

# Non-Obvious Obviousness Arguments (To Overcome 35 USC 103 Rejections)

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For good or bad, the vast majority of patent applicants are familiar with receiving an Office Action with the dreaded news that at least one of their claims has been rejected. After formality objections, antecedent basis rejections, assertions of anticipation, and other grounds, the patent prosecution of a given case often ends up hinging on one word – obvious – or in the words of the US Patent Examiner “your invention has been found to be obvious under 35 USC §103 based on the prior art.” What does that mean? More importantly, what do you do now? In the paragraphs to follow, we hope to outline at least some of your options, as one size most definitely does not fit all.

To put it another way, there are numerous ways to tackle an obviousness rejection. Pardon the pun, but some are obvious, some are not. For example, using the all elements rule<sup>1</sup>, the claims of the rejected patent application can be amended to include an element or elements not shown in the combination of prior art cited by the Examiner. If all elements are not shown, the Examiner has not established a *prima facie* case of obviousness, and the rejection should be withdrawn barring discovery and citation of any further prior art. While effective, this approach of course does not come without drawbacks. More specifically, any time an element is added to a claim, that claim necessarily becomes more narrow and potentially less useful. The practitioner should be judicious in this approach and only add claim elements where necessary and not unduly restrictive.

Other arguments are not so obvious, or at least the applicability of them in the context of some obviousness rejections is not. For example, data is playing an increasingly important role in patent prosecution. Arguments from your patent attorney advocating the strength of your invention and weakness of the prior art are great, but understandably viewed by the Examiner assigned to the case with a jaundiced eye. An often more convincing approach is to combine those arguments with real life data that itself attests to the non-obviousness of a given invention.

Take the case of an insect repellent spray nozzle we prosecuted a few years ago. The nozzle was designed to expel a jet of insecticide in a tightly maintained cylindrical formation over a relatively long distance. One can surmise the importance of this approach when spraying an active hornet nest or the like. Better to spray such a nest from a long distance rather than get up close and personal with the nest when spraying. In any event, due to government regulations phasing out the use of certain volatile organic compounds deemed harmful to the environment, the makers of the spray can had to create a nozzle that allowed for such dispersion without the chemicals previously used. They did so with a unique mechanical design in the nozzle. While different dimensionally, with unique radii of curvature and other geometric differences with known nozzle facets, the overall elements of the spray can were readily shown in the prior art. What were the applicants to do? Well, knowing that the art was close, and suspecting the Examiner would raise some sort of obviousness rejection, applicants fortified their patent application with significant data showing the performance characteristics of the nozzle design of choice. More to the point, applicants noticed that while changing the nozzle dimensions and ratios in incremental fashion normally resulted in relatively linear changes in the resulting nozzle design performance, there was a range and combination of parameters where such incremental changes did not follow a linear progression, but rather performed many times better. As a result, we included that data in the patent application itself and when the Examiner raised the expected obviousness rejection, used an unexpected results<sup>2</sup> argument pointing his attention to that performance range. A US patent ensued shortly thereafter.

Or take the example of a local steel foundry that created a specialty steel that has been very well-received in its target industry. The fracking industry had been clamoring for a steel from which pump blocks could be manufactured and used in pumping the extremely abrasive fluid used in the fracking process to break up the shale and other underground materials in order to access the oil therein. By adding certain metals and other elements, and doing so in specific weight percentages, the resulting specialty steel greatly outperformed the other metal pump blocks on the market at the time. However, when couched in terms of a patent claim, the Examiner took the position that such a percentage of elements was an obvious design choice. Enter a Rule 132 Declaration.<sup>3</sup> Similar to the above, we did not simply rely on our arguments as to why the pending claim was non-obvious over the cited art, but rather supplemented those arguments with a signed declaration from an expert in the steel industry. Without the built-in predispositions of an attorney advocating for a client, the testimony of the unbiased expert carried the day for the invention, resulting in a notice of allowance.

Other examples of non-obvious obviousness arguments are plentiful. If your industry is especially focused and thus the metrics by which your product are measured are very detailed, or perhaps even unique to you, consider a results effective variable argument<sup>4</sup> Similar to the nozzle example given above, maybe it is difficult to define your invention in terms of the physical elements of the claim, but at the end of the day you know your product performs better. Couch that performance in terms of a variable or metric you internally track and write the claim to include that variable. When filed with the US Patent & Trademark Office, the Examiner assigned to the case will inevitably perform a search and if not a variable known in the industry, prior art will be difficult if not impossible to find. That by itself will serve as evidence of the non-obviousness of the invention.

A still further argument might be that the proposed combination of prior art cited by the Examiner simply would not work for its intended purpose.<sup>5</sup> In other words, when a patent application is filed, and that patent application of course includes claims at its conclusion, USPTO Examiners often use those claims as a laundry list of sorts from which to embark on a wideband search to find those elements, at least in isolation. However, if that proposed combination of elements would not physically work for the intended purpose laid out in the pending application, that too should weigh in favor of a finding of non-obviousness.

Going hand in hand with “unsatisfactory for its intended purpose” argument directly above might be non-analogous art argument.<sup>6</sup> For example, if the patent application you file is directed to an automotive engine, is it fair for the Examiner to cite a jet engine patent against the application? Perhaps the broad goal of power generation for a vehicle is the same, but should one of ordinary skill in the art of automobiles be expected to look to the teachings of the aerospace industry for guidance? The answer of course depends on the specific facts of the case and language of the claim, but it is at least an argument worth exploring if the facts are right.

Many other non-obviousness arguments can be used depending on the nature of the invention, proximity to the prior art, and other factors, but include situations where the prior art “teaches away” from the direction a given invention eventually led<sup>7</sup>; or where the Examiner is engaging in impermissible “hindsight reasoning”<sup>8</sup> and not placing himself in the shoes of the inventor at the time of the invention; or where the industry as a whole had endured an extended period of “long-felt need”<sup>9</sup> without solution; or where the very level of commercial success enjoyed by an invention serves as convincing evidence of non-obviousness.<sup>10</sup>

In the end analysis, our overall point is that the approach you take to your patent prosecution should be multi-faceted. It is too easy for your patent counsel to fall into the habit of simply adding a claim element, or stressing an existing claim element is not shown in the prior art. As mentioned above, this is sometimes the best way, but by no means is it the only way, especially when considering the effect that approach might have on the prosecution history of the patent and resulting range of equivalents it may or may not ultimately enjoy under the Doctrine of Equivalents. Knowing that, you would be well served to consider all the above approaches, and others not specified. After all, the goal should be an issued patent with claims which are just narrow enough to distinguish over the prior art, and yet broad enough to read on potential competitive approaches, all the while with a prosecution history that keeps estoppel possibilities to a minimum.

The patent practitioners at von Briesen are well versed in all the nuances of patent prosecution, including obviousness and the myriad approaches to avoiding and overcoming Section 103 rejections. Should you have any questions in connection with your idea, patent application, or patent portfolio, we invite you to contact us for a conversation.

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<sup>1</sup> See, MPEP §2143

<sup>2</sup> See, *KSR Int'l Co. v. Teleflex Inc.*, 550 US 398 (2007)

<sup>3</sup> 37 C.F.R. §132 reads: “When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided must be by way of an oath or declaration under this section.

<sup>4</sup> See, MPEP §2144.05.

<sup>5</sup> See, MPEP §2145.

<sup>6</sup> See, *Donner Technology, LLC v. Pro Stage Gear, LLC*, App. No. 20-1104 (Fed. Cir. 2020).

<sup>7</sup> See, *Polaris Industries, Inc. v. Arctic Cat, Inc.* 2016-1807 (Fed. Cir. 2018).

<sup>8</sup> See, MPEP §2142.

<sup>9</sup> See, *Graham v. John Deere Co.*, 383 US 1 (1966).

<sup>10</sup> *Id.*

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