

## Kratz, Quintos &amp; Hanson, LLP – IP Newsletter

## WATCH OUT FOR THE UNNECESSARY NARROWING OF CLAIM SCOPE WITH THE USE OF THE TEACHING AWAY ARGUMENTS

By: Mel R. Quintos

**A**pplicants may be too quick to amend their claims when faced with an obviousness rejection (35 U.S.C. §103) based on a combination of references. Many times, claim amendments are truly necessary to combat obviousness assertions, but in those times where the prior art “teaches away” from an Examiner’s suggested modification or combination of references, the unnecessary narrowing of claim scope by amendment may altogether be avoided or at least minimized. The examples below summarize how the courts have articulated the applications of the teaching away arguments when weighing the teachings of the combined references.

**1. The modifications of the references render the result inoperable.**

In *In re Sponnable* (CCPA 1969), the invention relates to a mixing vial with a plurality of compartments and “an improved center seal plug” placed between the compartments to temporarily seal the compartments from each other. Sponnable’s mixing vial includes a center seal plug of butyl rubber to prevent the passage of moisture through the center plug. The claims were rejected based on Bujan or Lockhart in view of Jensen and either Parsons or Umbdenstock under 35 U.S.C. §103. Bujan and Lockhart teach the use of plugs made of natural rubber, and do not mention any moisture transmission through the plug. Jensen teaches the impermeability of butyl rubber to steam, but there is no mention that “impermeability to *liquid* water is desired or necessary in a center seal plug.” Based on these teachings of the prior art, the court reasoned that:

First butyl rubber does not slide readily against a glass surface because of its frictional properties, as evidenced by the rolling operation of Jensen’s butyl rubber sealing ring as it disengages the metal disc \* \* \*. Both the operability and utility of Jensen’s vessel depend upon this frictionally induced rolling action; in contradistinction, a sliding engagement is absolutely essential to the operability of appellant’s center seal plug. Hence, Jensen’s center seal is totally incapable of serving appellant’s purposes. Moreover, since butyl rubber is significantly less resilient and more rigid than natural rubber, Lockhart’s *flanged* center gate plug, if made of butyl rubber, would be difficult, if not impossible, to either seat or displace from its seat. Thus, a combination of either Lockhart or Bujan with Jensen alone would produce a seemingly inoperative device. [Emphasis added.]

In *In re Gordon* (Fed. Cir. 1984), “[u]nlike blood filter assemblies used in the prior art, [Gordon’s] invention permits both entry of the blood into, and ultimate discharge of the blood out of, the bottom end of the filter.” The claimed invention was rejected under 35 U.S.C. §103 based on U.S. Patent No. 1,175,948 to French. The court reversed the obviousness rejection, and reasoned that if the French apparatus were turned upside down to force the liquid at the bottom end, “it would be rendered inoperable for its intended purpose [because the] gasoline to be filtered would be trapped in [a pocket], and the water [instead of the filtered gasoline] French seeks to separate would flow freely out of the outlet.”

**2. A person of ordinary skill in the art is led in a direction divergent from the path that was taken by the applicant.**

In *In re Gurley* (Fed. Cir. 1994), the invention is directed to an epoxy based printed circuit material that is bendable and shape-retaining. According to the Yamaguchi reference, a printed circuit made of an epoxy-impregnated fibrous substrate is inferior to a circuit board made of a polyester-imide resin. Gurley argued that Yamaguchi's statement of "inferiority" teaches away from Gurley's invention. The court stated that a reference teaches away when a person of ordinary skill in the art, upon reading the reference, "would be led in a direction divergent from the path that was taken by the applicant." However, a known or obvious composition does not become patentable simply because it has been described in the reference as inferior to another product for the same use.

**3. A person of ordinary skill in the art is discouraged from following the path set out in the reference.**

In the U.S. Supreme Court case of *United States v. Adams* (1966), Adams invented a battery consisting of a magnesium electrode (anode) and a cuprous chloride electrode (cathode) placed in a container with water to be supplied as the electrolyte, without the use of acids. In Adams' suit against the U.S. government for failing to compensate him for the government's use of his patented battery, the government introduced 24 patents to invalidate Adams' claims. In affirming the lower court's judgment of validity, the U.S. Supreme Court recognized that batteries that get heated when in use are not practical, and water-activated batteries only worked with electrolytes detrimental to magnesium. The Court then held, in affirming the validity of Adams' claims, "that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness."

**4. The references leaves the impression that the product would not have the property sought by the applicant.**

In *In re Caldwell* (CCPA 1963), the claimed invention is directed to a "method of stimulating growth of ruminants, poultry and swine" by feeding them aspirin for that purpose. The court found that the Gross reference used to reject the claims under 35 U.S.C. §103 did not suggest such teaching of the claim; and "[o]n the contrary, the reference suggests that such a method is an impossibility, not merely as a theoretical proposition, moreover, but on the basis of laboratory tests and controlled experiments."

**Washington D.C. Office:**  
 4<sup>th</sup> Floor  
 1420 K Street, N.W.  
 Washington, DC 20005  
 U.S.A.  
 Tel: 202-659-2930  
 Fax: 202-887-0357  
[correspondence@kqhpatentlaw.com](mailto:correspondence@kqhpatentlaw.com)  
[www.kqhpatentlaw.com](http://www.kqhpatentlaw.com)

**Tokyo Liaison Office:**  
 Tokyo Banker's Club Building  
 15<sup>th</sup> Floor  
 1-3-1 Marunouchi, Chiyoda-ku  
 Tokyo 100-0005 JAPAN  
 Tel: 03-3216-7188  
 Fax: 03-3216-7210

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