

## EXPERT OPINION

## The uncertainty of obviousness: Some strategies moving forward | IP Frontiers

Rachel L. Pearlman [SPECIAL TO THE DAILY RECORD](#)



Rachel L. Pearlman

When the Supreme Court eliminated the “teaching-suggestion-motivation” test in *KSR International Co. v. Teleflex Inc.*, it also eliminated the certainty regarding what is obvious and what is not obvious. This issue is particularly prevalent when an Examiner pens an Office Action that combines 6-8 references and uses this combination to reject an independent claim of the pending application. The obviousness of this vast combination is somewhat laughable on its face, although there can be some reasoning behind it when one digs deeper. Of course, Examiners are allowed to combine a limitless amount of references, but the ruling that provides this guidance pre-dates *KSR*. When Examiners had to show a motivation for combining multiple references, at least there was some sanity check. Now, the combinations are somewhat unfettered. I received a rejection the other day where what I would privately consider the heart of the claim was not taught by the primary reference (the Examiner agreed), but that Examiner asserted that because the

technology existed at the time (applying a second reference), it was obvious to include it. Of course, the invention presented a novel use of that technology. Common sense would suggest that just because something exists and can be used to do X does not mean that it can do Y and furthermore, if A is missing parts and you need B-Z to cover all the limitations, maybe the very combination is an act of novelty.

Arguments of logic seldom win the day in a discussion about obviousness with the USPTO. I have found myself saying in many interviews, “Well, yes, the publication you cited does recognize the same issue and suggests a solution, but the solution is entirely different.” I also find myself saying, “Just because the publication uses the same word to describe something does not mean that it is actually doing the same thing.” The most frustrating prosecution situations I find myself in nowadays are: 1) 101 (subject matter patentability)-type disagreements where I believe the Examiner is misinterpreting the guidelines based on Alice (which is a story for another day); and 2) 103 (obviousness)-type disagreements where every time I overcome an existing combination,

a new reference is added. The latter situation just feels like being stuck in a loop. I had one client who did not want to appeal and together, we were stuck in that loop for about four years until a new Examiner was assigned to the case and called me and said, of the now 14-reference combination, “What exactly is going on here?” The case was eventually allowed but only because the new Examiner took a different view.

No one wants to be in a situation that feels repetitive where progress is not being made, but the avenues for leaving the loop are not ideal. First, you can hope to win an argument. This can sometimes happen and in my experience, one can be far more successful if one participates in an interview. That said, I had an Examiner beg for a call back at 10 p.m. my local time because he wanted to correct some small issues prior to allowance (a call I returned) only to have him change his mind and apply another reference to the ever-growing group. I have often walked away from interviews and had the Examiner conduct a new search and apply a new, larger, combination of references. Second, you can appeal or at least request Pre-Appeal review. In my

experience (as supported by statistics), the Pre-Appeal panels are growing more loath to side against an Examiner. Appeal is lengthy and is arguably a reasonable path for an obviousness rejection, but it is a slow process. In some technologies one could argue that it is slow enough that the priorities of the entity who will own an eventual patent can change. Also, there is always the chance that the Patent Trial and Appeals Board (PTAB) will agree with you but find another fault in the application. A new IOI analysis for a software patent by the PTAB can occur, as the law changes and evolves, and because of the subjectivity of that standard, a new analysis is unlikely to be helpful. Yes, I know of situations where the obviousness argument was won on appeal, but the patent was not allowed as a result of this decision because the PTAB questioned the patentability of the subject matter.

A reasonable approach, if possible, is to change the argument. Appeals can change the decision-maker, which is helpful but, again, slow and uncertain. In the absence of changing the decision-maker, one can attempt to change the argument. Everyone hates admitting to being wrong. Most people seldom make this admission. So a reasonable strategy is to move as far away from the sticking point as possible and try to add something entirely new, either to an independent claim or to a dependent claim. The idea is to allow the Examiner to agree with the Applicant and still save face. For example, if you are arguing about component X, throw in component B, which is not a change to component X but looks like something

new (though fully supported by the specification). True, a claim with A and B is not as broad as A, but at a certain point it becomes clear that a particular Examiner is not going to allow an application with component A. One can try to pursue A later in a continuation application, if desired. But usually, the same Examiner will pick that up so one should understand the risks associated with this strategy. Making B sound like something new while minimizing its impact on claim scope can be helpful. It might not be readily apparent what component B should be and there may be various options in the application. In this instance, adding a number of dependent claims and arguing them separately can be helpful. The Examiner may indicate that one in particular could be helpful in gaining in an allowance.

Patent prosecution is a puzzle — I like logic puzzles which is part of what drew me to this profession. The Examiner is trying to find references to fit all the pieces that a claim provides. Unfortunately, the Examiner can piecemeal a rejection and put together any combination of references (arguing that a combination renders parts of the combination inoperable is helpful but not a slam dunk). If your attorney or you find yourself in a quagmire where the combination is growing into what looks like Frankenstein's Monster and prosecution is protracted, it is important to make some sort of a shift. Even if you and your attorney believe that you are absolutely right, because obviousness is so flexible, being right is less important than ultimately getting a positive result.

The Supreme Court does not generally have an appetite for patent cases and when they do, the decisions can arguably create more chaos than clarity. Thus, although a case finding a multiplicity of references non-obvious post-KSR would be helpful, it does not appear to be coming soon. However, there are two (somewhat) recent cases that do provide some hope in this area. The Federal Circuit decided *In re NuVasive, Inc. and PersonalWeb Technologies, LLC v. Apple, Inc.* in the context of a review of an agency, in this case the PTAB, under the Administrative Procedure Act (APA). At the core of the critique was that the PTAB decided appeals in patent prosecutions incorrectly because the PTAB's actions were "insufficiently or inappropriately explained." *In re Van Os*, 844 F.3d 1359, 1361–62 (Fed. Cir. 2017). *In re Van Os* focused on whether combining references was intuitive. These decisions cut against an Examiner stating that a combination is obvious without any actual reasoning. So although there is no "motivation" requirement, one can argue that there is also no "because I said so," logic in the post-KSR world. Arguments that dissect a combination and attack the basis for the combination are therefore certainly worth making, but back-up plans should also be formulated if they fail.

*Rachel L. Pearlman is a partner in the Albany office of Heslin Rothenberg Farley & Mesiti P.C. If you have any questions, please feel free to reach out to her at (518) 452-5600 or rachel.pearlman@hrfmlaw.com.*