

Federal Circuit Patent Bulletin: *Q.I. Press Controls, B.V. v. Lee*

June 16, 2014

"We do not hold that the Board should always apply references that are before it affecting some claims to every other claim on appeal, but we do find that in this instance, in which nearly identical claims were found both valid and invalid due to similar combinations of prior art resulting in a Board opinion that was seemingly inconsistent, the Board erred by not considering the [prior art combination giving rise to this inconsistency] . . . as a new ground for rejection"

On June 9, 2014, in *Q.I. Press Controls, B.V. v. Lee*, the U.S. Court of Appeals for the Federal Circuit (Lourie,* Bryson, Hughes) affirmed-in-part, vacated-in-part, and remanded the USPTO Board of Patent Appeals and Interferences' decision in an inter partes reexamination that reversed both the examiner's obviousness rejection of claims 1-17 and 19-60 and written description rejection of claims 14 and 24 of U.S. Patent No. 6,867,423, which related to a visual inspection system for printing presses. The Federal Circuit stated:

In PTO reexaminations, "the standard of proof—a preponderance of the evidence—is substantially lower than in a civil case' and there is no presumption of validity in reexamination proceedings." . . . A claim is invalid for obviousness if, to one of ordinary skill in the pertinent art, "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" "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." In assessing this question, assessment of proffered evidence of non-obviousness must be part of the inquiry,

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even in the reexamination context. . . .

Sainio teaches a printing press incorporating a single high intensity illumination system. That illumination system is used to detect misalignments in the printing press and to adjust the system accordingly. Ross discloses a circular LED lighting configuration consisting of a plurality of LEDs surrounding an optical sensor. As the Board correctly found, it would have been obvious for one of skill in the art, in seeking alternatives to a single high intensity light, to increase the number of light sources and utilize LEDs, teachings found in Ross. Additionally, incorporating multiple light sources in a configuration that would permit a high level of multidirectional lighting would obtain the predictable result of a greater degree of illumination. The Board thus did not err in concluding that claims 61-72 would have been obvious over Sainio in view of Ross. . . .

The written description is a statutory requirement set forth in 35 U.S.C. § 112. The test for written description is that it “must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” The disclosure must “convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” [Substantial evidence] supports the Board’s conclusion that claim 18 is invalid due to an inadequate written description because the written description does not disclose a physically unsupported substrate at the point of illumination. . . .

[T]he Board has the discretion to issue a new ground of rejection if it has knowledge of one. In those instances, the “Board must designate its decision a new ground of rejection and provide the appellant with an opportunity to respond.” If a new ground of rejection is included in the opinion, the patentee then has the option to either reopen prosecution before the examiner or request rehearing. Here, when all these references were before the Board, and this court, an obligation is owed to the public not to permit inconsistent results when a proper challenge to that inconsistency is made on appeal. The Board should have observed the similarities between the claims, noted those similarities between the claims and the references before the Board on appeal, analyzed whether the combination of Sainio and Ross would have rendered claims 1-60 obvious, and if so, issued a new ground of rejection. The combination of Sainio and Ross was before the Board on appeal because those references were cited by the examiner to invalidate claims 61-72. And, given the minor differences between the claims, the Board “[had] knowledge of . . . grounds not raised in the appeal for rejecting [claims 1-60].” We do not hold that the Board should always apply references that are before it affecting some claims to every other claim on appeal, but we do find that in this instance, in which nearly identical claims were found both valid and invalid due to similar combinations of prior art resulting in a Board opinion that was seemingly inconsistent, the Board erred by not considering the combination of Sainio and Ross as a new ground for rejection of claims 1-60. Accordingly, we vacate the Board’s decision to the extent that it holds that claims 1-60 would not have been obvious and remand that portion of the case for

further proceedings consistent with this opinion.