



Robinson Intellectual Property Law Office

PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165

Voice: 571-434-6789
Fax: 571-434-9499
G4 Fax: 571-434-2916
Email: info@riplo.com
www.riplo.com

Patent Prosecution Developments

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Consider Using our
"Motivation Checklist" when
Reviewing Rejections
Under § 103

Motivation Often Misapplied by USPTO

It is our observation that Examiners often misapply the law in forming rejections under 35 U.S.C. § 103, particularly the motivation requirement of a *prima facie* case of obviousness. We surmise that Examiners increasingly rely on computerized searches of the prior art, leading to poor combinations of references. A typical § 103 rejection from the USPTO will pair a primary reference and one or more secondary references and allege as motivation some feature of the secondary reference. Although the references are often from the same field of endeavor, the alleged motivation to combine the references cited by the Examiner will often relate solely to the secondary reference and have little or no relationship with the deficiency in the primary reference. Often, the alleged motivation to combine can be achieved by implementation of the secondary reference alone. Attached below is a checklist to help you analyze the merits of motivation in a § 103 rejection.

- What is the motivation relied upon by the Examiner to suggest the combination of references?
- Does the secondary reference suggest the desirability of the feature of the present invention missing from primary reference?
- Does the advantage resulting from the alleged motivation simply suggest practicing either the primary or secondary reference alone? That is, can the advantages alleged by the Examiner be achieved by one of the references without combining or modifying the references?
- Do the primary and secondary references "reach" for each other?
- Do the primary and secondary references "teach away" from each other?

Before amending the claims and to avoid unnecessary prosecution history estoppel, consider the strength of the Examiner's motivation argument.