

Using KSR to Overturn Obviousness Rejections for Lack of Motivation

As applicable to *KSR*-based evaluations involving combinations of references in which a primary reference is modified, the requirement that evidence support motivation for modifying a primary reference is alive and kicking.¹ Since *KSR*, Examiners are increasingly relying upon *KSR*-type arguments in situations where the operation of a reference is modified, simply by asserting some “articulated reasoning” that stops short of providing (prior art) evidence, motivation or other support of the proposed modification. The *Kubin* court affirmed the *KSR* court’s reiteration that such an “articulated reasoning” is insufficient where the proposed combination is not a simple combination, but instead modifies the operation of a primary reference.²

KSR and M.P.E.P. § 2141 make it clear that rejections based upon the relatively simple “articulated reasoning” standard are impermissible when the operation of a reference is modified. Such a change in operation of the respective references brings us back into the old guard, requiring that evidence must be provided in support of the proposed modification. According to M.P.E.P. § 2141, where evidence of motivation has not been provided, the Applicant can rebut such assertions of obviousness simply by showing that “the elements in combination do not merely perform the function that each element performs separately.” Obviousness can thus be countered by showing that the function an element performs separately is modified by the proposed combination (preferably, significantly modified). The *KSR* court highlighted such instances in which the cited references are not modified in their operation:

- (1) “In *United States v. Adams*, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the *mere substitution of one element for another* known in the field, the combination must do more than yield a predictable result.” *KSR at 416* (emphasis added).
- (2) “In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, . . . [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation.” *KSR at 417*.
- (3) “[I]n *Sakraida v. AG Pro, Inc.*, the Court derived . . . the conclusion that when a patent *simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement*, the combination is obvious.” *KSR at 417* (Internal quotations omitted, emphasis added). The principles underlining these cases are instructive when the question is whether a patent application claiming the combination of elements of prior art would have been obvious. The Supreme Court further stated that: When considering obviousness of a combination of known elements, the operative question is thus “*whether*

¹ *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (U.S. 2007)

² *In re Kubin*, 561 F.3d 1351 (Fed. Cir. 2009)

the improvement is more than the predictable use of prior art elements according to their established functions.” KSR at 418 (emphasis added).

Relative to the first instance above, it is helpful to establish that the proposed combination of references goes beyond substituting one element for another (or simply adding an element without modifying a primary reference). It is also important to remember that the evidenced motivation must support a modification of a reference that would be required in order to provide correspondence to the claimed invention. In this context, it is also helpful to establish that the cited motivation is insufficient to support such a modification of the primary reference, regardless of whether or not the rejection proposes that the modification be made.

As relative to the second instance above, the specification can be a useful resource for identifying results, goals and other aspects that the Applicant felt were important enough to support the cost of filing the application, and which help to establish that the combination is not simply an arrangement of “old elements.” This information can be used in support of arguments that demonstrate new or otherwise modified functionality. At times, early invention disclosure materials will help to identify such information. These materials are also helpful in addressing allegations that the proposed modification of a cited reference involves a “predictable use,” by presenting other uses or aspects of unexpected results that counter such assertions of predictability.

As the USPTO is rejecting claims at an ever-increasing rate, addressing assertions of obviousness in an efficient and effective manner remains an important issue. In addressing these matters, the courts continue to provide ammunition that can be used to combat obviousness rejections. With careful evaluation and a bit of elbow grease, these decisions can be very beneficial in overturning a rejection or establishing a favorable record for Appeal.