

Keywords: Motivation to combine, obviousness, 35 U.S.C. §103.

General: Decisions by Board of Patent Appeals and Interferences finding that prior art references would motivate person of ordinary skill in art to make inventions of applications at issue are affirmed in action in which applicants have not identified any legal error affecting board's obviousness analysis, or any factual grounds sufficient to question its findings as to teachings of prior art and motivation that references would impart to skilled artisan.

In re Berg
65 U.S.P.Q.2d 2003 (Fed. Cir. 2003)
February 20, 2003

I. Facts

Inventors brought appeal to the Federal Circuit following two decisions of the United States Patent Office Board of Patent Appeals sustaining obviousness rejections of inventors' application and of a related divisional application.

The first patent application in issue (08/278,774) was for "Mutated Recombinant Collagens." Subsequently a divisional application (08/630,654) was filed claiming nucleic acids that encode the proteins claimed in the first application. Certain claims of the '744 and '654 applications were rejected by the examiner as obvious in light of four and three prior art references respectively. The examiner's decision was appealed to the Board, which agreed with the examiner as to all but two claims.

The examiner cited a single reference, read broadly, as providing the motivation to combine the teachings of the other references. Applicants objected to the broad reading and supplied their own more narrow reading of the reference, but failed to sufficiently address the examiner's other motivational grounds which the examiner found were supported in the single reference and other cited references. The Appellants argued that the motivations were not present in any prior art references but did not point to any flaws in the reasoning of the examiner or the Board which made their conclusions unsupported.

II. Issues

What weight is given to the findings of an examiner or the Board on prior art interpretation and motivation to combine, and what must be shown by an applicant to overcome such a finding?

III. Discussion

Examiners and administrative patent judges sitting on the Board are persons of scientific competence in the fields in which they work. As such, they are qualified to interpret prior art references as a person of ordinary skill in the art would, and judge what motivations those references would provide to one of ordinary skill in the art. Absent legal error or contrary factual evidence, those findings establish a prima facie case of obviousness.

IV. Conclusion

The Appellants did not point to any legal error nor provide sufficient factual basis to question the findings made by the examiner and Board. Therefore, the rulings of the board were upheld and the claims in issue were rejected as obvious.