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## Obviousness and Inherency

*An outsider's view*

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# DISCLAIMER

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The views expressed herein are solely those of the presenter and should not be attributed to his clients, his firm or his firm's clients.

This discussion is not to be construed as necessarily being authoritative. It is intended to raise awareness of this issue and the importance of focusing on precise claim language and specific teachings of the applied references regarding expected properties and functions.

# Program

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- Inherency and unexpected results
  - Multiple reference 103 rejection
  - Single reference 103 rejection

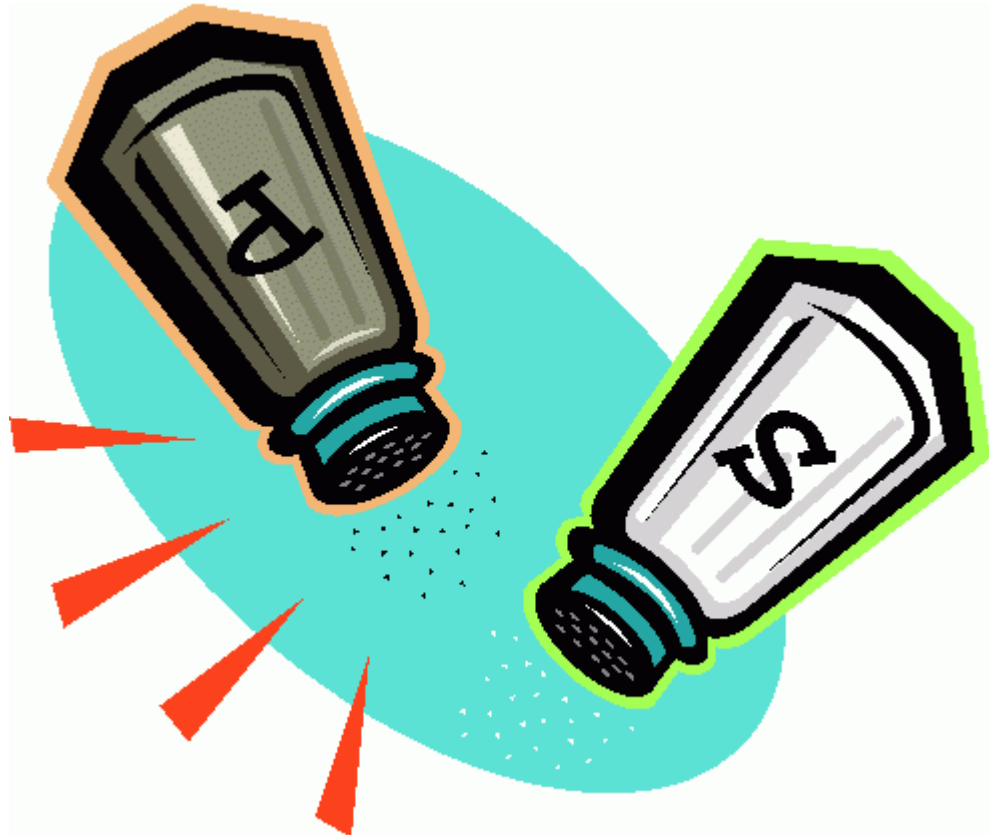
# What is inherency?

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Common definition of “inherency” is  
“existing in ***something*** as a permanent,  
essential, or characteristic attribute.”  
(emphasis added)

## The Problem

- Assume no one has ever mixed salt and pepper together.
- Inventor walks into your office and makes the admixture in front of you.
- What is the expected taste of the mixture?
  - Salt and pepper
- However, the mixture tastes like lemon!
- Unexpected result or inherent result?



# 35 U.S.C. § 103

By statute obviousness is:

- Determined as of the time of the invention
  - Cannot use the inventor's work against her
    - Impermissible hindsight
- Based upon the subject matter of the claim as a whole
  - *In re Papesch*, 315 F.2d 381, 391 (CCPA 1963)  
("From the standpoint of patent law, a compound [and by extension, a composition of matter] and all of its properties are inseparable; they are one and the same thing.")

# *What is prima facie obviousness?*

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- “*Prima facie* obviousness is a legal conclusion, not a fact.” *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1972).
- By definition, a *prima facie* obvious composition has never been in existence, it is a novel product.
  - “The compounds are not described in Karrer within the meaning of 35 U.S.C. 102(b). In determining whether the claimed compounds are obvious within the meaning of 35 U.S.C. 103, we think their properties may and should be considered....” *In re Papesch*, 315 F.2d at 390-391.

# Role of unexpected results

“[F]or many inventions that seem quite obvious, there is no absolute predictability of success until the invention is reduced to practice. There is always at least a possibility of unexpected results, that would then ***provide an objective basis for showing that the invention, although apparently obvious, was in law nonobvious.***” *In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988) (emphasis added)



# Evidentiary procedure

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“If rebuttal evidence of adequate weight is produced, the holding of *prima facie* obviousness, being but a ***legal inference*** from previously uncontradicted evidence, **is dissipated**. Regardless of whether the *prima facie* case could have been characterized as strong or weak, the examiner must consider all of the evidence anew.” *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (emphasis added)

# Problem 1 (Multiple reference 103 rejection)

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- Claims are directed to a composition of salt and pepper where the claims recite that the composition tastes like lemon.
- Reference 1 teaches salt and Reference 2 teaches pepper.
- Examiner states that it would have been obvious to combine salt and pepper as a matter of personal taste. Neither reference discusses a lemon taste.
- Examiner states in regard to claimed lemon taste “The **modified** [Reference 1] compositions would meet the compositional limitations as claimed presently and therefore, would inherently have properties as claimed presently.” (from actual office action, emphasis added)

# Why is this a problem?

- Assuming there is a proper reason to combine References 1 and 2, the so-called “modified” prior art composition exists only as a legal fiction or conclusion. What properties does such a hypothetical, modified composition actually possess?
  - Only those that can be predicted or expected to occur from the teachings of the applied references!

# Proper procedure

- The rejection should explain why it would have been obvious to combine References 1 and 2 to arrive at a composition within the claim. The applied references should then be analyzed to determine what properties the hypothetical composition would ***expectedly*** possess, not inherently possess.
  - A mixture of salt and pepper would ***expectedly*** taste like salt and pepper.