

Knobbe Martens Webinar
Series: Strategic
Considerations Under Section
103 – Obviousness

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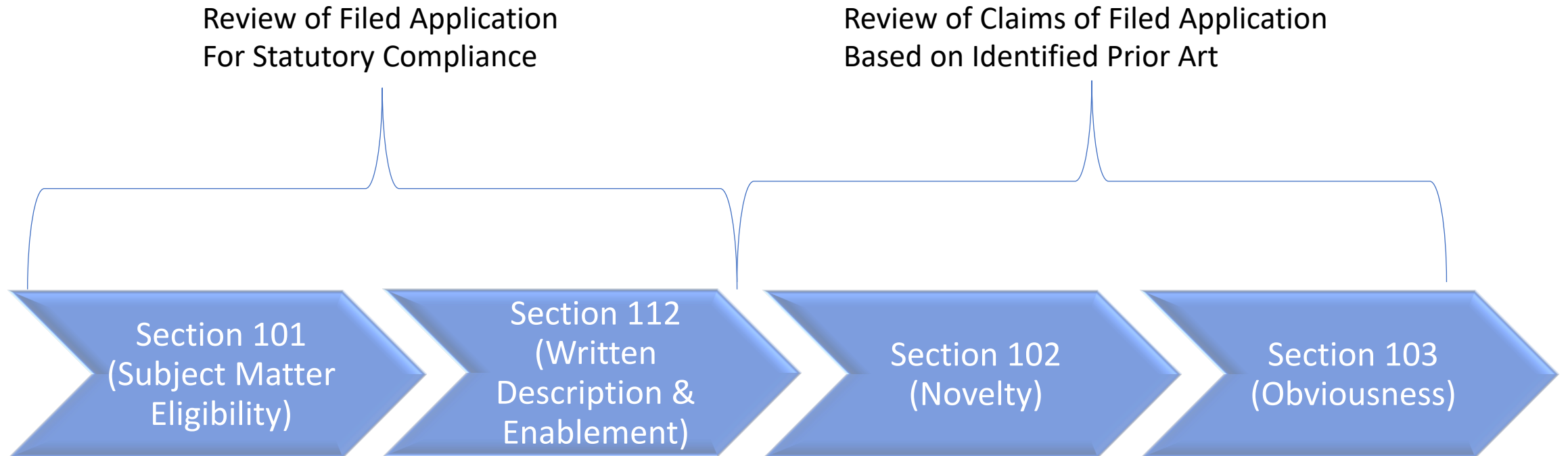
1 Statutory
Requirements,
Response Format, and
Practical
Considerations

2 Practical Considerations
and Examples

3 Secondary Considerations

Statutory Requirements

Statutory Requirements – Patentability of Inventions



Statutory Requirements – Patentability of Inventions



35 U.S. Code § 103

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.

Response Format

- What are the rejection(s) set forth in the Office Action?
- What is the examiner's burden in establishing each identified rejection?
- What evidence and rationale did the Office Action provide to meet that burden?
- Why does the provided evidence not meet that burden?

MPEP Guidance – Prima Facie Obviousness Rejection

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 it was made. In view of all 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. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP 2142 Legal Concept of Prima Facie Obviousness

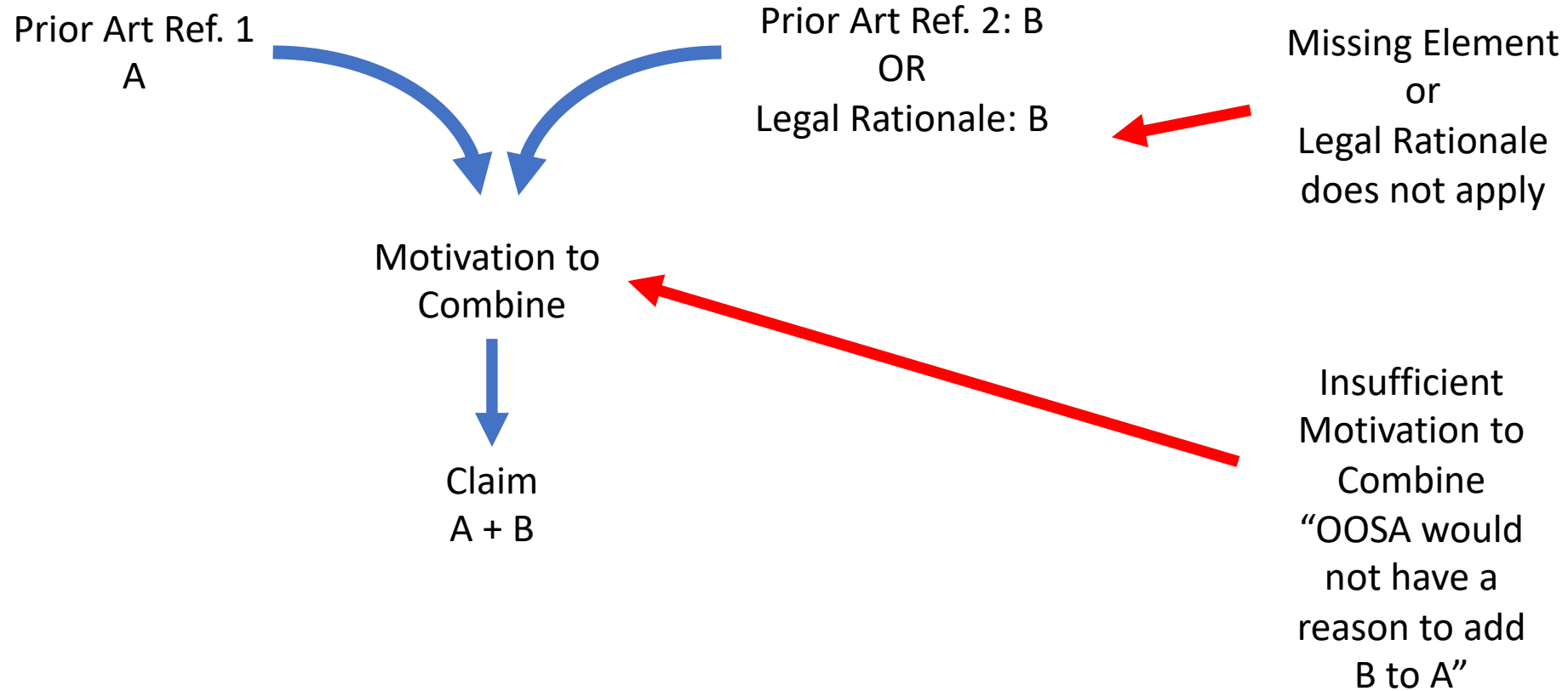
- Initial Burden: Examiners must factually support conclusion of obviousness in rejection claims
 - Evidentiary standard: Preponderance of evidence
 - Claim Term Interpretation: Broadest Reasonable Interpretation (BRI) – MPEP 2111
 - Rebuttal: Factual Inquiry (MPEP 2141)
 - A. Determining the scope and content of the prior art;
 - B. Ascertaining the differences between the claimed invention and the prior art; and
 - C. Resolving the level of ordinary skill in the pertinent art.
- Burden shifts to the applicant to provide arguments and evidence (MPEP 2145)
 - Discussion/challenge to teachings of the cited references
 - Discussion/challenges to combination of references or combined teaching of combined references
 - Secondary considerations

Review of Part I – Challenging A Prima Facie Obviousness Rejection

MPEP 2142 Legal Concept of Prima Facie Obviousness

One or more prior art references that teach all limitations with sufficient motivation to combine

E.G.: Claim A + B



General Prosecution Tips - Addressing Section 103 Rejections/Rationale

- References must teach or suggest cited concepts
- Reasons for obviousness or combination of prior art teachings
- Teaching away
- Inoperability of combined teachings
- Improper hindsight combination
- Non-analogous art

Supporting Non-obviousness Arguments with Amendments

- Time-based Amendments
 - determining, by the controller component, a range of processing times for use in operating the machine in different environmental conditions;
 - responsive to the completion of the determination of the range of processing times, transmitting configuration changes based on the determined range of processing times.
- Condition Precedent Amendments
 - determining, by the controller component, a range of processing times for use in operating the machine in different environmental conditions;
 - responsive to a determined change in the range of processing times, transmitting configuration changes based on the determined range of processing times

Supporting Non-obviousness Arguments with Amendments

- Automation Amendments

- determining, by the controller component, a range of processing times for use in operating the machine in different environmental conditions;
- automatically transmitting configuration changes based on the determined range of processing times to begin processing by the controller component.

- Duplication Amendments

- determining, by the controller component, a range of processing times for use in operating the machine in different environmental conditions, wherein the range of processing times include a default processing time, a first time associated with a first environmental condition and a second time associated with the second environmental condition;
- transmitting configuration changes based on the determined range of processing times

General Prosecution Tips - Addressing Section 103 Rejections/Rationale

- Persuasive / Compelling Story can overcome strong obviousness rejections
- Evidence of Criticality / Unexpected results – Better to be in Original Specification
 - If not, can be submitted by Declaration in OA response
- 8 Flavors of “Legal Rationale” of Obviousness have many nuances.
 - Each Flavor has unique requirements
 - Understanding each flavor can inform claim strategies for drafting Original Application
- Track 1 Expedited Examination is more successful.
- Critical to tie Claims to Evidence (“Nexus”)
 - E.g., Commercial Success

Secondary Considerations

Secondary considerations are a non-exhaustive list of economic and motivational considerations that can establish overcome an obviousness rejection:

Common Considerations

- the invention's commercial success,
- long felt but unresolved needs,
- the failure of others,
- skepticism by experts,

Other Considerations

- praise by others,
- teaching away by others,
- recognition of a problem,
- copying of the invention by competitors

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Practical Considerations – Beyond Statutory Requirements



Examiner's Are Not Attorneys

- Examiner References: USPTO Training; MPEP; Supervisors; and Specific Memos
- Avoid Complex Legal Jargon
- Good Faith Efforts to Understand Office Actions and Examiner Rationale

Practical Considerations – Beyond Statutory Requirements

EXAMINER'S ARE
NOT ATTORNEYS



STREAMLINING
PROSECUTION



ADDITIONAL
AUDIENCE
MEMBERS

Streamlining Prosecution

- Advocate v. Adversary
- Engage with the Examiners

Practical Considerations – Beyond Statutory Requirements

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NOT ATTORNEYS



STREAMLINING
PROSECUTION



ADDITIONAL
AUDIENCE
MEMBERS

Additional Audience Members

- Clients
- Opposing Counsel & Competitors
- General Public