

Combating Obviousness with *In re Kubin*

The Federal Circuit's recent *In re Kubin* decision provides ammunition to combat obviousness rejections on several fronts.¹ The *Kubin* court provides a path to clarify the obviousness standard set forth in *KSR*, in which "a skilled artisan merely pursues 'known options' from a 'finite number of identified, predictable solutions'."² The *Kubin* decision is particularly helpful for addressing rejections based upon arguments rooted in an "obvious to try" context. The *Kubin* court further confirmed the court's holding in *O'Farrell*, as reinvigorated by the court in *KSR*, that the cited references should contain "detailed enabling methodology for practicing the claimed invention, a suggestion to modify the prior art to practice the claimed invention, and evidence suggesting that it would be successful."³

Rejections falling into the "obvious to try" realm are often based upon a combination of elements taken from complex systems, and the prior art teachings are often silent as to how such elements could be combined. The *Kubin* court explained that inventions are not rendered obvious simply by characterizing a general approach, even where the characterized approach seems to be in a promising field of experimentation. More is required, such as guidance from the asserted prior art that sets forth the particular form of the claimed invention or otherwise describes how to achieve it. Interpreting *KSR*, the *Kubin* court explained two situations in which the "obvious to try" standard under § 103(a) may not be applied:

- (1) where one would have "to vary all parameters ... where the prior art gave either no indication of which parameters were critical ..."; or
- (2) an area of "new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." (quoting *In re O'Farrell* at 903).

Often, an asserted combination would, at best, lead to open-ended speculation on how a hypothetical embodiment would operate, which the *Kubin* court has expressly indicated as improper. This is especially true in highly complex technical fields.

When asserted combinations go beyond simple open-ended speculation, it is useful to show that the cited reference would lead the skilled artisan in a direction that is different from that which is proposed. As applicable in such situations, M.P.E.P. § 2143.01 explains the long-standing principle that a §103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of a main reference - the rationale being that the prior art

¹ *In re Kubin*, 561 F.3d 1351 (Fed. Cir. 2009)

² *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007)

³ *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988)

teaches away from such a modification (leading the artisan in a different direction). *See KSR at 1742* (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). *See also*, M.P.E.P. § 2143.01 (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”). Where no reason is provided as to why a skilled artisan would be led along a path that diverges from that in the cited reference, the rejection can be shown as relying (at best) upon an “obvious to try” argument.

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