Appealing a Rejection at the Board: Analysis of Recent Board Decisions and Non-Appeal Alternatives

Susan Perng Pan[1]

ABSTRACT

This article discuses the merits of appealing rejections to the Board of Patent Appeals and Interferences in comparison to continued *ex parte* prosecution before the Examiner. The analysis takes into account recent decisions rendered by several patent panels and recent precedent of the Court of Appeals for the Federal Circuit. Recommendations are offered to place claims in better condition for appeal, types of arguments to be made and potential pitfalls to guard against.

1. TIMING FOR APPEAL

The timelines for Appeal and *ex parte* prosecution become intertwined because the U.S. patent statute permits appeal of a rejection in the following circumstances.

> An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.[2]

In implementing the statute, the patent office regulations permit an Applicant to appeal a rejection in an application for original patent either

1 The author is a partner of Sughrue Mion, PLLC, Washington, D.C. Ms. Pan's practice includes litigation and extensive *ex parte* prosecution and appellate practice. The view express herein are solely those of the author.

2 35 U.S.C. § 134(a) (2000).

after receiving a final rejection or after two non-final rejections.[3] It is not necessary that all claims be twice rejected and it is sufficient to confer jurisdiction on the Board if any claim in the application satisfies this requirement. It is also not necessary that the rejection occur during prosecution of a single application, and it is sufficient if one claim is rejected both in a prior application and in a continuing application.[4]

The patent regulations thus permit Applicants the opportunity to obtain a final disposition of the patentability of their patent claims by appealing the Examiner's rejections prior to reaching a "final" impasse with the Examiner. Because Applicant has the choice to continue *ex parte* prosecution or pursue the appeal route, the decision should take account the strength of the claims and arguments in view of the cited art and whether the claims are in their best possible form prior to entering the appeal process.

II. To Amend or to Appeal: The *Festo* Factor

Given the option of 1) appealing a final rejection or a second non-final rejection or 2) pursuing prosecution on the merits by the filing of an Amendment or Response, an Applicant would be well-advised to press matters for patentability of the *originally filed* claims as far as possible before the Examiner. The Supreme Court's 2002 decision in *Festo* emphasizes the importance of appealing a rejection that Applicant views as patently incorrect as opposed to amending the claims in a response to an Office Action. "While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim."[5] When a claim is amended and narrowed whether for purposes of complying with a prior art rejection under 35 U.S.C. § 102 or § 103 or for purposes of clarifying the claim meaning under 35 U.S.C. § 112, the patentee is regarded as "having conceded an inability to claim the broader subject matter or at least as having abandoned the right to

3 37 C.F.R. § 1.191 (2000). The Rule further sets forth that for *ex parte* reexamination filed under Rule §1.510 for a patent that issued from an original application filed on or after November 29, 1999, no appeal may be filed until the claims are finally rejected.

4 Manual of Patent Examining Procedure (hereafter "MPEP") §1205 (2002).

5 Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 122 S. Ct. 1831, 1840; 62 U.S.P.Q.2d (BNA) 1705, 1711 (2002).

appeal a rejection. In either case estoppel may apply."[6] The Supreme Court establishes amendment and appeal as opposite paths to be taken. Abandonment of the right to appeal, i.e. amending the claims, is taken as a strong concession. As a result of *Festo*, Applicants who amend claims without any explanation do so at their peril. "[W]hen a court is unable to determine the purpose underlying a narrowing amendment – and hence a rationale for limiting the estoppel to the surrender of particular equivalents [under the doctrine of equivalents]— the court should presume that the patentee surrendered all subject matter between the broader and narrower language."[7]

The *Festo* decision equates amendment with a surrender of the right to appeal, and that estoppel or surrender of equivalents arises from such amendment. This suggests that if the rejection of a broad independent claim is appealed, rather than amended, then estoppel may not apply or perhaps a less stringent estoppel may apply even if the claim is ultimately deemed unpatentable on appeal, because Applicant has not acquiesced to the Examiner's rejection. In view of the Federal Circuit precedent, during *ex parte* practice, an Applicant who can make a colorable argument of patentability over prior art without amending the claims should proceed to make such arguments. This approach should be taken even though amendatory material would strengthen the arguments. Such an Applicant will not have been deemed to have acquiesced in the rejection and not surrendered a wide swath of equivalents between the original and amended claim. As a safeguard, amendatory material can be placed in a separate dependent claim to test whether the amendatory material would be deemed to describe allowable subject matter.

Aside from the issue of scope of equivalents addressed by the Supreme Court, the Federal Circuit case law on dedication also suggests that narrowing claim amendments are a form of conscious waiver.

> The patentee has control over the drafting of the claims, and if he discloses but omits to claim certain subject matter, he will be held to have waived the right to capture the disclosed matter under the doctrine of equivalents, and to have dedicated it to the public. No such waiver occurs where, as in *GraverTank II*, the

6 122 S. Ct. at 1840; 62 U.S.P.Q. (BNA) at 1712.
7 122 S. Ct. at 1842; 62 U.S.P.Q.2d (BNA) at 1713.

patentee actually claimed the subject matter, even if the particular claims are later held invalid. There is, moreover, in such circumstances far less possibility that the patentee is "gaming" the system, that is, deliberately writing narrow claims with the objective of avoiding a searching PTO examination and recapturing the disclosed subject matter through the doctrine of equivalents.

In view of the negative consequences of failing to argue patentability to the fullest extent and pitfalls of dedication if broad claims are amended to exclude particular embodiments, it behooves an Applicant to strenuously fight any patentability rejections without amendment, if possible.[8]

III. Evaluating Whether to Appeal a Rejection

Over the course of *ex parte* prosecution, the Applicant should continually evaluate the strength of the Examiner's rejection not only on the technical points underlying the rejection, but also the procedure applied in making the rejection and the rationale used to maintain any rejections. This evaluation will provide a better informed decision on whether an Appeal should be pursued.

In the event of a second non-final rejection under 35 U.S.C. § 102 or 103 in view of newly applied art, it is beneficial to respond to the rejection under 37 C.F.R. § 1.111. In view of such a non-finality, the Applicant still has the opportunity to obtain allowance of the claims in a timely manner without incurring the expense and time delays of an appeal. The most recent available figures from the U.S. Patent Office indicate that the Board of Patent Appeals is currently deciding appeals filed up to three years ago.[9] The opportunity to respond again under

8 Johnson & Johnston v. R.E. Service Co., 285 F.3d 1046, 1060; 62 U.S.P.Q. (BNA) 1225, 1235 (Fed. Cir. 2002) (concurring opinion reconciling applicability of equivalents in *Graver Tank* and inapplicability of equivalents in the subject case).

9 With the exception of a limited number of appeals involving special circumstances, the Board of Patent Appeals and Interferences is currently deciding appeals received at the Board as follows:

BIOTECH	Fiscal Year 2000
CHEMICAL	Fiscal Year 1999
ELECTRICAL	Fiscal Year 2000
MECHANICAL	Fiscal Year 2002
DESIGN	Fiscal Year 2002

These statistics were obtained from the U.S.P.T.O. website at www.uspto.gov/web/offices/dcom/bpai/baiproduction.xls.

Section 1.111 also affords the opportunity to develop the record further, which leads to either of two possible benefits.

As a first possibility, the Examiner will accept the arguments in the response as being sufficiently persuasive to place at least some of the claims in condition for allowance. At that juncture, the Applicant has the additional option of amending the claims to obtain allowance of some claims and filing a separate continuation application for any claims that remain rejected. As a second possibility, the Examiner will reject the arguments in the response as not being persuasive, but expand upon the rationale as to the lack of persuasiveness in a subsequent non-final or final rejection. The value of the second possibility necessarily relies on the nature of the response filed by the Applicant. This makes it very important to exercise precision in formulating the response rather than stating generalities. General denials submitted by the Applicant merely beget general denials from the Examiner, which is not helpful towards advancing a dialog with the Examiner, obtaining the patent or developing the record for appeal. For these same reasons, an Applicant should respond to a final rejection under 37 C.F.R. § 1.116 using the same strategy. In particular, for any Response to Arguments made by the Examiner, the Applicant should assess the underlying rationale and explain any weaknesses or inconsistencies in the Examiner's position.

Arguments directed towards patentability over prior art fall generally into two broad categories, technical arguments and legal arguments. Both types of arguments should be developed in responses filed under 37 C.F.R. § 1.111 and 1.116 prior to entering the appeal stage.

A. Analysis of Recent Decisions

The decisions of the Board of Patent Appeals and Interferences dating from appeals filed during Fiscal Year 1993 are available through the U.S.P.T.O. website at www.uspto.gov/web/offices/com/sol/foia/index.html. The database is searchable, through somewhat limited search constraints, at www.uspto.gov/web/menu/search/html. A random sample of the decisions indicates that legal and technical arguments are equally effective in reversing Examiner rejections.[10]

A review of a number of recent Board Decisions reveals several analyses that are noteworthy. These particular decisions offer some

10 The database of opinions runs several thousands in number. Approximately 200 decisions were reviewed in this assessment.

insight on "claim construction" approaches that have been taken by various panels, compares and contrasts effective arguments based on technical distinctions and legal arguments. It is noted that most, if not all, of the decisions posted to the website and all those discussed below are identified as "non-precedential" decisions that are not binding on the Board. If any weight is given to such decisions, the weight is severely limited.[11] However, in certain circumstances, the Federal Circuit which reviews appeal decisions of the Board, will give some weight to decisions designated as non-precedential.[12] For purposes of fashioning or evaluating arguments for purposes of appeal, a brief discussion of selected decisions follow.

1. Claim Interpretation Of Rejected Claims

In analyzing prior art rejections, Board decisions that address claim interpretation rely upon two seemingly opposite lines of legal precedent. Recent panels, following the mandate of the Supreme Court in *Markman v. Westview Instruments, Inc.*,[13] resort to Applicant's disclosure for purposes of interpreting the claims.[14] This appears to be contrary to the concept that during prosecution, the claims are to be given their broadest reasonable meaning and the scope of the claim cannot be narrowed by reading disclosed limitations in to the claim.[15] Several decisions of the Board do in fact resort to the specification and drawings for purposes of understanding the scope of a rejected claim.

Even though the panels have turned to the specification to interpret claims on appeal, any Applicant deciding whether to pursue an appeal

11 See *Ex parte Theurer*, Appeal 96-2142 stating:

Unpublished (or non-precedential) opinions of the Federal Circuit are not precedent in the Federal Circuit and will not be cited, considered or regarded as precedent by the EIC, the Board or any other tribunal within the Patent and Trademark Office.

12 An opinion or order which is designated as not to be cited as precedent is one unanimously determined by the panel issuing it as not significantly adding to the body of law. Any opinion or order so designated must not be employed or cited as precedent. This rule does not preclude assertion of claim preclusion, issue preclusion, judicial estoppel, law of the case or the like based on a decision of the court designated as non-precedential. Rules of the Court of Appeals for the Federal Circuit, Rule 47.6(b).

Federal Circuit Rule 47.6(b) does not unconditionally prohibit citation of non-precedential opinions but instead permits citation of opinions for limited purposes. Burke, Inc. v. Bruno Indep. Living Aids, Inc., 183 F.3d 1334, 1337; 51 U.S.P.Q.2d (BNA) 1295, 1297 (Fed. Cir. 1999). See also Anastaff v. United States, 223 F.3d 899-905 (8th Cir.) (holding that unpublished decision have precedential effect) *vacated* 99-3917, 2000 WL 1863092 (8th Cir. 2000).

13 116 S.Ct. 1384; 38 U.S.P.Q.2d (BNA) 1461 (1996).

14 *Ex parte Horstmann*, 1997-3241.

15 In re Morris, 127 F.3d 1048, 1054; 44 U.S.P.Q.2d (BNA) 1023, 1027 (Fed. Cir. 1997).

based on existing claim language or whether to continue prosecution by one of several non-appeal alternatives discussed below, should consider whether their particular arguments can be supported by the *context* and broad *concepts* of the pending claim recitations. In such a case, it is possible that the broad concepts of the claim can be argued on appeal without modifying the claim language to specifically include the limitations in the specification. However, if the arguments must rely on actual limitations discussed in the specification but are unclaimed, then the Applicant would be better advised to amend the claim to describe the invention more specifically.

A. Conceptual Distinctions Based On Context

In *Ex parte Schmidt*, 94-4239, the claim in question recited:

1. An extended field-of-view mirror, the mirror comprising:
(a) a convex reflective surface having a viewing area and a continuous perimetral edge surrounding the viewing area;
(b) an *opaque band integrally formed* with the reflective surface and depending therefrom, the opaque band substantially surrounding the entire reflective surface; and
(c) a mounting flange *integrally formed with* the opaque band and extending outwardly therefrom. (Emphasis added)

A central issue in the appeal was how to define the broad recitation "integrally formed with." The Board recognized that the specification provided no definition of the term, but turned to Fig. 4 of the application to determine that in the context of claim 1, "integrally formed with" meant that the mirror parts were joined together prior to any use of the mirror. In essence, the mirror included each of the cited components prior to its being secured to a mounting frame. In reversing the rejection, the Board noted that the cited art did not include the claim elements "integrally formed with" since a separate elastic ring was only part of the disclosed structure after being put into an interlocking relationship with a frame. The cited ring was thus "separate" and not integrally formed with the mirror prior to any use. The decision and definition of the phrase "integrally formed with" appears to have put significant weight on the context established by the claim preamble. In particular, it was "a mirror" that included several elements "integrally formed with" other elements. It is conceivable that a different outcome

would have resulted on appeal if the claim recited a "mirror assembly" rather than just a "mirror."[16]

The Board also resorted to Applicant's specification for claim construction purposes in *Ex parte Rahman*, 2001-1480. While acknowledging that claims should be given their broadest reasonable interpretation during prosecution, the Board further indicated that the terms in the claim should be construed as those skilled in the art would construe the claim.[17]

In *Rahman*, the claim in question recited:
A method for controlling traffic comprising:
developing global positioning system information about a plurality of vehicles;
analyzing traffic patterns based on said information;
developing traffic control signals based on said traffic patterns; and
transmitting said traffic control signals to *traffic control devices*. (Emphasis added).

Based on descriptions in the specification, the Board construed "traffic control devices" to comprise devices such as speed limit signs, traffic metering lights, traffic signs and traffic signals. The cited art disclosed transmission of route information to a microcontroller located on a vehicle. The Board considered that the transmission of traffic information to a vehicle was not a transmission of traffic control signals to "a traffic control device."

Under its broadest construction, the term "traffic control device" may comprise any device that would have an impact on traffic. It is not inconceivable that a controller in a vehicle would have some impact on traffic flows. Yet, in reversing the rejection, the Board's analysis appears to import definitional aspects of the term "a traffic control device" into the claims to limit the phrase to those listed in the specification. Obviously, given the Federal Circuits' directive in *In re Morris* and *In re Hiniker Co.*,[18] that emphasizes the importance of claim language rather than resort to the specification, an Applicant cannot be assured that the Board will use the specification so liberally in the appeal of any given

16 The claim was rejected by the Board under 37 C.F.R. § 1.196(b), and that the subject claim was issued in U.S.P. 6293,679 with substantive changes to the claim recitations.

17 Citing Specialty Composites v. Cabot Corp., 845 F.2d 981, 986; 6 U.S.P.Q.2d (BNA) 1601, 1604 (CCPA 1977).

18 In re Hiniker, 150 F.3d 1362, 1369; 47 U.S.P.Q.2d (BNA) 1523, 1529 (Fed. Cir. 1998).

case. However, the context of the claim recitation in Rahman also suggests that "vehicles" recited in the first element of the appealed claim are being distinguished from "traffic control devices" recited in the last element. Therefore, apart from the definitions imparted by the specification, the claims themselves would appear to warrant the construction afforded by the Board that a "traffic control device" is distinguishable from a "vehicle."[19]

2. Patentability Of Invention Based On Achieved Effects Over Prior Art

In some decisions reviewed for the preparation of this article, the panel did not specifically rely on the definition of a claim term in deciding the case. Rather, the rationale underlying reversal of the appealed rejections were cast in terms of the Applicant's discovery and solution of a new problem.

In *Ex parte Nella*, 1998-2753, the rejected claim recited:

A target detection, seeking and guidance system for an air-to-air, air-to-ground and/or ground-to-air missile comprising:

a hyperspectral imaging system for detecting a target having a predetermined hyperspectral signature;

means for enabling the missile to track the target matching the predetermined hyperspectral signature; and

means including a missile controller for guiding the flight path of the missile to intercept the flight path of the target matching said predetermined hyperspectral signature.

The primary reference was directed generally towards missile guidance systems without specifically indicating that the targets were tracked by a hyperspectral signature. Three secondary references did teach hyperspectral imaging for scanning earthbound features such as mineral and vegetation deposits and for oceanographic and agricultural applications. The Examiner had deemed such earth-bound targets as corresponding to the "targets" in the claims. The claims themselves did not define what comprised "targets," and in reversing the rejection, the panel also did not specifically define what comprised a "target." Rather, the panel determined that reviewing the cited references, one skilled in the art would not have been motivated to combine the teachings in the manner proposed by the Examiner.

19 The Board set forth a new ground of rejection under 37 C.F.R. § 1.196(b). The patent issued as U.S.P. 6,247,113 without any substantive amendment to the appealed claim.

First of all, there is no mention in any of the three secondary references of utilizing hyperspectral imaging for a missile firing system. Cutts teaches utilizing hyperspectral imaging from a vehicle in space to scan the earth for the purpose of identifying mineral or vegetative types. While the appellants have acknowledged that the system disclosed in Davies would be "suitable for use" in the claimed missile system, the reference does not mention such use, suggesting only that the system be used in "earth monitoring satellites" such as oceanography, mapping and mineral exportation, for example. The only uses suggested in the Lurie reference are in space borne cameras that monitor environmental and agricultural situations. Second, the claims before us on appeal all require that the system detect, track and guide a missile based upon the "predetermined hyperspectral signature of a target of interest" which, as we understand the teachings of the applied references, is not the manner in which these systems operate. *Third, none of the applied references recognize the problems to which the appellants' invention are directed, namely, providing a target tracking system for missiles that provides a high degree of recognition and is immune to countermeasures.* (Emphasis added.)

The decision in the *Nella*[20] case has obvious benefits to the Applicant since it does not resort to any definition of what comprises a "target." *Cf. Rahman*, construing claim term "traffic control devices" to have particular meaning in comparison to devices taught in prior art.

As a second example, in *Ex parte Abbott*, 1997-2834, the claim recited a structure for a corrosion resistant lead frame for an integrated circuit which included, *inter alia*:

an isolation layer disposed upon said base metal layer and having a second standard reduction potential, said second standard reduction potential being greater than said first standard reduction potential....

In the decision, the Board noted that Applicant's specification provided an example of the isolation layer as comprising a palladium/nickel alloy layer. However, in reversing the rejection, the isolation layer was not specifically defined by reference to such materials. Rather, the panel stated more generally "the problems to be solved and/or the solutions to the problems in the Levine patents are different from that of the present invention." In addition, in reversing the prior art rejection, the decision further explains "Since [the cited art] is

20 *Nella* at pages 6-7.

concerned with a different problem relative to the claimed invention and thus a different solution, we agree with the appellant that the combined teachings of the admitted prior art and Levine '067 cannot render the subject matter of the appealed claims to be unpatentable within the meaning of 35 U.S.C. § 103."[21]

The case law is replete with the general concepts that references need not be directed to the same problem as an invention in order to render a claim unpatentable[22]; that the references themselves need not expressly teach each and every claim feature to provide motivation for a modification[23]; that intended use of a particular element does not confer patentability[24], and that to comprise analogous art, a reference need not be pertinent to every problem with which Applicant is involved[25]. This case law liberates the Examiner to apply and combine prior art that may seem unrelated to the invention at hand. The wide swath of available art and rationale for their combination limits the amount of ground that Applicant can truly proclaim as new and unobvious. Therefore, there appears to be a great legal hurdle against the likelihood that an argument that the Applicant discovered a problem and solution therefor would be successful. Nevertheless, if at all feasible, arguments on appeal should address this matter of Applicant's discovery of a solution to a new problem since the benefits are so numerous. Primarily, the claim may be passed to issuance without the Board making any pronouncements in the file history on the definition of any claim term. In addition, there will be a pronouncement in the file history that Applicant was the first to identify a problem and solution. This is a strong factual component that would favor conferring "pioneer" status on the patent and a greater scope of equivalents.[26]

As a corollary, while the above two examples in *Nella* and *Abbot* pertain to an effect achieved by the invention over the cited art, it is

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21 *Abbot* at page 7.

22 Ex parte Levengood, 28 U.S.P.Q.2d (BNA) 1300, 1302 (BPAI 1993); In re Kemps, 97 F.3d 1427 1430; 40 U.S.P.Q.2d (BNA) 1309, 1311 (Fed. Cir. 1996).

23 In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1956 (Fed. Cir. 1988).

24 Pitney Bowes, Inc. v. Hewlett Packard Co., 182 F.3d 1298, 1305; 51 U.S.P.Q. (BNA) 2d 1161, 1165 (Fed Cir. 1999).

25 Ex parte Gaechter, 65 U.S.P.Q.2d (BNA) 1690, 1692 (BPAI 2002) (unpublished).

26 Sun Studs, Inc. v. ATA Equip. Leasing, Inc., 872 F.2d 978, 787; 10 U.S.P.Q.2d (BNA) 1338, 1346 (Fed. Cir. 1989) (indicating that pioneer status is a question of fact) but see Augustine Medical, Inc. v. Gaynor Indus., 181 F.3d 1291, 1301, 50 U.S.P.Q.2d (BNA) 1900, 1907 (Fed. Cir. 1999) (indicating that the USPTO and the courts cannot predict the future of whether any invention will open wide vistas of innovation).

important to note that the effect is actually described by the claim language. In *Nella*, the claim actually described guiding a missile according to a "flight path" of the target. Therefore, the conceptual difference between the claimed "target" and the earthbound targets in the references was fairly recited in the claims. Similarly, in *Abbot*, the relative "standard reduction potential" of the isolation layer was also described by the claims themselves, such that conceptually the claims were distinguishable over the prior art. In contrast to the above examples, panels also consistently *affirm* rejections where the Applicant argued that the invention achieved a particular effect over the prior art. However, in those cases where the rejection was affirmed, the claims were silent as to the purported improved effect.[27]

3. Semantic Distinctions Based On Definitions

Additionally, following the widespread use of dictionaries in claim construction exercises by the Federal Circuit,[28] the Board of Patent Appeals also turns to dictionary definitions in determining whether rejections are sustainable. In *Ex parte Abe*, 1997-2212, the claim included a "second step for decompiling the machine program, thereby producing a second high-level language source program which does not depend on any architecture...." The panel recognized that neither the specification nor the file history defined the term "decompiling" and thus relied upon a technical dictionary to ascertain the scope of the claim. In so doing, the Board determined that the cited art did not include a step for decompiling which was independent of a particular architecture, but in fact provided an opposite step of recompiling a program into an architecture dependent form. Accordingly, the Board reversed the pending rejections.

In similar manner, in *Ex parte Goumaz*,1997-2296, the panel referred to a technical dictionary to determine the meaning of the claim term "charge amplifier." There, the Board determined that amplification required a component to increase the strength of a signal without

27 See *Ex parte Cameron*, 1996-2199 (affirming rejection when Applicant argued that claimed invention exhibited a hysteresis effect that was not claimed in the independent claims); *Ex parte Abbey*; 96-0849 (affirming rejection premised on unclaimed "Venturi" effect); *Ex parte Achter*, 96-0760 (affirming rejection when speed and continuity of operation of device was not claimed by Appellant).

28 Inverness Medical Switzerland GmbH v. Warner Lambert Co., 309 F.3d 1373, 1378; 64 U.S.P.Q.2d (BNA) 1933, 1936 (Fed Cir. 2002) *citing* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582; 39 U.S.P.Q.2d (BNA) 1573, 1576 (Fed. Cir. 1996).

appreciably altering its characteristic waveform. During *ex parte* prosecution, the Examiner had continually relied upon a storage capacitor as corresponding to the claimed charge amplifier. The Board noted that the passive capacitor cited by the Examiner could not correspond to the claimed amplifier.

Of course, the Board's use of dictionaries also can have the opposite effect and lead the panel to affirm a rejection. In *Ex parte Aboaf*, 1998-0261, a claim recited a type of recording head, and the outcome of the appeal turned on the proper construction of the term "modules" appearing in the claim. The panel determined that "module" is a broad and non-specific term, generally defined with respect to electronic apparatus as a "packaged functional assembly of electronic components for use with other such assemblies. *Webster's Ninth New Collegiate Dictionary*, 1990." The panel noted that the specification referred to a particular arrangement of read and write heads to make up "modules" but that the claims were not so limited. The non-specificity of the term "module" was also used throughout the cited art to identify different groupings of elements, other than those specifically identified by the Applicant. Therefore, the rejection was affirmed in part because no distinction could be made based on the general term "module."

In the decisions discussed above, the Examiner seasonably challenged any construction being argued by Applicant during the course of prosecution. In an instance where the Examiner offers no construction that is broader than that offered by Applicant, this should be pointed out in the Appeal Brief. *See Ex parte Abdelmonem*, 95-4609. In the *Abdelmonem* appeal, the panel acknowledged that the claim recitation at issue was very broad and subject to varying interpretations. However, the Examiner had never indicated that the claim step was being interpreted in making the rejections in a way that differed than that set forth by Applicant. Therefore, the Applicant's interpretation prevailed, without the panel relying on embodiments in the specification for claim interpretation purposes.

As a final note on the use of dictionaries during appeal proceedings, the Board has been known to use a dictionary to determine the definition of a term used in a *cited reference* to determine whether an appealed claim reads on the applied art.[29]

29 *Ex parte Baccini*, 95-5066.

In view of the foregoing, an Applicant that is relying on definitional aspects of certain claim terms as a basis for distinguishing rejected claims from cited art would be well advised to consider 1) whether the Examiner has considered a broader definition in construing a claim term that is supportable; 2) whether the context of the claim recitation supports the reading being advocated; 3) whether the plain meaning either by a common dictionary or a technical dictionary results in a broader construction that would make the rejected claim readable on the applied art; and 4) whether a term used in a cited reference, while different from Applicant's terminology, nonetheless can be construed to have the same meaning either under a common or technical dictionary definition.

4. Claim Interpretation For Section 112 Rejections

In decisions relating to a rejection under 35 U.S.C. § 112, second paragraph, various panels have relied on the specification to determine whether Applicant has claimed the invention with sufficient clarity. See e.g. *Ex parte Ohira*, 1999-0608; *Ex parte Ruck*, 1998-0515; *Ex parte Babel*, 1997-2977. Federal Circuit precedent gives clear direction that construction of the claim for purposes of clarity is charged to the examination process. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."[30] The test for indefiniteness under Section 112, second paragraph, is whether the claim language when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct.[31]

Despite the liberal use of the specification in determining claim precision, many rejections under 35 U.S.C. § 112, second paragraph, are affirmed. In the *Ohira* and *Babel* appeal decisions, the panel had to determine whether the modifiers "substantial" and "substantially" rendered the claims indefinite. In each instance, the panel determined that the claims were indeed indefinite for including these modifiers. The result is somewhat surprising because the MPEP expressly permits latitude in use of relative terminology in claim language, including the

30 In re Zletz, 893 F.2d 319, 322; 13 U.S.P.Q.2d (BNA) 1320, 1322 (Fed. Cir. 1989).
31 In re Merat, 519 F.2d 1390, 1396; 186 U.S.P.Q. (BNA) 471, 476, (CCPA 1975).

use of the term "substantially."[32] It is noted that both in *Ohira* and in *Babel*, the panel found that the specifications gave no specific definition of what comprised a "substantial" amount of the characteristic in question. Therefore, unlike the cases discussed in the MPEP, the specification did little to inform one skilled in the art the precise nature of the claim scope.

As an additional claim construction exercise for purposes of Section 112, second paragraph, the Board may also consider whether the terminology in question has a particular meaning to one skilled in the art by examining prior art references. In *Ex parte Takaku*, 2000-0156, Appellant presented prior art not relied upon the Examiner to demonstrate that physical characteristics of transparency would be understood by one skilled in the chemical vapor deposition art.

5. Legal Arguments

The above discussions relate primarily to technical assessments based on the teachings of the prior art in comparison with appealed claims. The second major category of argument is the legal argument. Legal arguments redirect the emphasis towards the Examiner's improper application of references as set forth in MPEP. Focusing a response and appeal on the weaknesses in Examiner's rationale rather than on the actual technical teachings forces the Examiner to reveal more of his thought processes. This will help Applicants understand the Examiner's arguments, identify weaknesses of the claims, and shore up any such weaknesses prior to appeal. Focusing on the Examiner's rationale during *ex parte* prosecution also has the benefit of avoiding the inadvertent limiting of claims based on express representation of what the claimed invention "is" and "is not" in comparison to the applied art. This reduces the impact of file history estoppel in the case.

A. Lack of Inherency in Cited Art

A review of sample cases suggests that contemporary panels are not inclined to rely on purported implicit teachings in a reference to affirm a rejection. The hesitancy to find inherent disclosures in prior art references applies to both 1) structural features that are claimed and 2) resultant effects that are claimed. The structural features include, for example, attributes of shape of a particular element *Ex parte Turos*,

32 MPEP 2173.05(b) citing In re Nehrenberg, 280 F.2d 161; 126 U.S.P.Q. (BNA) 383 (CCPA 1960); Andrew Corp. v. Gabriel Electronics, 847 F.2d 819; 6 U.S.P.Q.2d (BNA) 2010 (Fed. Cir. 1988).

2002-0022 (applied art for a shoe cleat did not inherently teach annular ring encircling a hemispherical chamber); the ratios of dimensions for deciding placement of claim elements *Ex parte Uchida*, 1999-0555; the carbon bonding in a chemical structure *Ex parte Sampath*, 1999-2173 (compound containing percentage of carbon in bound state did not require carbon bonding with molybdenum to form molybdenum carbide precipitates); and the presence of close-boiling of non-aromatics *Ex parte Nacamuli*, 1998-1067.

Claimed effects include whether a rubber material is suitable for use as an "eraser" *Ex parte Rudduck*, 1999-2186 (Appellant submitted expert declaration to support position that not all rubber substances act as an eraser); whether a component is operable in a "push on, pull off" fashion *Ex parte Qiao*, 1999-2371 (indicating that Examiner's conclusion that a fastener can be disengaged by pulling is merely speculation); and whether a hanger is rotatable about a post *Ex parte Olsen*, 1999-1044.

It is noteworthy that the cases that reverse rejections based on inherency appear generally to be of more recent vintage. The concept of the lack of inherency argument is not a new one.[33] However, the Federal Circuit's decision in *In re Robertson* appears to have given new strength to this legal argument.[34] "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"[35] In view of the prevalence of reversals of rejections on grounds of lack of inherency of claim elements in applied art, the record should be carefully developed with regard to any viable inherency positions.

B. Motivation to Combine

The argument for teaching away from particular combinations of references has proven to be a common basis for reversing rejections under 35 U.S.C. § 103. In *Ex parte A. Said el Shami*, 93-3369, the claim for a diagnostic device for biological samples recited, in relevant

33 See In re Oelrich, 666 F.2d 578; 212 U.S.P.Q. (BNA) 323, 326 (CCPA 1981).
34 169 F.3d 743, 745; 49 U.S.P.Q.2d (BNA) 1949, 1951 (Fed. Cir. 1999).
35 *Id.* (Internal citations omitted.)

part, "a specific antibody binder covalently immobilized on said first solid phase support to which an analyte label is pre-reacted to saturate substantially all binding sites on said binder to form a first solid phase specific antibody binder-analyte label complex…." The Board noted that the cited art was not drawn to antibody-analyte complexes and to the extent that any analogies could be drawn, it was clear that the target DNA in the reference did not become saturated as claimed. The saturation of all the binding states in the disclosed probe would disable the DNA hybridization, which was the desired result in the reference. An additional secondary reference also included a similar deficiency since saturation of the binding sites would cause the binding sites to become occupied when the reference relied on site availability for the disclosed device to operate. It is not obvious to modify a prior art device which would lead to an inoperative construction.[36]

The Examiner's motivation for combining references can also be undermined by focusing on the effects of the cited art. In *Ex parte Palulu*, 1999-2068, the Examiner contended that positioning of certain operating switches onto the steering wheel of the vehicle would be obvious to minimize driver distraction from the road. However, the cited reference was operable only when the vehicle is at a stop, in an idling state or in a park position. Accordingly, there is no concern for the driver's distraction as the Examiner had postulated. The panel subsequently reversed the rejection.

Strongly contesting the propriety of combining references either under the principle that the references teach away from their combination, or that the modification or combination would render one reference inoperable for its intended purpose is valuable since as discussed above, it focuses the analysis away from particular definitions in the claim language. Moreover, in the event that it appears that the combination of art does conceptually teach each feature of the claim, then lack of motivation remains an option to traverse the rejection.

IV. Options To Pursue If Appeal Is Not Pursued

As a general rule, *ex parte* prosecution should be exhausted up through receipt of the Advisory Action after Applicant responds to a final rejection. A constructive dialog between Applicant and the Examiner

36 In re Gordon, 733 F.2d 900, 902; 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).