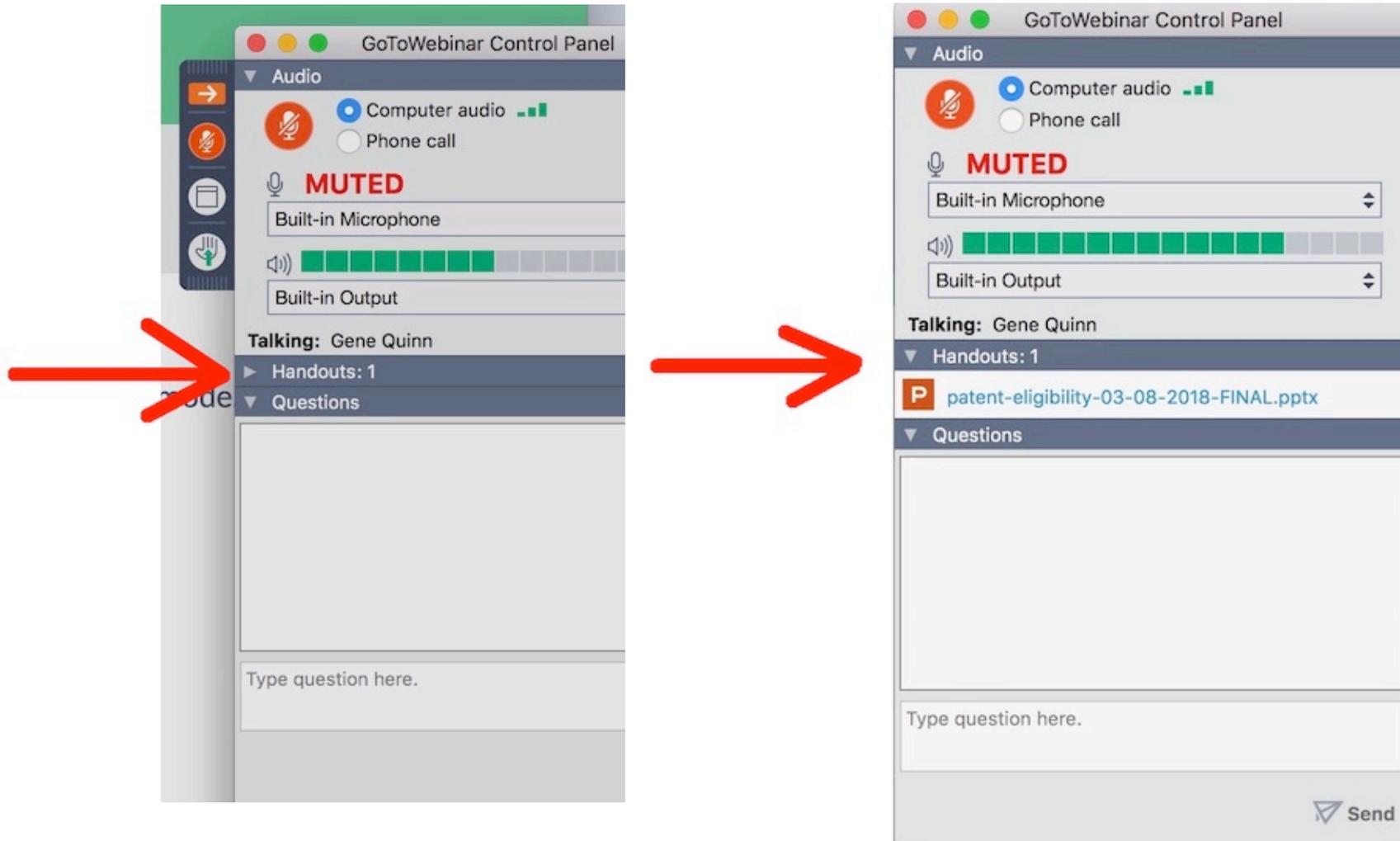


# THE ART OF RESPONDING TO OBVIOUSNESS REJECTIONS: SECTION 103 AND THE KSR GUIDELINES

October 11, 2018

# Accessing the PowerPoint

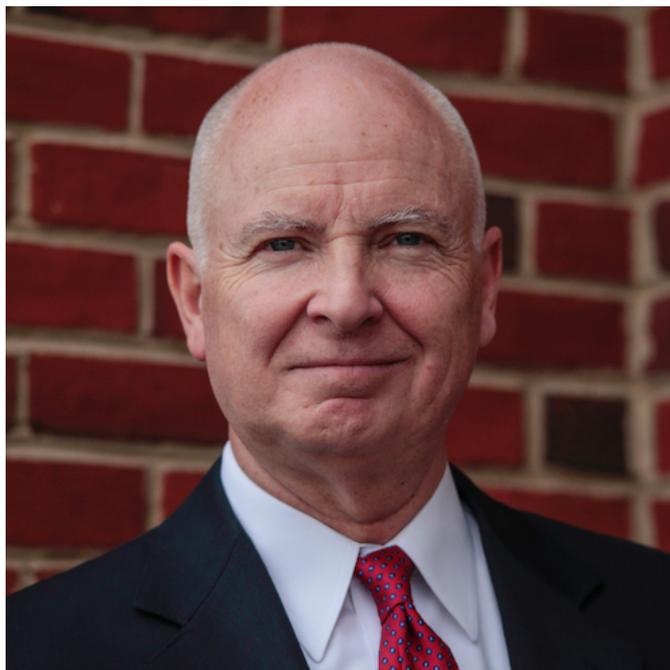


# Speakers



**Gene Quinn**

Patent Attorney & Founder of IPWatchdog



**John White**

Patent Attorney & Expert Witness



**Megan McLoughlin**

Patent Attorney & Product Director PatentAdvisor®

# Outline

While much attention in recent years has been placed on patent eligibility – and rightly so – the truth is obviousness remains the most important threshold for most innovations. Obviousness today is about predictability of results.

When the Supreme Court issued its decision in *KSR v. Teleflex* things substantially changed. We used to be able to argue that any obviousness rejection was inappropriate where there was no teaching, suggestion or motivation to combine references. Today, however, it is all too easy for examiners to subjectively and in a rather cavalier way conclude claims do not pass muster under one of the other so-called *KSR Rationales*. Indeed, what the MPEP instructs examiners to do is not in line with current Federal Circuit precedent, which can and does create problems both at the examination level and at the post-grant challenge level at the Patent Trial and Appeal Board.

In addition to answering as many questions as possible, this webinar will address:

- Specific requirements examiners must satisfy in order to rely on each of the KSR rationales;
- The most common obviousness rejections and how handle them; and
- Tips for successfully working with patent examiners to convince them to issue patent claims.

# The Impact of a 103 rejection

## Art Unit 1711 (Cleaning and Liquid Contact with Solids)

80% of applications have a 103 rejection

Without 103 rejections

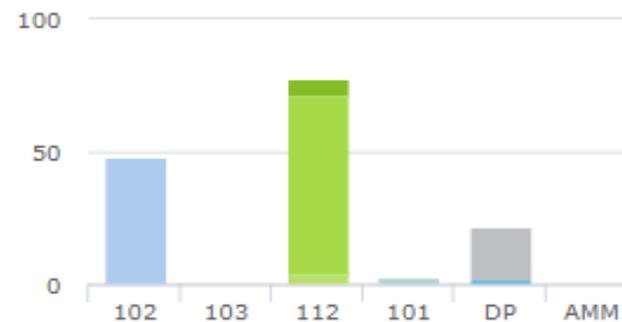
- Allowance rate: **77.4%**
- Time to allowance: **2y, 2m, 29d**

With 103 rejections

- Allowance rate: **64.4%**
- Time to allowance: **3y, 3m, 4d**

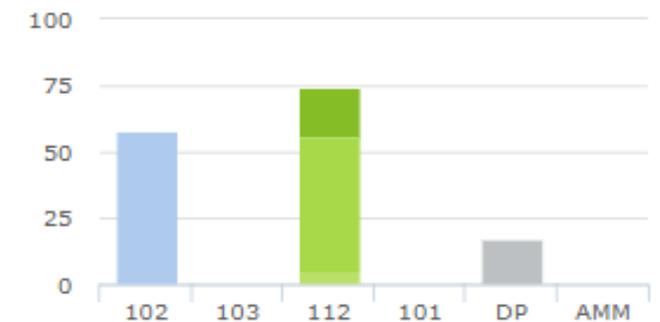
Non-final Office Action Rejection Frequency

(214 Non-Final Office Actions Analyzed)



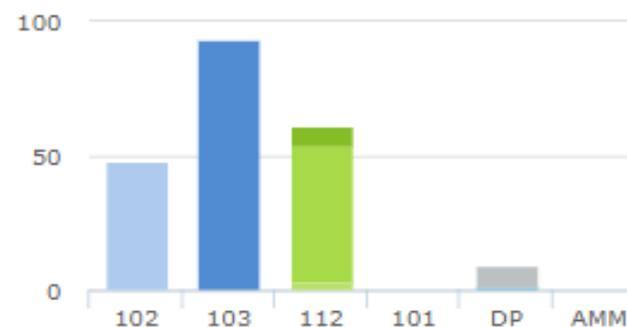
Final Office Action Rejection Frequency

(59 Final Office Actions Analyzed)



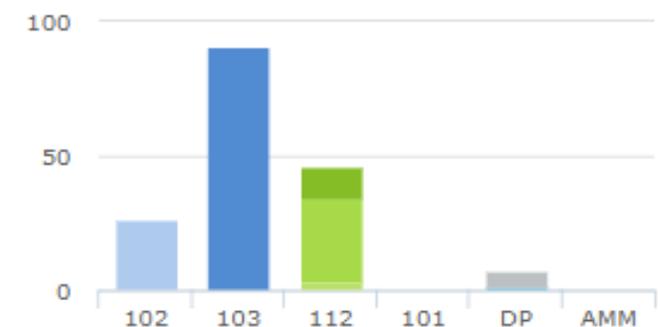
Non-final Office Action Rejection Frequency

(1819 Non-Final Office Actions Analyzed)



Final Office Action Rejection Frequency

(1123 Final Office Actions Analyzed)



# The Impact of a 103 rejection

## Art Unit 3628 (Data processing: financial, business practice, management, or cost/price determination)

90% of applications have a 103 rejection

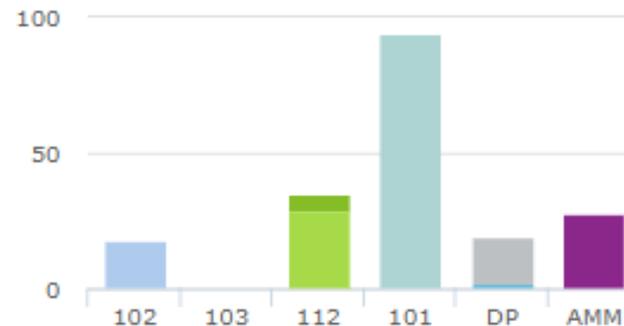
Without 103 rejections

- Allowance rate: **27.8%**
- Time to allowance: **3y, 5m, 5d**

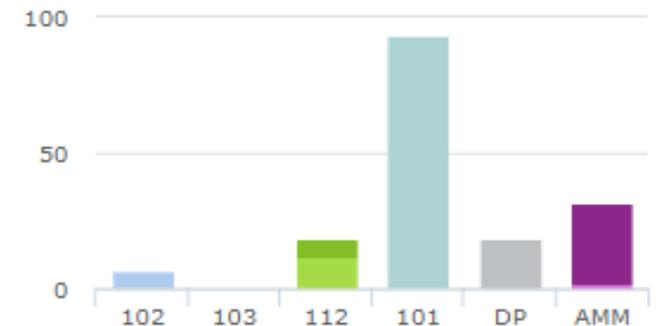
With 103 rejections

- Allowance rate: **17.9%**
- Time to allowance: **5y, 0m, 14d**

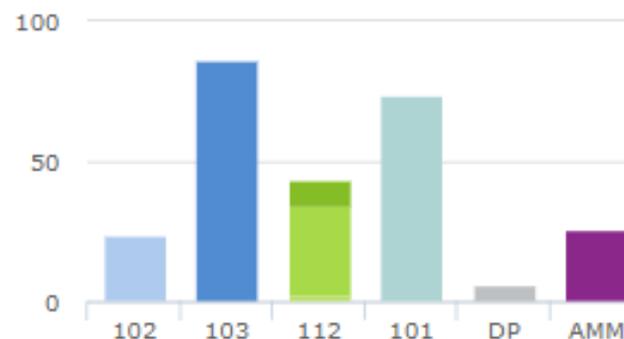
Non-final Office Action Rejection Frequency  
(106 Non-Final Office Actions Analyzed)



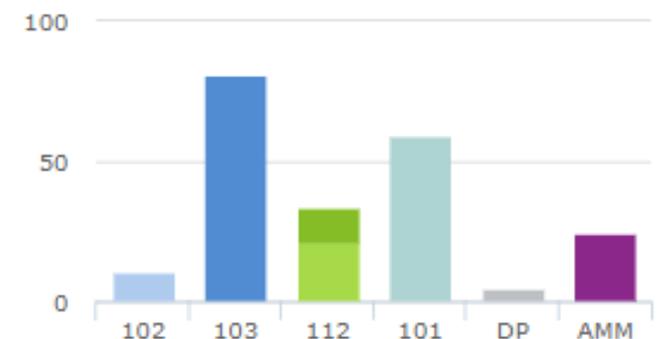
Final Office Action Rejection Frequency  
(60 Final Office Actions Analyzed)



Non-final Office Action Rejection Frequency  
(1756 Non-Final Office Actions Analyzed)



Final Office Action Rejection Frequency  
(1361 Final Office Actions Analyzed)



# Know Your Examiner

Significant variability in 103 patterns exists among examiners.



Examiner A: **Dennis William Ruhl**

- Art Unit: **3689**
- % of applications with at least 103 rejection: **25%**
- Allowance rate without 103: **4.2%**
- Allowance rate with 103: **31.2%**



Examiner B: **Akiba Kanelle Allen**

- Art Unit: **3628**
- % of applications with at least 103 rejection: **92%**
- Allowance rate without 103: **66.7%**
- Allowance rate with 103: **35.9%**



# The Graham Factors

In order to determine whether an invention is obvious one must work through this analytical framework:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the claimed invention and the prior art;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Consider objective indicia of non-obviousness (i.e., are there secondary considerations of non-obviousness that suggest a patent should issue despite an invention seeming to be obvious).

# Secondary Considerations (Basics)

- “Secondary considerations” or “objective indicia of non-obviousness,” are a reality check on the first 3 factual inquiries.
- Evidence of secondary considerations may include evidence of commercial success, long-felt but unsolved needs, failure of others, copying by the industry and **unexpected results**.
- Not all secondary considerations are created equally. For example, there are many possible reasons why a particular product may enjoy commercial success (i.e., a great marketing campaign or superior access to distribution channels). In order for commercial success to be useful tie commercial success to the innovation.
- One particularly strong secondary consideration is long-felt but unresolved need. If there has been a well documented need or desire in an industry that has gone unanswered or unmet how is it intellectually honest to say that that a resulting solution is obvious?

# Secondary Considerations (Basics)

- Just because your invention has never existed in the past does not in and of itself mean that it would be considered non-obvious.
- What makes a long felt, well-documented need so powerful is that the invention has never existed even as the industry has been searching for solutions. **The key** is not that it hasn't existed, but that the invention **hasn't existed despite efforts to find a solution.**

Evidence pertaining to secondary considerations must be taken into account whenever present; however, it **does not necessarily control** the obviousness conclusion. See, e.g., *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1372, 82 USPQ2d 1321, 1339 (Fed. Cir. 2007) (“the record establish[ed] such a strong case of obviousness” that allegedly unexpectedly superior results were ultimately insufficient to overcome obviousness conclusion); *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (“given the strength of the *prima facie* obviousness showing, the evidence on secondary considerations was inadequate to overcome a final conclusion” of obviousness). Examiners should not evaluate rebuttal evidence for its “knockdown” value against the *prima facie* case, *Piasecki*, 745 F.2d at 1473, or summarily dismiss it as not compelling or insufficient. If the evidence is deemed insufficient to rebut the *prima facie* case of obviousness, Examiners should specifically set forth the facts and reasoning that justify this conclusion.

# MPEP 716.01(b)

## **MPEP 716.01(b): Nexus Requirement and Evidence of Nonobviousness**

The weight attached to evidence of secondary considerations by the examiner will depend upon its relevance to the issue of obviousness and the amount and nature of the evidence. The Supreme Court has in the past placed great reliance on this type of evidence in upholding the patent. See *United States v. Adams* (1966).

To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a factually and legally sufficient connection (i.e., nexus) between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness.

# Nexus Requirement

*Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357 (Fed. Cir. 2010), involved a disposable protective covering for a portion of a hearing aid inserted into the ear canal. The covering was such that it could be readily replaced by a user as needed... [A]s to secondary considerations, the Federal Circuit determined Hearing Components had shown a **nexus** between the commercial success of its product and the patent by providing evidence that “the licensing fee for a covered product was more than cut in half immediately upon expiration” of the patent.

The invention at issue in *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318 (Fed. Cir. 2008), was a method for auctioning municipal bonds over the Internet. The Federal Circuit found that a nexus between the claimed invention and the proffered evidence was lacking because the evidence was not coextensive with the claims at issue. For this reason, the Federal Circuit determined that Muniauction’s evidence of secondary considerations was not entitled to substantial weight.

# Zup, LLC v. Nash Manufacturing, Inc. (July 25, 2018)

## **Newman Dissent:**

The requirement that the secondary considerations “overcome” the conclusion based on the first three factors is incorrect, for the obviousness determination must be based on the invention as a whole including the evidence of all four *Graham* factors. It is incorrect to convert the fourth *Graham* factor into “rebuttal,” requiring it to outweigh the other three factors. Consideration of the objective indicia “is not just a cumulative or confirmatory part of the obviousness calculus, but constitutes independent evidence of nonobviousness.” *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008). This evidence must be considered together with the other evidence, and not separated out and required to outweigh or rebut the other factors. All of the factors must be considered in connection with proving invalidity by clear and convincing evidence. *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1048 (Fed. Cir. 2016) (en banc).

# MPEP 2141 – The Role of Common Sense?

The MPEP says that prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations however.

*The MPEP is directly inconsistent with Arendi v. Apple, 832 F.3d 1355 (Fed. Cir. 2016), where the Federal Circuit explained that in order for an obviousness rejection to be appropriate all claim limitations must be present and “common sense” cannot be used to supply limitations missing in the prior art.*

*The MPEP should be revised to contain is this: “The prior art reference (or references when combined) must teach all the claim limitations. Only in the most extraordinary of situations where the missing claim limitation is ‘unusually simple and the technology particularly straightforward’ is it appropriate for common sense to be relied upon to supply a missing claim limitation.”*

# Arendi v. Apple

ISSUE: Did the Board misuse “common sense” to conclude that it would have been obvious to supply a missing limitation in a prior art reference.?

Judge O’Malley explained that common sense is ordinarily invoked to provide a known motivation to combine and not to supply a missing claim limitation.

O’Malley recognized that in *Perfect Web* the Federal Circuit did authorize the use of common sense to supply a missing claim limitation, but she pointed out that this was the only case where that has been done. O’Malley further explained that in *Perfect Web* that which was missing was “unusually simple and the technology particularly straightforward.” In fact, in *Perfect Web*, which dealt with sending e-mail to an e-mail list, the missing claim limitation was nothing more than merely repeating the step of resending e-mails in accordance with the claim. Thus, O’Malley explained that *Perfect Web* is properly considered an exception to allowing common sense to supply a missing claim limitation, rather than the rule.

Judge O’Malley also pointed out that Federal Circuit cases have repeatedly warned against the use of common sense to supply either a motivation to combine or a missing limitation. Common sense “cannot be used as a wholesale substitute for reasoned analysis and evidentiary support, especially when dealing with a limitation missing from the prior art references specified,” O’Malley wrote.

# Combating Inherent Obviousness

The Federal Circuit has sensibly explained, “discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” [Atlas Powder Co. v. Ireco Inc.](#), 190 F.3d 1342, 1347 (Fed. Cir. 1999). Therefore, merely claiming of a new use, new function or unknown property that is inherently present within the prior art does will not in and of itself necessarily make the offered claim patentable. [In re Best](#), 562 F.2d 1252, 1254 (CCPA 1977).

Inherency was initially a doctrine rooted in anticipation, but has long since been applied to become applicable to obviousness rejections as well. What this means is this: Inherency may supply a missing claim limitation in an obviousness rejection. See [Par Pharmaceutical, Inc. v. TWi Pharmaceuticals, Inc.](#), 773 F.3d 1186 (2014). However, the Federal Circuit has always been mindful that inherency in the context of an obviousness rejection must be carefully limited. There is “a high standard in order to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis...” *Id.*

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. [In re Rijckaert](#), 9 F.3d 1531, 1534, (Fed. Cir. 1993). Furthermore, “[a]n invitation to investigate is not an inherent disclosure” where a prior art reference “discloses no more than a broad genus of potential applications of its discoveries.” [Metabolite Labs., Inc. v. Lab.Corp. of Am. Holdings](#), 370 F.3d 1354, 1367 (Fed. Cir. 2004).

# Combating Inherent Obviousness

In [Southwire Co. v. Cerro Wire LLC](#) (2017), where the Board in an *inter partes* reexamination proceeding found a reference inherently taught reducing a pulling force by at least 30% by adding a lubricant. The Board concluded that although the reference did not teach the specific limitation it would have been obvious to select an appropriate amount of lubricant to achieve the 30% limitation. The Federal Circuit disagreed, explaining: “the Board erred in relying on inherency without finding that [the reference] *necessarily* would achieve a 30% reduction in pulling force, but rather finding that it merely renders the limitation obvious.” *Southwire Co.* (emphasis in the original). In essence, it seems the Board simply thought one of skill in the art could figure it out if they tried after reading the reference, but no evidence confirming that assumption was offered.

Still further, the Federal Circuit has repeatedly warned that use of inherency in the context of obviousness must be carefully limited because “that which may be inherent is not necessarily known and that which is unknown cannot be obvious.” [Honeywell Int’l Inc. v. Mexichem Amanco Holding S.A. DE C.V.](#) (2017).

# Combating Inherent Obviousness

Here are some key take-away lessons for those fighting inherency rejections:

1. “The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient to establish inherency.” *In re Rijckaert* at 1534 (emphasis in original).
2. Facts are required to establish that the reference being cited necessarily presents the claim limitation in question. *See Par Pharmaceutical*.
3. An assumption, without evidence, that the reference presents the claim limitation is insufficient. *See Southwire Co.*
4. That which is unknown cannot be obvious. *See Honeywell*.

<https://www.ipwatchdog.com/2017/10/24/inherency-rejections-inherent-obviousness/id=89506/>

# MPEP 2143 - KSR Rationales

1. Combining prior art elements according to known methods to yield predictable results;
2. Simple substitution of one known element for another to obtain predictable results;
3. Use of known technique to improve similar devices (methods, or products) in the same way;
4. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
5. “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
6. Known work in one field 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;
7. 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.

# 1. Combining Prior Art Elements

To reject a claim based on this rationale, Examiners must resolve the *Graham* factual inquiries and articulate the following:

1. A finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
2. finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;
3. Finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
4. Whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts, to explain a conclusion of obviousness.

## 2. Simple Substitution

For an examiner to reject a claim based on this rationale, Examiners must resolve the *Graham* factual inquiries and articulate the following:

1. a finding that the prior art contained a device (method, product, etc.) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components;
2. a finding the substituted components and functions were known in the art;
3. a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable; and
4. whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.



# 3. Known Technique to Improve

For an examiner to reject a claim based on this rationale, Examiners must resolve the *Graham* factual inquiries and articulate the following:

1. a finding that the prior art contained a device (method, product, etc.) a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement;”
2. a finding that the prior art contained a "comparable" device (method, or product that is not the same as the base device) that has been improved in the same way as the claimed invention;
3. a finding that one of ordinary skill in the art could have applied the known “improvement” technique in the same way to the “base” device (method, or product) and the results would have been predictable to one of ordinary skill in the art; and
4. whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

# 4. Ready for Improvement

For an examiner to reject a claim based on this rationale, Examiners must resolve the *Graham* factual inquiries and articulate the following:

1. a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement;”
2. a finding that the prior art contained a known technique that is applicable to the base device (method, or product);
3. a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and
4. whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

# 5. Obvious to Try

For an examiner to reject a claim based on this rationale, Examiners must resolve the *Graham* factual inquiries and articulate the following:

1. a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem;
2. a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem;
3. a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success; and
4. whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.



# 5. Inspire Variations

For an examiner to reject a claim based on this rationale, Examiners must resolve the *Graham* factual inquiries and articulate the following:

1. a finding that the scope and content of the prior art, whether in the same field of endeavor as that of the applicant's invention or a different field of endeavor, included a similar or analogous device (method, or product)
2. a finding that there were design incentives or market forces which would have prompted adaptation of the known device (method, or product);
3. a finding that the differences between the claimed invention and the prior art were encompassed in known variations or in a principle known in the prior art;
4. a finding that one of ordinary skill in the art, in view of the identified design incentives or other market forces, could have implemented the claimed variation of the prior art, and the claimed variation would have been predictable to one of ordinary skill in the art; and
5. whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

# 1. Responses: All Claim Limitations

If just one claim limitation is not accounted for, then the examiner has failed to present a prima facie case of obviousness.

## 2. Responses: Teaching Away

- In *KSR*, the Supreme Court held that when the prior art teaches away from combining the certain known elements, discovery of a successful means of combining them more likely to be nonobvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).
- Whether a reference teaches away from a claimed invention is a question of fact. See *In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005).
- Prior art merely disclosing more than one alternative does not constitute a teaching away. *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004).
- “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554 (Fed. Cir. 1994).
- “Despite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them as did Adams required that a person reasonably skilled in the prior art must ignore” the teaching away of the prior art that such batteries were impractical and that water-activated batteries were successful only when combined with electrolytes detrimental to the use of magnesium electrodes. *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)

### 3. Responses: Simple substitution.

The Supreme Court has stated that in cases involving more than the simple substitution of one known element for another, or the mere application of a known technique to a piece of prior art ready for the improvement, it will be necessary to “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417-418 (2007).

There has to be some underlying pieces of evidence within the record that are the “rational underpinnings” for the reason to combine in the manner presented in the obviousness rejection.

## 4. Responses: Changing Principle Operation

A proposed modification that changes the principle of operation of a device disclosed in a primary reference, or which requires substantial reconstruction of the device, might support a conclusion of obviousness if the Examiner identifies a persuasive reason why one of ordinary skill in the art might have undertaken the modification. However, if the degree of modification that would have been required is significant, then proposed modification would not have been a “mere substitution of one element for another known in the field.” See *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

# 5. Responses: Defeating Purpose of Invention

**Do the Examiner's modifications defeat the purpose of a reference, or is a reference becoming inoperable and, therefore, unsatisfactory for its intended purpose?**

In relying on a combination of prior art references, the examiner's proposed modification cannot render a prior art reference unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

## 7. Responses: Conclusory ‘Obvious to try’

**Knowledge alone is not a good enough rationale to combine the teachings of the prior art, i.e., “because such a modification was within the knowledge of a person of ordinary skill in the art.”**

Examiner’s says “its obvious to try”

Without evidence or explanation in the record that would lead to this solution the rejection is inappropriate. Cite *Arendi*.

# 8. Responses: Examiner creates a problem

**The Examiner reasoning to combine the references generates a problem in order to solve the problem.**

In order to reach the claimed invention with the ground of rejection, the examiner creates the problem in the primary reference in order to solve the problem with the secondary reference that did not exist within the primary reference, but for the Examiner wanting to modify the primary reference with the secondary reference in order to reject the claim.

# 9. Responses: Sparse Technical Disclosure/Speculation

A reference relied on to prove unpatentability must be so clear and explicit that those skilled in the art will have no difficulty in ascertaining its meaning. See *In re Turlay*, 304 F.2d 893, 899 (CCPA 1962).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

# 10. Responses: Analogous Art

- For a reference to be proper for use in an obviousness rejection, the reference must be analogous art to the claimed invention. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). A reference is analogous if: (1) the reference is from the same field of endeavor (even if it addresses a different problem); or (2) the reference is reasonably pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor). *See Bigio*, 381 F.3d at 1325.
- In order for a reference to be "reasonably pertinent" to the problem, it must "logically... have commended itself to an inventor's attention in considering his problem." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374 (Fed. Cir. 2007).
- *In re Klein*, 647 F.3d 1343 (Fed. Cir. 2011), is instructive as to the "reasonably pertinent". If the problem to be solved is viewed in a narrow or constrained way, and such a view is not consistent with the specification, the scope of available prior art may be inappropriately limited. It may be necessary for the examiner to explain why an inventor seeking to solve the identified problem would have looked to the reference in an attempt to find a solution to the problem, i.e., factual reasons why the prior art is pertinent to the identified problem.

# 11. No *per se* Rules

*In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (“The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention--including all its limitations--with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO Examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any rules of obviousness, just as those precedents themselves expressly declined to create such rules.”)

## 12. No Expectation of Success

Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 1054-55 (CCPA 1976).

Obviousness requires that a person of ordinary skill in the art have reasonably expected success in achieving the known goal. The expectation-of-success analysis must match the desired goal and not switch to a different goal that may be less challenging but also a less worthwhile pursuit. *Institut Pasteur & Univ. Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337 (Fed. Cir. 2013)

# 13. Contraindicated

*In re Giannelli*, 739 F.3d 1375 (2014)(Jan. 13, 2014)

“Physical capability alone does not render obvious that which is contraindicated,” *id.* at 4. “Don’t pull it when it says push it.”

The proper inquiry for all obviousness rejections is whether it would have been obvious to modifying the prior art to arrive at the claim invention’s function; not whether the prior art could be capable of performing the function. The former requires evidence in the record demonstrating that it would be obviousness to modify; an examiner’s or the Board’s belief (personal view) is insufficient to establish the prima facie case.

# Research Examiner/Art Unit Specific Strategies

How have others been successful with your examiner/art unit?

PatDocSearch

Text Search Results for "secondary considerations"

**Document type**

Office Actions  Claims  Responses  Appeal

Petitions  Terminal Disclaimers

Document codes included in search

**Application status**

Pending  Abandoned  Patented

RESET SEARCH

Filters Applied

TO DATE FROM DATE

APPLICATION:	96/000,144
DOCUMENT TYPE:	REM - Applicant Arguments/Remarks Made In an Amendment
MAILING DATE:	2016-11-08
STATUS:	Patented
PATENT NUMBER:	-
EXAMINER:	ANDUJAR, LEONARDO
ART UNIT:	3992
LAW FIRM:	ALSTON & BIRD LLP

METHOD OF MANUFACTURING ELECTRICAL CABLE, AND RESULTING PRODUCT, WITH REDUCED REQUIRED INSTALLATION PULLING FORCE

...te the invention of Patent Owner's 518 Patent. Id. Evidence of **Secondary Considerations** of Non-Obviousness Evidence of **Secondary Considerations** of Non-Obviousness also support the conclusion that Claims...

# Research Examiner/Art Unit Specific Strategies

How have others been successful with your examiner/art unit?

## Evidence of **Secondary Considerations** of Non-Obviousness

Evidence of **Secondary Considerations** of Non-Obviousness also support the conclusion that Claims 7, 8, 11-16, 18, 20-22 and 26-30 are non-obvious. Specifically, as shown in the November 8, 2016 Declaration of Murrell W. Blackburn and the November 8, 2016 Declaration of Brian McCardel submitted herewith, substantial evidence exists of skepticism, praise, long-felt but unmet need and commercial success for the commercial embodiment of Patent Owner's '518 Patent. A recent decision from the Court of Appeals for the Federal Circuit reaffirms that this evidence cannot be ignored. See *Apple, Inc. v. Samsung Elec. Inc.*, 2016 WL 5864573, at \*12, \*15 (Fed. Cir. Oct. 7, 2016) (en banc) ("Evidence that the industry praised a claimed invention or a product that embodies the patent claims weighs against an assertion that the same claimed invention would have been obvious. . . . Evidence of a long-felt but unresolved need can weigh in favor of the non-obviousness of an invention because it is reasonable to infer the need would not have persisted had the solution been obvious."); *Applied Materials, Inc. v. Adv.*

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