

# KRATZ, QUINTOS & HANSON, LLP

IP NEWSLETTER November 2007

## **U.S. PTO RULE CHANGES IN CLAIMS AND CONTINUATIONS PRACTICE ARE NOT TO TAKE EFFECT AS SCHEDULED ON NOVEMBER 1, 2007, AND U.S. PTO EXAMINATION GUIDELINES ON OBVIOUSNESS UNDER 35 U.S.C. 103 IN VIEW OF *KSR INTERNATIONAL v. TELEFLEX INC.*<sup>1</sup>**

by Mel R. Quintos      November, 2007 Issue

On October 31, 2007, the U.S. District Court for the Eastern District of Virginia issued a Preliminary Injunction suspending the U.S. PTO rule changes in claims and continuations practice that were to take effect on November 1, 2007. Thus, the changes to these rules will not go into effect until further notice.

On a separate matter, the U.S. PTO, in an October 10, 2007 Notice, issued guidelines for use by office personnel for determining obviousness under 35 U.S.C. 103 in view of the U.S. Supreme Court case of *KSR International v. Teleflex Inc.* The Notice summarized the decision and principles set forth in the *KSR International* case with a discussion on the following basic factual inquiries of the 1966 U.S. Supreme Court case of *Graham v. John Deere Co.*: (1) determining the scope and content of the prior art, (2) ascertaining the differences between the claimed invention and the prior art, and (3) resolving the level of ordinary skill in the pertinent art. In recognizing that the ultimate finding of obviousness is a legal conclusion and that the above *Graham* inquiries are factual which are to be determined by U.S. PTO personnel, the Notice stated that: “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason[s] why the claimed invention would have been obvious.”

Accordingly, the Notice set forth and subsequently discussed reasons, which may include the following, for use by U.S. PTO personnel in articulating an obviousness rejection: (a) combining prior art elements according to known methods to yield predictable results, (b) simple substitution of one known element for another to obtain predictable results, (c) use of known technique to improve similar devices (methods or products) in the same way, (d) applying a known technique to a known device (method or product) ready for improvement to yield predictable results, (e) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success, (f) a known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art, and (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine the prior art reference teachings to arrive at the claimed invention.

The Notice suggested that in the case of a claim to a combination of elements, the applicants “may submit evidence or argument to demonstrate that: (1) one of ordinary skill in the art could not have combined the claimed elements by known methods (e.g., due to technological difficulties); (2) the elements in combination do not merely perform the function that each element performs separately; or (3) the results of the claimed combination were unexpected.”

---

<sup>1</sup> This article is not intended to convey our legal opinion or advice. We disclaim any liability for any errors or omissions.