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Understanding 35 U.S.C rejection in the office action

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Prior Art Rejections

- What are they?
- Where do they fit in the examination process?
- How do we determine what is prior art?
- What are the different types of prior art?
- What are the statutory requirements?

Determining Patentability

- Claimed inventions are presumed to be patentable ***unless*** the examiner is able to establish a *prima facie* case that one of the patentability requirements is not met.
- A ***prima facie*** case is one that ***at first sight*** presents sufficient evidence to support your conclusion. An examiner's evidence is prior art, e.g., prior publications, patents, admissions of prior art, on-sale items, etc.
- ***Anticipation*** (35 USC §102) and ***obviousness*** (35 USC §103) are the most frequent reasons for rejecting a claim.

Prior Art and Anticipation

How is Prior Art Used for Lack of Novelty?

What is Anticipation?

- Anticipation: When a single prior art reference describes, either expressly or inherently, each and every limitation of a claim
 - A single prior art reference ***anticipates*** the claimed invention by describing every limitation in the claim.
 - The limitations may either be set forth expressly or be inherently present in the prior art reference.

Types of Evidence That Can Be Employed to Make Prior Art Rejections

- **References** – Printed documents, including patents (domestic and foreign) and other printed publications (non-patent literature, known as NPL); *see MPEP 2126-2128*
- **Admissions** – Statements by applicants that certain information was prior art to the inventor; *see MPEP 2129*
- **Affidavits and Declarations** – Evidence may be provided of knowledge and activity that constitute prior art – i.e. “sworn evidentiary statements”
- **Knowledge in the Art** – may be evidenced by logical reasoning or common knowledge; *see MPEP 2144* (such evidence is sometimes made “of record” by “taking official notice;” *see MPEP 2144.03*)

Otherwise Available to the Public

- America Invents Act (AIA) First Inventor To File (FITF) adds another category of prior art: “Otherwise available to the public” is a catch-all provision of 35 USC §102(a)(1). For example:
 - an oral presentation at a scientific meeting
 - a demonstration at a trade show
 - a lecture or speech
 - a statement made on a radio talk show
 - a YouTube video, website, or other on-line material

Prior Art Requirements for Anticipation under 35 USC §102 (AIA FITF)

AIA FITF Prior Art Requirements

35 USC §102(a)(1) and 102(a)(2)

(a) Novelty; Prior Art. — A person shall be entitled to a patent unless—

- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
- (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

102(a)(1) Types of Prior Art

1. "...patented, described in a printed publication,"
2. "or in public use, on sale,"
3. "or otherwise available to the public..."

**Now let's briefly look at
35 U.S.C. §102(a)(1)....**

35 U.S.C. §102(a)(1)

§ 102. Conditions for patentability; novelty

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention

35 U.S.C. §102(a)(1) Overview

- An essential part of the overall patent examination process is to determine whether those conditions are met for claims in an application
- This determination is made after a complete search for the claimed invention is done

35 U.S.C. §102(a)(1) Overview

- Conditions met: the claims lack “novelty”(unless an exception applies) and are therefore unpatentable
 - Result: Reject claims under 35 U.S.C. §102(a)(1)
- Conditions not met: no rejection is made under 35 U.S.C. §102(a)(1)
 - Patent is not necessarily issued because rejections under other statutes may still apply
 - 35 U.S.C. §101
 - 35 U.S.C. §102(a)(2)
 - 35 U.S.C. §103
 - 35 U.S.C. §112

35 U.S.C. 103

Overview of the Statute

MPEP 2141

35 U.S.C. 103 Conditions for Patentability: Non-Obvious Subject Matter

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole **would have been *obvious before the effective filing date of the claimed invention* to a person having ordinary skill in the art to which the claimed invention pertains.** Patentability shall not be negated by the manner in which the invention was made.

(emphasis added)

When Should a Rejection Under 35 U.S.C. 103 Be Made?

- A rejection based on 35 U.S.C. 103 is used when the claimed invention is **not identically disclosed** so the reference teachings must somehow be modified in order to meet the claims
- The differences between the claimed invention as a whole and the reference teachings must have been **obvious differences:**
 - ***before the effective filing date of the claimed invention;***
and
 - ***to a person having ordinary skill in the art***

See MPEP 706.02

35 U.S.C. 103

- The ultimate determination of whether or not an invention is obvious is a ***legal conclusion*** based on underlying ***factual inquiries***
- Factors to be considered when analyzing prior art under 35 U.S.C. 103 were articulated by the Supreme Court in a 1966 decision, ***Graham v. John Deere Co.***, 838 U.S. 1, 17-18, 148 USPQ 459, 467 (1966)

Inquiries in *Graham v. John Deere* Must be Addressed to Determine Obviousness

- The Supreme Court affirmed that the framework set forth in *Graham v. John Deere* continues to define the inquiries that should be addressed in determining obviousness under 35 U.S.C. 103 [*KSR Int'l Co. v. Teleflex Inc.* 550 U.S. 398, 82 USPQ2d 1385 (2007)]
- Office personnel serve as fact finders when resolving the *Graham* inquiries and must ensure that the written record includes findings of facts concerning the state of the art and teachings of the references applied

***Graham v. John Deere* Inquiries**

- 1) What is the scope and content of the prior art?
- 2) What are the differences between the prior art and the claims at issue?
- 3) What is the relevant level of ordinary skill in the pertinent art?
- 4) Does any objective evidence of non-obviousness exist?

See MPEP 2141

The Basic Factual Inquiries of Graham v. John Deere Co.

Determining Obviousness

Obviousness Analysis: Inquiry One

- I. Determine the Scope And Content of the Prior Art

MPEP 2141.01

What is Prior Art for the Purposes of 35 U.S.C. 103?

- Prior art includes both the specialized understanding of one of ordinary skill in the art and the common understanding of the layman
- Most 35 U.S.C. 103 rejections are made based on prior art available under 35 U.S.C. 102
- References that meet the “who,” “when,” and “where” criteria set forth in 102 to qualify as **prior** art are available as prior art to use in any appropriate rejection under 103

What is Prior Art for the Purposes of 35 U.S.C. 103? (*cont.*)

In addition to references available under 35 U.S.C. 102, examiners may rely on, for example, **official notice, common sense, common ingenuity, and obvious matters of design choice, provided sufficient explanation is set forth to establish a *prima facie* case of obviousness**

Combining References

- A single reference does not need to teach all aspects of the claimed invention; a 103 rejection may be based on a combination of references
- The Supreme Court discussed “the need for caution in granting a patent based on the combination of elements found in the prior art” (*KSR* at page 1395)

Combining References (*cont.*)

- “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” (*KSR* at page 1396; emphasis added)

Prima Facie Obviousness

MPEP 2142-2144

***Prima Facie* Obviousness – Examiner's Initial Burden**

- The examiner bears the initial burden of establishing a *prima facie* case that the invention as claimed would have been obvious to one of ordinary skill in the pertinent art before the effective filing date of the claimed invention
- The examiner must supply facts and reasoning supporting a *prima facie* conclusion of obviousness

***Prima Facie* Obviousness – Burden Shifts to Applicant Only If Established**

- **If the examiner establishes a *prima facie* case of obviousness, the applicant has the burden** of coming forward with evidence or arguments of non-obviousness
- Evidence of non-obviousness may include comparative test data showing that the claimed invention possesses improved properties not expected in view of the prior art
- An examiner's failure to establish a *prima facie* case of obviousness relieves the applicant of needing to provide evidence of non-obviousness

***Prima Facie* Obviousness – Person of Ordinary Skill in the Art**

To reach a proper determination under 35 U.S.C. 103:
the examiner must step backward in time and into the shoes worn by the hypothetical “**person of ordinary skill in the art**” when the invention was unknown and just before the effective filing date of the claimed invention

***Prima Facie* Obviousness – Claimed Invention “As a Whole”**

In view of all the factual information, the examiner must then make a determination whether the **claimed invention “as a whole”** would have been obvious at that time to that person

***Prima Facie* Obviousness – Articulation of Rationale**

- The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the rationale or reason(s) why** the claimed invention would have been obvious
- Mere conclusory statements are not adequate to support a 35 U.S.C. 103 rejection: “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*In re Kahn*, 78 USPQ2d 1329, 1336)

***Prima Facie* Obviousness – Preponderance of Evidence**

- The decision on patentability is based on “a preponderance of evidence” (>50% likelihood)
 - The evidence supporting patentability must be more convincing than the evidence against it
- If the examiner determines that there is factual support for making an obviousness rejection, then the examiner must consider all evidence supporting the patentability of the claimed invention
 - This includes evidence in the specification and any other evidence submitted by the applicant

***Prima Facie* Obviousness – Modification of Prior Art Invention**

A prima facie case of obviousness cannot be established if:

- A proposed modification of a prior art invention would render the invention being modified inoperable or unsatisfactory for its intended purpose (because there is no reason to make the modification), or
- A proposed modification of a prior art invention would change the principle of operation of the prior art invention

See MPEP 2143.01

***Prima Facie* Obviousness – Reasonable Expectation of Success**

- Obviousness requires a reasonable expectation of success
- Obviousness requires some degree of predictability, but not absolute predictability

See MPEP 2143.02

***Prima Facie* Obviousness – Consider All Claim Limitations**

- When establishing a *prima facie* case of obviousness, all claim limitations must be considered, including indefinite limitations and limitations that do not find support in the specification as originally filed
- “All words in a claim must be considered in judging the patentability of that claim against the prior art.” (*In re Wilson*, 165 USPQ 494, 496 (CCPA 1970))

See *MPEP* 2143.03

When Establishing a *Prima Facie* Case of Obviousness – Remember...

- If the rejection set forth in the office action does not answer **WHY** it would have been obvious to have combined the teachings or made the modification, the examiner has failed to set forth the rationale necessary to establish a *prima facie* case of obviousness
- Only through setting forth a *prima facie* case of obviousness in the written office action does the burden shift to applicant

When Establishing a *Prima Facie* Case of Obviousness – Remember... (*cont.*)

- The rationale may come from a variety of sources
- “Any need or problem known in the field of endeavor at the time of invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed” (*KSR* at page 1397)

See MPEP 2144

Determining the Scope and Content of the Prior Art – Impermissible Hindsight

- When considering references, the examiner must not use applicant's disclosure against the claims unless applicant has admitted something is prior art
- With the exception of an admission of prior art, the disclosure of the application being examined **cannot** be used to negate patentability
- However, the examiner can use applicant's statements regarding the state of the art and problems known in the art

Questions



Upcoming OI Events

- June 20th–Inventor Info Chat: Understanding Trademark in Spanish
- September 13th and 14th, 2019 –Invention Con –
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