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Using "Teaching Away" To Overcome an "Obviousness Rejection"

If you have ever been involved with filing a patent application in the United States, then there is a good probability that the patent examiner at the USPTO initially rejected at least one of the claims of the patent application for "obviousness" under 35 U.S.C § 103. A rejection based on "obviousness," also known as a "103 rejection" or an "obviousness rejection," is very common and may be difficult to overcome. This article briefly discusses what a 103 rejection is, and one tactic patent attorneys use to overcome a 103 rejection.

To better understand what a 103 rejection is, we first need to look at the applicable statue, 35 U.S.C. § 103. 35 U.S.C. § 103 states:

> "a patent for a claimed invention may not be obtained … if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains."

Practically speaking, a patent examiner at the USPTO can combine multiple "prior art" references to argue that the combination of said references teaches all elements of that claim. The term prior art generally refers to references, such as patents or publications, which were available to the public prior to the filing date of a patent application. Another way to describe a 103 rejection is that an invention disclosed in a patent application is obvious based upon the combination of multiple components of patents, patent publications, or other public disclosures that were publicly known prior to the date a patent application was filed.

There are several ways that an applicant can overcome a 103 rejection. One way is to argue that one of the prior art references combined by the patent examiner at the UPSTO "teaches away"

from the patent application's invention. "Teaches away" means that the prior art provides some sort of evidence showing why a person of ordinary skill would in fact not combine the cited art reference as suggested by the patent examiner. In other words, if a prior art reference "teaches away" from the applicant's invention, then it cannot be used as evidence of obviousness.

Chemours Company FC, LLC v. Daikin Industries, Ltd. is one example of how a patent holder successfully argued that a reference "teaches away" from combining with other cited prior art and thus the 103 rejection was improper. In *Chemours*, the Federal Circuit Court of Appeals reversed the Patent Trial and Appeal Board's ("Board") obviousness determination holding that the Board improperly found motivation to modify a prior art reference where the "inventive concept" of the prior art reference "taught away" from that modification.

In *Chemours*, the challenged patent at issue related to high melt flow fluoropolymer for insulating communication cables. Specifically, the patent at issue's claims provided that the polymer had a specific melt flow rate range, i.e., "a high melt flow rate of about 30±3 g/10 min." The Board found the patent at issue's claims to be obvious over a single prior art reference. The prior art reference's specification disclosed that its polymers may have melt flow rates of "15 g/10 min or greater" and provided an example with a melt flow rate of 24 g/10 min. The Board held that it would have been "obvious" to have modified the prior art reference to increase the melt flow rate because other evidence of record taught about increasing the melt flow rate as a means for achieving higher coating speeds.

On appeal, the Federal Circuit concluded that the prior art reference "teaches away from broadening molecular weight distribution" and that the Board erred in finding the claims of the patent at issue not patentable under 35 U.S.C. § 103. The Federal Circuit found that the prior art taught away from the patent at issue's claims because the patent at issue's inventive concept was "narrowing molecular weight distribution." Simply put, because the patent at issue's inventive concept was "narrowing molecular weight distribution" the prior art "taught away from" broadening to teach the patent at issues claims.

The "teaching away" argument when used correctly may be an effective way to overcome complex 103 rejections. The patent attorneys at The Plus IP Firm have experience responding to complex 103 rejections. To learn more about Derek Fahey, the author of this article, please click HERE.