

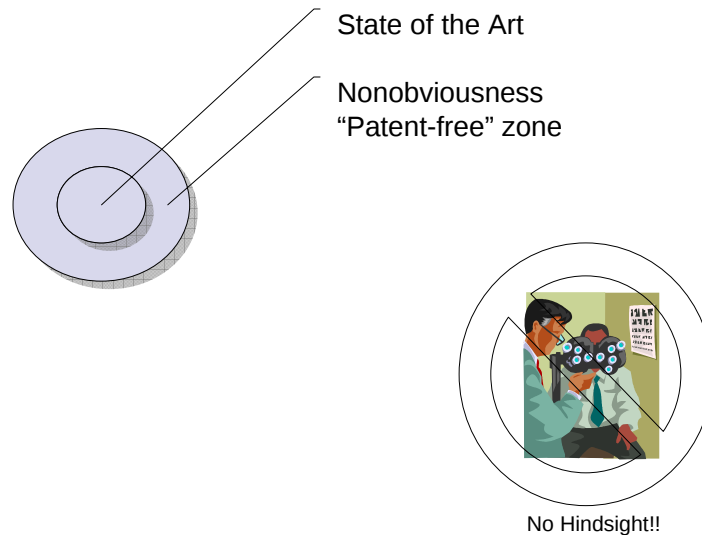
Patent Law

- Slides for Module 5
- Nonobviousness

§103(a) – The obviousness inquiry

- 103(a):
 - A patent may not be obtained
 - though the invention is not identically disclosed or described as set forth in section 102 of this title **[distinguishes from novelty]**,
 - if the differences between **[{2} ascertain differences]**
 - the subject matter sought to be patented
 - and
 - the prior art are such that **[{1} scope & content]**
 - the subject matter **[A] as a whole [B]** would have been obvious [C] at the time the invention was made [D] to a person having ordinary skill in the art to which said subject matter pertains. . . .
[{3} assess level of skill]
- Patentability shall not be negated by the manner in which the invention was made

The obviousness inquiry



§103(a) – The obviousness inquiry

• Fundamental Inquiries

- **{1} scope & content of the prior art**
- **{2} ascertain differences between**
 - the subject matter sought to be patented & the prior art
 - for the claims at issue on a claim by claim basis
- **{3} assess level of skill of a POSITA**
- **{4} "secondary" or objective indicia**
 - One formulation of the list of these indicia
 - Commercial success
 - Long-felt but unsolved need
 - Failure of others
 - Prompt copying, licensing
 - Unexpected results
 - Recognizing the problem
 - Teaching "away"
 - Results unexpected
 - Disbelief / incredulity

The now defunct “invention” standard

- Judge Hand:

- the invention standard was “as fugitive, impalpable, wayward and vague a phantom as exists in the whole paraphernalia of legal concepts”



- Justice Jackson:

- “the only patent that is valid is one which this Court has not been able to get its hands on.”

- Formulations:

- “inventive effort,” “a substantial invention or discovery,” “that impalpable something,” “the inventive skill,” “something new unexpected and exciting”
- “the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling”
- Negative rules – see footnote 12, pg. 322
 - mere change in material or form,

Great A & P Tea (US 1950) – the invention standard



- It is agreed that the key to patentability of a mechanical device that brings old factors into cooperation is presence or lack of invention. In course of time the profession came to employ the term 'combination' to imply its presence and the term 'aggregation' to signify its absence, thus making antonyms in legal art of words which in ordinary speech are more nearly synonyms.
- The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics. This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned, and there is nothing to indicate that the lower courts scrutinized the claims in the light of this rather severe test.
- Two and two have been added together, and still they make only four.
- [SYNERGISM standard – but every invention can be seen as “simply the combination of old elements”]

Great A & P Tea (US 1950) – the invention standard



- From the concurrence, emphasizing the Constitutional limitations
 - The Constitution never sanctioned the patenting of gadgets. Patents serve a higher end--the advancement of science. An invention need not be as startling as an atomic bomb to be patentable. But it has to be of such quality and distinction that masters of the scientific field in which it falls will recognize it as an advance. Mr. Justice Bradley stated in Atlantic Works v. Brady, 107 U.S. 192, 200, the consequences of a looser standard: 'It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.'

Graham v. John Deere Co. (US 1966)

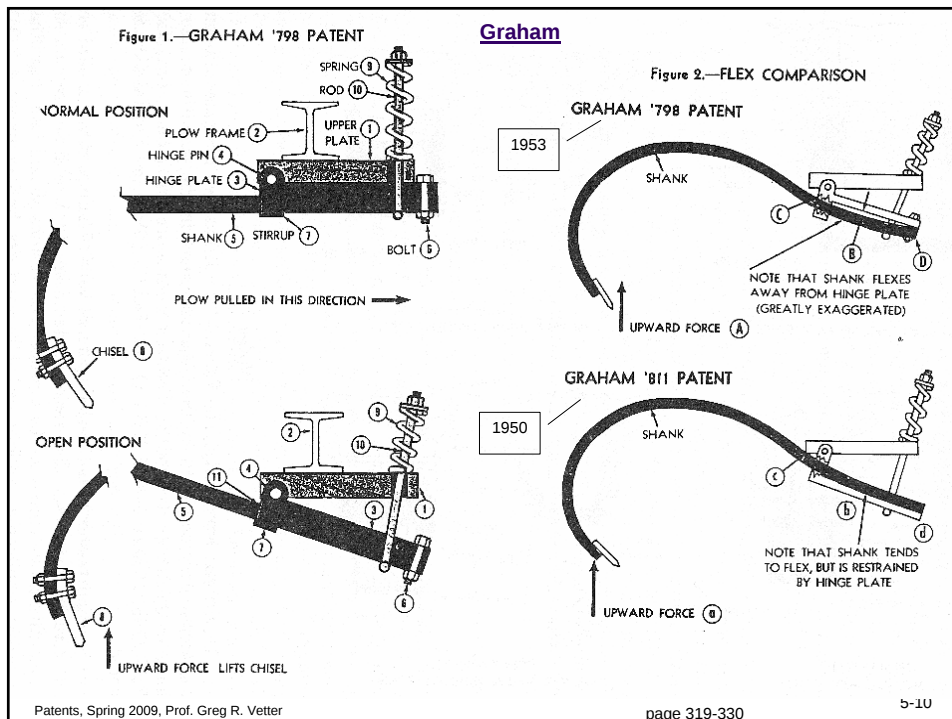
- Split among the circuits on Graham's '798 plow shank patent
 - The 8th circuit says that the patent is invalid
 - ultimately affirmed by the Supreme Court
 - 8th applied the traditional standard of "invention"
 - The 5th circuit said that the patent was valid
 - It produced an old result in a cheaper and otherwise more advantageous way
- Cook's bottle cap patent was sustained in two actions by the 8th circuit
 - ultimately reversed by the Supreme Court

Graham – how to deal w/ the statutory change

- How to draw the line
 - “between the things which are worth the public embarrassment of an exclusive patent and those which are not”
 - Jefferson only wrote the utility and novelty requirements into the original patent act
- Hotchkiss (US 1851)
 - (U)nless more ingenuity and skill . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilful mechanic, not that of the inventor
 - 103 codifies this “additional” requirement of patentability
- Recharacterize “invention” test as a “label”
- Clear emphasis on new word – nonobviousness
 - Difference between the subject matter sought to be patented and the prior art
- New statutory language not intended to change the general level of “patentable invention”
 - as evidenced by the legislative history’s apparent references to Hotchkiss

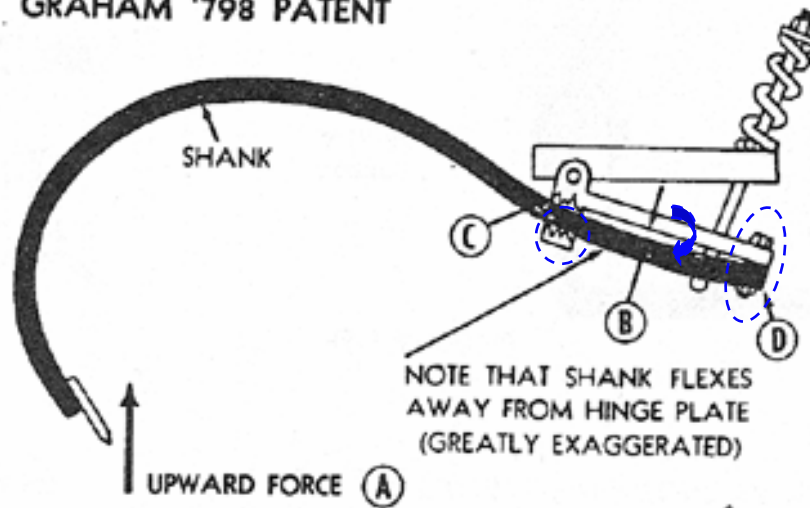


“first administrator of our patent system”



Graham

GRAHAM '798 PATENT



- Two items are different in the '798 patent compared to the '811 patent
 - Stirrup and bolted connection
 - Position of the shank, moved from above the hinge plate to below it

Graham

- **{1} scope & content of the prior art**
 - Graham '811
 - Glencoe device
 - Shank is above hinge plate, like the '811 patent, but it provides a stirrup about which the hinging action occurs.
 - Is it "analogous" art
 - A topic for the next class's reading
- **{2} ascertain differences between**
 - the subject matter sought to be patented & the prior art
 - Graham '811
 - Does not have the stirrup & bolt
 - The shank is above the hinge plate
 - Glencoe
 - The shank is also above the hinge plate
 - Has the stirrup
 - for the claims at issue on a claim by claim basis

Graham

- {3} **assess level of skill of a POSITA**
 - The court notes that Graham's expert stated that "flexing" in the '798 patent was not a significant feature
 - Without documenting much of its basis for saying so, the court determines that this change in the cooperation among the elements would have been obvious
 - In large part based on the belief that a POSITA would have instantly seen what to do
 - What is the "flexing" argument? Why is it rejected by the court?
- {4} **"secondary" or objective indicia**
 - The court does not do much with its quote:
 - Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.
 - However, this quote becomes the basis for significant development of this fourth fundamental inquiry by the Federal Circuit

Claims - Anticipation

When a claim "reads-on" a Prior Art reference, that reference anticipates the claim.

Put another way, whenever a Prior Art reference contains (explicitly or implicitly via the inherency doctrine) or all of the elements/limitations expressed by the claim, that Prior Art reference anticipates the claim

Anticipating Reference (assume its prior)??	
A drawing disclosing a stool with: A (a perfectly square seat) B (four legs) C (legs connected to the seat with steel nails)	A seating apparatus, comprising : 1. A (a horizontal base; and) B (three legs each having one end connected to the bottom of said horizontal base); and C (said connection between said legs and bottom of said horizontal base being a slim metal piece partially traversing some of said leg and said base, wherein the metal of said slim metal piece is brass, steel, iron, or tin)
A plant stand with: A (an oval base) B (two legs and a "wall") C (legs connected to the base with glue) D (a "back" like a chair)	Same as above

Claims - Obviousness

Unlike anticipation, to allege that a patent is “obvious” does not require that all the elements/limitations be in a single anticipating reference. Typically, the elements/limitations are spread over multiple references (but can be in one). The legal argument is that a POSITA would have found it obvious to combine the elements/limitations from multiple references.

A more fine-grained distinction between claim language that describes structure versus claim language that describes how structure connects, interacts, or cooperates is necessary for the obviousness inquiry

and/or

Teachings

Is the invention obvious in light of the patent in view of the stool sold in the US?

A patent disclosing a stool with:

- A (seat)
- B (three legs)
- C (legs connected to the base with glue)

A stool sold in the US with:

- A (seat)
- X (two “walls” on either side)
- Y (walls connected to the seat with metal screws)

A seating apparatus, comprising:

1. A (a horizontal base; and)

B (three legs each having one end connected to the bottom of said horizontal base) and

C (said connection between said legs and bottom of said horizontal base being a slim metal piece partially traversing some of said leg and said base, **wherein the metal of said slim metal piece is brass, steel, iron, or tin**)

Cook Chemical

- Cook was the assignee of Scoggin’s “push down” bottle cap patent – for use in a “shipper-sprayer”
 - The “shipper-sprayer” solved several problems
 - No loss of externally connected spray apparatus
 - Overcap sealing mechanism prevented leaks
- The patent was sustained in two actions by the 8th circuit
 - ultimately reversed by the Supreme Court
- Calmar manufactured the allegedly infringing spray bottle (SS-40), and Colgate-Palmolive purchased the bottles from Calmar and used them to distribute its products
- Cook had originally asked Calmar to develop a shipper-sprayer, but Calmar attempts were not entirely successful

Cook Chemical

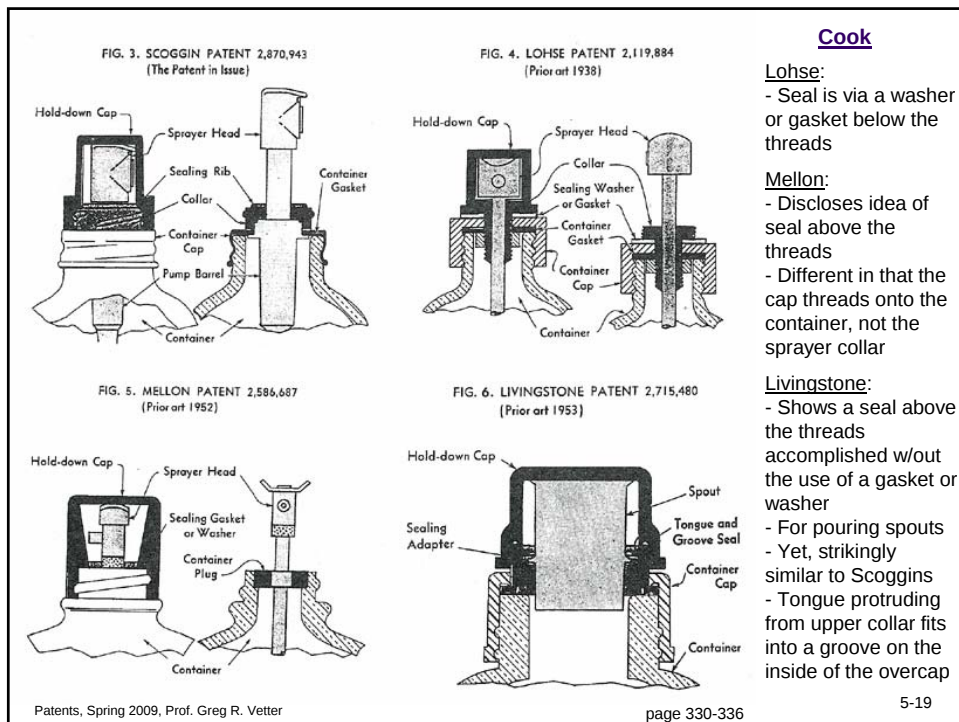
1. In a closure assembly for an open-top container having a perforated cap over said open top thereof mounting a spray unit including a barrel provided with a tubular extension passing coaxially upwardly through the perforation in said cap, a plunger reciprocably carried by the barrel and normally extending therebeyond and a spray head on the upper end of the plunger above said extension, the combination with said spray unit of an annular retainer telescoped over and secured to the extension above said cap and provided with external, circumferentially disposed screw threads and an annular, continuous segment at the upper part of the retainer above said screw threads, and a cup-shaped hold-down member housing the head and holding the plunger depressed at substantially the innermost path of travel thereof within the barrel, said member being provided with internal screw threads complementally engaging said screw threads on the retainer and having an internal, circumferentially extending, continuous shoulder disposed to engage said segment around the entire periphery thereof and thereby present a liquid-tight seal located between the spray head and said threads on the retainer and said member respectively, said shoulder being spaced from the lower annular peripheral edge of the member a distance at least slightly less than the

distance from that portion of said segment normally engaged by said shoulder, to the proximal upper surface of the cap whereby said lower edge of the member is maintained out of contacting relationship with the cap when the member is on the retainer in a position with said shoulder in tight sealing engagement with the segment.

- Claim 1 of Scoggin's patent

Cook Chemical

- **{1} scope & content of the prior art**
 - Lohse & Mellon were before the PTO
 - Livingston was cited by Calmar in the litigation
 - Court felt that the Livingston "tongue and groove" approach was more efficient than Scoggin's lip because the tongue and groove was an inherently more stable structure
 - Both Cook and Calmar have incorporated the Livingstone tongue and groove structure into their shipper sprayers
- **{2} ascertain differences between**
 - the subject matter sought to be patented & the prior art
 - for the claims at issue on a claim by claim basis
 - Claim construction is mentioned by the court
 - (i) interpretive sources; (ii) interpretive canons; (iii) interpretive procedures
 - Which canons does the court mention?
 - Impact on the "scope of the claims" the court allowed Scoggins?
 - During prosecution
 - rib seal
 - overcap not contacting the container cap
 - Implications of interview with examiner?
 - SEE NEXT OVERHEAD



Cook

Lohse:

- Seal is via a washer or gasket below the threads

Mellon:

- Discloses idea of seal above the threads
- Different in that the cap threads onto the container, not the sprayer collar

Livingstone:

- Shows a seal above the threads accomplished w/out the use of a gasket or washer
- For pouring spouts
- Yet, strikingly similar to Scoggins
- Tongue protruding from upper collar fits into a groove on the inside of the overcap

Cook Chemical

- **{3} assess level of skill of a POSITA**
 - Is the Supreme Court acting as the POSITA?
- **{4} “secondary” or objective indicia**
 - **Discussed by lower courts**
 - [The district court] decision seems to be bottomed on the finding that the Scoggin sprayer solved the long-standing problem that had confronted the industry. The Court of Appeals also found validity in the 'novel 'marriage' of the sprayer with the insecticide container' which took years in discovery and in 'the immediate commercial success' which it enjoyed. While finding that the individual elements of the invention were 'not novel per se' the court found 'nothing in the prior art suggesting Scoggin's unique combination of these old features . . . as would solve the . . . problems which for years beset the insecticide industry.' It concluded that 'the . . . (device) meets the exacting standard required for a combination of old elements to rise to the level of patentable invention by fulfilling the long-felt need with an economical, efficient, utilitarian apparatus which achieved novel results and immediate commercial success.

Cook Chemical

- {4} “secondary” or objective indicia
 - Supreme Court
 - Cook Chemical insists, however, that the development of a workable shipper-sprayer eluded Calmar, who had **long and unsuccessfully sought to solve the problem**. And, further, that the **long-felt need** in the industry for a device such as Scoggin's together with its **wide commercial success** supports its patentability. These legal inferences or subtests do focus attention on economic and motivational rather than technical issues and are, therefore, **more susceptible of judicial treatment** than are the highly technical facts often present in patent litigation. . . . Such inquiries may lend a helping hand to the judiciary which, as Mr. Justice Frankfurter observed, is most ill-fitted to discharge the technological duties cast upon it by patent legislation. . . . They may also serve to **'guard against slipping into use of hindsight'** . . . and to resist the temptation to read into the prior art the teachings of the invention in issue.
 - However, these factors do not, in the circumstances of this case, tip the scales of patentability. The Scoggin invention, as limited by the Patent Office and accepted by Scoggin, rests upon exceedingly small and quite non-technical mechanical differences in a device which was old in the art

Obviousness – other considerations

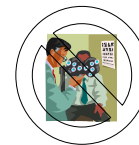
- Determining the level of ordinary skill in the art
 - (1) the educational level of the inventor;
 - (2) type of problems encountered in the art;
 - (3) prior art solutions to those problems;
 - (4) rapidity with which innovations are made;
 - (5) sophistication of the technology; and
 - (6) educational level of active workers in the field.
 - Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case

Obviousness – other considerations

- Courts should not hold patents “valid”
 - Why?
- Rise and fall of “synergism” after Graham
 - “resulting in an effect greater than the sum of the several effects taken separately” Sakraida (US 1976)
 - Repudiation by Federal Circuit – its not in the statute
 - Policy problems with “synergism”
- Patentability shall not be negated by the manner in which the invention was made
 - To eliminate any “flash of genius” requirement
 - Accidental or lucky inventors are on equal footing with methodological researchers

Obviousness – other considerations

- Teaching, suggestion or motivation to combine – BATTLE HINDSIGHT!
 - Suggestion or motivation, before the invention itself, to make the combination – to modify a reference or combine the reference teachings
 - Requirements to make a “prima facie” case of obviousness:
 - teaching, suggestion or motivation must be found in
 - The nature of the problem
 - Teachings of the references, or
 - Ordinary knowledge of a POSITA
 - A POSITA will know that certain references are of special importance to a field
 - As a “higher” level of “ordinary” skill is found for POSITAs in a field, more “knowledge as teachings” may be charged to the POSITA, but only so long as there is a specific explanation of the understanding or principle within the knowledge of the POSITA that would motivate one w/ no knowledge of the invention to make the combination



Obviousness – other considerations

- Requirements to make a “prima facie” case of obviousness:
 - reasonable expectation of success, but absolute predictability not required;
 - prior art references must teach or suggest (different from having or clearly disclosing) all the claim elements/limitations, and must be “analogous art”
 - the factual predicates of the prima facie case are in the first three fundamental inquiries (see page 364, Hybritech case)
 - scope & content of PA, differences compared to the subject matter, level of POSITA skill
 - The “suggestion to combine” requirement can be thought of as a procedural mechanism to implement the first three fundamental inquiries
 - Once a prima facie case is made, the applicant/patentee may try to rebut the facts underlying the prima facie case, or assert objective indicia, or both.

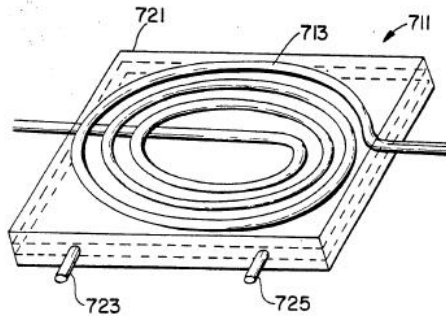


Obviousness – other considerations

- Suggestion to combine – contra-indicative of a prima facie case
 - Can be combined
 - POSTIA is capable of combining
 - Proposed modification/combination destroys the intended function of the prior art reference(s)
 - The Proposed modification/combination changes the principle of operation of the prior art
 - The suggestion or motivation in fact teaches away
 - The applicant discovered the problem
- The motivation/suggestion can be for a different purpose or problem or reason
 - It can be “implicit” as the teaching would be viewed by a POSITA

Princeton Biochemicals v. Beckman Coulter

- Patent for a capillary electrophoresis device used to separate proteins from other matter
- The Federal Circuit affirmed the district court's grant of JMOL that the claim at issue was obvious, contrary to the jury verdict in Princeton's favor
- The prior art references disclosed all the claim elements
- The evidence was clear that the motivation to combine was
 - within the knowledge of a person of ordinary skill in the art
 - as well as suggested by the nature of the problem



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KSR Intl. v. Teleflex

- What does the future hold for the "suggestion test"?

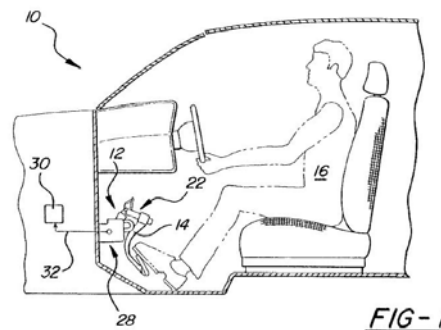
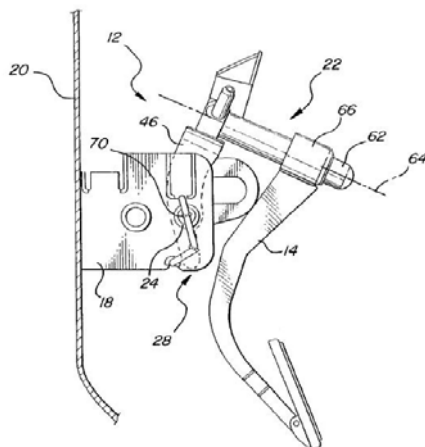


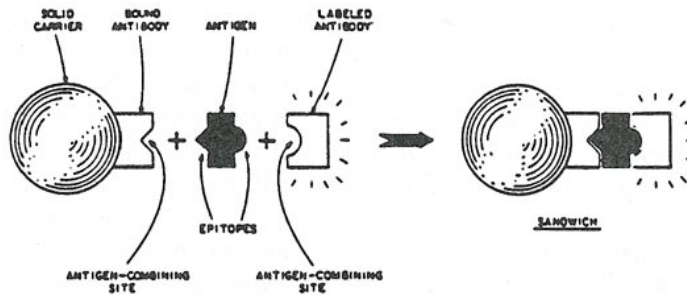
FIG-1

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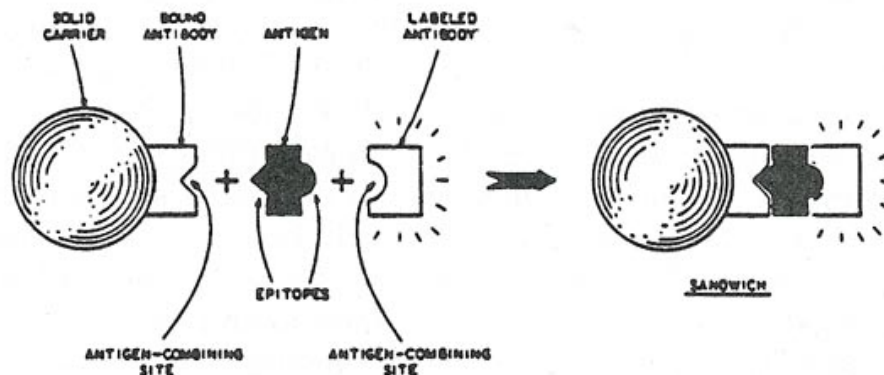
Hybritech v. Monoclonal Antibodies, Inc. (Fed. Cir. 1986) (Rich, J.)

- Not just a peanut butter and jelly sandwich . . .
 - New technology allows production of monoclonal antibodies which bind with only one site (epitope) on an antigen with a certain strength of degree of "affinity"
 - Antigens are substances that when introduced into the body stimulate the production of an antibody
 - Antigens include toxins, bacteria, foreign blood cells, and the cells of transplanted organs
- Immunoassays, the subject of the 4,376,110 patent, assigned to Hybritech, are diagnostic methods for determining the presence/amount **of antigen in body fluids** by employing the ability of an antibody to bind to an antigen



Hybritech

- 19. In an immunometric assay to determine the presence or concentration of an antigenic substance in a sample of a fluid comprising forming a ternary complex of a first labeled antibody, said antigenic substance, and a second antibody said second antibody being bound to a solid carrier insoluble in said fluid wherein the presence of the antigenic substance in the samples is determined by measuring either the amount of labeled antibody bound to the solid carrier or the amount of unreacted labeled antibody, **the improvement comprising** employing monoclonal antibodies having an affinity for the antigenic substance of at least about 10.sup.8 liters/mole for each of said labeled antibody and said antibody bound to a solid carrier.
- This is the form for a "Jepson" type claim.



Hybritech

- District court
 - District court held in favor of Monoclonal, that all 29 claims are invalid as anticipated under § 102(g), obvious under § 103, and invalid under §112
 - Held that the monoclonal assays were obvious
 - Some references showed similar assays using polyclonal antibodies
 - And, there was a similar sandwich structures to map epitopes on antigens.
 - For obviousness determination, the district court said that
 - polyclonal sandwich assays make monoclonal sandwich assays obvious, and
 - seminal article by Kohler and Milstein would lead everyone to make widespread use of monoclonals in assays
 - After Kohler & Milstein's work, 8 references "predicted" the advantages of monoclonal antibodies
 - As to Hybritech's offered secondary considerations
 - no casual relationship proven, no nexus
 - success was from business expertise & acumen

Hybritech

- **{1} scope & content of the prior art & {2} ascertain differences**
 - Kohler and Milstein
 - creation of antibodies in vitro; creation of monoclonals using Hybridomas
 - BUT - do not suggest using monoclonal antibodies in a sandwich assay
 - Cuello article
 - discloses specificity benefits of using monoclonal antibodies in conventional radio-immunoassay techniques
 - BUT - while using monoclonals, uses only one, no ternary complex
 - Several patents – BUT – only speak to polyclonals
 - Jeong (use of polyclonals in sandwich assays)
 - Piasio (polyclonals in reverse sandwich)
 - Schurr (polyclonals in forward sandwich)
 - Eight other articles relied on by district court
 - later of 4 of the 8 articles are not 102(a)/103 nor 102(b)/103 PA – well after date of conception and before filing date
 - earlier 4 of the 8 articles, none disclose sandwich assays
 - At most, these are **invitations to try** monoclonal antibodies in immunoassays – but say nothing about accomplishing that end

Hybritech

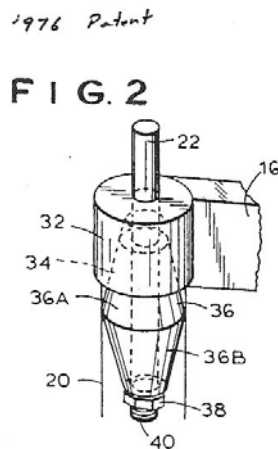
- {3} **assess level of skill of a POSITA**
 - FN3. – “Although the district court failed expressly to find the level of ordinary skill in the art at the time the invention was made, it did make reference to ‘[p]eople working in immunology aware of the Kohler and Milstein discovery’ which we deem an accurate finding for the purposes of that portion of the *Graham* factual inquiries.”
- {4} **“secondary” or objective indicia**
 - “Objective evidence such as commercial success, failure of others, long-felt need, and unexpected results must be considered *before* a conclusion on obviousness is reached and is not merely “icing on the cake,” as the district court stated at trial”
 - Commercial Success
 - Quick run-up in sales, 25% market share, marketing expenses within industry range
 - Not due to mere availability of monoclonals
 - Unexpected Advantages
 - Three experts recited various types of unexpectedly better test performance

Hybritech

- Three Alternative HYPOs - Imagine that Cuello reference (discloses specificity benefits of using monoclonal antibodies in conventional radio-immunoassay techniques) also says:
 - “It would also work really well if one used another monoclonal with the technique described here **or with other known assay techniques** to link two monoclonal antibodies in some structure with an antigen for detection purposes.”
 - “It **might** work to use another monoclonal with the technique described here to link two monoclonal antibodies in some structure with an antigen for detection purposes.”
 - “Someone could make a lot of money by implementing conventional sandwich immunoassays using the recently available monoclonal antibodies and ‘tuning’ the affinity to better specificity.”

- Secondary considerations – selected excerpts from the case notes (not all the factors are listed here)
 - “these legal inferences or subtests do focus attention on economic and motivational rather than technical issues, and thus more susceptible of judicial treatment”
 - Critiquing commercial success as a secondary consideration
 - Equates to a suggestion that borderline cases be decided in favor of patentees – because only commercially valuable patents are litigated??
 - Count the sales of alleged infringers?
 - Prior failures
 - Have been called “virtually irrefutable” evidence of nonobviousness
 - What if the failure was by a law professor experimenting to develop a new cancer drug?
 - Unexpected results
 - Suffers from hindsight problems
- Ranking the secondary considerations:
 - Skepticism; long-felt need; prior failures of POSITAs; results unexpected; licenses taken; copying; commercial success

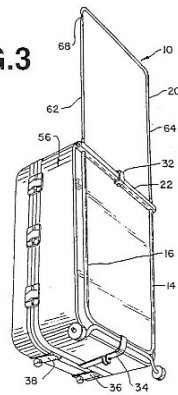
- Patented article has
 - (1) a rectangular frame with two horizontal and two vertical members;
 - (2) wheels on the lower horizontal members;
 - (3) a pull-up handle connected to the rectangular frame; and
 - (4) a wedging member, preferably frustoconical in shape, frictionally received in a bore which keeps the pull-up handle in a fully extended position.



Obviousness Exercise

- Fundamental Inquiries
 - {1} scope & content of the prior art
 - {2} ascertain differences between
 - the subject matter sought to be patented & the prior art
 - for the claims at issue on a claim by claim basis
 - {3} assess level of skill of a POSITA
 - {4} "secondary" or objective indicia

FIG.3



Schrecongost 5,024,455

Patents, Spring 2009, Prof. Greg R. Vetter

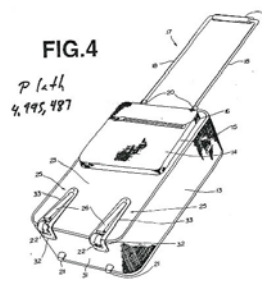
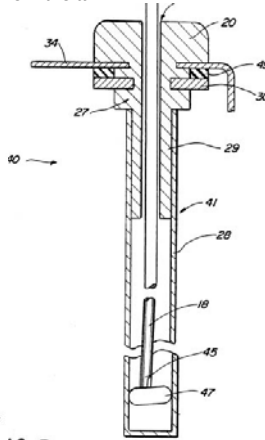


FIG.4
Plath 4,195,487

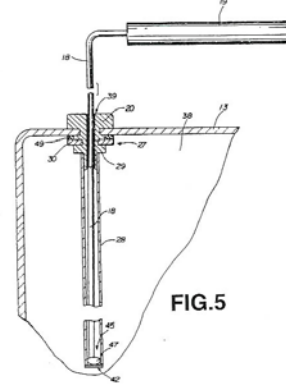


FIG.5

page 406-410

Obviousness Exercise

103(a) Issues

- Is it appropriate to combine the three references?
- Does the difference between the claimed wedging member and the locking mechanism disclosed in the Plath patent indicate that the claimed invention would have been obvious?
- Does the additional difference between the placement of the wheels on the frame itself, as opposed to a separate axle which is in turn attached to the frame in the Schrecongost and Kazmark patents, indicate that the claimed invention would have been obvious?

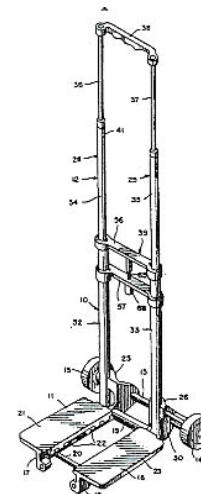


FIG.6

Kazmark 3,998,476

Patents, Spring 2009, Prof. Greg R. Vetter

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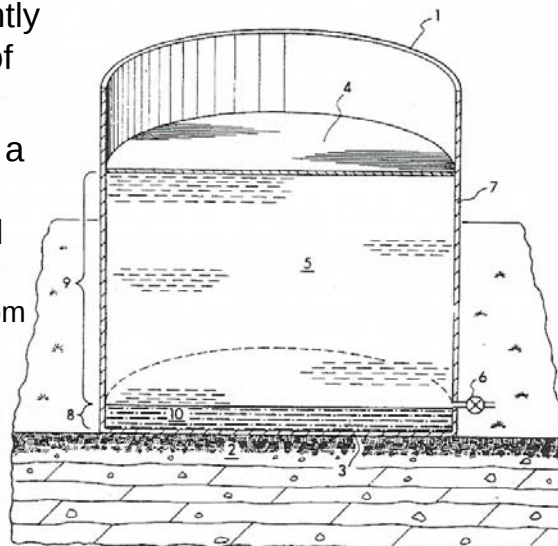
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Obviousness Exercise

Patent to attack	Sch.	Plath	Kaz.
1. A suitcase comprising:			
a luggage member,	X	X	
a support structure attached to the luggage member,	X	X?	
the support structure comprising			
a first horizontal member having two wheels thereon to facilitate towing on the ground,	X?	?	X?
a second horizontal member,	X	X	X
two tubular members coupling the first and second horizontal members, thereby forming a rectangular frame,	X	?	X
a shaft in extensible slidable engagement in each of said tubular members,	X	X	X
the shafts being connected by a first handle,	X	X	X
the shafts being extensible between a collapsed position in the tubular members and a fully extended position to enable towing of the luggage member on the wheels,	X	X	X
at least one of the shafts including a wedging member slidable within the respective tubular member		?	
which is received frictionally in a first bore provided at an end of the respective tubular member adjacent the second horizontal member to maintain the shafts in the fully extended position.		?	
Patents, Spring 2009, Prof. Greg R. Vetter page 406-410 5-39			

Analogous Art – In re Clay (Fed. Cir. 1992)

- Touchstone: sufficiently germane to the field of the claimed invention
- Clay's invention is for a process to store gasoline underground
 - gel at bottom allows complete extraction from the tank
 - PTO held invention obvious in light of two references



Analogous Art – In re Clay (Fed. Cir. 1992)

- References
 - Hetherington
 - Discloses bladders/bags for removing “deadspace” at the bottom of the tank
 - Sydansk
 - Injection of gel into underground, natural geologic formations to channel the flow of hydrocarbons in the optimal direction
- What is analogous art?
 - From the same field of endeavor, regardless of the problem addressed
 - If not, reasonably pertinent to the particular problem?
 - Would the reference logically have commanded itself to the inventor’s attention?
- Is Sydansk in the same field of endeavor?
 - Not because both relate to the petroleum industry
 - Various differences between the two processes (Sydansk and the claimed invention)
 - Sydansk – extraction of crude petroleum
 - Clay – storage of refined liquid hydrocarbons

Analogous Art – In re Clay (Fed. Cir. 1992)

	Problem or Purpose	
	Filling dead spaces to recover oil	Extracting oil from man-made tanks
Is Sydansk analogous art?	Yes	No

- How to resolve the problem that the test for analogous art is highly dependent on the definition of the “problem” or the “purpose”
- The scope of the “problem” or “purpose” should be correlated to (but not necessarily coterminous with) the scope of the claim(s)
- Should there be deference to the U.S. PTO’s classification scheme?

Analogous Art – In re Winslow (CCPA 1966)

- Winslow patent application for apparatus for packaging articles w/in flexible plastic bags.

- Board affirmed examiner's rejection in light of Gerbe, Hellman & Rhoades.

- In affirming, Judge Rich offers the “workshop walls” analogy for PA



- Is the analogy inherently hindsight because it posits filtering out all the unwanted references, which obscure, teach away, or increase search costs?
- Later correction
 - don't presume full POSITA knowledge outside the field of the endeavor – only that inventor can select from pertinent references

In re Bigio

