



Lack of Apparent Reason to Combine Argument

- Even if the references disclose all of the claimed features, it is still possible to show nonobviousness by demonstrating that the features of the references should not be combined.
- The object of the argument is to demonstrate, for example, why there are differences between what is taught about the features in the references such that there would have been no reason for one skilled in the art to have used the teachings of the secondary reference or references to modify the apparatus or method disclosed in the primary reference.
- The lack of reason to combine argument can be a strong argument in response to an obviousness rejection.

RESPONSE STRATEGIES

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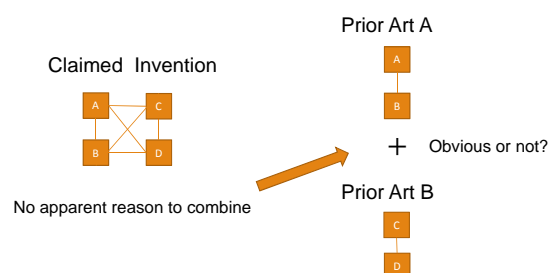
Lack of Apparent Reason to Combine – Example (continued)

- However, we can argue that one skilled in the art would have had no reason to have modified the communication device described in Reference 1 to include an encryption device described in Reference 2 **because the receiver in the communication device of Reference 1 receives data that has already been encrypted.**

RESPONSE STRATEGIES

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Lack of Apparent Reason to Combine Argument



RESPONSE STRATEGIES

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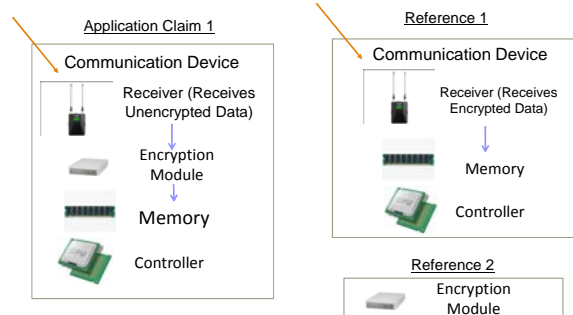
Lack of Apparent Reason to Combine Argument

- The best types of arguments are those which can show that the teaching of one reference is contrary to the teachings of the other reference or references. For instance, the secondary reference describes techniques to decrease a characteristic while the purpose of the primary reference is to increase that particular characteristic. This can lead into the “teaching away” aspect discussed below.

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Lack of Apparent Reason to Combine – Example



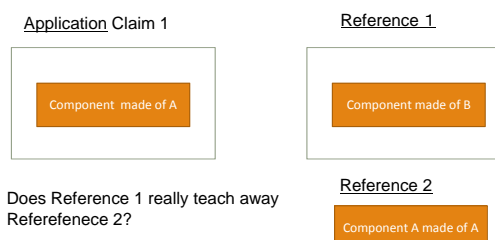
- The Examiner argues that it would have been obvious to have modified the communication device of Reference 1 to include an encryption circuit as shown in Reference 2 because it is known to encrypt received data.

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- “Teaching away” arguments are sometimes possible, but it is typically difficult to persuade an Examiner with a “teaching away” argument.

Example A



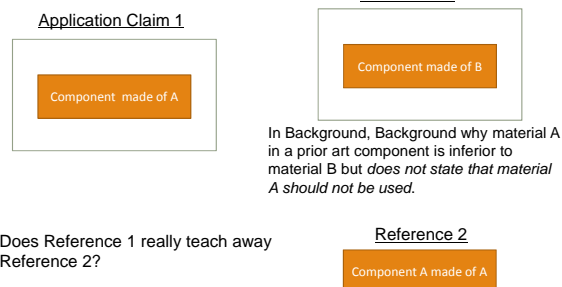
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- “Teaching away” argument might not be successful even if one reference states that a particular modification is inferior or less desirable.

Example B



RESPONSE STRATEGIES

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Nonanalogous Art Argument

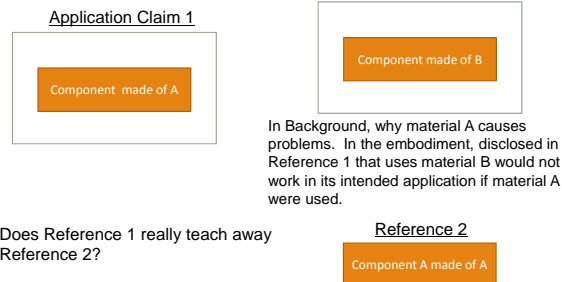
- The USPTO uses the “reasonably pertinent” standard as outlined in *In re Bigio*, 381 F.3d 1320 (Fed. Cir. 2004).
- Basically, a reference is analogous art to the claimed invention if:
 - (1) the reference is from the same field of endeavor as the claimed invention (even if it addresses a different problem); or
 - (2) the reference is reasonably pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor as the claimed invention).

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- “Teaching away” argument can be successful mainly when one reference actually states or implies that a particular modification *should not* be used or considered.

Example B



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- In *Bigio*, the Federal Circuit agreed that references pertaining to toothbrushes were analogous to an invention pertaining to hairbrushes since both types of devices have a handle and a brush section.



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Nonanalogous Art Argument

- The nonanalogous art argument is the weakest of the types of primary arguments.
- The object of the argument is to demonstrate, for example, why the technical areas of the references are so unrelated that there would have been no reason for PHSITA to have used the teachings of the secondary reference(s) to modify the apparatus or method disclosed in the primary reference.
- Typically, an Examiner will find a way to show that the reference are “analogous” to the claimed invention and to each other.

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Nonanalogous Art Argument

- In *re Klein* further clarifies that in determining whether a reference is “reasonably pertinent” to the claimed invention, “an examiner should consider the problem faced by the inventor, as reflected - either explicitly or implicitly - in the specification.”
- The Examiner may wish to include a statement of the Examiner’s understanding of the problem in the rejection.

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