

RECENT DECISIONS OF THE BOARD OF PATENT APPEALS AND INTERFERENCES CONFIRM THE NEED FOR AN ADEQUATE RATIONALE TO MODIFY/COMBINE

BY MICHAEL E. KONDOUDIS

A COLLEAGUE PASSED ALONG THE RESULTS OF A BRIEF SURVEY OF SOME RECENT BOARD OF PATENT APPEALS AND INTERFERENCES (BPAI) DECISIONS IN WHICH THE BPAI CITED KSR AND REVERSED CLAIM REJECTIONS. TWO ASPECTS OF THE SURVEY RESULTS STOOD OUT. OF THE 43 REVERSALS IDENTIFIED BY THE SEARCH, 24 WERE BASED ON A FAILURE OF THE CITED ART TO MEET EVERY FEATURE OF A REJECTED CLAIM WHILE 11 WERE BASED ON AN EXAMINER'S FAILURE TO PROVIDE SUFFICIENT REASONING FOR AN ASSERTED COMBINATION/MODIFICATION.

THIS ADMITTEDLY INCOMPLETE SURVEY APPEARS TO INDICATE TWO THINGS ABOUT CURRENT APPEAL PRACTICE. FIRST, SOME EXAMINERS STILL FAIL TO ADDRESS EACH AND EVERY CLAIM FEATURE, SO CONTINUE TO ARGUE THAT ASSERTED COMBINATION(S) IS/ARE DEFICIENT, WHEN APPROPRIATE. SECOND, CHALLENGES TO THE SUFFICIENCY OF A PROFFERED RATIONALE TO COMBINE/MODIFY APPEAR TO STILL HAVE SOME BITE, DESPITE KSR'S "AFFIRMATION" THAT THE PROPER INQUIRY FOR MOTIVATION IS NOT LIMITED TO THE OVERLY RIGID TEACHING SUGGESTION MOTIVATION (TSM) TEST AND LEAPFROG'S CONFIRMATION THAT "THE COMMON SENSE OF THOSE SKILLED IN THE ART DEMONSTRATES WHY SOME COMBINATIONS WOULD HAVE BEEN OBVIOUS WHERE OTHERS WOULD NOT."

ONE LAST POINT, RECENT BPAI DECISIONS PROVIDE USEFUL GUIDANCE ON HOW TO EFFECTIVELY ARGUE NON-OBVIOUSNESS IN LIGHT OF KSR, AND THEY ARE AVAILABLE AT WWW.USPTO.GOV/GO/DCOM/BPAI.

THE LAW OFFICE OF MICHAEL E. KONDOUDIS, PC

A PROFESSIONAL CORPORATION FOCUSED EXCLUSIVELY ON INTELLECTUAL PROPERTY LAW

WWW.MEKIPLAW.COM

MKONDOUDIS@MEKIPLAW.COM

+1-202-349-9850

PATENTABLY DEFINED

THE PATENT PROSECUTION BLOG OF MICHAEL E. KONDOUDIS

THE LAW OFFICE OF MICHAEL E. KONDOUDIS, PC
A PROFESSIONAL CORPORATION FOCUSED EXCLUSIVELY ON INTELLECTUAL PROPERTY LAW
WWW.MEKIPLAW.COM
MKONDOUDIS@MEKIPLAW.COM
+1-202-349-9850