion is relatively poor, and oil repellency may be less than desired. Martin ¶ 34. Martin identifies “suitable” application techniques for anti-soiling coating as including, but not being limited to, spraying, casting, rolling, or immersing. *Id.* ¶ 52. One of ordinary skill in the art reading Martin would be discouraged from choosing the claimed vapor evaporation deposition and would choose a technique other than the claimed vacuum evaporation deposition to apply an anti-soiling coating.

Ex parte Strobel, Appeal 2020-002803 (PTAB Apr. 22, 2021).



Obvious to try

Claim: A heat exchanger. . . including flow channels having a flow pattern with a pattern of waves of a first wavelength in a first direction and waves of a second wavelength in a second direction.

Rejection: The Examiner stated there were two possibilities regarding the waves: (1) the first and second wavelength were the same, or (2) the first and second wavelengths were different. In light of this, the Examiner determined it would have been obvious to try different first and second wavelengths.

Argument: Appellant argues that it has not chosen to use two different wavelengths as a simple selection from a finite universe of possibilities because the universe of possibilities before the present invention was to use the same wavelength in both directions, as is evidenced by the applied prior art.

 **Effective**

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Obvious to try

The obvious-to-try rationale applies “[w]hen there is a **design need or market pressure** to solve a problem **and** there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the **known options** within his or her technical grasp.” *KSR*, 550 U.S. at 421 (emphasis added).

Of the two options that the Examiner contends would have been obvious for one of ordinary skill in the art to choose from--using the same wavelength, or using different wavelengths--**only one has been shown** to have been known in the art at the time of the invention: using the same wavelength. Thus, *KSR*'s obvious-to-try rationale is not applicable on this record.

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