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To
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Commisioner for Patents
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Sir

Attached are my comment(s) concerning the Examinations Guideline Update: Developments in the Obviousness Inquiry After KSR v Teleflex, [Docket No: PTO-P-2010-0055] as appeared in the Federal Register Vol 75, No. 169, page 53643, Wed. Sept. 1, 2010.

Respectfully

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Comment relating to Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, as printed in Fed. Reg. Vol 75, No 169, Wednesday Sept. 1, 2010, pages 53643, ff. [2010 KSR Guidelines Update]

This comment specifically concerns the proposed use of “common sense” in supporting a prior-art based rejection as discussed in the Guidelines Update at page 53648 (concerning the *Wyers v. Master Lock* Federal Circuit opinion) and at pages 53656-7 (concerning the *Perfect Web* opinion).

The Guidelines Update repeats language from these cases that state “common sense may be used to support a legal conclusion of obviousness so long as it is explained with sufficient reasons” Below are my reasons opposing that, and objecting to common sense reasoning in any serious obviousness analysis under 35 USC 103.

The call for “common sense” in a prior-art based rejections is the result of an unfortunate choice of terminology by Judge Dyk in *Wyers v. Master Lock*. Common Sense is by any definition a subjective mental process, incapable of explanation with any meaningful precision, and certainly not conducive to any administrative or judicial review. My specific objection to the uses of “common sense” here is that it is too subjective, by nature, to be used in reasoning; and because the additional requirement of “sufficient reasoning” should take the justification for rejection OUT OF the subjective realm of “common sense” and into the more objective region of “predictability” where the examiner’s reasoning can rely on the usual standards of obviousness and predictability. In that case, there is no need for reliance on common sense; the use of common sense can only lead to difficulties. Also, “common sense” is a resort to what “everybody” knows, and gets us to lose track of what the person of ordinary skill knows.

“Common Sense” in philosophical considerations is sometimes called Epistemological Particularism, which basically involves a gathering of a list of propositions that seem obvious and unassailable, and then using that set of propositions in testing the adequacy of a particular theory. According to Aristotle, “Common Sense” is an inner sensibility whereby the five external senses (i.e., hearing, sight, smell, taste, touch) are unified and judged, such that the human mind can determine, by this “common” sense, just what the substance is of the object that is being sensed.. In modern times, “Commonsense Reasoning” (a branch of artificial intelligence) is the branch concerned with the replicating of human thinking. This means the use of inexact reasoning methods that seem to characterize human thinking:

- a. reasoning with knowledge that is true-by-default;
- b. reasoning rapidly across a broad range of domains;
- c. tolerating uncertainty in knowledge;
- d. making decisions under incomplete knowledge, with flexibility to revise a belief or design when more complete knowledge becomes available.

Common Sense is thus the inexact, subconscious reasoning that may or may not lead us to the

right answer, but which we have learned to rely on where errors can be easily corrected. Common Sense is never the basis for exact legal reasoning.

“Common Sense” also refers to a set of beliefs or propositions that seem to many people to be prudent and of sound judgment, without resort to or dependence upon specialized, esoteric knowledge. Presumably, this would include the body of knowledge known to others outside the community of persons of ordinary skill.

The most useful discussion of “common sense” as such that I could find is in “A Common-Sense Reasoning System for Mechanical Engineering,” Aaron M. Sokoloski, M.I.T. 2005: “Common Sense is a huge domain of knowledge that is built up cumulatively over many years, and could be defined as the knowledge that is common to the vast majority of people of a given culture. This knowledge is mostly automatically learned, just by living. Comparing the time spent gathering common sense (nearly every waking hour since birth) to the amount of time necessary to learn, for example, basic calculus (a few hours per day for a semester), the difference in the magnitude of the knowledge involved becomes quite evident.”

I might also point out that neither the term “common sense” nor any synonym for it appears anywhere in Section 102 or Section 103 of the patent act.

The more usual terms, “obvious” and “predictable” are not so problematic.

“Obvious” comes from the Latin *ob viam* (i.e., blocking one’s path), i.e., lying in the road, or right in front of you. Some of its synonyms are “apparent”, “self-evident”, “visible”, “discernible”, “clear”, “unobscured”, and “in plain sight.”

“Predictable” means “allowing the user to see the impact of a proposed change before the change is made.”

The two terms “Obvious” and “Predictable” provide plenty of ammunition for the examiner in applying prior art and explaining why.

One last point: When I was a young kid, one day my grandmother, who lived in another town about 35 miles away, had come to visit, and when my dad drove her back home I rode with them in the car. The entire journey, they had an argument, or rather a debate, about God and Common Sense, with my grandmother arguing that faith in God and Common Sense were one and the same thing, and with my dad arguing that they were two difference things altogether. At the time I had no idea what they were talking about. After we left Grandma’s house I asked Dad and he said I would understand better when I grew up. Looking back on that day, I still do not know what they were arguing about. All I can say is that common sense, like faith in God, is something that can only be perceived and understood from one’s own personal perspective, and is not susceptible to any sort of verification or objective analysis. Common sense, being so

completely subjective, is not going to lead us to any sort of predictable result. Common sense reasoning thus has no business being involved with any sort of obviousness test.

I strongly recommend that the KSR Guidelines instruct the Examining Corps to rely on the usual well-defined terms “obvious” and “predictable” for reasoning to explain the application of prior art to a claimed invention, and completely and altogether avoid the subjective and diffuse matters raised by use of “common sense.”

Respectfully,

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