

# The Endless Pursuit of the Obvious

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# Endless Pursuit of the Obvious

- How can “obvious” be so difficult?
- Who decides a claim is obvious?
- Patent examiners in Office Actions
- BPAI in Appeals
- Federal District Courts

- CAFC Court of Appeals for the Federal Circuit
- [228 Fed. Appx. 988](#) (remand from USSC)
- US Supreme Court  
KSR v Teleflex 127 S. Ct. 1727

# BPAI Decisions

- Examiners rejecting more applications as obvious? Reasserting earlier 103(a) rejections in light of KSR?
- BPAI obviousness cases
  - Ex Parte Smith 2007-1925
  - Appl 09/391,869
- Appealing final rejection cl.1-21 & 32-36

# BPAI 2007-1925

- Appellant claims pocket insert for a bound book, pocket to receive material not easily bound by book binding, e.g., diskette CD

# Ex Parte Smith 2007-1925

## THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Dick	US 1,495,953	May 27, 1924
Ruebens	US 4,965,948	Oct. 30, 1990
Michlin	US 5,141,252	Aug. 25, 1992
Wyant	US 5,540,513	Jul. 30, 1996

The following rejections are before us for review.

1. Claim 35 is rejected under 35 U.S.C. § 102(b) as anticipated by Michlin.
2. Claims 1-9, 11-13, 16-18, and 32-24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick.
3. Claims 10, 14, 15, 19-21, and 36 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick, and further in view of Ruebens.

# Ex Parte Smith 2007-1925

## OBVIOUSNESS

### *The § 103(a) Issues*

There are two obviousness issues before us. The first is whether Appellant has shown that the Examiner erred in rejecting claims 1-9, 11-13, 16-18, and 32-24 under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick. The first issue turns on whether it would have been obvious to glue two separate sheets to form a continuous two-ply seam, as taught by Dick, rather than folding one sheet to create a seam along the folded edge, as taught by Wyant.

The second obviousness issue is whether Appellant has shown that the Examiner erred in rejecting claims 10, 14, 15, 19-21, and 36 under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick, and further in view of Ruebens. This issue turns on whether it would have been obvious to improve a pocket insert by creating two pockets from a single pocket using an additional line of adhesive.

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and Dick, we have found that (1) each of the claimed elements is found within the scope and content of the prior art; (2) one of ordinary skill in the art could have combined the elements as claimed by methods known at the time the invention was made; and (3) one of ordinary skill in the art would have recognized at the time the invention was made that the capabilities or functions of the combination were predictable. Furthermore, neither Appellant's Specification nor Appellant's arguments present any evidence that cutting the folded edge of Wyant and gluing the resulting separate pocket sheet and base sheet along the cut edge to form a continuous two-ply seam as taught by Dick was uniquely challenging or difficult for one of ordinary skill in the art. The substitution of the continuous, two-ply seam of Dick for the folded seam of Wyant thus is no 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 improvement." *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Therefore, it would have been obvious at the time the invention was made to modify Wyant's pocket insert to attach a separate pocket

# Ex Parte Smith 2007-1925

Appellant disputes that the prior art teaches “at least a portion of the attached edge section being one of chemically bonded, fused or glued to the first surface of the base sheet” as recited in Appellant’s claim 1. In particular, Appellant argues that Dick does not disclose chemical bonding, fused or glued construction (Substitute Br. 11). Dick teaches that the pocket may be secured by any suitable means (Finding of Fact 16). Moreover, Wyant teaches that any convenient bonding method including adhesive can be used to secure the tab yielding panel to the card (Finding of Fact 13). From these teachings, we find that the combination of Wyant and Dick would have taught one of ordinary skill in the art to use the Wyant teaching of bonding method to secure the Dick pocket. Therefore, the prior art teaches “at least a portion of the attached edge section being one of chemically

# Ex Parte Catan 2007-0820

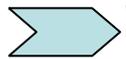
- BPAI Ex Parte Catan 2007-0820
- Appl. 09/734,808 Claims 5-11 & 13-16 under appeal
- Claims found obvious over Nakano 5845260 in view of Dethloff 4837422 & Harada 5721583

# Pfizer v Apotex

## NORVASC

- CAFC 06-1261 March 22, 2007
- Fed Circuit reversed DC holding of validity & infringement, held claims 1-3 of 4878303 invalid , obvious
- Used same prior art PTO examiner considered, viz 4572090 & Berge, "Pharmaceutical Salts," J. Pharm. Sci., 66(1):1-19 (Jan. 1977) ("Berge"). Table 1 of Berge shows 53 FDA-approved, commercially marketed anions, including benzene sulphonate, that are useful for making pharmaceutically-acceptable salts, and lists the relative frequency of which each was used as a percentage based on the total number of anions or cations in use through 1974. Berge discloses that benzene sulphonate had a frequency of use of 0.25%.

- We reject Pfizer’s first argument, since a suggestion, teaching, or motivation to combine the relevant prior art teachings to achieve the claimed invention does not have to be found explicitly in the prior art references sought to be combined, but rather “may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.” *DyStar*, 464 F.3d at 1361;



- Court: What if I sic my phalanx of zealous scientists on that list and then come up with a product. Would that be a logical thing for me to do?
- The Witness: It would be logical to try that.
- This is true especially given the fact that the genus of FDA-approved anions at the time was small, i.e., only 53. That benzene sulphonate was only used in creating 0.25% of FDA-approved drugs is not highly probative, much less dispositive.

# In re Icon Health & Fitness

- Icon repeatedly sued companies over
- US5676624. Icon sought reexam of '624 to bolster claims for lawsuits.
- PTO rejected most of claims, ICON appealed to CAFC.
- Analogy between portable, folding treadmill & Murphy bed with springs to hold closed
- Did applicant provide evidence that “teaches away” from the combination of nonanalogous art?

# Friskit vs RealNetworks

- RealNetworks, accused of infringing Friskit patents 6389467, 6519648, 6484199 6735628, and 6725275
- 3cv05085 ND CA
- RealNetworks awarded summary judgement of invalidity on 103(a) grounds in light of KSR. Same judge had denied motion prior to KSR. Same facts, only difference was KSR obviousness Big Stick

# Exam Support Documents ESD

- Sufficiency of prior art searching for ESD
- Applicants must classify their claims into appropriate & complete fields of search US class/subclasses inclusive of all inventive elements
- Best prior art references written up in Examination Support Document, “document of doom.”

# ESD Problems

- File Wrapper Estoppel
- Inequitable Conduct writ large
- Costly, professionally risky
- Most patent attorneys say:  
    Avoid at all Costs!
- Sowing seeds of own invalidity!
- PTO estimated ESD prep at \$20-\$30K

# Search “Sufficiency”

- PTO Guidelines for Exam Support Documents (ESD)  
37 CFR 1.265
- Must include:
  - 1) Preexam Search Statement ID fields of search USPC, search logic for database searches
  - 2) List closest references
  - 3) ID of claim limitations disclosed by refs
  - 4) Detailed explanation of patentability in spite of closest art
  - 5) Enablement analysis 35 USC 112

# Preexam Search Statement

Preexam search must encompass all limitations of all claims, independent & dependent

Recommend searching disclosed but unclaimed features that may be subject of amendments (searchers as SEERS)

Foreign patent office search report won't automatically suffice

ISR probably won't suffice, since OUS PO don't search with USPC

# Search Insufficiency

- If preexam search doesn't find "a number of refs. . .where applicant has searched. . . but examiner" find refs he considers more relevant
- If preexam search doesn't include all class/subclasses examiners consider pertinent to their examination of patentability

## “Classified Search”

- “A classification search is defined as a complete search of all the documents in a particular subclass and it is not limited by a text query or a set of text queries or other means.”
- Applicant must also perform text search of claimed elements, alone & in combos
- Search of foreign patents
- Search of open literature suggested by PTO templates

# Accelerated Exam Model

- Accelerated Examination rarely used in its 1<sup>st</sup> year. Most patent attorneys refuse to take AE cases, too loaded with inequitable conduct risk.
- PTO notes 400 petitions for AE has been filed, admits that more than  $\frac{3}{4}$  have been rejected, mostly on search insufficiency

# Blog Postings on AESD, ESD

- [http://inventblog.com/2007/01/first\\_round\\_of\\_.html](http://inventblog.com/2007/01/first_round_of_.html)
- >>>Briefly stated, one of the conditions is to include a statement, made based on a Good Faith Belief, that a pre-examination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable. "Sanitized" to avoid retaliation, the rejection stated in part that,
- "...the petition lacks an indication of a pre-examination search that encompasses all of the features of the claims. Specifically, with respect to the classification search, in addition to searching class 123, subclass 234 (which is the class and subclass where the application will be classified), subclasses 7, 8, 9, 10, 11, 12 and 13 are necessary subclasses to be searched. In addition, class 345, subclasses 10 and 11, as well as class 456, subclasses 222, 333, 444.4, 555.5 and 666 are required areas of search."
- See the Catch-22?
- Class/subclass are assigned AFTER the preliminary search. You need a crystal ball to know which class/subclass will be assigned. If you honestly guess wrong (not to hard given the poor design of many PTO classes), they reject your Special application.<<<
- Inventblog quoting from Aharonian's Internet Patent News, Jan 2007

# Catch 5 & 25!

- That's some catch, that Catch 5 & 25?!
- Is PTO attempting to make its backlog of cases dwindle by administrative sleight of hand?
- Appeals made more difficult, Markush groups made more explicit, claims limited,
- Cont, RCE limited
- Burden of prior art searching, patentability & enablement analyses shifted to applicants

# Reap the Harvest of Changes

- Litigators “field of dreams”
- File histories rife with obviousness, inequitable conduct defenses to infringement
- Infringers picnic, particularly foreign infringers
- Even the “unpredictable arts” at risk!
- (Norvasc case, other ANDA invalidity attacks)
- Plan to get fewer patents at much greater expense!

# Catch 5 & 25

- Searching more now & enjoying it less?!
- Hire Karnack the Magnificent! Only he can predict the fields of search, the “best references” within them, the unclaimed subject matter to search in light of future amendments