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PATENT AGENT
ALLEN C. YUN, PH.D.

September 28, 2000

VIA TELEFACSIMILE

Mr. Sava V. Kulhavy
Dipl.-Ing. S.V. Kulhavy & Co.
Postfach 1138
CH-9001 St. Gallen
SWITZERLAND

Re: Walter KASER - Appln. No. 09/308,909
HOUSING FOR A DISK-SHAPED...
Your Reference: P2158pct/us SK-mr
Our Reference: KASER=1

Dear Mr. Kulhavy:

Enclosed with the confirmation copy of this report is a copy of our September 25, 2000, response to the Examiner's May 25, 2000, Official Action on the above-identified application. This response was prepared in accordance with your September 19, 2000, instructions.

As you will note, we cancelled claims 1-10 in favor of new claims 11-29. We did not use the claims you provided because they did not meet U.S. format requirement (they would have been rejected under the second paragraph of § 112) and from our review claimed the invention too narrowly, i.e. many of the claims described structure in such fine detail that they could be easily avoided by a change in shape. In comparison, new claims 11-29 are as broadly drafted as possible.

Unfortunately, we were unable to determine from our review of the enclosed claims what you considered to be the primary inventive features distinguishing the invention from the cited prior art. We thought that the feature of the stand (5) being narrower than disk (4) and being spaced above base (2) was clearly one of the primary inventive features and focused on that in new independent claim 11 and argued in the rebuttal of the prior art that this was not shown. We added other features in the dependent claims.

If you believe that we have not included all the features the client wishes to cover, we are still in a position to add claims before the Examiner acts. However, if you wish us to do so, please advise us generally what these features are and we will draft appropriate claims. We believe that this is the most economical way to proceed and suggest that in future cases that, rather than providing us with new claims structured similar to those provided in this case, you simply list the primary inventive features distinguishing the invention from the prior art and permit us to place them in appropriate claim format. This will save us time and be more cost effective.

If we can be of any further assistance, please feel free to contact us. Also enclosed with the confirmation copy of this report is our debit memorandum for services. Our debit note is somewhat higher than normal due to the need to first analyze your proposed claims, but does not cover all the time expended.

Sincerely,

Norman J. Latker
Managing Attorney

NJL:dr
Enclosure

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September 28, 2000

Mr. Sava V. Kulhavy
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Postfach 1138
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SWITZERLAND

DEBIT NO. 82914

Re: Walter KASER - Appln. No. 09/308,909
HOUSING FOR A DISK-SHAPED...
Your Reference: P2158pct/us SK-mr
Our Reference: KASER=1

To:	Services in connection with preparation and filing a response to the Examiner's Official Action dated May 25, 2000, including review of application, cited references and instructions amended specification, abstract, drawing and claims, remarks rebutting rejection, and written report	$910.00
To:	Government fees for extensions of time including Browdy & Neimark surcharge for advancing payment money	$ 60.50
To:	Out-of-pocket expenses, including copying, postage, and miscellaneous expenses	$ 25.00
	TOTAL:	$995.50

NJL:dr

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fication, would not be satisfactory), the Examiner has not shown in the prior art the various elements from which a choice may be made.

From Ex parte Haas, Connelly, and Van Voorhis, 144 USPQ 98,9:

> "Why the examiner states that the particular features of novelty, which give results that the reference device cannot give, are arbitrary, we cannot understand. Changes yielding new and improved results are never arbitrary. They are made for the purpose of yielding the new and improved results. When novel features yield novel and useful results, a basis for patentability is established; ... .
>
> "The examiner then says that these are a matter of choice. It is not a matter of choice presented by the prior art. The prior art gives only one choice; a process which will not yield these new and improved results. Thus, one of ordinary skill in the art, turning to the prior art to make his choice, would never arrive at the claimed process."

also see Ex parte Dere, 118 USPQ 541,4 and Ex parte Krantz, 61 USPQ 238; Ex parte Kaiser, 194 USPQ 47,48. (~~194 253~~).

The rejection should be withdrawn; neither the subject matter claimed nor the results obtained are shown, suggested or remotely inferred by the cited prior art which is so diverse from the invention.

All of appellant's claims stand rejected under 35 U.S.C. §103 over Levengood in view of the combined teachings of Janick and Holl. We reverse the rejection.

As noted by the examiner, the Levengood Patent describes a method for increasing the proportion of mutants in a single plant species by applying electrical field gradients to the plant while it is in the germinal stage. Importantly, the Levengood reference does not suggest that members of a first plant species should be placed in contact with whole cells and associated materials of a second species while simultaneously applying the electrophoretic current.

The Janick and Holl references are not concerned with the application of electrical current and merely teach standard grafting and/or genetic engineering procedures. Janick describes the grafting of one type of plant onto the rootstock of another type of plant; for example, fruit trees are grafted onto dwarfing rootstocks in order to produce dwarf fruit trees, and watermelon is grafted onto the gourd *Langenaria* to control Verticillium wilt. This reference has little bearing on what is being claimed. The Holl reference teaches that DNA is capable of being transferred from one species of plant to another, usually by using modified bacteria to infect the plant and incorporate heterologous DNA therein. Importantly, neither Holl nor Janick suggest carrying out their respective processes while simultaneously applying an electrophoretic field.

At pages 4 and 5 of the Answer, the examiner has set forth the rationale for the rejection. The examiner notes that each reference discloses a different aspect of the claimed process. The examiner also notes that all aspects were "well known in the art." The examiner then indicates that because the various aspects of the claimed process were individually known in the art, the modifications of the electrophoretic process of Levengood by exposing Levengood's plant materials to cell-associated materials in order to "graft" or otherwise incorporate the cell associated material into the plants was "*well within the ordinary skill of the art* at the time the claimed invention was made."

We reverse the rejection because the examiner has used the wrong standard of obviousness.

Obviousness is a legal conclusion, the determination of which is a question of patent law. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*,[1] preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. See, for example, *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

[1] Motivation for combining the teachings of the various references need not be explicitly found in the references themselves, *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Indeed, the examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963).[2]

In this case, however, the only suggestion for the examiner's combination of the isolated teachings of the applied references improperly stems from appellant's disclosure and not from the applied prior art. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979). At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. See *Orthokinetics Inc. v. Safety*

[1] The importance of evidence in the examination process is set forth in the following quotation from *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984):

> The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the 'burden of proof on the Patent Office which *requires it to produce the factual basis for* its rejection of an application under sections 102 and 103'. *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967). After a *prima facie* case of obviousness has been established, the burden of going forward shifts to the applicant.

[2] Preferably the examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification. *In re Albrecht*, 514 F.2d 1385, 185 USPQ 585 (CCPA 1975). See also *Fromson v. Advance Offset Plate Inc.*, 720 F.2d 1565, 219 USPQ 1137 (Fed. Cir. 1983).

Travel Chairs Inc., 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd.App. 1980). See also footnote 16 of *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985). That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.

Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual "to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.

In the case before us, the examiner has provided references having teachings which go a long way towards providing a scientific explanation for *what happened* when appellant performed the claimed combination of process steps. However, the references themselves fall far short of providing the "motivation" or "suggestion" to assemble their teachings into a viable process. A *prima facie* case of obviousness has not been made out.

The examiner's rejection of claims 6 through 30 is reversed.

REVERSED.

U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences

Ex parte Phillips

No. 92-3045

Decided April 27, 1993
Released August 6, 1993

PATENTS

1. Practice and procedure in Patent and Trademark Office — Prosecution — In general (§110.0901)

Patentability/Validity — Obviousness — Relevant prior art — Particular inventions (§115.0903.03)

Examiner properly shifted burden to patent applicants to establish, through objective evidence, that hybridoma and monoclonal antibody of invention differ in unobvious manner from those of prior art reference, since Patent and Trademark Office lacks facilities and resources to provide factual evidence needed to establish that claimed subject matter is unobvious, and it is thus applicants' burden to make such showing, which requires factual evidence demonstrating that actual, unobvious differences exist, rather than simply speculation about possible differences.

Appeal from final rejection of claims (John Doll, supervisory patent examiner; Robert D. Budens, examiner).

Patent application of Joseph H. Phillips, Lewis L. Lanier, Athena Huey-Jiuan Ding, Elizabeth Evans, David W. Buck, and Lori Rhodes, serial no. 07/146,745, filed Jan. 21, 1988 (Leu 23: monoclonal antibody for monitoring leukocyte activation). From final rejection of all claims remaining in application, applicants appeal. Affirmed.

Robert M. Hallenbeck, Franklin Lakes, N.J., for appellants.

Before Pellman, Goolkasian, and W. Smith, examiners-in-chief.

Smith, examiner-in-chief.

This is an appeal from the final rejection of claims 26 and 27, all the claims remaining in the application. These claims read as follows:

26. A hybrid
HB-9627.

27. A monoclo
a hybridoma
HB-9627.

The reference rel
is:

Hara et al. (Har
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1988-2005 (Dec.

Claims 26 and 27
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