

# Winning a Non-Obviousness Case at the Board

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Obvious



Not Obvious



# Ratcheting Up a Non-Obviousness Position

- Attack with Argument Only
- Attack with Argument + Evidence
- Where to Focus Arguments to be Most Effective?
- Where to Direct Your Evidence?
- How Best to Present your Evidence of Non-Obviousness?

# Rebutting Non-Obviousness - Our Approach

- Met with BPAI Judges and Collected Their Feedback
- Reviewed 100 BPAI cases in 2010 where Board Reversed Examiner
- Plus Gloss of Our Own Practice

# Overcoming a Prima Facie Case of Obviousness

- "USPTO bears the initial burden of presenting a prima facie case of unpatentability."

*In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002)

- *Prima facie*: "Evidence good and sufficient on its face; such evidence as, in the judgment of the law, is sufficient to establish a given fact, or the group or chain of facts constituting the party's claim or defense, and which if not rebutted or contradicted is sufficient to sustain a judgment in favor of the issue which it supports, but which may be contradicted by other evidence...." *Blacks Law Dictionary*, 1189-90 (6th ed., West 1990).

# Question of law based on factual inquiries

- USPTO serves as fact finder
- *Graham v. Deere* factual inquiries:
  - Determine the scope and content of the prior art.
  - Determine the differences between the prior art and the claimed invention.
  - Determine the level of ordinary skill in the relevant art.
- Legal determination of obviousness
- Must have articulated reasoning or rationale for obviousness
- Must take into account secondary considerations
  - (long felt need, unexpected results, commercial success, failure of others, etc.)

# Post-KSR Hurdles

- "a court must ask whether the improvement is more than the **predictable** use of prior art elements according to their established functions."
- " When a work is available in one field of endeavor, design incentives and other **market forces** can prompt variations of it, either in the same field or a different one."
- "...[A] court can take account of the inferences and **creative steps** that a person of ordinary skill in the art would employ."
- " Granting patent protection to advances that would occur in the ordinary course **without real innovation** retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility."
- " **Common sense** teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle."

# Examination Guidelines

- Exemplary rationales in support of obviousness:
  - (A) Combining prior art elements according to known methods to yield predictable results;
  - (B) Simple substitution of one known element for another to obtain predictable results;
  - (C) Use of known technique to improve similar devices (methods, or products) in the same way;
  - (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
  - (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
  - (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art; and
  - (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention."

(M.P.E.P. § 2141.III.)



# BPAI Judges Feedback

## Persuasive Bases

- Technical Differences/Missing Element
- Claim Construction
- Rationale for Obviousness Missing
- Teaching Away
- Inoperative Result/ Change of Intended Purpose

# Examiner Reversal by BPAI under §103<sup>1</sup>

- Specified Basis for Reversal (All Technologies):
  - 55% - Lack of Articulated Rationale
  - 35% - Missing Element
  - 8% - Improper Claim Construction
  - 2% - Secondary Considerations
- Few 132 Declarations Present

<sup>[1]</sup> Based on review of 100 cases decided by BPAI from January 20, 2010 to February 22, 2010 in which the BPAI had reversed the Examiner on the issue of obviousness.

# Tabular Results

Table

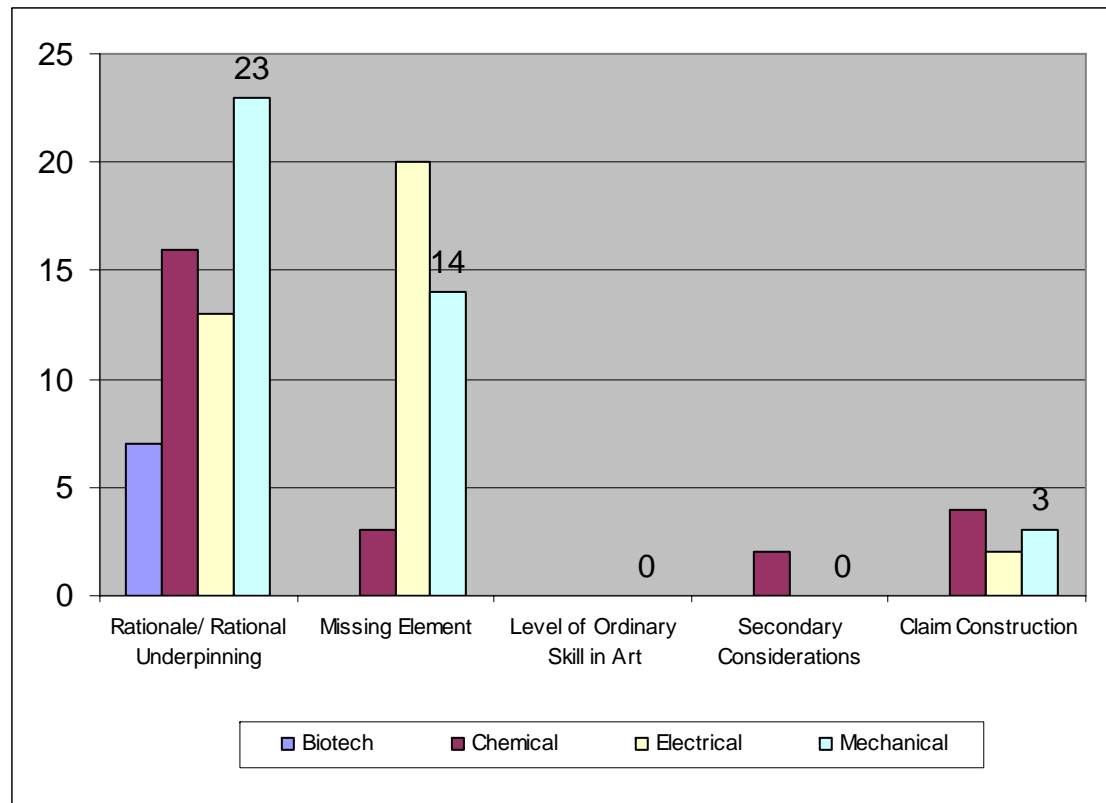
Bases for Reversal of Examiner Cited by Board in 100 Cases Decided  
Between January 20, 2010 to February 22, 2010

<b><i>Cited Basis for Reversal on 103</i></b>	Biotech	Chemical	Electrical	Mechanical	Total
Rationale/ Rational Underpinning	7	16	13	23	59
Missing Element	1	3	20	14	38
Secondary Considerations	0	2	0	0	2
Claim Construction	0	4	2	3	9
Totals	8	25	35	40	108 <sup>1</sup>

<sup>1</sup> Note the total exceeds 100 as some cases had more than one basis cited for reversal.

# Graphical Results

Bases for Reversal of Examiner Cited by Board in 100 Cases Decided  
Between January 20, 2010 to February 22, 2010

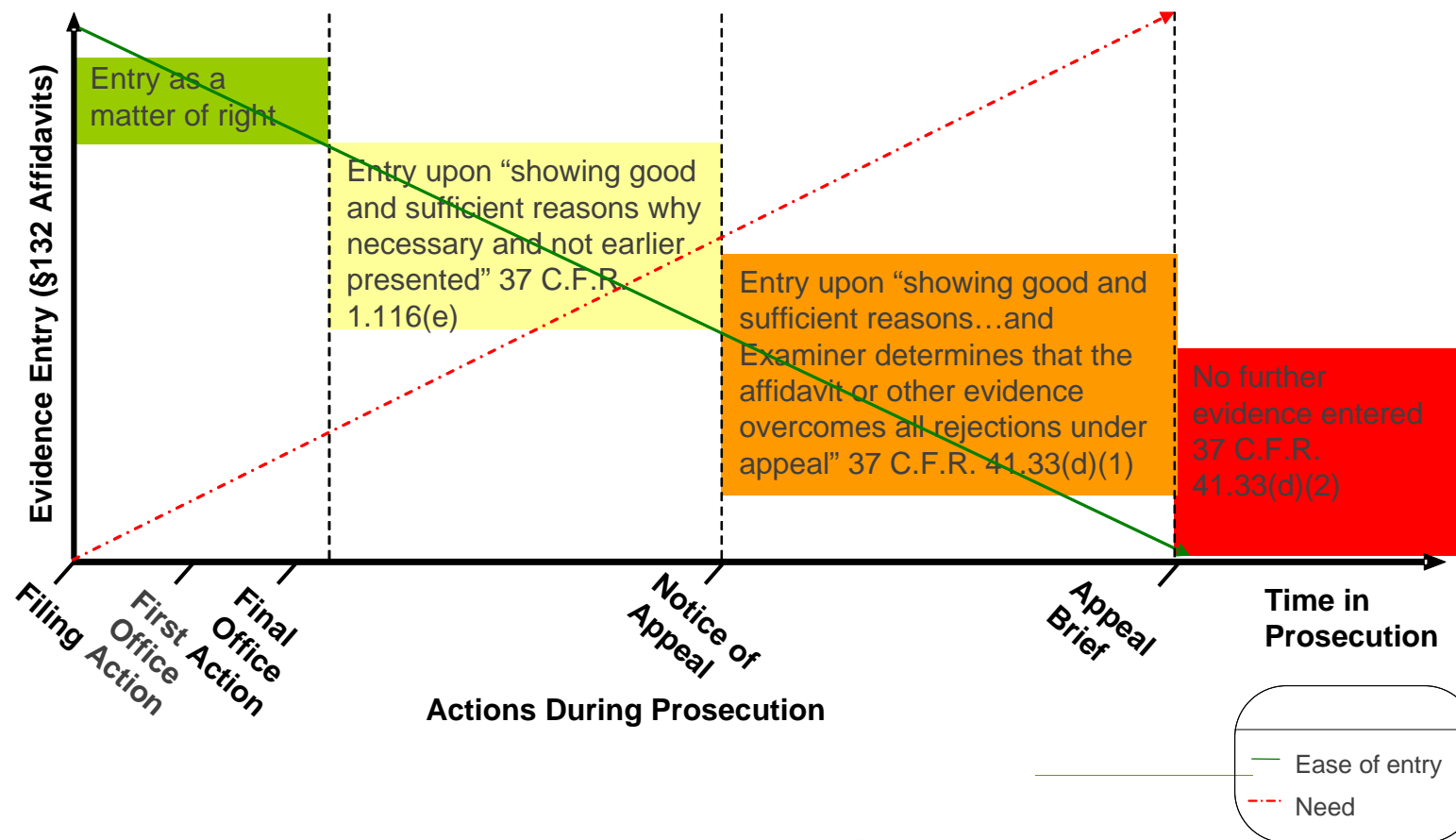


# How to Present Evidence

- Declaratory Evidence under Rule 132
- Examples of Rule 132 Declarations

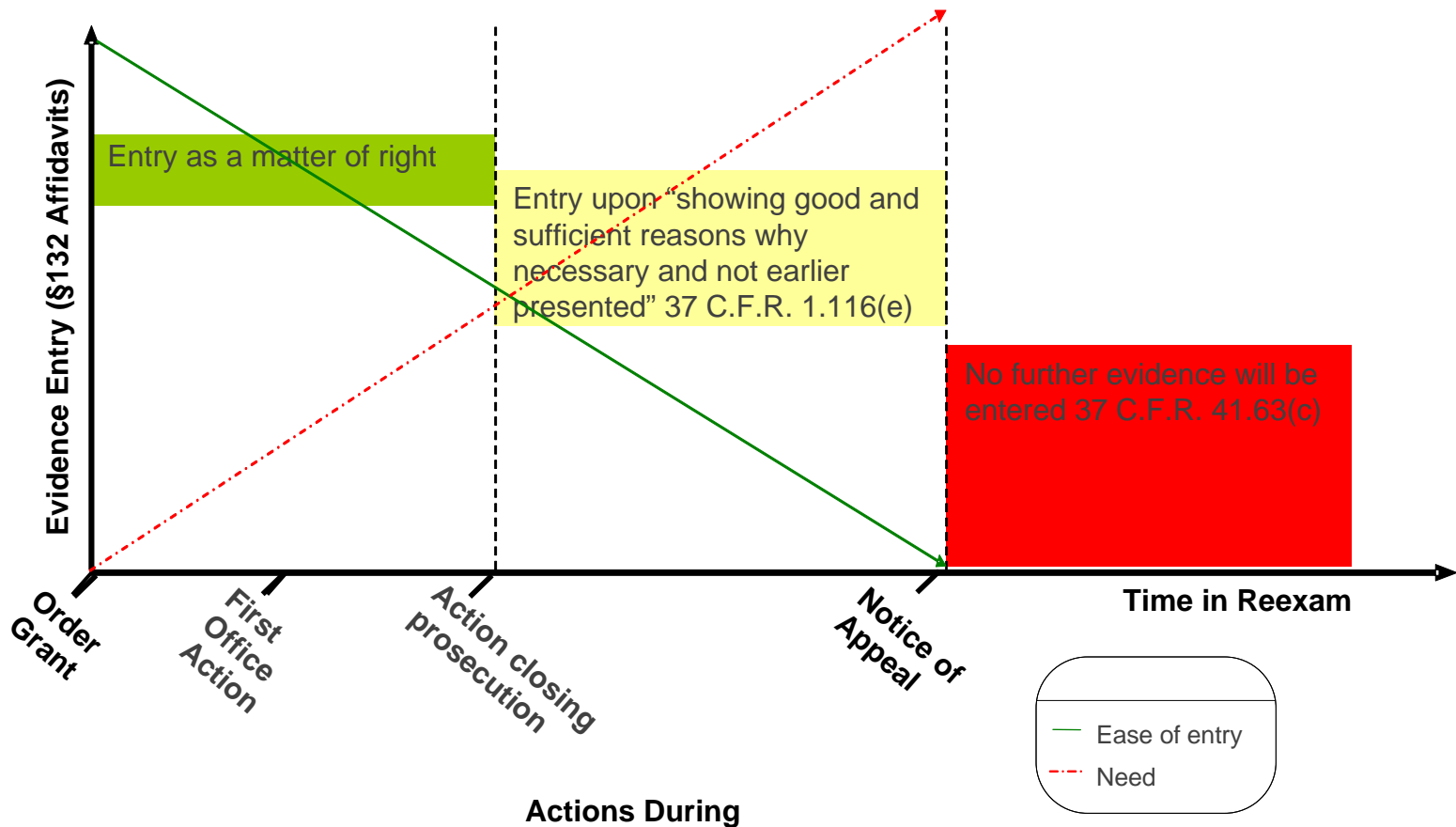
# Need versus Timing

## Ability to Enter Evidence During Ex Parte Prosecution and Reexamination



# Need versus Timing - Reexamination

## Ability to Enter Evidence During Inter Partes Reexamination



# Strategies and Takeaways

- Follow General Principles of Good Advocacy
- Present Non-Obviousness Arguments Clearly
- Many Tried and True Arguments Still Apply
- Consider Attacks based on Lack of Rationale and Improper Claim Construction
- Consider Evidence of Non-Obviousness Early On and Throughout Prosecution
- Draft Sound §1.132 Declarations Presenting Factual Evidence on Relevant Issues  
(not mere conclusory statements)



# Conclusion

# Thank you!



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