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# **Affidavit/Declaration Evidence Addressing § 103 Rejection**

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## **37 CFR § 1.132 provides a mechanism for presenting evidence relevant to patentability**

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- predictability of prior art teachings
- level of skill in the relevant art
- secondary considerations such as unexpected results
- Persuasive evidence connects the claims at issue to the conclusion of nonobviousness (nexus)

# Types of Evidence

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- Showing no reasonable expectation of success –  
In re Rinehart, 531 F.2d 1048 (CCAA 1976)
- Reference “teaches away” from making the  
claimed invention – Medichem, S.A. v. Rolabo,  
S.L. 437 F.3d 1157, 1165 (Fed. Cir. 2006)
- Level of skill in the art – Okajima v. Bourdeau, 261  
F.3d 1350, 1355 (Fed. Cir. 2001)

# Types of Evidence

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- Where PTO establishes a prima facie case of obviousness, the burden shifts to applicant to provide any evidence of nonobviousness In re Piasecki, 745 F.2d 1468 (Fed. Cir. 1984)
- Secondary considerations may be the most pertinent, prohibitive, and revealing evidence available in reaching a conclusion of the obviousness/nonobviousness issue – Ashland Oil, Inc. v. Delta Resins & Refractories Inc., 776 F.2d 281 (Fed. Cir. 1985)

# Secondary Considerations

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- Evidence of skepticism of experts in the relevant art – Burlington Indus. Inc., v. Quigg, 822 F.2d 1581 (Fed. Cir. 1987)
- Evidence of long-felt but unfulfilled need for the claimed invention – Tex. Instruments, Inc. v. U.S. Int’l Trade Comm’n, 988 F.2d 1165 (Fed. Cir. 1993)
- Evidence that other inventors failed when trying to achieve the claimed invention – Heidelberger Druckmaschinen AG v Hantscho Commercial Prods. Inc., 21 F.3d 1068 (Fed. Cir. 1994)

# Secondary Consideration

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- Evidence of unexpected results – In re Soni, 54 F.3d 746 (Fed. Cir. 1995)
- Evidence of licenses and offers to license might show industry acceptance of claimed invention – Pentec Inc, v. Graphic Controls Corp., 776 F.2d 309 (Fed. Cir. 1985)
- Commercial success, where success caused by claimed invention – Hybritech Inc,. v Monoclonal Antibodies, Inc., 802 F.2d 1367 (Fed Cir. 1986)
- Must be commensurate in scope with claimed invention – In re Tiffin, 448 F.2d 791 (CCPA 1971)

# Ex Parte Jella, 90 USPQ 2d 1009 (BPAI 2008)

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- To be entitled to substantial weight in the determination of obviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations
- Applicant bears the burden of establishing a nexus

# Ex Parte Jella, 90 USPQ 2d 1009 (BPAI 2008), cont'd

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- Declaration from those in garage door industry re skepticism whether garage door section height would work satisfactorily
- Declaration re improvement in production capabilities and reduced labor costs
- Declaration re commercial success
- Declaration re long-felt and growing need



# Consideration of Evidence

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- All relevant evidence must be evaluated when determining obviousness under § 103 – In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992)
- BPAI expects examiners to consider evidence when submitted
  - Ex parte Malone (BPAI 2009) – explanation re POSITA
  - Ex parte Rapp.(BPAI 2009) – long felt need and commercial success
  - Ex parte Ramsden (BPAI 2009) – experimental results in specification

# Candor and Good Faith

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- Cases involving affidavits or declarations are held to a higher standard – *Innogenetics, NV v. Abbott Labs*, 512 F.3d 1363, 1379 (Fed. Cir. 2008)
- Failure to disclose possible biases of the declarants constituted a material omission – *Ferring B.V. v. Barr Laboratories, Inc.*, 437 F.3d 1181, 1190 (Fed. Cir. 2006)
- Submission of inaccurate and misleading declaration in order to overcome obviousness rejection and failure to submit directly conflicting article co-authored by declarant himself constituted inequitable conduct – *Pharmacia Corp. v. Par Pharmaceutical, Inc.*, 417 F.3d 1369 (Fed. Cir. 2005)

# Affidavit/Declaration Evidence - § 103

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- Avoid where practical
- Focus on failure of PTO to establish prima facie case of obviousness
- Secondary considerations
- Nexus to obviousness issue
- Commensurate in scope with claimed invention