



Intellectual Property Advisory:

Ex parte Kubin, et al.

The recent precedential decision of the Board of Patent Appeals and Interferences (BPAI) in *Ex parte Kubin*, Appeal No. 2007-0819, provides some early insight into the Board and the U.S. Patent and Trademark Office's interpretation of obviousness under 35 U.S.C. § 103(a) following the recent Supreme Court decision of *KSR Int'l Co. v. Teleflex*, 127 S.Ct. 1727 (2007).

35 U.S.C. § 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

The application under appeal claimed nucleic acid molecules that encode polypeptide molecules that will bind to a specific membrane glycoprotein found in cells. The BPAI affirmed an Examiner's rejection under 35 U.S.C. §103(a) holding that several claims were "obvious to try" and a person skilled in the art would have had a reasonable expectation of success using known methodologies.

Relying on *KSR*, where the Supreme Court rendered obvious a patent claim in which a person of ordinary skill in the art would have reason to pursue known options in the prior art, even if those options were "obvious to try", the BPAI affirmed the Examiner's rejection of several claims in the patent application (Application No. 09/667,859) under 35 U.S.C. § 103(a) as obvious in view of the combined teachings of three references. The BPAI also rejected Appellant's argument that a person skilled in the art would not

have motivation to combine references because one of the references suggested that the relevant gene is not expressed in humans. Instead of teaching away from a combination, the BPAI found that this reference showed conflicting data and would not have deterred a skilled artisan from combining the applied references. In this case, the BPAI held that the motivation to combine references was implicit citing *In re Kahn*, 441 F.3d, 977, 988 (Fed. Cir. 2006).

In applying the *KSR* teachings, the BPAI appears to have confirmed what many have cautioned - - the USPTO will likely expand the scope of obviousness rejections during the patent acquisition process. This precedential decision may impact patent applications in technology areas where the level of skill in the art is high and there are a finite number of methodologies to obtain the claimed combinations, and will require creative strategies by applicants to overcome future obviousness rejections.

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