

OVERCOMING OBVIOUSNESS / 35 U.S.C. § 103(a) Rejections



談定宇

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YOUR RESOURCES

- ✘ MPEP
- ✘ This course material
- ✘ Consult someone knowledgeable in U.S. patent law
- ✘ Consult technical experts of the relevant field(s)
- ✘ Consult other patent professionals
- ✘ CAFC case law
- ✘ BPAI case studies
- ✘ Perform in depth research into technology if necessary
- ✘ Gather Secondary Evidence - Affidavits or Declarations

Traversing Rejections, 37 CFR 1.132

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**ARTICULATED
REASONING**
BASED ON FACTS,
LOGIC, REFERENCES...

**TEACHING
AWAY**

REFERENCEs
to **MODIFY** or
COMBINE:
DESCRIPTION
ENABLEMENT

**EVERY FEATURE
NEED TO BE
MET/TAUGHT**

2

**INCORRECT CLAIM
CONSTRUCTION BY
EXAMINER UNDER
BROADEST REASONABLE
INTERPRETATION**

**EXAMINER ARGUMENT:
SPECULATIVE &
ESTABLISHED BY
MERE PROBABILITY**

**IMPERMISSIBLE
HINDSIGHT**

**NOT MERELY PERFORM
FUNCTIONS THAT EACH
ELEMENT PERFORMED
SEPARATELY**

3

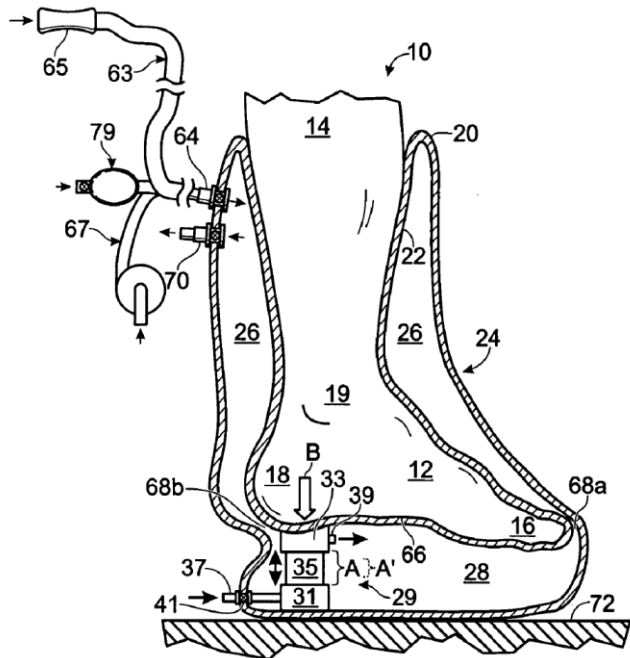
**REASONABLE
EXPECTATION
OF SUCCESS**

**HIGHLY COMPLEX
& EXTENSIVE
MODIFICATIONS
REQUIRED**

**EXAMINER ARGUMENT
IS A CONCLUSION &
NOT A REASON**

**COMMON SENSE ACTING
AS TEACHING AWAY**

Appeal 2009-004249;
Application 11/060,933
[Prior Art Teaching Away]



- ✘ Inflatable boots - rehabilitation of toe injuries - massaging - variation of pressures = improved blood flow to injured area
- ✘ References: Eischen, US 5,868,690 ; Spier US 4,995,173
- ✘ Spier: “inlet valve 14 is located above the heel so as to reduce the

possibility of drawing water and dust into the bladder 24”

- ✘ Teaching away from placing the inlet valve on the sole of the shoe. And would have **reasonably discouraged ... from placing inlet valve into the sole** as required by the claim.

Appeal 2009-006512; Application 11/000,124

[Reasonable Expectation of Success]

Coextruded Toner Receiver Layer for Electrophotography (Xerography)

✘ Toner receiving member with improved gloss & resistance to environmental damage with good toner adhesion.

✘ Board: Evidence supports that a photoreceptor is a **distinct element distinguishable from** an image-receiving sheet.

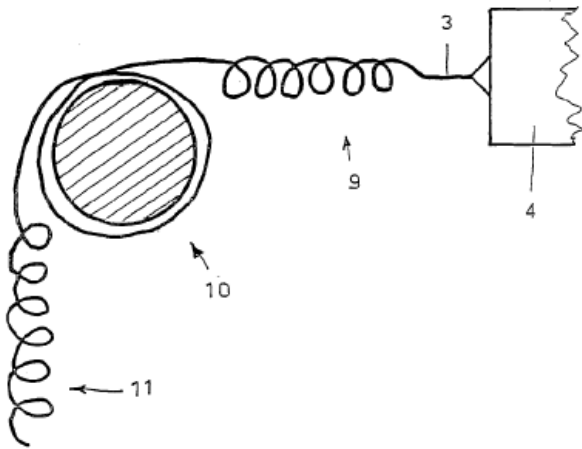
Therefore ... **cannot agree with** Examiner that the two devices are “functionally equivalent”.

✘ However, Examiner **has not established that** ... would have a reasonable expectation that ethylene methacrylate **would predictably** provide **properties** disclosed by Kato in the **different environment** of Tani (reasonable expectation of success).

✘ Insufficient reasoning as to why PHOSITA would have used the

ethylene methacrylate taught by Kato for use in a photoreceptor in electrophotographic image-receiving sheet taught by Tani. (Lacking articulated reasoning)

Appeal 2009-002234;
Application 10/475,322

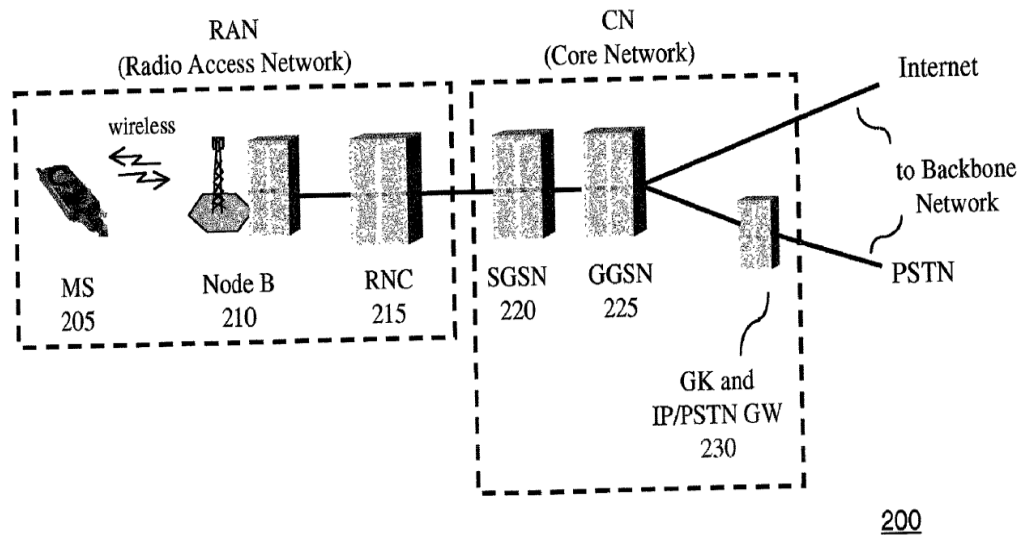


- ✘ Process for forming a curl decorative ribbon
- ✘ Jofs reference **does not support the conclusion** by the Examiner, which he had admitted. (official notice)
- ✘ However, Examiner states “[t]he cited portions also teach the net like formations are formed on the other plastic layer, which is **interpreted as** improving the bond between the two layers.” This **newly presented explanation does not appear to be based upon**

technical reasoning supplied by the cited references. (official notice/Examiner's own wrongful interpretation)

- ✘ Examiner has also **not addressed** why PHOSITA would have sought to include a component in the polymer laminate that would have increased the friction **contrary to** the teachings of Corbett. (teaching away)
- ✘ **No explanation** has been provided by Examiner as to why PHOSITA reasonably expected the system of Pooley, one that requires adding an activator compound to a layer separate from the layer to which the blowing agent was added, **would have been suitable** for the process of Corbett. (reasonable expectation of success / articulated reasoning)

Appeal 2009-000156; Application 09/764,510



- ✘ Universal Mobile Telecommunications System core network: supports negotiation of variable QoS. A QoS information element is defined that supports downgradeable QoS requirements by allowing multiple traffic classes to be specified in a priority order. Similarly, it also supports upgradeable QoS requirements.
- ✘ Issuance of a request for preferred ones of traffic classes (e.g., streaming and interactive) in a priority order during negotiations for

variable quality of service between a transmitting station and a receiving station.

- ✘ Appellant argues “[a] traffic class protocol field value included within a received packet and used by a QoS classifier for classifying the received packet into a QoS class and QoS subclass for QoS-based transmission over a radio network, as taught in Rinne, **is not a** traffic class field for conveying a request . . . for preferred ones of traffic classes in a priority order” as set forth in the claims. (incorrect feature construction)
- ✘ Although Rinne describes a QoS scheduler that comprises means for determining from a priority table priorities of packets stored according to differing classes,....., **Rinne is silent as to** a request being made for preferred ones of traffic classes in a priority order.
- ✘ In claims having **complex sets of features, which may also involve high degree of specialized technical expertise**, sometimes Examiner

would mistakenly construct a feature to produce an incorrect match
taken from prior art (feature/element mismatch)

Appeal 2009-003720; Application 09/870,672



- ✘ A stent, having a deformable portion, to improve flexibility of an annular unit of the device, so can pass easily through a bent portion of human body.
- ✘ Appellant points out, “there are many . . .symmetrical and asymmetrical configurations for the groove[s] . . . **that would not ‘read upon’** Appellant’s claims”
- ✘ Appellant **disagreed that Palmaz’s teaching** that grooves “may be provided anywhere on the inner surface of the stent . . . , or an asymmetrical, pattern of grooves” is an **adequate reason** to place the

grooves in an “endless annular configuration” **or** a “spiral configuration” as **specifically required by the claims**.

- ✘ Examiner argues that “there must be an initial user interface into which the data is [sic] integrated in order to generate the custom user interface” (official notice/Examiner interpretation)... but we can **find no explicit support** in Hart for such a judgment.
- ✘ **It could be equally true** that Hart **implies** a template, into which data are provided to construct the custom interface, **without the need for** modification of an existing template and/or interface. (alternative interpretation offered by Appellant to counter the validity of Examiner’s argument)
- ✘ As such, we find this **to be speculation, and not a foundation** for a prima facie case of obviousness. (mere speculation does not form proper articulated reasoning)

Appeal 2009-003838; Application 10/503,314

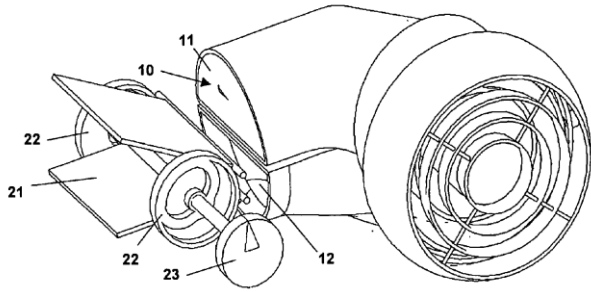
✘ **Ceramic composite material, and pencil-type glow plug containing such a material**

✘ Examiner asserted that rejection was premised on the **substitution of one dielectric layer for another.**

✘ However, **no explanation was provided** as to why PHOSITA would have **reasonably expected** the exposed dielectric layer for a semiconductor device **to be suitable for** a heat-resistant glass layer disposed inside a protective pipe such as disclosed in Kita
(articulated reasoning / reasonable expectation of success)

✘ Lacking articulated reasoning & reasonable expectation of success when combined

Appeal 2009-002693; Application 10/528,566



- ✘ Air inlet for a motor vehicle. Air-guiding device dividing air into streams, imparting a swirling motion.
- ✘ Substitution proposed by Examiner **does not seem to be obvious combination** of prior art elements or any other indicator of obviousness.
- ✘ Rather the **extensive amount of modification needed** is **suggested nowhere** in the cited art, and is born from **use of impermissible hindsight** ... in view of Appellant's Specification. (extensive amount of modification where teachings are missing in the prior art / impermissible hindsight)

Appeal No. 2009-005519; Reexam Control 90/008,305

- ✘ Method for detecting a deficiency of cobalamin or folic acid in warm-blooded animals. (anemia in children)
- ✘ While Westhuyzen fairly suggests a correlation between an elevated plasma homocysteine level and vitamin B12 deficiency
Homocysteine is **only a part of** “total” homocysteine and its increase **does not necessarily mean an increase in “total”** homocysteine ...
- ✘ In particular, since Westhuyzen precipitated the plasma proteins with acid prior to determining the amino acid levels in the plasma,
Thus, Westhuyzen **did not determine total** homocysteine levels.
(Appellant providing facts to negate Examiner’s determination validity)
- ✘ Examiner has **made no findings which provide a factual basis** for extrapolating “total homocysteine” levels from one or more of the forms which comprise it, especially in view of the known

redistribution between free and bound forms of homocysteine

(lack of articulated reasoning)

✘ Examiner has **failed to provide a sufficient factual basis** to support conclusion of obviousness

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THANK YOU