

## Ex parte Talkowski

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The Board published an opinion 6/26/2013 as a new informative opinion. Ex parte Talkowski, (PTAB 5/24/2013)(Opinion by Senior APJ McKelvey, for a panel consisting of APJs McKelvey, Best, and Praiss). The Board published the opinion at: [http://www.uspto.gov/ip/boards/bpai/decisions/inform/fd2012002290\\_ex\\_parte\\_talkowski .pdf](http://www.uspto.gov/ip/boards/bpai/decisions/inform/fd2012002290_ex_parte_talkowski.pdf)

There are two interesting things about this opinion.

The first interesting thing is the conclusion that “Applicant DuPont likely knew of the Wakabayashi/Register research.” The issue here is that the Applicant, DuPont, had only disclosed the Wakabayashi 1 abstract, and not the Wakabayashi 2 and 3 papers, all of which were 102(b) available references. And it was the Board that independently discovered Wakabayashi 2 and 3 when investigating if the Wakabayashi 1 Abstract had resulted in a publication. The Board’s analysis then relied upon the “Wakabayashi publications” in its analysis of obviousness, ultimately affirming the rejection of the examiner, and expressly noting that the Board had “relied on Wakabayashi 2 and Wakabayashi 3.” While reading the opinion, I kept expecting the Board to at least mention rule 56, given the foregoing, but it did not. One cannot say at this time if the Board referred this case to OED. Even if a patent issues from this application, its enforceability would clearly be infirm. But that was the first issue; not the substantive patent law issue. It was the substantive patent law issue which was why this opinion was made informative.

The second interesting thing is the substantive patent law issue. Talkowski broadens the scope of prior art available for a conclusion of legal obviousness, at least within the PTO. Specifically, it concludes that the teachings of two references can form the basis for legal obviousness even when both of them are not analogous art under In re Wood, 599 F.2d 1032 (CCPA 1979).

Here is what Talkowski says on this issue:

According to applicant, Chen and Wakabayashi 1 are what is referred to in a § 103 context as "non-analogous" art. We will assume applicant would also maintain that Wakabayashi 2 and Wakabayashi 3 are non-analogous vis-a-vis Chen. If applicant is correct, then Chen cannot be combined with Wakabayashi 1, Wakabayashi 2 or Wakabayashi 3 to defeat Claim 1 under § 103. \*\*\*  
Wood and similar earlier precedent seems to have approached the "nonanalogous" art issue from a perspective of an inventor. Notwithstanding Wood and similar precedent, and as will become apparent, a "no" answer to both Step 1 and Step 2 [of the Wood test] does not always compel a decision that a reference is non-analogous and therefore may not be used as a reference in a § 103 context. [Footnote 7 omitted.] Since Wood, § 103 obviousness considerations have not been restricted to an analysis based solely from an inventor's point of view. Rather, § 103 analysis focuses on what is claimed apart from the motivation of the inventor. In re Dillon, 919 F.2d 688 (Fed. Cir. 1990) (en banc), is illustrative. \*\*\*

It may be true that Chen and applicant set out to solve different problems. However, those practicing the Chen invention should be free to make a

modification to that invention by including in the Chen composition the blends described by the Wakabayashi publications. Allowance of Claim 1 on appeal on the record before us would preclude those skilled in the art from practicing an obvious modification of Chen's invention. As KSR notes, § 103 is designed to prevent that from happening.

When a Wood analogous art analysis is made from the point of view of combining the Chen patent and the Wakabayashi publications, it then becomes manifest that the Wakabayashi publications are related to Chen's field of endeavor. On that basis, the patent and publications can be combined to determine whether Claim 1 on appeal is unpatentable under § 103. We agree with the Examiner's observation (Answer, page 21):

the fact that Wakabayashi [1] is not concerned with ... [applicant's] field of endeavor (ostensibly the manufacture of shaped articles from PTT compositions) and solves a problem other than that identified by . . . [applicant] does not preclude the use of . . . [Wakabayashi 1] in a proper rejection under 35 USC [§] 103(a).

For the reasons given, we reject applicant's argument that Chen and the Wakabayashi publications are non-analogous art which cannot be used to support a § 103 rejection.

What Talkowski means is that a combination of teachings of two references (1) neither of which is in the inventor's field of endeavor and (2) neither of which is reasonably pertinent to the particular problem the inventor was trying to solve (that is two references which each fail the Wood criteria), may result in the inventor's invention being found legally obvious. That may occur if one of the references is related to the field of endeavor of the other reference.

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