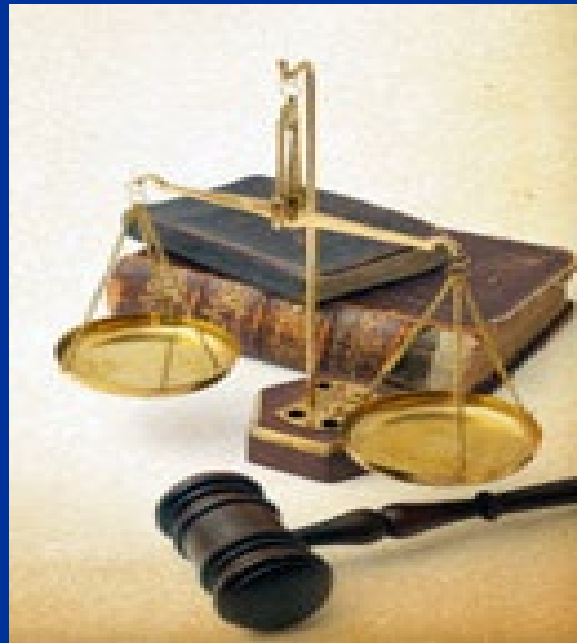


How to Read and Understand Case Law



Overview

- Case Law
- Structure of a Decision
- Precedent
- Case Citation
- Practice Exercises

What is Case Law?

Case Law

- Decisions made by the courts, i.e., judge-made law
- 2 functions:
 - Interpret Constitution, statutes, and regulations—“put meat on the bones of the law”
 - Apply Constitution, statutes, and regulations to particular facts

Case Law (cont.)

(Example)

- Under 35 U.S.C. §112, ¶ 1, “[t]he specification shall contain a written description of the invention.”
- What does it mean to have a written description of the invention?
- Case law tells us.

Case Law (cont.)

(Example)

- “The ‘written description’ requirement serves a teaching function, as a quid pro quo in which the public is given ‘meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time.’” *Univ. of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 922 (Fed. Cir. 2004).
- The written description requirement may be satisfied in a variety of ways, including:
 - (i) a recitation of a representative number of species falling within the scope of the genus, *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1569 (Fed. Cir. 1997);
 - (ii) a recitation of structural features common to members of the genus, which features constitute a substantial portion of the genus; *id.*; and
 - (iii) functional characteristics when coupled with a known or disclosed correlation between structure and function, *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 964 (Fed. Cir. 2002).

How Does Case Law Apply to Examiners?

- Case law is often cited by applicants to argue against a rejection. When that happens, examiners need to understand the cited case law and either:
 - explain why it does not overcome the rejection; or
 - recognize that the rejection is not correct and withdraw it.
- Case law can be relied upon to support a rejection, see e.g., MPEP § 2144.04
 - Ensure a clear and concise rejection
 - Increase chance for affirmance at Board
 - Quicker disposal of case
- Case law may not be necessary to use in all circumstances, i.e., it is not a per se rule that case law is needed to support every rejection.

Options for How Case Law Can Help Support a Rejection

- Clarify the correct legal standard
- Compare or contrast facts in case law with those in an application and then apply result and reasoning from case law to application
- Case law does not apply to the rejection

Case Law

(Legal Standard Example)

- Non-patent law example of incorrect legal standard:
 - An argument that you cannot be found guilty of murder unless the body has been found.
 - A body is not required to prove murder, though is surely helpful in proving the case.
- Patent law example of incorrect legal standard:
 - An argument that a showing of obviousness always requires a showing of teaching, suggestion, or motivation.
 - After KSR, TSM is but one of several ways to support a showing of obviousness.

Case Law

(Patent Case Law Analogy/Distinction)

- In Anderson's-Black Rock, the claimed invention was a paving machine that included a radiant heat burner.
 - Paving machines and radiant heat burners were both in the prior art.
 - Supreme Court held the invention obvious because “the radiant-heat burner functioned just as a burner was expected to function; and the paving machine did the same.”

Case Law

(Patent Case Law Analogy)

- Claimed invention is bicycle including a bell.
- By analogy to Anderson's-Black Rock, one could argue that putting a bell on a bicycle would be obvious.
- Bell and bicycle both known.
- Bell would function on a bicycle as expected, just like radiant-heat burner functioned as expected when included on paving machine.

Case Law

(Patent Case Law Distinction)

- Claimed invention is a battery that combined various elements from prior art batteries.
- In contrast to Anderson's Black Rock, one could argue that combination of prior art elements in claimed battery would not be obvious.
- Elements of battery known, like the radiant-heat burner and paving machine.
- But, elements functioned together in an unexpected way, unlike the radiant-heat burner on the paving machine, which functioned as expected.

MPEP and Case Law

- MPEP contains case law that is consistent with Office policy.
- MPEP is the best source of case law for examiners and should always be consulted **first**.
- But, the MPEP is just a summary; it may be necessary to go beyond the MPEP and read the actual case to fully understand it.

Structure of a Decision

Why Is the Structure of a Decision Relevant to Examiners?

- Helps examiners navigate a decision to more quickly and easily identify examination tips

The Dirty Little Secret

- It may not be necessary to read the entire case to decide whether it is relevant.
- Go to specifically the cited text and read it in context first
- If relevant, then read the other parts of the case that are pertinent to examination. *See slide 23.*

In re Fulton

Results for: CASENAME(Fulton)

◀ Previous | Next ▶

[USPO, 1st Series \(1929 - 1986\)](#) > [U.S. Court of Customs and Patent Appeals](#) > In re FULTON, KERR, AND OBRECHT, 155 USPQ 460 (C.C.P.A. 1967)

155 USPQ 460

In re FULTON, KERR, AND OBRECHT
U.S. Court of Customs and Patent Appeals

Appl. No. 7813

Decided November 2, 1967

384 F2d 1014

Headnotes

PATENTS

[\[1\] Patentability—Invention—In general](#) (▶ [51.501](#))

It may well be that applicants solved an actual problem, but it does not necessarily follow that solution was unobvious.—In re Fulton, Kerr, Obrecht (CCPA) [155 USPQ 460](#).

Particular Patents

Particular patents—Valve

Fulton, Kerr, and Obrecht, Relief Valve, claims 16 to 19 and 21 of application refused.—In re Fulton, Kerr, Obrecht (CCPA) [155 USPQ 460](#).

Case History and Disposition

Appeal from Board of Appeals of the Patent Office.

Application for patent of Howard A. Fulton, Laird I. Kerr, and Clayton Duane Obrecht, Serial No. 251,905, filed Jan. 16, 1963; Patent Office Group 380. From decision rejecting claims 16 to 19 and 21, applicants appeal. Affirmed.

Attorneys

WATTS & FISHER, B. D. WATTS, and LOWELL L. HEINKE, all of Cleveland, Ohio, for appellants.

JOSEPH SCHIMMEL (JERE SEARS of counsel) for Commissioner of Patents.

Judge

Before WORLEY, Chief Judge, RICH, SMITH, and ALMOND, Associate Judges, and KIRKPATRICK, Judge. ^{*}

^{*} Senior District Judge, Eastern District of Pennsylvania, sitting by designation.

Case Caption

- *Ex Parte Applicant*
 - Case before the BPAI
- *In re Applicant*
 - Cases before the court after BPAI decision
- *A v. B*
 - Two parties suing each other, e.g., patent infringement, interference, etc.
- *Applicant v. Director of the USPTO*
 - Someone suing the Office

What Is In a Name?

(Examples)

- *Ex Parte Kubin*
- *Kubin v. Monsanto*
- *Kubin v. Dudas*
- *In re Kubin*

Opinion Type

- Majority
 - Forms the opinion for the court
 - Presents the holding and rationale for the court

- Concurrence
 - Agrees with ultimate outcome, but for different reasons
 - Written by one or more judges
 - Judge in the majority may also be in concurrence

- Dissent
 - Disagrees with ultimate outcome
 - Written by one or more judges
 - Dissenting judge is not part of majority

- Plurality
 - No majority; fractured opinion with multiple judges going different ways for different reasons
 - Happens with appellate court sitting en banc or Supreme Court

Importance of Opinion Type

- Decision of the court is found in the majority opinion
- Any statements in the concurrence or dissent are for a single judge only; such statements are not the opinion of the court and are not binding on the court
 - If concurrence or dissent is cited, the authoring judge should be mentioned to indicate that the cited statement is from that judge and does not represent the view of the court

How Do I Know the Opinion Type?

(Examples)

■ Opinion will show it.

United States Court of Appeals for the Federal Circuit

2007-1145, -1161

INNOGENETICS, N.V.,

Plaintiff-Cross Appellant,

v.

ABBOTT LABORATORIES,

Defendant-Appellant.

Appeals from the United States District Court for the Western District of Wisconsin in case no. 05-CV-0575, Judge Barbara B. Crabb.

DECIDED: January 17, 2008

Before BRYSON, Circuit Judge, CLEVENGER, Senior Circuit Judge, and MOORE, Circuit Judge.

MOORE, Circuit Judge.

4

MICROSOFT CORP. v. AT&T CORP.

Syllabus

copies of software may create a “loophole” in favor of software makers, the Court is not persuaded that dynamic judicial interpretation of §271(f) is in order; the “loophole” is properly left for Congress to consider, and to close if it finds such action warranted. Section 271(f) was a direct response to a gap in U. S. patent law revealed by *Deep-south Packing Co. v. Laitram Corp.*, 406 U. S. 518, where the items exported were kits containing all the physical, readily assemblable parts of a machine (not an intangible set of instructions), and those parts themselves (not foreign-made copies of them) would be combined abroad by foreign buyers. Having attended to that gap, Congress did not address other arguable gaps, such as the loophole AT&T describes. Given the expanded extraterritorial thrust AT&T’s reading of §271(f) entails, the patent-protective determination AT&T seeks must be left to Congress. Cf. *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U. S. 417, 431. Congress is doubtless aware of the ease with which electronic media such as software can be copied, and has not left the matter untouched. See the Digital Millennium Copyright Act, 17 U. S. C. §1201 *et seq.* If patent law is to be adjusted better to account for the realities of software distribution, the alteration should be made after focused legislative consideration, not by the Judiciary forecasting Congress’ likely disposition. Pp. 17–19.

414 F. 3d 1366, reversed.

GINSBURG, J., delivered the opinion of the Court, except as to footnote 14. SCALIA, KENNEDY, and SOUTER, JJ., joined that opinion in full. ALITO, J., filed an opinion concurring as to all but footnote 14, in which THOMAS and BREYER, JJ., joined. STEVENS, J., filed a dissenting opinion. ROBERTS, C. J., took no part in the consideration or decision of the case.

Structure of a Decision

- All decisions have standard sections, which are always presented in a certain order
- Standard sections are typically identified by headings or roman numeral dividers
- Some sections are relevant to examiners; others are not

Structure of a Decision (cont.)

(Parts Relevant to Examiners)

- Introduction
- Facts
- Procedural History
- Discussion of Issues
 - Issue #1
 - Law
 - Application of law to facts, etc.
 - Issue #2
 - Law
 - Application of law to facts, etc.

Structure of a Decision (cont.)

(Parts Not Relevant to Examiners)

■ Jurisdictional Statement

- One sentence statement explaining the basis for the court's authority to decide the case

■ Standard of Review

- Test used by court in deciding whether to interfere with a decision of Board/lower court

■ Conclusion

- Statement addressing relief sought by plaintiff/appellant (e.g., affirm, reverse, affirm-in-part and reverse-in-part, or remand)

Introduction

- One sentence summary of who is seeking review and on what issue
- One sentence summary of outcome with short reason

Introduction

(Fulton Example)

- Appellants Daniel Fulton and James Huang appeal from the decision of the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences (“Board”), affirming the examiner’s rejection of appellants’ application for a utility patent on grounds that the invention claimed would have been obvious under 35 U.S.C. § 103(a). The appeal was submitted for decision without oral argument on November 5, 2004. Because the Board’s finding that the prior art suggested the desirability of the combination of shoe sole limitations claimed in appellants’ patent application was supported by substantial evidence, we affirm.

Facts

- Technology in dispute
- Claims
- Prosecution history — pertinent parts
- Prior art

Facts

(*Fulton Example*)

- On July 24, 1997, appellants filed application number 09/122,198 (the '198 application) for a utility patent directed to a shoe sole with increased traction. Claim 1, the only independent claim at issue, reads:

An improved shoe sole '198 application, at 7.

- Three limitations of this claim are at issue, namely the limitations that: (A) the perimeter of the shoe is mostly open, (B) the projected surfaces, also called studs, are hexagonal in shape, and (C) the hexagonal shapes be oriented so that opposite edges of the hexagon “face generally in the directions of said fore-aft axis.” *Id.* A figure from the '198 application is reproduced below, with non-substantive modifications for simplicity of presentation.
- Prior art related to the '198 application includes U.S. Patent No. 3,793,750 (“Bowerman”), U.S. Design Patent No. 281,462 (“Pope”), U.S. Design Patent No. 263,645 (“Mastrantuone”), and United Kingdom Patent No. 513,375 (“Davies”). Figures from these patents are reproduced below.

Procedural History

- Description of action in lower tribunal
- Decision of lower tribunal
- Reasoning of lower tribunal
 - Be careful not to confuse reasoning of lower tribunal with that of Court issuing the decision

Procedural History

(*Fulton Example*)

- The examiner rejected the '198 application, *inter alia*, on obviousness grounds by considering Pope in light of Bowerman and Davies, and appellants appealed this rejection to the Board.
- In its decision, the Board reversed the examiner's ground for rejection, supplied an alternative ground for rejection, and remanded.
- After the Board entered its decision, appellants filed a request for rehearing.
- The panel held this motion for rehearing in abeyance while the examiner considered the application on remand. After reopening prosecution, the examiner rejected the '198 application for reasons identical to those offered by the Board in its first decision

Discussion

- Issue
 - Sometimes, court will present the parties' arguments before identifying the legal issue.
 - Be careful not to confuse parties' arguments with the Court's decision and reasoning
- Relevant law
- Application of law to facts with decision on issue and explanation of reasons for decision
- **Relevant legal principles, analysis, and phraseology will be found here**

Holding

- Court's ultimate legal conclusion on an issue
- Under *this* law, with *these* facts, *this* result
- “We hold”
- Use extreme caution in classifying a statement by a court as a holding
- Courts use the “hold” sparingly; do the same
- MPEP usually captures holding for most cases

Rationale

(a.k.a., reasoning)

- Reasons for the ultimate conclusion
- No magic words
- E.g., “We conclude,” “We determine,” “We think”

Dicta—It's Dangerous

- Dictum (singular): Dicta (plural)
- Statement or observation made by a judge that does not form a necessary part of the court's decision, but is included in the body of the court's opinion
- Court said it, but not needed to reach decision
- Attorneys may cite dicta in arguing against a rejection
- **Dicta IS NOT A HOLDING**

Holding v. Dicta

(Example)

- In *eBay v. MercExchange*, 547 U.S. 388 (2006), the Supreme Court addressed issue of whether patentee MercExchange was entitled to a permanent injunction.
- Supreme Court observed that the district court denied a permanent injunction because patentee MercExchange expressed a willingness to license its patents, showing it would not suffer irreparable harm if an injunction did not issue.

Holding v. Dicta (cont.)

(Example)

- In the context of reviewing whether willingness to license could defeat an injunction, Supreme Court stated:
 - “For example, some patent holders, **such as university researchers or self-made inventors**, might reasonably prefer to license their patents, rather than undertake efforts to secure the financing necessary to bring their works to market themselves. **Such patent holders** may be able to satisfy the traditional four-factor test, and we see no basis for categorically denying them the opportunity to do so.” 547 U.S. at 393.
- Statement is dicta because it is not about the private parties to the case, but instead concerns university researchers or self-made inventors as hypothetical parties

Issue

(Fulton Example)

- Appellants first argue that the Board's finding of a motivation to combine lacks substantial evidence because the Board failed to demonstrate that the characteristics disclosed in Pope, hexagonal surfaces in a facing orientation, are preferred over other alternatives disclosed in the prior art.
- This argument fails because our case law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention.
- '[T]he question is whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination,' not whether there is something in the prior art as a whole to suggest that the combination is the *most desirable* combination available. See *In re Beattie*, 974 F.2d at 1311 (internal quotation omitted; emphasis added). A case on point is *In re Gurley*, 27 F.3d 551, 552-53 (Fed. Cir. 1994)

Sources of Confusion

- Syllabus — summary of decision

- Don't cite or quote because not authored by the Court

- Prepared by publisher

(Slip Opinion) OCTOBER TERM, 2005 1

Syllabus

NOTE: Where it is feasible, a syllabus (headnote) will be released, as is being done in connection with this case, at the time the opinion is issued. The syllabus constitutes no part of the opinion of the Court but has been prepared by the Reporter of Decisions for the convenience of the reader. See *United States v. Detroit Timber & Lumber Co.*, 200 U. S. 321, 337.

SUPREME COURT OF THE UNITED STATES

Syllabus

EBAY INC. ET AL. *v.* MERCEXCHANGE, L. L. C.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

~~No. 03-1301. Argued March 20, 2005. Decided May 10, 2005.~~

Petitioners operate popular Internet Web sites that allow private sellers to list goods they wish to sell. Respondent sought to license its business method patent to petitioners, but no agreement was reached. In respondent's subsequent patent infringement suit, a jury found that its patent was valid, that petitioners had infringed the patent, and that damages were appropriate. However, the District Court denied respondent's motion for permanent injunctive relief. In reversing, the Federal Circuit applied its "general rule that courts will issue permanent injunctions against patent infringement absent exceptional circumstances." 401 F. 3d 1323, 1339.

Held: The traditional four-factor test applied by courts of equity when considering whether to award permanent injunctive relief to a prevailing plaintiff applies to disputes arising under the Patent Act. That test requires a plaintiff to demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law are inadequate to compensate for that injury; (3) that considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction. The decision to grant or deny such relief is an act of equitable discretion by the district court, reviewable on appeal for abuse of discretion. These principles apply with equal force to Patent Act disputes. "[A] major departure from the long tradition of equity practice should not be lightly implied." *Weinberger v. Romero-Barcelo*, 456 U. S. 305, 320. Nothing in the Act indicates such a departure. Pp. 2–6.

401 F. 3d 1323, vacated and remanded.

THOMAS, J., delivered the opinion for a unanimous Court. ROBERTS,

Sources of Confusion (cont.)

- Headnotes — summary of decision

- Don't cite or quote because not authored by Court

- Prepared by publisher

Results for: CASECITE(73 uspq 2d 1141)

[USPO, 2d Series \(1986 - Present\)](#) > [U.S. Court of Appeals, Federal Circuit](#) > [In re Fulton, 73 USPQ2d 1141 \(Fed. Cir. 2004\)](#)

73 USPQ2d 1141

In re Fulton

U.S. Court of Appeals
Federal Circuit

No. 04-1267

Decided December 2, 2004

391 F3d 1195

Headnotes

PATENTS

[\[1\] Patentability/Validity – Obviousness – Combining references](#) [▶ 115.0905](#)

Finding of motivation to combine prior art references need not be supported by showing that claimed combination is preferred over other alternatives, since proper inquiry is whether there is something in prior art as whole to suggest desirability, and thus obviousness, of making combination, not whether there is something in prior art as whole to suggest that combination is preferred or most desirable.

[\[2\] Patentability/Validity – Obviousness – Combining references](#) [▶ 115.0905](#)

Prior art does not "teach away" from combination of references claimed in application for shoe sole with increased traction, even though prior art disclosed more than one alternative to each element of claimed invention, since such disclosure does not criticize, discredit, or otherwise discourage solution claimed in application.

[\[3\] Patentability/Validity – Obviousness – Combining references](#) [▶ 115.0905](#)

Substantial evidence supports finding by Board of Patent Appeals and Interferences that invention claimed in patent application for shoe sole with increased traction is rendered obvious by combination of prior art references, despite applicants' argument that prior

Page 1142

art does not teach importance of aligning cylindrical polygonal studs in "facing" orientation on sole of shoe, in which there is predetermined, usual, or ordinary direction of travel, since references need not be combined for reasons contemplated by inventor in order to render claimed invention obvious, and since board's finding is sufficiently broad to encompass applicants' idea of using "facing" orientation for studs where predominant direction of travel is forward, and therefore recognizes importance of providing "bite" in forward direction.

Remember the Dirty Little Secret

- It may not be necessary to read the entire opinion to decide whether a case is relevant
- Go to specifically cited text and read it in context first
- If relevant, then read the parts of the case pertinent to examiners

Precedent

Precedent

- A decision of a tribunal, considered to furnish a rule of law for future cases with identical or similar facts
- Must be followed if “directly on point”

Two Components of Precedent

- Level of Tribunal Issuing Decision
- Form of Decision Issued by the Tribunal

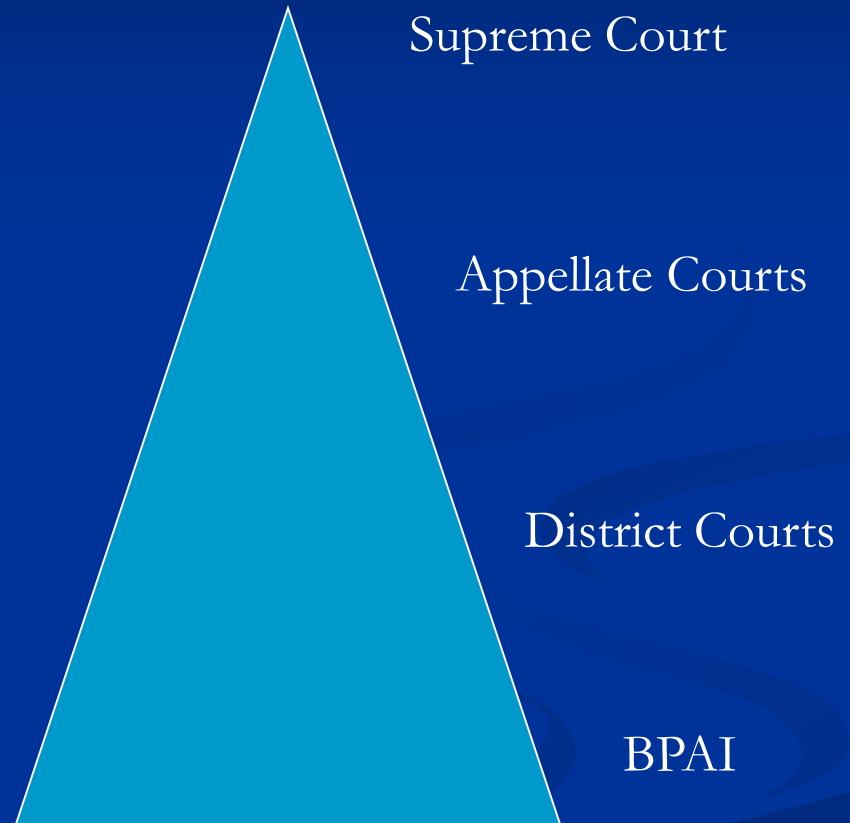
Level of Tribunal Issuing Decision

- Supreme Court
 - Highest court

- Appellate Courts
 - Reviewing court (2nd level)

- District Court
 - Trial court (1st level)

- BPAI



Form of Decision

- Tribunal can issue a decision as:
 - Binding
 - Not Binding

Binding v. Non-Binding Decisions

■ Binding

- Precedential (Court and BPAI)
 - Decision will add to body of law
 - All lower tribunals must follow

■ Not Binding

- Non-precedential (Court and BPAI)
 - Decision will not add to body of law
 - Binds only the parties
- Informative (BPAI only)
 - Helps clarify the law
 - Binds only the parties
- Other (BPAI only)
 - Binds only the parties

What Decisions Are Binding on Examiners?

- Technically, all binding decisions issued by the BPAI and courts
- However, examiners are to follow the cases cited in the MPEP or those endorsed by Patent Policy
- If a decision is new or not discussed in the MPEP, consult SPE before citing
 - Why? The Office has to interpret a decision before applying it to examination, e.g., *KSR v. Teleflex*

How To Know Form of Decision?

(Examples)

■ Decision will indicate the disposition

United States Court of Appeals for the Federal Circuit

2007-1109

MONSANTO COMPANY,

Plaintiff-Appellee,

v.

BAYER BIOSCIENCE N.V.,

Defendant-Appellant.

Appeal from the United States District Court for the Eastern District of Missouri in case no. 4:00-CV-01915, Judge E. Richard Webber.

DECIDED: January 25, 2008

Before BRYSON, GAJARSA, and DYK, Circuit Judges.

GAJARSA, Circuit Judge.

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

2006-1615

CANON, INC.,

Plaintiff-Appellee,

v.

GCC INTERNATIONAL LIMITED, GCC MANAGEMENT LIMITED,
GATEHILL INTERNATIONAL LIMITED, Q-IMAGING (USA), INC.,
and TALLYGENICOM LP,

Defendants-Appellants.

Nicholas M. Cannella, Fitzpatrick, Cella, Harper & Scinto, of New York, New York, argued for plaintiff-appellee. With him on the brief were Brian V. Slater, and Joseph B. Divinagracia. Of counsel on the brief was Edmund J. Haughey, of Washington, DC.

Michael N. Rader, Wolf, Greenfield & Sacks, P.C., of Boston, Massachusetts, argued for defendants-appellants. With him on the brief were Michael A. Albert and James J. Foster.

Appealed from: United States District Court for the Southern District of New York

Judge P. Kevin Castel

How To Know Form of Decision?

(Examples)

PRECEDENTIAL OPINION

Pursuant to the Board of Patent Appeals and Interference's Standard Operating Procedure 2, the opinion below has been designated a precedential opinion.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAREK Z. KUBIN and RAYMOND G. GOODWIN

Appeal 2007-0819
Application 09/667,859
Technology Center 1600

Decided: May 31, 2007

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
TEDDY S. GRON, TONI R. SCHEINER, ERIC GRIMES, and
NANCY J. LINCK, *Administrative Patent Judges*.
LINCK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a 35 U.S.C. § 134 appeal in the above-referenced case.¹

We have jurisdiction under 35 U.S.C. § 6(b). We affirm.



The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FABIO RIGHI

Appeal 2007-0590
Application 09/872,416¹
Technology Center 2600

Decided: July 25, 2007

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
JAMES D. THOMAS, *Administrative Patent Judge*, FRED E.
MCKELVEY, *Senior Administrative Patent Judge*, MAHSHID D.
SAADAT, and ALLEN R. MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

Why Is Precedent Important?

- Examiners should only rely on decisions sanctioned for use by the Office to support a rejection.
- If an applicant cites a non-binding decision to argue against a rejection, the examiner need not follow it because it is not binding.
- **Trick:** If the facts of an application under examination are similar to a those in a non-binding decision, the examiner may want to carefully review the reasoning applied by the tribunal that issued the non-binding decision.
 - If the non-binding decision helps the rejection, then **the examiner may use the reasoning, but not cite the decision.**
 - If the case hurts the rejection, then the examiner may want to withdraw the rejection or attempt to distinguish away the non-binding decision **without citing or discussing it.**

Case Citations

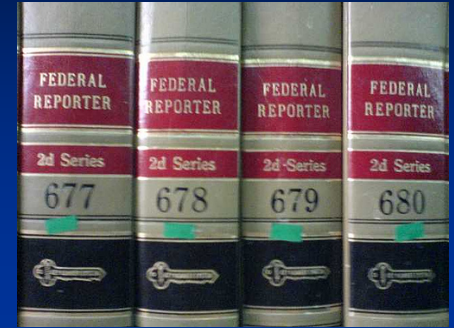
Why Are Case Citations Important to Examiners?

- Gives the address for how to find a case
- Identifies the specific pages in the case where relevant facts/holding/rationale is found
- Akin to citation format for scientific journal articles

Where to Find a Case?

- Opinions are published in two places:
 - Books called “reporters”
 - Electronic databases (e.g., BNA publishes USPQ)

- USPQ electronic database
 - Used by USPTO
 - Searchable



Citation Convention

- Basic case citation format:
 - Case Name, Volume Number, Source, Page Number Where Case Begins (Court Issuing Decision, Date of Decision).
 - Case name is either underlined or italicized
 - Examples:
 - Reporter: *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004).
 - BNA: *In re Fulton*, 73 USPQ 2d 1141 (Fed. Cir. 2004).
 - Both (parallel citation): *In re Fulton*, 391 F.3d 1195, 73 USPQ 2d 1141 (Fed. Cir. 2004).

Citation Convention (cont.)

- Pinpoint citation — exact page number in a case where cited text or statement can be found
 - Case Name, Volume Number, Source, Page Number Where Case Begins, **Page Number Where Material of Interest Found** (Court Issuing Decision, Date of Decision)
 - Examples:
 - Reporter: *In re Fulton*, 391 F.3d 1195, **1199-1200** (Fed. Cir. 2004).
 - BNA: *In re Fulton*, 73 USPQ 2d 1141, **1144-45** (Fed. Cir. 2004).
 - Both (parallel citation): *In re Fulton*, 391 F.3d 1195, **1199-1200**, 73 USPQ 2d 1141, **1144-45** (Fed. Cir. 2004).

Short Form Citation

- After the first full citation to a case, can use the “short form” for a citation
 - Case name is shortened
 - Citation is shortened
 - Shortened Case Name, Volume Number, Source at Page Number Where Material of Interest Found.
 - Examples:
 - Reporter: *Fulton*, 391 F.3d at 1199-120.
 - BNA: *Fulton*, 73 USPQ 2d at 1144-45.
 - Both (parallel citation): *Fulton*, 391 F.3d at 1199-1200, 73 USPQ 2d at 1144-45.

Id.

- *Id.* is a shorthand way of providing a case citation by referencing the immediately preceding citation.
- *Id.* is used when the citation is identical to the prior citation.
- If page number where material of interest is found is the same, citation is: *Id.*
- If page number where material of interest is found is different, citation is: *Id.* at ____ where the “____” is the page number where material is found.
- *Id.* is either underlined or italicized.

Id. (cont.)

■ Examples:

- The written description requirement may be satisfied by a recitation of a representative number of species falling within the scope of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1569 (Fed. Cir. 1997). It may also be satisfied by a recitation of structural features common to members of the genus, which features constitute a substantial portion of the genus. *Id.*

What Citation Convention Do Tribunals Use?

- MPEP normally uses parallel citation to reporter book and USPQ.
- BPAI decisions normally use USPQ citation.
- Court decisions use only reporter book citation.

How Applicants Will Cite Cases to Examiners?

- Probably using reporter book citation and maybe USPQ citation.
- If applicant gives only the reporter book citation, an examiner can use the case name to find the case. An examiner does not have to have a USPQ citation to find the case.
- If applicant gives a list of cases for a proposition, review the cases beginning with the first one cited. It usually is the most relevant.

How Examiners Should Cite Cases to Applicants?

- Use USPQ citation
- If reporter book citation is available, consider giving it too. Reporter book citation form may or may not appear in MPEP.
- Examiners likely will not have access to reporter books.
- Once an examiner provides the citation for a case, the examiner need not repeat the cite each time the case is mentioned. Instead, the examiner should give the case name and a page number for where the cited material can be found to enable the applicant to quickly find the material.
 - Analogous to short cites for journal article or patent.

Questions?

Appendices

Appendix 1: Finding Case Law

How Examiners Find Case Law

- Two steps to finding case law:
 - Step 1: Consult MPEP (possibly stop there)
 - Step 2: Find the case in USPQ database (court decisions) or on BPAI website

MPEP

- Cases are discussed in the MPEP by relevant topics
- Gives a summary of the case and usually the holding
- Reliance on the case has been endorsed by Patent Policy for the stated proposition
- Use MPEP Insight in Examiner's Toolkit to find a particular case

MPEP (cont.)


- If the discussion of a case in the MPEP gives sufficient information about a case, then stop with the MPEP discussion of the case
- But, if you need to read the case, then use USPO database to find it

USPQ Database

- USPQ website
 - <http://iplaw.bna.com/iplw/>
 - Easy to use
- 4 Ways
 - By citation
 - By case name—often needed because applicants may not provide USPQ cite; applicants typically use reporter book cite
 - By word searching
 - By topical index

Using USPQ to Find Case Law

HOME ABOUT CONTACT US SITE MAP PREFERENCES HELP

 Intellectual Property Library

SEARCH * Favorites
Saved Searches Search History

Welcome. [Log in to your preferences.](#) January 29, 2008

INDEX

› **Topical Index** provides access to USPQ headnotes and decisions.
[Search Index »](#)

SITE LINKS

› **Treatise**
Patents and the Federal Circuit (8th ed.) by Robert L. Harmon.
[Search Treatise »](#)

› **Laws and Regulations**
Text of federal IP laws and regulations.
[Search Laws and Regulations »](#)

› **Other BNA IP Products**
Links to other products within BNA's IP suite.

› **Other Resources**
Links to key IP sources outside BNA.

› **Library Update**
See what content has been added most recently to the Library.

GETTING STARTED

Phone support is available at 1-800-372-1033

› [First-Time User Setup](#)
› [Take a Quick Tour](#)
› [Frequently Asked Questions](#)
› [Instructor-Led Training Options](#)
› [Quick Reference Card](#)
› [Training and Support](#)

› [Sign up for E-mail Highlights](#)

FIND CASES

› **Find a USPQ Case by Citation**
Use this search to find a specific case.
[Search all USPQ Cases](#)
Find decisions by searching the Library's entire collection of decisions by word, phrase, tribunal, date, and other parameters.

› **See Most Recent USPQ Cases**
Review the decisions most recently added to the Library.

› **Headnote Finder**
Find decisions by first viewing the Headnotes sorted by classification number and, optionally, by court and date.

› **Find Classification Numbers by Searching the Outline**
Find the best Classification Numbers for viewing the Headnotes, by searching the Classification Outline.

› **Find Classification Numbers by Browsing the Outline**
Find the best Classification Numbers for viewing the Headnotes, by browsing the Classification Outline.

SEARCH OPTIONS

› **Choose the Specific Collections you wish to search**
Search the Library — or limit your search to specific collections — by word, phrase, tribunal, date, and other parameters.

› **Choose a Guided Search**
Use the Guided Search option to search specific collections by specific parameters.

NEWS HIGHLIGHTS

› **Login** to the Patent, Trademark & Copyright Journal to see all highlights.

› ['A' or 'An' With 'Comprising' in Patent Claim Means 'One or More'](#)

› [Copyright Claims Outside Scope of Agreement Do Not Require Arbitration](#)

› [Res Judicata Exception Prevents Preclusion of Patent License Claim](#)

EDITORS' PICKS

› [Patent Specification Is Not 'New Evidence' Under PTO Rule 202\(d\)](#)

› [Karaoke Machines Ineligible for Compulsory Copyright License](#)

› [Unauthorized Use of Latter Day Saints Church Marks Enjoined](#)

FAVORITE DOCUMENTS

No favorite documents have been selected to display. For help with this feature, [view the Help file.](#)

[Edit Favorite Documents](#)

Case by Citation

FIND CASES

■ Step 1:

Find a [USPQ Case by Citation](#)
Use this search to find a specific case.

■ Step 2:

Find a case by citation: ?

Enter one citation and click Go. The question mark lists citation formats.

To search with maximum flexibility, try the [Main Search](#).

To use pre-selected search fields, try the [Guided Search](#)

■ Step 3:

Search Results

Search Options: [Edit](#) | [Save](#)



Results for: CASECITE(73 uspq 2d 1141)

Your search returned: 1 document

Check to add to print selection list

Cases and Decisions : *[by date within court]* (1 document) > Show results: [by relevance](#) | [in split screen](#)

U.S. Court of Appeals, Federal Circuit

[In re Fulton, 73 USPQ2d 1141 \(Fed. Cir. 2004\)](#)

Case by Citation (cont.)

Step 4:

Intellectual Property Library

SEARCH Favorites
Saved Searches Search History

In re Fulton

Go: Browse Contents Search Options: Edit | Save | Clear | Results List
Add to Favorites Split Screen Go to Hit

Results for: CASECITE(73 uspq 2d 1141)
USPO, 2d Series (1986 - Present) > U.S. Court of Appeals, Federal Circuit > In re Fulton, 73 USPQ2d 1141 (Fed. Cir. 2004)

73 USPQ2d 1141
In re Fulton
U.S. Court of Appeals
Federal Circuit
No. 04-1267
Decided December 2, 2004
391 F3d 1195

Headnotes

PATENTS

[1] **Patentability/Validity — Obviousness — Combining references** (▶115.0905)
Finding of motivation to combine prior art references need not be supported by showing that claimed combination is preferred over other alternatives, since proper inquiry is whether there is something in prior art as whole to suggest desirability, and thus obviousness, of making combination, not whether there is something in prior art as whole to suggest that combination is preferred or most desirable.

[2] **Patentability/Validity — Obviousness — Combining references** (▶115.0905)
Prior art does not "teach away" from combination of references claimed in application for shoe sole with increased traction, even though prior art disclosed more than one alternative to each element of claimed invention, since such disclosure does not criticize, discredit, or otherwise discourage solution claimed in application.

[3] **Patentability/Validity — Obviousness — Combining references** (▶115.0905)
Substantial evidence supports finding by Board of Patent Appeals and Interferences that invention claimed in patent application for shoe sole with increased traction is rendered obvious by combination of prior art references, despite applicants' argument that prior

Page 1142

art does not teach importance of aligning cylindrical polygonal studs in "facing" orientation on sole of shoe, in which there is predetermined, usual, or ordinary direction of travel, since references need not be combined for reasons contemplated by inventor in order to render claimed invention obvious, and since board's finding is sufficiently broad to encompass applicants' idea of using "facing" orientation for studs where predominant direction of travel is forward, and therefore recognizes importance of providing "bite" in forward direction.

Case History and Disposition
Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.
Patent application of Daniel S. Fulton and James Huang (serial no. 09/122,198). Applicants appeal from final rejection of claims for obviousness under 35 U.S.C. §103. Affirmed.

Attorneys
Garth E. Janke, of Birdwell & Janke, Portland, Ore., for appellants.
John M. Whealan, solicitor; W. Asa Hutchinson, attorney-advisor; William LaMarca, associate solicitor, for U.S. Patent and Trademark Office.

Judge
Before Michel, Rader, and Gajarsa, circuit judges.

Opinion Text

Opinion By:
Michel, J.

Appellants Daniel Fulton and James Huang appeal from the decision of the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences ("Board"), affirming the examiner's rejection of appellants' application for a utility patent on grounds that the invention claimed would have been obvious under 35 U.S.C. §103(a). The appeal was submitted for decision without oral argument on November 5, 2004. Because the Board's finding that the prior art suggested the desirability of the combination of shoe sole limitations claimed in appellants' patent application was supported by substantial evidence, we affirm.

Background
On July 24, 1997, appellants filed application number 09/122,198 (the "198 application") for a utility patent directed to a shoe sole with increased traction. Claim 1, the only independent claim at issue, reads:

An improved shoe sole for increasing the resistance to slip on a contact surface, the sole comprising a bottom surface and defining a perimeter bounding a forefoot portion corresponding to the forefoot of the shoe and a heel portion corresponding to the heel of the shoe, wherein the sole extends generally along a fore-aft axis running from said heel portion to said forefoot portion, the sole further comprising a substantially regular bling array of projections projecting from said bottom surface, said projections terminating in hexagonal shaped projected surfaces spaced from said bottom surface in a direction for making contact with the contact surface, said projections being oriented so that opposite edges of said projected surfaces face generally in the directions of said fore-aft axis, said projected surfaces being substantially flat and parallel to the bottom surface to maximize the area of contact with the contact surface, said projections being spaced from one another to define substantially continuous channels therebetween for conducting liquid, said channels being open over at least most of said perimeter, said forefoot portion and said heel portion of the sole.

'198 application, at 7 (emphases added).

Three limitations of this claim are at issue, namely the limitations that: (A) the perimeter of the shoe is mostly open, (B) the projected surfaces, also called studs, are hexagonal in shape, and (C) the hexagonal shapes be oriented so that opposite edges of the hexagon "face generally in the directions of said fore-aft axis." *Id.* A figure from the '198 application is reproduced below, with non-substantive modifications for simplicity of presentation.

Prior art related to the '198 application includes U.S. Patent No. 3,793,750 ("Bowerman"), U.S. Design Patent No. 281,462 ("Pope"), U.S. Design Patent No. 263,645 ("Mastrantuone"), and United Kingdom Patent No. 513,375 ("Davies"). Figures from these patents are reproduced below.

As can be seen in the figures, the orientation of the projected surfaces in these figures is different. In this opinion, we will refer to the orientation in the '198 application,

Case by Name

■ Step 1:

Choose a **Guided Search**

Use the Guided Search option to search specific collections by specific parameters.

■ Step 2:

Guided Searches

Other search options: [Treatise](#) | [Laws and Regs](#) | [Finding Aids](#) | [Multiple Collections](#)

Search Cases and Decisions

Select collection(s) to search:

[deselect all](#)

- USPO, 2d Series (1986 - Present)
- USPO, 1st Series (1929 - 1986)

Choose field(s) to search:

Case Name ?

fulton

Limit by date ?

No date restrictions From To

Ex. 1/12/2004

Ex. 10/21/2004

Citation ?

- Find this case
- Find cases citing this case

Court ?

Classification Number ?

Headnotes ?

Particular Patents ?

Case History/Disposition ?

Docket Number ?

Attorney ?

Judge ?

Limit Judge Search to:

- Opinion
- Concur
- Dissent

Word(s)

Need help? View our [search tips](#) or try the [Main Search](#). If you prefer the Guided Search, you can make it your [default search page](#).

Case by Name (cont.)

■ Step 3:

Search Results
Search Options: [Edit](#) [Save](#)

Results for: CASENAME(fulton)
Your search returned: 18 documents

Check to add to print selection list

Cases and Decisions : *[by date within court]* (18 documents) > **Show results:** [by relevance](#) | [in split screen](#)

U.S. Supreme Court

- [HARTFORD-EMPIRE CO. et al. v. UNITED STATES; CORNING GLASS WORKS et al. v. SAME; OWENS-ILLINOIS GLASS CO. et al. v. SAME; HAZEL-ATLAS GLASS CO. et al. v. SAME; THATCHER MFG. CO. et al. v. SAME; LYNCH CORP. et al. v. SAME; BALL BROTHERS CO. et al. v. SAME; GLASS CONTAINER ASSOCIATION OF AMERICA, INC., et al. v. SAME; COLLINS SAME; FULTON et al. v. SAME, 64 USPO 18 \(U.S. 1945\)](#)
- [Philip Hurn and Percy Morgan, Jr. v. Fulton Oursler, Lowell Brentano, Albert Lewis and Sam H. Harris, 17 USPO 195 \(U.S. 1933\)](#)

U.S. Court of Appeals, Federal Circuit

- [In re Fulton, 73 USPO2d 1141 \(Fed. Cir. 2004\)](#)

U.S. Court of Customs and Patent Appeals

- [In re FULTON, KERR, AND OBRECHT, 155 USPO 460 \(C.C.P.A. 1967\)](#)

U.S. Court of Appeals, Sixth Circuit

- [The Patrol Valve Company v. Robertshaw-Fulton Controls Company, 100 USPO 239 \(6th Cir. 1954\)](#)
- [The Bishop and Babcock Manufacturing Company v. The Fulton Company., 4 USPO 398 \(6th Cir. 1930\)](#)

U.S. District Courts, Illinois

- [GLEN MFG. INC. v. FULTON INDUSTRIES, INC., et al., 159 USPO 610 \(N.D. Ill. 1968\)](#)

U.S. District Courts, Louisiana

- [Sable Communications Co. of Georgia Inc. v. Fulton, 40 USPO2d 1370 \(E.D. La. 1996\)](#)

U.S. District Courts, Maryland

- [ROBERTSHAW-FULTON CONTROLS CO. v. NOMA ELECTRIC CORPORATION, 84 USPO 221 \(D. Md. 1950\)](#)

U.S. District Courts, New York

- [Margaret Dana Rush et al. v. Fulton Oursler et al.; Samuel Payder et al. v. Albert Lewis et al., 5 USPO 320 \(S.D.N.Y. 1930\)](#)

U.S. District Courts, Ohio

- [Robertshaw-Fulton Controls Company v. The Patrol Valve Company, 93 USPO 414 \(N.D. Ohio 1952\)](#)
- [ROBERTSHAW-FULTON CONTROLS COMPANY v. THE PATROL VALVE COMPANY, 83 USPO 527 \(N.D. Ohio 1949\)](#)

U.S. Patent and Trademark Office, Commissioner for Trademarks

- [FULTON SMOKED FISH COMPANY v. THE GREAT ATLANTIC AND PACIFIC TEA COMPANY, 92 USPO 284 \(Comm'r Pat. 1952\)](#)
- [Ex parte Palmer and Fulton, 7 USPO 11 \(Comm'r Pat. 1930\)](#)

U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences

- [Ex parte FULTON AND HAENNI, 157 USPO 161 \(Bd. Pat. App. & Int. 1967\)](#)

U.S. Patent and Trademark Office, Trademark Trial and Appeal Board

- [Atlanta-Fulton County Zoo Inc. v. DePalma, 45 USPO2d 1858 \(TTAB 1998\)](#)
- [KRAMER TRENTON COMPANY v. ROBERT-SHAW-FULTON CONTROLS COMPANY, 133 USPO 621 \(TTAB 1962\)](#)

Patent Office Board of Appeals

- [Ex parte Karl T. Steik and Stewart C. Fulton, 31 USPO 343 \(Bd. Pat. App. 1936\)](#)

Case by Name (cont.)

■ Step 4:

In re Fulton

Go: [Browse Contents](#) Search Options: [Edit](#) | [Save](#) | [Clear](#) | [Results List](#)

[Add to Favorites](#) | [Split Screen](#) | [Go to Hit](#) | [Cases and/or documents citing this](#)

Results for: CASENAME(fulton) [Previous](#) | [Next](#)

[USPO, 2d Series \(1986 - Present\)](#) > [U.S. Court of Appeals, Federal Circuit](#) > [In re Fulton, 73 USPQ2d 1141 \(Fed. Cir. 2004\)](#)

73 USPQ2d 1141
In re Fulton
U.S. Court of Appeals
Federal Circuit

No. 04-1267
Decided December 2, 2004
391 F3d 1195

Headnotes

PATENTS

[\[1\] Patentability/Validity – Obviousness – Combining references \(▶115.0905\)](#)

Finding of motivation to combine prior art references need not be supported by showing that claimed combination is preferred over other alternatives, since proper inquiry is whether there is something in prior art as whole to suggest desirability, and thus obviousness, of making combination, not whether there is something in prior art as whole to suggest that combination is preferred or most desirable.

[\[2\] Patentability/Validity – Obviousness – Combining references \(▶115.0905\)](#)

Prior art does not “teach away” from combination of references claimed in application for shoe sole with increased traction, even though prior art disclosed more than one alternative to each element of claimed invention, since such disclosure does not criticize, discredit, or otherwise discourage solution claimed in application.

[\[3\] Patentability/Validity – Obviousness – Combining references \(▶115.0905\)](#)

Substantial evidence supports finding by Board of Patent Appeals and Interferences that invention claimed in patent application for shoe sole with increased traction is rendered obvious by combination of prior art references, despite applicants’ argument that prior

Page 1142

art does not teach importance of aligning cylindrical polygonal studs in “facing” orientation on sole of shoe, in which there is predetermined, usual, or ordinary direction of travel, since references need not be combined for reasons contemplated by inventor in order to render claimed invention obvious, and since board’s finding is sufficiently broad to encompass applicants’ idea of using “facing” orientation for studs where predominant direction of travel is forward, and therefore recognizes importance of providing “bite” in forward direction.

Case History and Disposition

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Daniel S. Fulton and James Huang (serial no. 09/122,198). Applicants appeal from final rejection of claims for obviousness under 35 U.S.C. §103. Affirmed.

Attorneys

Garth E. Janke, of Birdwell & Janke, Portland, Ore., for appellants.

John M. Whealan, solicitor; W. Asa Hutchinson, attorney-advisor; William LaMarca, associate solicitor, for U.S. Patent and Trademark Office.

Judge

Before Michel, Rader, and Gajarsa, circuit judges.


Opinion Text

Opinion By:

Michel, J.

Word Searching Operators

- Used to connect search terms and establish hierarchy for search

Search Operators 	
Use operators to show relationships between search terms. Click on an operator to add it to your search.	
Operator	Definition
and (or a blank space)	and
or (or)	or
not	not
near/N	within N words
/s	in the same sentence
/p	in the same paragraph
?	replace one character
*	replace zero or more characters at the end of the term
"xxx"	phrase

Word Searching Using Legal Terms

■ Step 1:

Search all USPQ Cases

Find decisions by searching the Library's entire collection of decisions by word, phrase, tribunal, date, and other parameters.

■ Step 2:

Advanced Search | [Find a Case by Citation](#)

You are searching:

CASES AND DECISIONS: USPQ, 2d Series (1986 - Present); USPQ, 1st Series (1929 - 1986)

[Edit collections to be searched](#)

Enter search term(s):
obvious* /p motivat* w/p "nature of problem"

Choose fields: (Optional) [?](#)
Choose a field, enter search terms for the field, then click Add to Search.

Choose a field

Note: Not all fields are available in each collection. The list of available fields is determined based on the collection(s) selected.

Limit by date: (Optional) [?](#)
 No Date Restrictions From To
Ex. 1/12/2004 Ex. 10/21/2004

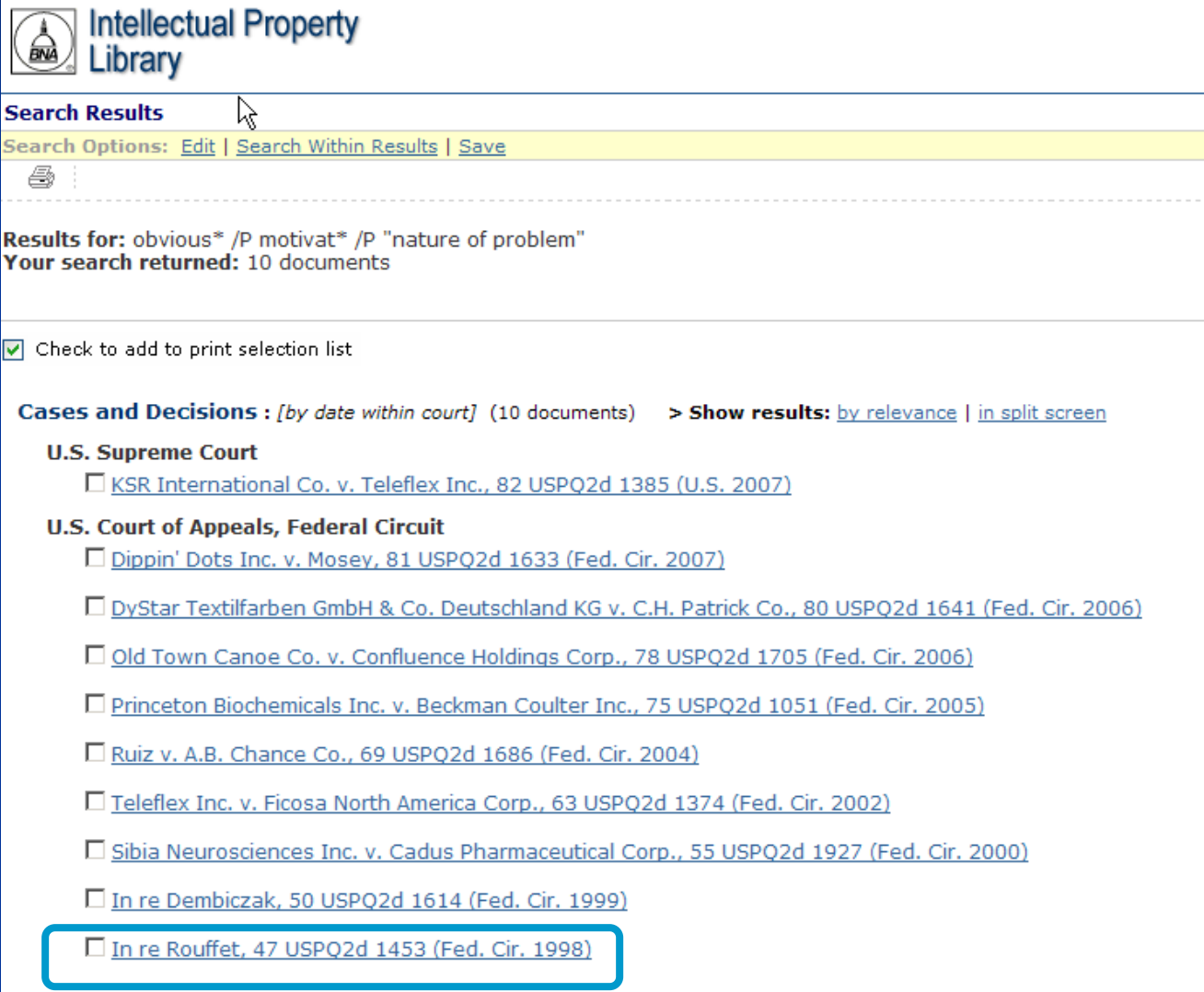
To use pre-selected search fields, try the [Guided Search](#)


Search Operators [?](#)
Use operators to show relationships between search terms. Click on an operator to add it to your search.

Operator	Definition
and (or a blank space)	and
or (or)	or
not	not
near/N	within N words
/s	in the same sentence
/p	in the same paragraph
?	replace one character
*	replace zero or more characters at the end of the term
"xxx"	phrase

Word Searching Using Legal Terms (cont.)


■ Step 3:



 Intellectual Property Library

Search Results

Search Options: [Edit](#) | [Search Within Results](#) | [Save](#)

 :

Results for: obvious* /P motivat* /P "nature of problem"
Your search returned: 10 documents

Check to add to print selection list

Cases and Decisions : *[by date within court]* (10 documents) > **Show results:** [by relevance](#) | [in split screen](#)

U.S. Supreme Court

- [KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 \(U.S. 2007\)](#)

U.S. Court of Appeals, Federal Circuit

- [Dippin' Dots Inc. v. Mosey, 81 USPQ2d 1633 \(Fed. Cir. 2007\)](#)
- [DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 80 USPQ2d 1641 \(Fed. Cir. 2006\)](#)
- [Old Town Canoe Co. v. Confluence Holdings Corp., 78 USPQ2d 1705 \(Fed. Cir. 2006\)](#)
- [Princeton Biochemicals Inc. v. Beckman Coulter Inc., 75 USPQ2d 1051 \(Fed. Cir. 2005\)](#)
- [Ruiz v. A.B. Chance Co., 69 USPQ2d 1686 \(Fed. Cir. 2004\)](#)
- [Teleflex Inc. v. Ficosa North America Corp., 63 USPQ2d 1374 \(Fed. Cir. 2002\)](#)
- [Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp., 55 USPQ2d 1927 \(Fed. Cir. 2000\)](#)
- [In re Dembiczak, 50 USPQ2d 1614 \(Fed. Cir. 1999\)](#)
- [In re Rouffet, 47 USPQ2d 1453 \(Fed. Cir. 1998\)](#)

Word Searching Using Legal Terms (cont.)

Step 4:

In re Rouffet

Go: [Browse Contents](#) Search Options: [Edit](#) | [Search Within Results](#) | [Save](#) | [Clear](#) | [Results List](#)

[Add to Favorites](#) | [Split Screen](#) | [Go to HR](#) Cases and/or documents citing this case

Results for: obvious* /P motivat* /P "nature of problem" ← Previous | Next →

[USPO, 2d Series \(1986 - Present\)](#) > [U.S. Court of Appeals, Federal Circuit](#) > In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998)

47 USPQ2d 1453
In re Rouffet
U.S. Court of Appeals Federal Circuit
No. 97-1492
Decided July 15, 1998
149 F3d 1350

Headnotes

PATENTS

[\[1\] Patentability/Validity -- Obviousness -- Combining references \(▶ 115.0905\)](#)

Claimed low orbit satellite communications system for mobile terminals, which addresses problem of minimizing "handover" of receiver from beam footprint of one transmitting satellite to that of another through use of multiple fan-shaped beams, is not prima facie obvious over combination of three prior art references, since critical reference that teaches use of fan-shaped beam to transmit from ground station to orbiting satellites does not specifically address handover minimization, and to extent it addresses handover problem at all, does so with orbit selection rather than beam shape, and since there is no reason one of ordinary skill in art, seeking to minimize handovers due to satellite motion, would have been motivated to combine this reference with remaining references in manner that would render claimed invention obvious.

[\[2\] Patentability/Validity -- Obviousness -- Person of ordinary skill in art \(▶ 115.0902\)](#)

Patentability/Validity -- Obviousness -- Combining references (▶ 115.0905)

Three possible sources for **motivation** to combine prior art references in manner that would render claimed invention **obvious** are **nature of problem** to be solved, teachings of prior art, and knowledge of persons of ordinary skill in art; high level of skill in field of art cannot be relied upon to provide necessary **motivation** absent explanation of what specific understanding or technical principle, within knowledge one of ordinary skill in art, would have suggested combination, since, if such rote invocation could suffice to supply motivation to combine, more sophisticated scientific fields would rarely, if ever, experience patentable technical advance.

Page 1454

[\[3\] Patentability/Validity -- Obviousness -- Person of ordinary skill in art \(▶ 115.0902\)](#)

Patentability/Validity -- Obviousness -- Combining references (▶ 115.0905)

Claimed low orbit satellite communications system for mobile terminals is not prima facie obvious over combination of two prior art references, even though person possessing high level of skill characteristic of this field would know to account for differences between claimed invention and prior art combination, since high level of skill in art, without more, cannot supply required motivation to combine references, and does not overcome absence of any actual suggestion to combine; obviousness rejection will not be upheld, even where skill in art is high, absent specific identification of principle, known to one of ordinary skill, that suggests claimed combination.

Case History and Disposition **Page 1454**

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Denis Rouffet, Yannick Tanguy, and Frederic Berthault, serial no. 07/888,791, filed May 27, 1992. From decision upholding examiner's final rejection of application as obvious under 35 USC 103(a), applicants appeal. Reversed.

Attorneys

Richard C. Turner and Grant K. Rowan, of Sughrue, Mion, Zinn, Macpeak & Seas, Washington, D.C., for appellants.

David J. Ball Jr., associate solicitor, Nancy J. Linck, solicitor, Albin F. Drost, deputy solicitor, Craig R. Kaufman, associate solicitor, and Scott A. Chambers, associate solicitor, U.S. Patent and Trademark Office, Arlington, Va., for appellee.

Judge

Before Plager, circuit, judge, Archer, senior circuit judge, and Rader, circuit judge.

Opinion Text

Opinion By:

Rader, J.

Word Searching Using Science Terms

■ Step 1:

Search all USPQ Cases

Find decisions by searching the Library's entire collection of decisions by word, phrase, tribunal, date, and other parameters.

■ Step 2:

Advanced Search | [Find a Case by Citation](#)

You are searching:

CASES AND DECISIONS: USPQ, 2d Series (1986 - Present); USPQ, 1st Series (1929 - 1986)

[Edit collections to be searched](#)

Enter search term(s):
catalyst and reactor

Search ? Reset Form ?

Choose fields: (Optional) ?
Choose a field, enter search terms for the field, then click Add to Search.

Choose a field [v] [] Add to Search ?

Note: Not all fields are available in each collection. The list of available fields is determined based on the collection(s) selected.

Limit by date: (Optional) ?
 No Date Restrictions From [] To []
Ex. 1/12/2004 Ex. 10/21/2004

Search ? Reset Form ?

To use pre-selected search fields, try the [Guided Search](#)

Search Operators ?
Use operators to show relationships between search terms. Click on an operator to add it to your search.

Operator	Definition
and (or a blank space)	and
or (or)	or
not	not
near/N	within N words
/s	in the same sentence
/p	in the same paragraph
?	replace one character
*	replace zero or more characters at the end of the term
"xxx"	phrase

Word Searching Using Science Terms (cont.)

■ Step 3:

Results for: catalyst AND reactor
Your search returned: 72 documents

Check to add to print selection list

Cases and Decisions : *[by date within court]* (72 documents) > Show results: [by relevance](#) | [in split screen](#)

U.S. Court of Appeals, Federal Circuit

- [Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co., 76 USPQ2d 1705 \(Fed. Cir. 2005\)](#)
- [Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co., 64 USPQ2d 1545 \(Fed. Cir. 2002\)](#)
- [Exxon Research and Engineering Co. v. United States, 60 USPO2d 1272 \(Fed. Cir. 2001\)](#)
- [Ecolchem Inc. v. Southern California Edison, 56 USPQ2d 1065 \(Fed. Cir. 2000\)](#)
- [In re Gartside, 53 USPQ2d 1769 \(Fed. Cir. 2000\)](#)
- [Phillips Petroleum Co. v. Huntsman Polymers Corp., 48 USPQ2d 1161 \(Fed. Cir. 1998\)](#)
- [The Standard Oil Company v. American Cyanamid Company, 227 USPO 293 \(Fed. Cir. 1985\)](#)

U.S. Court of Customs and Patent Appeals

- [Thomson and Waples v. Armitage, 212 USPO 65 \(C.C.P.A. 1981\)](#)
- [In re Priest, 199 USPO 11 \(C.C.P.A. 1978\)](#)
- [In re Hoqan and Banks, 194 USPO 527 \(C.C.P.A. 1977\)](#)
- [In re Rinehart, 189 USPO 143 \(C.C.P.A. 1976\)](#)
- [In re Mercier, 185 USPO 774 \(C.C.P.A. 1975\)](#)
- [In re Landgraf, Nienburg, Loesch, Appl and Francke, 168 USPO 595 \(C.C.P.A. 1971\)](#)
- [Bethell and Hadley v. Koch, Robinson, and Wiley, 166 USPO 199 \(C.C.P.A. 1970\)](#)
- [In re Doak and Erchak, 164 USPO 128 \(C.C.P.A. 1969\)](#)
- [In re VAN VENROOY AND BORKOWSKI, 162 USPO 37 \(C.C.P.A. 1969\)](#)
- [In re Khelghatian, 150 USPO 661 \(C.C.P.A. 1966\)](#)

Word Searching Using Science Terms (cont.)

■ Step 4:

Results for: catalyst AND reactor

[USPO, 2d Series \(1986 - Present\)](#) > [U.S. Court of Appeals, Federal Circuit](#) > Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co., 76 USPQ2d 1705 (Fed. Cir. 2005)

76 USPQ2d 1705

Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.

U.S. Court of Appeals
Federal Circuit

Nos. 04-1475, -1512

Decided October 3, 2005

425 F3d 1366

Headnotes

JUDICIAL PRACTICE AND PROCEDURE

[1] Procedure – Jury trials ([▶410.42](#))

Procedure – Judicial review – Appealability ([▶410.4603](#))

Patent infringement defendants did not waive arguments challenging jury verdict of infringement, even though defendants did not object at trial until after close of evidence and completion of jury instruction charge conference, since defendants' arguments are most relevant to noninfringement rather than claim construction, and since defendants sufficiently raised specific objections to jury instructions before jury deliberations began.

PATENTS

[2] Infringement – Literal infringement ([▶120.05](#))

Record contains sufficient evidence to support jury's conclusion that infringement defendants' silver catalysts for production of ethylene oxide meet "comparison test" limitation of asserted claim, since plaintiffs' expert applied test specifically approved by patent, and since this measure for catalyst efficiency yielded results placing accused catalysts squarely within limitation.

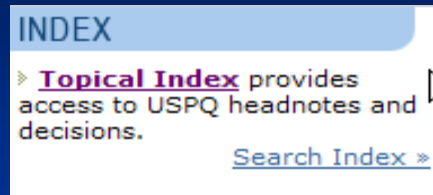
[3] Patentability/Validity – Anticipation – Identity of elements ([▶115.0704](#))

Infringement – Literal infringement ([▶120.05](#))

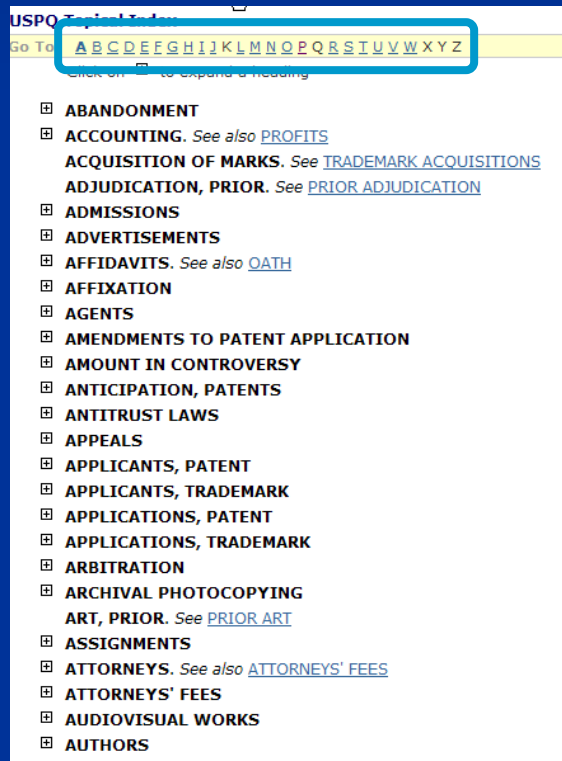
Record contains sufficient evidence to support conclusion that accused silver catalysts for production of ethylene oxide meet "characterizable" test expressed in efficiency equation recited in asserted claim, since characterizable test, properly construed, does not require variation of each of three independent variables in EO production system, in that claim permits variation of silver component of catalyst, but does not require variation of that component, since correct claim construction requires variation of at least concentration of alkali metals of cesium and lithium, and since experiments conducted by plaintiffs' expert made those variations; forgoing conclusion does not mean that patent in suit is anticipated by prior art patent, since prior patent does not disclose use of lithium-based catalysts in claimed continuous process for production of EO with carbon dioxide in feed, and since expert reports in evidence suggest that prior patent's catalyst does not meet characterizable test as properly construed.

Case by Topical Index

■ Step 1:



■ Step 2:




Case by Topical Index (cont.)

■ Step 3:

USPQ Topical Index

Go To: [A](#) [B](#) [C](#) [D](#) [E](#) [F](#) [G](#) [H](#) [I](#) [J](#) [K](#) [L](#) [M](#) [N](#) [O](#) [P](#) [Q](#) [R](#) [S](#) [T](#) [U](#) [V](#) [W](#) [X](#) [Y](#) [Z](#)

Click on  to expand a heading

- OATH. See also [AFFIDAVITS](#)
- OBSCENITY
- OBVIOUSNESS**
- OPERABILITY
- ORIGINALITY
- OWNERSHIP OF COPYRIGHTS

■ Step 4:

USPQ Topical Index

Go To: [A](#) [B](#) [C](#) [D](#) [E](#) [F](#) [G](#) [H](#) [I](#) [J](#) [K](#) [L](#) [M](#) [N](#) [O](#) [P](#) [Q](#) [R](#) [S](#) [T](#) [U](#) [V](#) [W](#) [X](#) [Y](#) [Z](#)

Click on to expand a heading

- OATH. See also [AFFIDAVITS](#)
- OBSCENITY
- OBVIOUSNESS**
 - Combining references, patentability, [USPO ►115.0905](#)
 - Commercial success, patentability, [USPO ►115.0908](#)
 - Evidence of, patentability, [USPO ►115.0906](#)
 - Failure of others to remedy, patentability, [USPO ►115.0910](#)
 - Long felt need, patentability, [USPO ►115.0909](#)
 - Particular inventions, patentability, [USPO ►115.0903.03](#)
 - Patentability, [USPO ►115.0901](#) et seq.
 - Person of ordinary skill in art, patentability, [USPO ►115.0902](#)
 - References and claims as whole, patentability, [USPO ►115.0904](#)
 - Relevant prior art, patentability, [USPO ►115.0903.01](#)
 - Secondary considerations, patentability, [USPO ►115.0907](#)
- OPERABILITY
- ORIGINALITY
- OWNERSHIP OF COPYRIGHTS

Case by Topical Index (cont.)

■ Step 5:

115.0905 - Combining references (42.9)

Go To: [Classification Outline](#) | [Headnote Finder](#)



Jump To: [U.S. Supreme Court](#) | [U.S. Courts of Appeals](#) | [U.S. District Courts](#) | [Administrative Panels](#)

[USPO Classification Outline](#) > [DIVISION I - PATENTS](#) > [115. Patentability/Validity](#) > [115.09 Obviousness \[35 USC 103\]](#) > **115.0905 - Combining references (42.9)**

U.S. Supreme Court

Rigid application of "teaching, suggestion, or motivation" test, under which patent claim is proved obvious only if prior art, nature of problem addressed by inventor, or knowledge of person having ordinary skill in art reveals some motivation or suggestion to combine prior art teachings, is inconsistent with expansive and flexible "functional approach" to resolution of obviousness issue, under which scope and content of prior art are determined, differences between prior art and claims at issue are ascertained, level of ordinary skill in pertinent art is resolved, and secondary considerations such as commercial success, long felt but unsolved needs, and failure of others may be considered if doing so would prove instructive; rigid TSM approach is therefore rejected. [KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 \(U.S. 2007\)](#)

Variations of particular work available in one field of endeavor may be prompted by design incentives and other market forces, either in same field or different one, and if person of ordinary skill in art can implement predictable variation, 35 U.S.C. §103 likely bars its patentability; similarly, if particular technique has been used to improve one device, and person of ordinary skill would recognize that it would improve similar devices in same way, then using that technique is obvious unless its actual application is beyond person's skill, and court resolving obviousness issue therefore must ask whether improvement is more than predictable use of prior art elements according to their established functions. [KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 \(U.S. 2007\)](#)

Court determining whether claimed combination of elements known in prior art would have been obvious will often be required to look to interrelated teachings of multiple patents, effects of demands known to design community or present in marketplace, and background knowledge of person of ordinary skill in art in order to determine whether there was apparent reason to combine known elements in manner claimed in patent in suit, and in order to facilitate review, this analysis should be made explicit; however, such analysis need not seek out precise teachings directed to specific subject matter of challenged claim, since court can take account of inferences and creative steps that person of ordinary skill in art would employ. [KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 \(U.S. 2007\)](#)

BPAI Decisions

■ Step 1:

<http://www.uspto.gov/web/offices/dcom/bpai/index.html>

Address <http://www.uspto.gov/web/offices/dcom/bpai/index.html> Go

United States Patent and Trademark Office
Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Boards & Counsel > Board of Patent Appeals and Interferences (BPAI)

Upcoming Events

- General Counsel
- Solicitor
- General Law
- BPAI
- TTAB
- OED
- Organization Chart

Information

- Contact Information
- Service of Process
- Employment Opportunities
- OGC Strategic Plan

Other Resources

- FOIA
- Federal Court Cases
- Department of Commerce (DOC)
- DOC General Counsel

Board Procedures

- Standard Operating Procedures
- [BPAI-related Official Gazette Notices](#)
- Final Rule (effective 9/13/04) [PDF]
- More information on BPAI Final Rule (posted 10Sep2004)
- Comments on July 2007 Rules of Practice Before the Board of Patent Appeals and Interferences n Ex Parte Appeals

Patent Interference Information

- Interference Web Portal
- Interference Trial Division Forms
- Interference Trial Division Rulemaking
- Transcripts of Interference Roundtables
- Interference Practice Specialists by Technology Center

Board Opinions and Decisions

- Precedential Opinions
- Informative Opinions
- BPAI Final Decisions

Board Contact

- Contact Information
- Mailing Addresses
- Directions

Hearing Information

- Public Admission
- Hearing Protocol
- Hearing Schedules

Board Statistics

- Process Production Report
- Receipts and Dispositions by Technology Center

BPAI Decisions (cont.)

■ Step 2: Precedential Decisions

Boards & Counsel > BPAI > Precedential Opinions

- [Ex Parte Letts \[PDF\]](#)
- [Ex Parte Nehls \[PDF\]](#)
- [Ex Parte Catan \[PDF\]](#)
- [Ex Parte Kubin \[PDF\]](#)
- [Ex Parte Smith \[PDF\]](#)
- [Basmadjian v. Landry \[PDF\]](#)
- [Ex Parte Bhide \[PDF\]](#)
- [Ex Parte Eggert et al. \[PDF\]](#)
- [Ex Parte Lemoine \[PDF\]](#)
- [Ex Parte Lundgren \[PDF\]](#)
- [Ex Parte Yamaguchi \[PDF\]](#)
- [Reitz v. Inoue \[PDF\]](#)

BPAI Decisions (cont.)

■ Step 2: Informative Decisions

Boards & Counsel > BPAI > Informative Opinions

Most files are in portable



Ex Parte Righi, No. 2007-0590 (25 July 2007)
Ex Parte Dart, No. 2007-1325 (22 August 2007)
Ex Parte McBrearty, No. 2007-1340 (27 July 2007)
Ex Parte Shealy, No. 2006-1601 (23 April 2007)
Ex Parte Bradshaw, No. 2006-2744 (19 July 2007)
Ex Parte Tullis, No. 2006-0210 (17 May 2006)
Ex Parte Wright, No. 2006-0003 (06 April 2006)
Ex Parte Shaw, No. 1997-3258 Supplement (19 Dec 2005) (Paper 109)
Ex Parte Shaw, No. 1997-3258 (21 May 2004) (Paper 94)
Ex Parte Liebermann, No. 2007-0012 (17 May 2007)
Guthrie v. Espiau, No. 105,393 (18 April 2007) (Paper 94)
Ex Parte Wellerdieck., No. 2007-1119 (04 May 2007)
Ex Parte Srinivasan., No. 2007-0512 (01 May 2007)
Ex Parte May., No. 2006-1776 (30 April 2007)
Ex Parte Batteux., No. 2007-0622 (27 March 2007)
Ashurst v. Brugger, No. 105,482 (25 April 2007) (Paper 44)
Perego v. Drehmel, No. 105,467 (9 March 2007) (Paper 63)
Rowells v. Vichinsky, No. 105,518 (6 March 2007) (Paper 19)
Karim v. Jobson, No. 105,376 (28 February 2007) (Paper 99)
Ex Parte Adams., No. 2007-0441 (14 March 2007)
Ex Parte Gleave., No. 2005-2447 (31 January 2006)
Ex Parte Curry., No. 2005-0509 (30 June 2005)
Ex Parte Mathias., No. 2005-1851 (10 August 2005)
Ex Parte Jud., No. 2006-1061 (30 January 2007)
Ex Parte Ashkenazi., No. 2005-2208 (20 October 2005)
Ex Parte Kraus., No. 2005-0841 Supplement (21 September 2006) (Paper 52)
Ex Parte Kraus., No. 2005-0841 (7 April 2005) (Paper 50)
Ex Parte Bilski., No. 2002-2257 (26 September 2006)

BPAI Decisions (cont.)

■ Step 2: Other Decisions

Board & Counsel > BPAI > CONTENT MOVED

This page has been removed and all content relocated to

<http://des.uspto.gov/Foia/BPAIReadingRoom.jsp>

Please modify your bookmarks.

Additional Resources

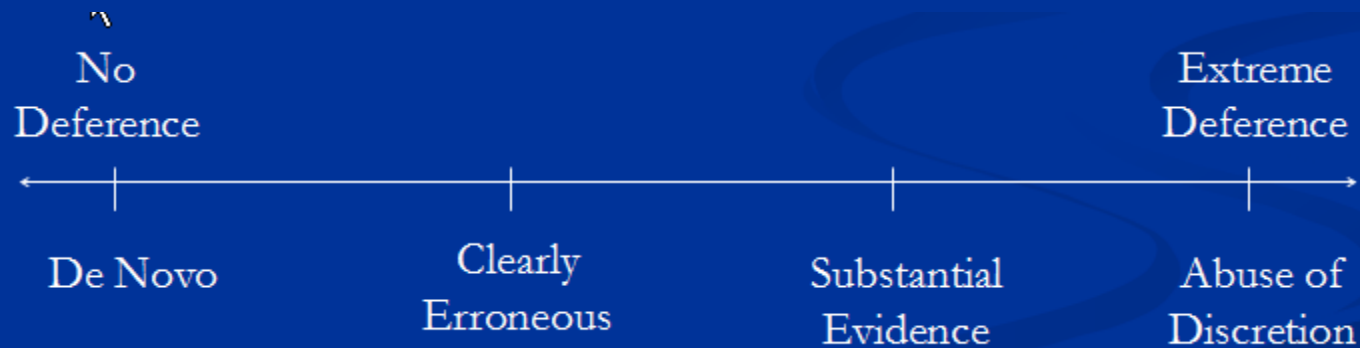
- For more detailed information on finding case law, see handouts:
 - Searching BPAI and Court Decisions; and
 - Citation Searching—MPEP Insight and USPQ Online—Guided Search

Appendix 2: Glossary

(entries appear in alphabetical order)

Abuse of Discretion

- Extreme deference



Applicant v. Appellant

- Applicant applies for a patent by filing an application with the Office.
- Appellant is the term used for an applicant who appeals a final rejection to the Board and possibly then on to a court.

Appellee

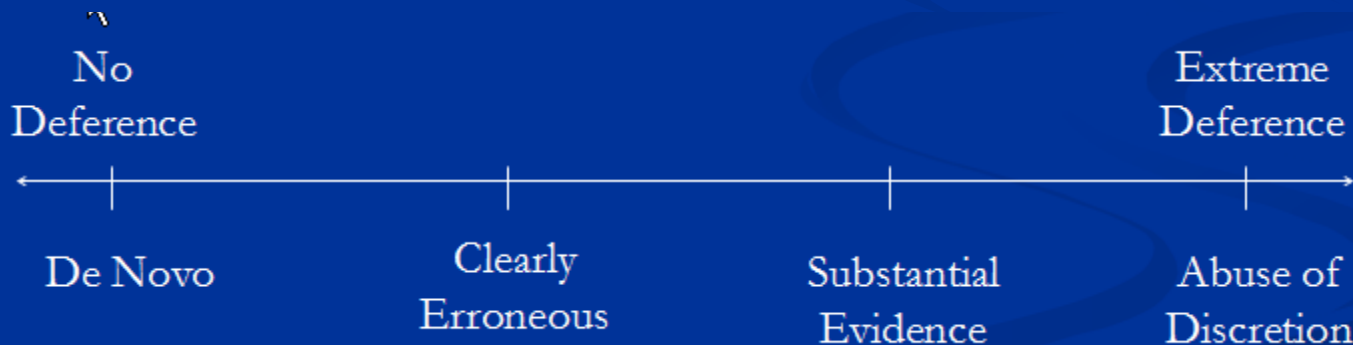
- Appellee is the term for a party who is adverse to an appellant. See slide 133.
- Before the Board, an examiner is not an Appellee.
- Before the Federal Circuit, the Office is the Appellee when an Applicant-Appellant appeals an adverse Board decision.

Authoring Judge

- Opinions for the court are either (i) authored by a judge or (ii) issued per curiam
- Authoring judge is listed on face of opinion, but he/she is writing for the court
- Mistake to say “Judge Smith’s opinion”

Clearly Erroneous

- For **factual** issues – as long as the findings of fact are plausible, they will not be overturned
- Does the reviewing judge have a “definite and firm conviction” that an error has been made?
- Limited deference

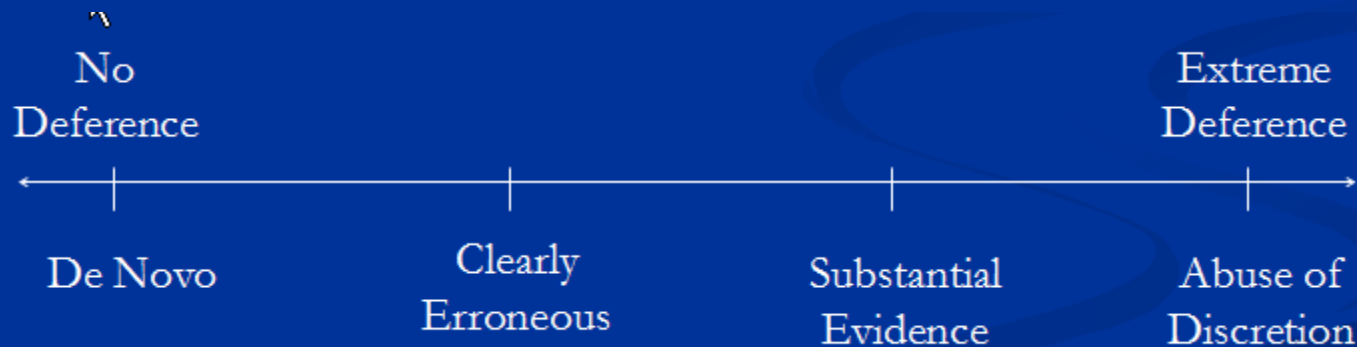


Declaration v. Affidavit

- Declaration is a statement of fact signed by an affiant, but not made under oath.
- Affidavit is a sworn statement of fact signed by an affiant under oath.

De Novo

- Means “anew” or “a second time”
- For questions of law
- No deference to lower court



En Banc

- Means “in full court”
- Means that all judges of the court sit together to hear a case
- Supreme Court always sits en banc
- Federal Circuit sits en banc only rarely for important cases

Per Curiam

- Means “by the Court”
- Court decides to issue the decision in per curiam form when obviously decision was written by one of the judges
- Usually a short opinion; may address controversial subject matter with which no judge wants to particularly associate his/her name as author
 - E.g., Bush v. Gore, 531 U.S. 98 (2000) is most famous per curiam decision of Supreme Court.

Prima Facie

- Means “on its first appearance” or “by first instance”
- The party that has the burden of proof must make a prima facie case essential to its case, e.g., unpatentability of a claimed invention
- If an Examiner fails to present a prima facie case to support a rejection, then the Applicant does not need to rebut.

Redaction

- Obscure or remove text from a document prior to release of the document

Substantial Evidence

- For factual issues
- Requires evidence that a reasonable mind might accept as adequate to support to the finding
- Very deferential

