UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Wilfried JUD
and Hans-Rudolf Nageli

Appeal No. 2006-1061
Application No. 09/505,713
Technology Center 1700

Decided: 30 January 2007

Before FLEMING, *Chief Administrative Patent Judge*, and TORCZON, KRATZ, TIMM, JEFFREY T. SMITH, MOORE, and LINCK, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

The appellant, Jud et al. (Jud), requests reconsideration of the original panel hearing in the present appeal by the Board sitting en banc and reversal of the original decision.

A rehearing pursuant to 35 U.S.C. 6(b) and 37 C.F.R. § 41.52 on the points specifically raised in the request is GRANTED;

the suggestion to rehear the request en banc is DECLINED, but the panel for rehearing has been expanded; and

the requested relief is DENIED.

Throughout the request, Jud argues that the Board misapprehended or overlooked the requirement that a determination of the level of ordinary skill in the art must be made in the record as part of an obviousness determination. The request presents four distinct issues: first, what determination must be made; second, from what evidence is such a determination made; third, whether such a determination was in fact made; and finally, to the extent the original decision failed to make such a determination, was the failure prejudicial error such that the decision must be set aside.

A. What determination must be made?

An obviousness determination is grounded in 35 U.S.C. 103(a), which provides in part:

> A patent may not be obtained...if 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 the subject matter pertains.

The language of the statute suggests that the "ordinary skill in the art to which the subject matter pertains" may be a contested issue in determining obviousness. The Supreme Court has elaborated that:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give

> light to the circumstances surrounding the origin of the subject matter sought to be patented.

Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). These four determinations have come to be known as the *Graham* factors. The Board immediately adopted *Graham* as a source of authority in determining obviousness. *See, e.g., Ex parte Rachlin*, 151 USPQ 56, 57 (Bd. Pat. App. [1] 1966) (affirming obviousness rejections against some, but not all, claims). The Board continues to follow the guidance of *Graham* today. *See, e.g., In re Kahn*, 441 F.3d 977, 985 78 USPQ2d 1329, 1334-35 (Fed. Cir. 2006).[2]

The skill-level determination is an important guarantee of objectivity in an obviousness analysis. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 1324, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). Neither the statute nor the *Graham* factors, however, prescribe a specific format for the skill-level determination. There are several pragmatic reasons for this flexibility. The nature and sources of evidence for skill level and the manner in which it is contested vary widely from case to case. *E.g., In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (various factors may be considered, but in a given case some may predominate and others may be absent). At its core, however, the question of the level of ordinary skill in the pertinent art boils down to a question of what the hypothetical person with such skill would have known (and known how to do). *E.g., Kahn*, 441 F.3d at 988, 78 USPQ2d at 1337 ("...the level of skill in the art—i.e., the

---

[1] The immediate predecessor to the present Board.

[2] The request includes an extensive new argument about the applicant's understanding of United States Patent and Trademark Office and Department of Commerce policy. The argument is internally inconsistent and factually incomplete. It is also, however, moot in view of the Board's long-standing history of following the *Graham* factors.

understandings and knowledge of persons having ordinary skill in the art at the time of the invention....").

B. *Evidence for determining the ordinary level of skill*

The applicant's disclosure provides a starting point for determining the level of skill in the art, followed by references and additional testimony, if any.

1. *The applicant's disclosure*

The disclosure is present in every examination and provides the applicant's views of the skill level at the time of filing. The disclosure is particularly helpful when it describes the background to the invention and the applicant's contribution to the art. Care must be exercised, however, to ensure that the applicant's contribution is not itself mistaken as an admission regarding the pre-existing knowledge and skill in the art.

Evidence of the skill level in the disclosure tends to be indirect.[3] The disclosure must, however, "enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use" the invention. 35 U.S.C. 112(1). Thus, an enabling disclosure implies a minimum base of technical knowledge and ability for "any person" skilled in the pertinent art at the time of filing. *E.g., Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1156, 72 USPQ2d 1190, 1200 (Fed. Cir. 2004) ("[A] patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art.").

The disclosure sets a floor rather than a ceiling on the level of skill. Moreover, it may be wrong—leading to a rejection under § 112(1). The

[3] Few patent disclosures provide express statements of the level of skill in the pertinent art. Fewer still include statements like "A person of skill in this art has a Ph.D. in...."

assessment of enablement may, however, prompt more direct evidence regarding the level of skill in the art. *E.g.*, *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569, 7 USPQ2d 1057, 1063 (Fed. Cir. 1988) (affirming use of statements made during prosecution regarding undue experimentation as evidence of the level of skill in the art).

2. *References*

References are also a part of an examination leading to an obviousness rejection. Prior art references are cited precisely because they show what those skilled in the art would have known and been able to do before the effective filing date for the application. When used in combination, prior art references may even reveal a continuum of knowledge and ability greater than the sum of their separate, express disclosures.

References are typically indirect in their teachings regarding the skill level in the art. Moreover, the teachings may sometimes be incomplete since explaining the skill level in the art is rarely the intended purpose of a reference. References are generally entitled to great weight, however, because they are almost always prepared without regard to their use as evidence in the particular examination in which they are used. *See, e.g.*, *Velander v. Garner*, 348 F.3d 1359, 1371, 68 USPQ2d 1769, 1778 (Fed. Cir. 2003) (contrasting preexisting references and litigation-inspired testimony from the authors of the references). Other references, even if not cited as a basis for the rejection, may be similarly probative of the skill level.

3. *Declarations and other testimony*

Testimony is the least common source of evidence for the level of skill in an art during examination. Generally, it is provided by the applicant with little opportunity for direct challenge from the examiner. A declaration well-grounded in facts may be quite probative, however, particularly if it

directly addresses the level of skill in the pertinent art at the relevant time. *Compare In re Oelrich*, 579 F.2d 86, 91-92, 198 USPQ 210, 214 (CCPA 1978) (fact-based affidavits are probative) *with In re American Academy of Sci. Tech Ctr.*, 367 F.3d 1359, 1368, 70 USPQ2d 1827, 1833 (Fed. Cir. 2004) (broad discretion to discount unsupported testimony). Testimony contrary to the other evidence of record may, however, be accorded little weight. *E.g.*, *GPAC*, 57 F.3d at 1579-80, 35 USPQ2d at 1121.

Two common types of testimony regarding skill level, however, are in themselves typically insufficient: (1) what education and work experience the hypothetical person of skill had and (2) whether the skill level was high or low. A statement that "a person of ordinary skill in the art had a Ph.D. in X and 7 years of relevant experience in Y" assumes that the reader already appreciates what such a person would have known.[4] A statement about education level and work experience could be relevant but only to the extent that it supports more direct evidence of what one of skill would have known (and known how to do). Indeed, the basis for a stated education level and work experience (if any is given) tends to be whatever would be necessary to understand and use references in the pertinent art. A statement that "the level of skill was high" is a summary of specific findings about the level of skill rather than a finding in itself.

The recent decision in *DyStar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 80 USPQ2d 1641 (Fed. Cir. 2006), shows how unhelpful the education level and work experience findings can be. The jury appeared to

[4] A number of recent non-binding decisions of the Board have made this same point. *E.g.*, *Univ. of California v. Children's Medical Center Corp.*, 79 USPQ2d 1029, 1032-33 (BPAI 2005); *Scripps Research Inst. v. Nemerson*, 78 USPQ2d 1019, 1025 (BPAI 2005); and *Argyropoulos v. Swarup*, 56 USPQ2d 1795, 1807 (BPAI 2000).

have determined a skill level based on testimony and then used its skill-level determination to disregard a century's worth of prior art. *Id.* at 1362-63, 80 USPQ2d at 1646-47. Understandably, the court held that the jury's determination lacked substantial evidence. We take *DyStar Textilfarben* as confirmation that a skill-level determination must not be at odds with what the prior art actually teaches about the art.

C. Was the level of skill actually determined?

In explaining her final rejection, the examiner reiterated what she believed one of skill in the art would understand based on the Breitler and the Muggli[5] references (Final Rej. at 3-4; Ans. at 7). For example, the examiner—

> ...further notes that her interpretation **is consistent** with what is understood in the packaging art, note specifically, the attached Muggli (USPN 5,968,663, commonly owned to Alusuisse Technology & Management) which also utilizes the same language as the commonly assigned Breitler et al....

(Final Rej. at 4, original emphasis). While the examiner did not have an expressly denominated finding regarding the level of skill in the art, Jud was on notice about what the examiner thought one of skill in the art would have known and why.

The original panel in this case certainly understood the examiner's basis with regard to the level of skill in the art. Indeed, when affirming the examiner's obviousness rejection, the panel specifically discussed what a

---

[5] The Examiner relied on Muggli only "as an evidentiary reference to rebut Appellants' arguments that the Examiner's interpretation of Breitler was incorrect and inconsistent with the art." Ans. at 9. *See also* Dec. at 11-12. As such, the Examiner applied Muggli to illustrate the level of skill in the art and also to show that Breitler, the reference supporting the prior art rejection, reflected that level of skill.

person of ordinary skill would have known in terms of references of record (*e.g.*, Dec. at 9).

The panel also specifically addressed Jud's argument that the examiner had not made a finding about the level of skill in the art (Dec. at 12). The panel indicated that it was satisfied with the examiner's reliance on the prior art for this purpose and noted that Jud had not provided any substantive reason to suppose that the prior art was not used appropriately as evidence of the level of skill.

On rehearing, Jud's request continues the approach of narrowly challenging the form of the skill-level finding rather than pointing to evidence that would support a materially different finding. The request does not attempt to demonstrate that the decision was wrong on the merits of the obviousness rejection, but instead focuses on the form of the opinion. The request does not point to any specific evidence that would require setting the decision on the merits aside.

Although Jud's disclosure is of record, neither the examiner nor Jud appears to have relied on it as a source of evidence regarding the level of skill. The examiner relied on the cited references as evidence of the skill level. Jud points out that many other references are of record (Req. at 9), but does not specifically point out how any of them would apply in determining the skill level. Jud also points to testimony from Breitler[6] (Req. at 8), but again does not explain how the testimony would lead to different findings regarding the level of skill. Breitler did not testify directly to the level of skill in the art, concentrating instead on the intended meaning of the

[6] Breitler is a named inventor of the Breitler patent and an employee of a "sister company" of the real party-in-interest for the present application (Breitler decl. at 1).

reference bearing his name. Thus, the relevance of the Breitler testimony stems from what its discussion of the Breitler patent would imply about the knowledge and ability of a person having ordinary skill in the art. The examiner and the original panel both considered Breitler's testimony regarding the Breitler patent but discounted its value because they considered Breitler's interpretation of his patent to be too narrow. The request neither asks us to rehear this finding nor points us to evidence requiring a different finding.

By outlining what one would know from references, the examiner met her burden to establish the skill level in the way it is typically met during examination. Since Jud failed to argue or provide a persuasive basis for a different finding, the original Board panel used the same methodology to make essentially the same findings. Procedurally the skill-level findings can—at most—be faulted for failing to be explicitly labeled as such. Jud's position that no skill-level finding was in fact made is simply wrong.

D. Was there prejudicial error?

Assuming, *arguendo*, that the original panel did fail to make a required finding about the skill level, our analysis would not be at an end. Jud cites *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), for the proposition that the Administrative Procedure Act [APA] requires the Board's decision to be full and reasoned such that it is amenable to judicial review. Significantly, however, the last sentence of the APA regarding judicial review states:

> In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

5 U.S.C. 706. A similar provision governs review of court decisions. 28 U.S.C. 2111. Both statutes reflect the pragmatic Congressional policy that a defect in a decision should not be used to reverse the decision unless some harm has resulted. A Board rehearing is not, of course, subject to either of these statutes, but the policy behind these statutes makes sense in this context as well.

Significantly, our principal court of review has from its earliest days assiduously followed the prejudicial error statutes. For example:

> We also find no error in the Board's determination of the level of ordinary skill in the art. Appellants contend that the Board erred by not more precisely identifying the level of ordinary skill in the art, and argue that the Board should have found a person with ordinary skill to be "a golfer, golf professional and/or golf course manager." (Appellants' Br. at 37.) But appellants have not shown how a different, more precise definition of the pertinent art would have changed the result.

In re Huston, 308 F.3d 1267, 1279 n.8, 64 USPQ2d 1801, 1809 n.8 (Fed. Cir. 2002) (affirming decision on ex parte appeal).

> While it is always preferable for the factfinder below to specify the level of skill it has found to apply to the invention at issue, the absence of specific findings on the level of skill in the art does not give rise to reversible error "where the prior art itself reflects an appropriate level and a need for testimony is not shown." *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163, 225 USPQ 34, 38 (Fed. Cir. 1985); *see also Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 963, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986) (excusing failure to make express findings as to the level of ordinary skill where there is no showing that the court's failure to make such a finding influenced the ultimate determination).

Okajima v. Bourdeau, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001) (affirming decision in interference).

> [A]n invention may be held to have been obvious (or nonobvious) without a specific finding of a particular level of skill or the reception of expert testimony on the level of skill where, as here, the prior art itself reflects an appropriate level and a need for such expert testimony has not been shown.

Chore-Time Equip., Inc. v. Cumberland, 713 F.2d 774, 779 n.2, 218 USPQ 673, 676 n.2 (Fed. Cir. 1983) (affirming court decision of invalidity).

Jud has pointed to the reservation in *Okajima* regarding the need for testimony, and we note a similar reservation in *Chore-Time Equip. Inc.*, but Jud has not explained its relevance in this case. The only cited testimony, Breitler's declaration, lacks any direct testimony on skill level, but was considered for what it had to say about the Breitler patent.

Curiously, the request does not urge alternative findings on skill level that the Board should have made, does not point to other findings that would have to change in view of a properly determined skill level, and does not even explain whether and why the obviousness determination as a whole is wrong on the merits. There is no point to undoing the original panel decision in the absence of some indication that it would make a difference in the ultimate outcome. *Cf. McNally v. Mossinghoff*, 673 F.2d 1253, 1254, 213 USPQ 281, 281 (CCPA 1982) (holding no abuse of discretion in declining to perform a useless act).

Special note regarding claim 51

The original panel stated that:

> Appellants' representative in the Hearing...indicated that the appeal as to the subject matter of claim 51 is withdrawn. Thus, we summarily affirm the Examiner's § 103 rejection of claim 51.

(Dec. at 6). The request for rehearing does not specifically address any claim, much less claim 51. Since the affirmance of the rejection of claim 51

was based on the withdrawal of the appeal for claim 51, we construe the request for rehearing to be directed at all of the rejected claims with the exception of claim 51.

DECISION

The request for rehearing has been considered, and the panel on rehearing has been expanded, but relief on the merits is—

DENIED

MICHAEL R. FLEMING
Chief Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

JAMES T. MOORE
Administrative Patent Judge

NANCY J. LINCK
Administrative Patent Judge

Board of Patent Appeals and Interferences

RT/mg

FISHER CHRISTEN & SABOL
1725 K STREET NW
SUITE 1401
WASHINGTON, DC 20006