

EFFECTS OF KSR ON PATENT PRACTICE

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ACTUAL EXAMPLES

**THESE ARE REAL EXAMPLES
FROM MY PERSONAL
EXPERIENCE**

CLIENT CONFIDENCES

EXAMPLES ARE DE -
IDENTIFIED TO PROTECT
CLIENT CONFIDENCES

KSR

BPAI PRECEDENTIAL CASES FOLLOWING KSR

- EX PARTE KUBIN – BIOTECH.
- EX PARTE SMITH - MECH.
- EX PARTE CATAN – ELECT.
- SEE <http://www.uspto.gov/web/offices/dcom/bpai/prec.htm>

OUTLINE

- I. EX. 1 – THE DING LETTER
- II. EX. 2 – NEW INVENTIONS
- III. EX. 3 - PROSECUTION
- IV. CONCLUSIONS

EX. 1 – SUMMARY

- IN VIEW OF KSR, PREDICTION OF ULTIMATE USPTO REJECTION OF APPLICATION ASSERTED AGAINST CLIENT ...
- SEARCHER TWIST

CLIENT CONFIDENCES

- **CLIENT NOT IDENTIFIED**
- **SUBJECT APPLICATION
NOT OWNED BY CLIENT**

EX. 1 - DING!

- CLIENT RECEIVED DING LETTER
- PATENT TO ISSUE FROM 10/946,947 ENTITLED "A SYSTEM AND METHOD FOR LEVERAGING HEALTH CARE AT A POINT OF SALE"

IDENTIFICATION PROBLEM

- 10/946,947 UNPUBLISHED
- 10/946,947 STATUS COULD NOT READILY BE DETERMINED

FOREIGN FILING

- WO 2006/036712
(PCT/US2005/033888) CLAIMS
PRIORITY TO 10/946,947

VALIDITY ISSUE

- F.F. IN AN APPLICATION HAVING A NON PUBLICATION REQUEST IS ILLEGAL
- WAS 10/946,947 ILLEGAL AND THEREFORE ABANDONED?
SEE 35 USC 122(2)(B)(iii).

VALIDITY ISSUE

- NO! OIPE OF USPTO FINALLY INDICATED THAT 10/946,947 ABANDONED BEFORE COMPLETION OF APP.
- ABANDONED APPS. NOT PUBLISHED. 35 USC 122(B)(2)(A)(I).

DING LETTER IN ERROR?

WHY DID WE GET A DING
LETTER BASED UPON AN
ABANDONED APPLICATION?

DING LETTER IN ERROR?

- PRESUMED CLERICAL ERROR, LISTING WRONG CASE IN A PATENT FAMILY, ON PART OF ACCUSING PARTY
- LOOKED FOR RELATED CASES (SAME INVENTOR)

RELATED CASES

- 60/668,886 – PROV.
- 10/946,947 – ABAND.
- 11/370,526 – PEND.
- 09/981,516 – PEND.

RELATED CASES

IN PENDING RELATED CASES,
ANALYZED PATENTABILITY OF
DISCLOSED CLAIMABLE
SUBJECT MATTER IN VIEW OF
CATAN/KSR

ANALYSIS EXAMPLE

- “1. A system for generating intelligent promotional recommendations for a product, comprising: a) a database ... b) a recommendation engine, ...c) a user interface....”
- KNOW TO BE ANTICIPATED

ANALYSIS EXAMPLE

“7. The system ... wherein the user interface comprises a personal digital assistant.”

CATAN: Substituting bio-authentication sensor for some other authenticifier, not patentable.

CONSEQUENCES

- QUICKLY DETERMINED THAT CLAIMABLE SUBJECT MATTER NOT PATENTABLE
- CLIENT COULD SAFELY IGNORE THE DING LETTER

EX. 2 – NEW INVENTIONS

HOW TO DRAFT APPLICATIONS
FOR NEW INVENTIONS IN VIEW
OF KSR (AND OTHER CHANGES
IN LAW AND PRACTICE)

CLIENT CONFIDENCES

- **CLIENT NOT IDENTIFIED**
- **SPECIFICS OF
INVENTIONS NOT
IDENTIFIED**

THE LAW

EX PARTE SMITH “The operative question in this ‘functional approach’ is thus “whether the improvement is more than the *predictable use of prior art elements according to their established functions.*””

THE NEW RULES

NEW USPTO RULES LIMIT “THE SIZE” OF APPLICATIONS, MAKING IT ADVISABLE TO FILE SMALLER APPLICATIONS

EX. 2 FACTS

- BIOMEDICAL ARTS
- INVENTIONS ARE 'SPECIES' 1-4
- 1-4 MANUFACTURES, NOT CHEMICALS,
- 1-4 SAME GENERIC STRUCTURE, AND FOR SAME PURPOSE
- ONE PRIOR ART SPECIES, 5

EX. 2 FACTS

- SIMILAR ELEMENTS TO THOSE OF SPECIES 1-4 APPEAR IN PRIOR ART SPECIES 5

EX. 2 FACTS

- SPECIES 1 HAS A SPECIAL UTILITY IN A SPECIAL ENVIRONMENT
- SPECIAL UTILITY UNKNOWN IN THE ART
- SPECIES 2-5 DO NOT HAVE THE SPECIAL UTILITY

KSR RISK

- 1-4 MIGHT BE REJECTED ON THE THEORY THAT THEY MERELY DEFINE STRUCTURES THAT HAVE A “*predictable use of prior art elements according to their established functions*”

KSR RISK

- REJECTION EASY TO REBUT FOR 1
- REJECTION MORE DIFFICULT TO REBUT FOR 2-4

STRATEGY FOR 1

FILE AN APPLICATION
DISCLOSING ONLY SPECIES
1, AND CLAIMING ONLY
SPECIES 1

BENEFITS

- AVOID LARGE APPLICATION TRAPS OF 1.75, 1.78(d) AND 1.78(f)
- AVOIDS CONFUSION OF PATENTABILITY ISSUES WITH 2-4
- AVOIDS ESTOPPELS

TACTICS FOR 1

- *DO NOT EXPRESSLY DISCUSS THE “SPECIAL” UTILITY OR ENVIRONMENT IN THE APPLICATION*
- ANTICIPATE REJECTION OF SPECIES 1 OVER PRIOR ART SPECIES 5

TACTICS USING KSR

- ANTICIPATED REJECTION

- SPECIES 1 IS ONLY A

“predictable use of prior art elements according to their established functions” IN VIEW OF SPECIE 5

TACTICS USING KSR

- ANTICIPATED RESPONSE
- SPECIES 1 YIELDS MORE THAN “*predictable*” RESULTS; MORE THAN “established functions,” IN SPECIAL ENVIRONMENT

TACTICS USING KSR

- ANTICIPATED RESPONSE
- “advance [would not have] occur[ed],” BECAUSE NO ONE RECOGNIZED THE SPECIAL UTILITY IN THE SPECIAL ENVIRONMENT

CONSEQUENCES OF STRATEGY AND TACTICS FOR SPECIES 1

- CLEAN PROSECUTION
- NO ESTOPPELS
- ENFORCEABLE PATENT

EX. 2 – SUMMARY

- KSR IMPACTS WHAT WE INCLUDE IN APPLICATIONS
- LOOK TO THE END, AT THE BEGINNING

EX. 3 - PROSECUTION

DRAMATIC IMPACT OF KSR
ON PROSECUTION, IN A
REEXAMINATION

CLIENT CONFIDENCES

- **I AM NOT OF RECORD**
- **REEXAM NUMBER NOT SPECIFIED**
- **FACTS DE-IDENTIFIED**

SUMMARY

- PRE KSR 'ALLOWANCE'
- POST KSR REJECTION,
BASED UPON KSR
- ON SAME PRIOR ART

PROSECUTION HISTORY

LETS FOLLOW THE
PROSECUTION HISTORY
IN SOME DETAIL

PRE KSR 1ST OA

- REJECT ALL CLAIMS AS OBVIOUS BASED UPON REFERENCES “A”, “B”, AND “C”
- “A” IS THE CLOSEST PRIOR ART

PRE KSR 1ST OA

REJECTIONS BASED UPON
MODIFICATIONS OF “A” IN
VIEW OF “B” AND “C” TO
CHANGE LIMITATIONS “X1”
TO “X2”

TACTICS

- MAKE ONLY THOSE ARGUMENTS NECESSARY TO OVERCOME REJECTIONS
- AVOID ESTOPPELS

TACTICS

POSSIBLE RESPONSES

- NO LEGAL MOTIVATION TO MODIFY
- CLAIMS DO NOT READ ON THE PROPOSED MODIFICATION

RESPONSE TO 1ST OA

- NO LEGAL MOTIVATION TO MODIFY
- PRIOR ART DOES NOT SUGGEST MODIFICATION OF “X1” TO “X2”

BENEFIT OF RESPONSE

RESPONSE DID NOT
REQUIRE A DETAILED
ANALYSIS CONSTRUING
CLAIMS VIZ ELEMENTS
TAUGHT BY PRIOR ART
REFS.

2ND, FINAL, OA

- ALLOWED ALL CLAIMS OVER PRIOR ART
- REJECTED SOME DEPENDENT CLAIMS UNDER 112

RESPONSE TO 2ND, FINAL, OA

- PATENTEE AMENDED DEPENDENT CLAIMS, CURING THE 112 PROBLEMS
- *SHOULD HAVE RESULTED IN ALLOWANCE*

KSR

KSR OPINION ISSUED
AFTER RESPONSE TO
2nd, FINAL, OA.

POST KSR 3RD, NON - FINAL, OA

- REJECTS ALL CLAIMS BASED UPON REFS. “A”, “B”, AND “C”

WHY NON-FINAL?

PROCEDURALLY, NON-FINAL
OA, AFTER A FINAL OA,
MEANS NEW REJECTIONS
NOT DUE TO APPLICANTS
AMENDMENTS

POST KSR 3RD, NON - FINAL, OA

- RELIED UPON “A” TO SUGGEST REPLACING “X1” WITH “X2”
- RELIED UPON “B”, “C”, TO SHOW ENABLEMENT OF “X2”

REF. A

- NO SUGGESTION IN “A” TO MODIFY “A” EMBODIMENT TO INCLUDE LIMITATIONS “X2”
- MODIFYING “A” TO INCLUDE LIMITATIONS “X2” REMOVES UTILITY SPECIFIED IN “A”
- CONCLUSION – “A” TEACHES AWAY FROM “X2” MODIFICATION

REF. A

- “A” SUGGESTED USE Y
- “X1” EMBODIMENT CAN PROVIDE USE Y
- MODIFICATION OF “A” REPLACING “X1” WITH “X2” COULD ALSO PERFORM USE, Y, BUT IN A DIFFERENT WAY

EXAMINER'S POST KSR REASONING

- Not be reasonable to consider from [A] that [USE Y] is tied solely to [X1]
- “one of ordinary skill in the art, having... [DESIGN SKILLS], would readily recognize, through the exercise of **common sense**, what ... [things] are not required or what ... [things] would need to be modified.”

KSR OVER REACTION

- EXAMINER - Not be reasonable to consider from [A] that [USE Y] is tied solely to [X1]
- THAT REASONING IS NOT BASED UPON EVIDENCE OF RECORD; - - OVER REACTION TO KSR

KSR RELIANCE

- EXAMINER - “would readily recognize, through the exercise of **common sense...**”
- LANGAUGE PARALLELS THAT IN KSR

KSR QUOTE

- “When there is a **design need or market pressure to solve a problem** and there are a **finite number of identified, predictable solutions**, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of **ordinary skill and common sense**. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.”

PATENTEE'S NEW RESPONSE

- PRIMARILY, DETAILED CLAIM CONSTRUCTION SHOWING PRIOR ART LACKS CERTAIN CLAIMED FEATURES
- SECONDARILY, NO MOTIVATION TO MODIFY, AND OVER REACTION TO KSR

CONCLUSIONS

MY ANECDOTES SHOW
THAT *KSR* HAS
SUBSTANTIALLY
IMPACTED PATENT
PROSECUTION, ADVICE,
AND COUNSELING

THE END THANK YOU!

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