Invalidating Obviousness Rejections without Creating Estoppel

Many obviousness rejections are readily invalidated without addressing limitations in the rejected claims or, in many instances, without addressing any aspect of the application at issue. By focusing upon errors in the rejection, particularly those relevant to combining references or otherwise modifying a primary reference, no record is created in regard to the claimed invention and the obviousness rejection is rendered invalid.

Establish a lack of motivation

The first and foremost manner in which to invalidate an obviousness rejection without addressing the invention at hand involves establishing that there is no motivation to modify the primary reference. While the standards that the Examiners must adhere to in asserting motivation have relaxed, the requirement is still there, particularly when the combination of references results in a modification of the operation of the primary reference (see "Using KSR to Overturn Obviousness Rejections" –Crawford Maunu- www.ip-firm.com). It is important that the motivation be evidenced from the prior art, and that such evidence be articulated in the rejection by way of citation.

Look for teaching away in the prior art

As part of a motivation-type argument, a more aggressive stance can be asserted by establishing that the prior art not only fails to provide motivation for combining references, it actually teaches away from a proposed combination. This approach can be particularly helpful in addressing lack of motivation when the motivation asserted in the rejection is unclear or otherwise difficult to address, such as when an Examiner relies upon an unsupported opinion.

There are a variety of resources from which to draw in establishing that the prior art teaches away from a proposed combination of references. For instance, the cited references themselves often hold information that can be very useful in establishing that the prior art teaches away from a proposed combination and related modification of a primary reference. Most patents, patent applications and other documents cited as prior art tend to boast or otherwise positively characterize aspects of the disclosure that are relied upon in asserting obviousness. These documents thus often include language that specifies that a certain machine, process, article or other inventive characteristic be implemented in a particular manner in order to address one or more problems. This implementation often teaches away from a proposed modification of a primary reference, where that modification would be contrary to the disclosure, result in a failure to address a problem as indicated or, in certain instances, render a reference inoperable for its purpose. In these contexts and as consistent with relevant case law, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when an asserted modification undermines either the operation or the purpose of the main reference, with the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v.*

Teleflex, Inc., 127 S. Ct. 1727, 1742 (2007) ("[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 In re Gordon* 733 F.2d 900 (Fed. Cir. 1984) (Where an asserted combination would render the invention inoperable, under M.P.E.P. § 2143.01, the rejections cannot be maintained).

At times, an obviousness rejection may draw from one or more references cited in the application against which the obviousness rejection is asserted. While we may be coached to avoid characterizing prior art in one's own application, citing references to facilitate enablement or for other purposes is quite common. In certain cases, and particularly those emanating from foreign priority applications, the specification identifies prior art references and goes on to identify problems with these references, which are addressed by the claimed invention. In these instances, the specification often provides an explanation (often an expert one – that of the inventor) as to why the prior art could not function in accordance with the claimed invention, or as to why the prior art cannot be modified if it is to achieve its purpose. Using the specification in this manner provides a relatively easy and cost-effective manner in which to address rejections.

Look for evidence demonstrating that the proposed modification would render a reference inoperable

As relevant to the above discussion, demonstrating that a proposed modification of a cited reference would render that reference inoperable is very strong manner in which to establish that the modification is improper. This approach often requires a bit of digging into the technical aspects of the cited references to fully understand the operation of the reference and, further, how that operation is modified by the proposed combination. This effort can go beyond any modification articulated in an obviousness rejection, by enquiring as to how a primary reference would need to be further modified in order to correspond to the claimed invention. By showing that such a modification would render the reference inoperable (or, at least inoperable for its purpose), the obviousness rejection is invalidated for lack of motivation. See, for example, *In re Gordon* and M.P.E.P. § 2143.01 as cited above.

Identify the rejection as amounting to an assertion that a combination is "obvious to try"

Obviousness rejections can also be attacked by establishing that the rejection amounts to a suggestion that a proposed modification is "obvious to try," yet falls into categories in which such an assertion is impermissible (*see In re Kubin*, 561 F.3d 1351 (Fed. Cir. 2009)). In short, many rejections lack clear evidence or other explanation as to how or why references would be combined, beyond a relatively simple articulated reasoning that effectively amounts to an assertion that one of skill in the art would try to make the combination. The relevant categories are (1) situations in which one would have "to vary all parameters … where the prior art gave either no indication of which parameters were critical …" and (2) situations in which the

rejections identify a promising field of experimentation where the prior art gives only general guidance as to arriving at the claimed invention. For more detailed information relative to such an approach, see "Combating Obviousness with *In re Kubin*" – Crawford Maunu – www.ip-firm.com).

Generally attack the Examiner's articulated reasoning

Attacking the sufficiency of an articulated reasoning can be an effective way to show the impropriety of the rejection without requiring that the claimed invention be distinguished. The court in *KSR* reaffirmed that it is important to clearly articulate a reason for a proposed modification, and M.P.E.P. § 2143 presents a list of such reasons commonly used by Examiners. Several of these reasons are predicated on the basis that the modification be tied to predictable results. Thus, where a proposed modification would produce a result that is not suggested by the references, the predictability of the results can often be called into question.

Another manner in which to attack an articulated reasoning is to show that an alleged result or benefit would not be obtained. This can sometimes be accomplished by showing that the problem solved by one reference does not exist in another reference in an asserted combination of references. In some instances, the proposed modification is not sufficiently tied to the alleged benefit. This can occur where an Examiner identifies an alleged benefit or result that is a general benefit of a reference, but that is not achieved by the element(s) used in the combination. As these examples show, this approach is often very fact specific and may require a solid understanding of the prior art references; however, the effort required to obtain this understanding is often justified by the results.

Conclusion

Using these tools, obviousness rejections can be attacked at the core of the rejection itself, without addressing any correspondence between the cited references and the claimed invention. In fact, reviewing the above discussion, no mention is made of the claim limitations that are subject to the rejection at hand, relative to any teachings in the prior art. That's the point.

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