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In Re Vaidyanathan - Predictable Use of Prior Art

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Einstein is quoted as saying "common sense is the collection of prejudices acquired by age eighteen." Occasionally, common sense is a reason used by the US Patent and Trademark Office (PTO) to reject a patent application as obvious. The Federal Circuit decided an appeal of such an obviousness rejection in *In Re Ravi Vaidyanathan* (2009-1404, Fed. Cir. 2010, non-precedential) and held that an obviousness rejection requires a reviewable explanation of the evidence and rationale behind the rejection.

The decision in *Vaidyanathan* clarifies how patent Examiners and the Board of Patent Appeals and Interferences ("the Board") should support obviousness rejections. This decision is especially important in light of the US Supreme Court decision in *KSR International, Inc. v. Teleflex, Inc.*, 550 U.S. 398 (2007), which removed the requirement of a teaching, suggestion, or motivation to combine prior art references for an obviousness rejection. However, as the *Vaidyanathan* Court reiterated, *KSR* did not remove the requirement to explain how a person of ordinary skill in the art would select and apply the references. *Vaidyanathan* at 16.

The *Vaidyanathan* application disclosed controlling a munition, vehicle, or aircraft by processing sensor information with a neural network to obtain a trajectory. The Examiner rejected claims 1-11 as obvious in view of the prior art. The rejection of claims 1-9 was subsequently affirmed by the Board. *Vaidyanathan* at 2. Specifically, the Board found that the advantages of the prior art "would have been obvious to a person of ordinary skill in the art, as this would involve nothing more than the predictable use of prior art elements according to their established functions." *Id.* citing *Ex parte Vaidyanathan*, No. 2008-2867 10 (B.P.A.I. March 11, 2009).

The Federal Circuit objected to the Board's lack of evidentiary support or reasoning to explain the conclusion of obviousness. *Id.* at 16. Indeed, the Court said "assertions of what such a person of ordinary skill would have found to be obvious require sufficient explanation to permit meaningful appellate review." *Id.* at 15. The Court found that both the Examiner and the Board did not provide any evidentiary support or reasons for why it was obvious to select and combine the features of the cited references. *Id.* at 16.

Yet, the Court did concede that when combining references, the Examiner "may include recourse to logic, judgment, and common sense available to a person of ordinary skill that do not necessarily require explication in any reference or expert opinion." *Id.* at 18, citing *Perfect Web Techs. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009). However, in "these cases the Examiner should at least explain the logic or common sense that leads the Examiner to believe the claim would have been obvious." *Id.*

Indeed, the Court held that conclusory statements alone should not be used when making obviousness rejections. *Id.* at 17. "Instead, the Examiner should elaborate, discussing the evidence or reasoning that leads the Examiner to such a conclusion." *Id.* Moreover, if the Examiner is unable to cite prior art references to demonstrate the state of knowledge, then an affidavit detailing the Examiner's own personal knowledge (as a person of ordinary skill in the art) could be submitted. *Id.* citing 37 C.F.R. § 1.104(d)(2).

In sum, the PTO cannot simply fall back on conclusory statements which apply common sense or being well known to reject an application as obvious. When making an obviousness rejection, the PTO should discuss the evidence and clearly articulate the rationale to support the legal conclusion of obviousness. Even if the reasoning for the rejection is sound, to be a proper rejection, it must be made of record to ensure the possibility for meaningful review. Accordingly, for this and other reasons, the rejection in *In Re Vaidyanathan* was vacated and remanded for further examination.