



PTAB Designates as Informative Two Decisions Regarding Examiners' Use of "Design Choice" Rationale

By: Clinton H. Brannon

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On October 15, 2019, the PTAB designated as informative two decisions providing insight into when it is appropriate for an examiner to rely upon a so-called "design choice" rationale in support of an obviousness rejection. This doctrine is appropriate only when noncritical design features differentiate a claimed invention from the prior art. Under such circumstances, when the chosen design fails to result in a different function, or does not provide unexpected results, then the design choice cannot serve as the basis for overcoming an obviousness rejection.

As is often the case when the PTAB designates decisions in pairs, one decision upheld a rejection where an examiner correctly qualified certain elements as noncritical obvious design choices, while the other decision reversed a rejection based on similar grounds. Taken together, these decisions communicate a clear message: an examiner may rely upon a design choice rationale for an obviousness rejection under certain circumstances, but examiners should fall back on such an argument sparingly and offer a detailed justification when doing so.

Specifically, in *Ex parte Spangler*, Appeal No. 2018-003800 (Feb. 20, 2019), appellants claimed invention related to "a featherseal for turbine engine components such as vanes and blade outer air seals." *Id.* at 2. The examiner found that it would be obvious to combine two pieces of prior art which together disclosed the critical elements of the invention. Appellants argued that the examiner wrongly dismissed critical inventive design features by finding them to be no more than obvious design choices. The PTAB upheld the examiner's rejection, stating that "Appellants fail to persuade us that the examiner's determination that the particular relative lengths and positioning of the tabs solve no stated problem and would have been an obvious matter of design choice is incorrect." *Id.* at 8.

In contrast, in *Ex parte Maeda*, Appeal No. 2010-009814 (Oct. 23, 2012), appellants claimed invention related to "a frozen dessert manufacturing apparatus" wherein a "combined passage member" positioned "inside cold storage" "combines dessert mix and air before entering a cooling cylinder." *Id.*

at 4. In rejecting appellants' claims as obvious, the examiner cited pieces of prior art and then summarily categorized the decision to place the combined passage member in cold storage as only a noncritical, obvious design choice. See *id.* at 5-6. The PTAB admonished the examiner for 'fail[ing] to provide reasoning based upon rational underpinnings to explain why a skilled artisan would have moved the combined passage member . . . to cold storage.' *Id.* at 6. The PTAB stated that examiners should be 'discourage[d] . . . from relying on 'design choice' because it is generally a mere conclusion, which is no substitute for obviousness reasoning based on factual evidence.' *Id.*

While *Ex Parte Spangler* is a recent decision, *Ex Parte Maeda* dates back to 2012. By designating these two decisions as informative at this time, the PTAB provides further guidance to examiners and applicants on the metes and bounds of the 'design choice' doctrine. In particular, when the specification of the patent application provides a description of the benefits or results provided by the purported design choice, such evidence will weigh in favor of non-obviousness. *Id.* at 4, 7. For additional information regarding practice before the PTAB please contact Clint Brannon or Janet M. Smith.

Related People

- Clinton H. Brannon ? 703.760.5226 ? cbrannon@williamsmullen.com

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