



SHIMOKAJI & ASSOCIATES, P.C.

Intellectual Property Lawyers
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NEWSLETTER

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We specialize in the litigation and registration of patent, trademark, and copyright matters. The clients we serve range from start-ups to Fortune 500 companies, government entities, and universities. Though located in the US, our expertise and representation has an emphasis in Asia.

— LATEST NEWS & EVENTS —

Seminars in Taiwan to Address US Patent Issues

During the month of December, the firm's managing partner Michael Shimokaji will be conducting a series of seminars in Taiwan. These seminars will address US patent litigation and prosecution strategies, including problems that face Taiwan enterprises and how to avoid those problems. Mr. Shimokaji will also provide an update on recent Federal Circuit decisions that impact Taiwan enterprises.

More information can be obtained at info@shimokaji.com

New USPTO Guidelines for Obviousness

These guidelines indicate that KSR is not a replacement of a single test for obviousness--the teaching-suggestion-motivation (TSM) test--with the seven rationales listed in the 2007 KSR Guide lines.

The 2007 Guidelines indicated that the TSM test was one possible approach. However, six other rationales could be used: (1) combining prior art elements according to known methods, (2) simple substitution of elements to obtain predictable results, (3) use of a known technique to improve similar things, (4) applying a known technique for improvement to yield predictable results, (5) obvious to try, and (6) known work in one field may prompt variations in the same or different field.

According to the 2010 Guidelines, factual findings are required. If a rejection has been made that omits one of the required factual findings, and in response to the rejection the applicant points out the omission, the examiner must either withdraw the rejection, or repeat the rejection including all required factual findings.

A strict TSM approach, according to the 2010 Guidelines, is not the only way to establish a prima facie case of obviousness. The Guidelines point out that familiar lines of argument still apply, including teaching away from the claimed invention by the prior art, lack of a reasonable expectation of success, and unexpected results. .

Case examples in the 2010 Guidelines are grouped according to the 2007 Guideline rationales. The first three groups correspond directly with three of the 2007 rationales. These rationales are combining prior art elements, substituting one known element for another, and obvious to try. The fourth group concerns consideration of evidence during prosecution.

The text of the guidelines can be found at <http://edocket.access.gpo.gov/2010/2010-21646.htm>

