

Appendix III - 35 U.S.C. 103 Rejections
PatentEducationSeries.com

2158 AIA 35 U.S.C. 103

2146 Pre-AIA 35 U.S.C. 103(c)

2145 Consideration of Applicant's Rebuttal Arguments

2144 Supporting a Rejection Under 35 U.S.C. 103

Copyright © 2016 Intellectual Properties Enterprises, Inc

706.02(j) Contents of a 35 U.S.C. 103 Rejection

706.02(k) Provisional Rejection (Obviousness) Under 35 U.S.C. 103 Using Provisional Prior Art Under Pre-AIA 35 U.S.C. 102(e)

706.02(l) Rejections Under Pre-AIA 35 U.S.C. 103(a) Using Prior Art Under Only Pre-AIA 35 U.S.C. 102 (e), (f), or (g)

706.02(l)(1) Rejections Under Pre-AIA 35 U.S.C. 103(a) Using Prior Art Under Pre-AIA 35 U.S.C. 102(e), (f), or (g); Prior Art Disqualification Under Pre-AIA 35 U.S.C. 103(c)
706.02(l)(2) Establishing Common Ownership or Joint Research Agreement Under Pre-AIA 35 U.S.C. 103(c)
706.02(l)(3) Examination Procedure With Respect to pre-AIA 35 U.S.C. 103(c)
706.02(n) Biotechnology Process Applications; pre-AIA 35 U.S.C. 103(b)

2141 Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103

2141.01 Scope and Content of the Prior Art 2141.01(a) Analogous and Nonanalogous Art
2141.02 Differences Between Prior Art and Claimed Invention
2141.03 Level of Ordinary Skill in the Art

2142 Legal Concept of Prima Facie Obviousness

2143 Examples of Basic Requirements of a Prima Facie Case of Obviousness

2143.01 Suggestion or Motivation To Modify the References
2143.02 Reasonable Expectation of Success Is Required
2143.03 All Claim Limitations Must Be Considered

2144.01 Implicit Disclosure
2144.02 Reliance on Scientific Theory
2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art
2144.04 Legal Precedent as Source of Supporting Rationale

2144.05 Obviousness of Similar and Overlapping Ranges, Amounts, and Proportions

2144.06 Art Recognized Equivalence for the Same Purpose
2144.07 Art Recognized Suitability for an Intended Purpose
2144.08 Obviousness of Species When Prior Art Teaches Genus

2144.09 Close Structural Similarity Between Chemical Compounds (Homologs, Analogues, Isomers)

I. OVERLAPPING, APPROACHING, AND SIMILAR RANGES, AMOUNTS, AND PROPORTIONS

A. Optimization Within Prior Art Conditions or Through Routine Experimentation

B. There is a Motivation to Optimize Result-Effective Variables

II. ROUTINE OPTIMIZATION

A. Showing That the Change Is Critical

B. Showing That the Prior Art Teaches Away

III. REBUTTAL OF PRIMA FACIE CASE OF OBVIOUSNESS