

## The Inherency Doctrine: A Performance Review

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The doctrine of inherency is relatively straight forward and there is very little subjectivity in the proper analysis. Nevertheless, both Patent Examiners at the USPTO and many Applicants struggle to conduct a proper analysis under this doctrine.

The USPTO takes the position that “the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.”<sup>1</sup> Whether a property is inherent or not is a question of fact,<sup>2</sup> the fact in question being, does the claimed property inherently occur in the prior art. With regard to defining inherency in the context of patent law, the Federal Circuit held in *In re Robertson* that, “It is well-settled that inherency cannot be established by mere probabilities or possibilities.”<sup>3</sup> As recent as 2016, the Federal Circuit citing *Robertson* offered the further definition that, “Inevitability is at the heart of inherency; that a certain thing may result from a given set of circumstances is not sufficient.”<sup>4</sup>

In the prosecution of a patent application at the USPTO, use of the Inherency Doctrine has essentially two phases:

1. Construction of a Prima Facie case of anticipation or obviousness using the doctrine;
2. Evaluating rebuttal evidence by the applicant under the doctrine.

In the first phase, the Examiner may use inherency to supply a missing claim limitation but bears the burden of providing, for example, “some evidence or scientific reasoning to establish the reasonableness of the Examiner’s belief that the functional limitation is an inherent characteristic of the prior art.”<sup>5</sup> In the

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<sup>1</sup>MPEP § 2112(I) (citing *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)).

<sup>2</sup>MPEP § 2112 (citing *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)) (“The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.”).

<sup>3</sup>*In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

<sup>4</sup>*Howmedica Osteonics Corp. v. Zimmer, Inc.*, 640 Fed. Appx. 951, 957 (Fed. Cir. 2016).

<sup>5</sup>See *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BPAI 1986); See also *Par Pharm., Inc. v. TWI Pharm. Inc.*, 773 F.3d 1186, 1194-1195 (Fed. Cir. 2014).

second phase, the burden shifts to Applicants to provide proof that the claimed functional limitation is not, in fact, inherent to the claimed structure or composition.<sup>6</sup> Rebuttal evidence has been described by the Federal Circuit as “merely a showing of facts supporting the opposite conclusion.”<sup>7</sup>

Generally the Inherency Doctrine is properly used during prosecution of a patent where the Examiner cannot find disclosure or a teaching in the prior art of a claimed property but can otherwise reasonably assert that claimed structure or composition exists in the prior art.

For example, consider a claim directed to a composition having components A, B, and C, wherein the composition possesses property X. In this hypothetical case, the Examiner cites to prior art teaching the combination of components A, B, and C in a composition but is unable to locate any teachings that such a composition possesses property X. In such circumstances, the Inherency Doctrine allows the Examiner to construct a prima facie case of anticipation or obviousness under the assumption that a composition having the same components would inherently have the same properties, including the one being claimed by Applicants but not taught by the prior art.<sup>8</sup> The above is a reasonable logical leap further justified considering that, “the Patent Office is not equipped to manufacture products and make physical comparisons therewith.”<sup>9</sup>

The procedural function of the Examiner making a prima facie case based on the Inherency Doctrine is to shift the burden to Applicants to prove that the claimed property is not in fact inherent.<sup>10</sup>

Satisfying this rebuttal burden is most directly achieved by providing an example which is strictly within the claimed structure/composition but lacks the claimed property.<sup>11</sup> In the example composition above, Applicants would be required to show that a composition which has components A, B, and C does not inherently possess property X. Providing even one such example is sufficient to overcome a prima facie case based on the Inherency Doctrine because even a single example proves that the claimed property is not inevitably or inherently tied to the claimed structure/composition.<sup>12</sup>

Another way to think about this issue is that by proving that the claimed property does not necessarily occur in a claimed structure or composition, Applicants are showing that by including this property in the claim, they are actually reducing the scope of the claim. That is, a composition having components A, B, and C is broader in scope than a composition having components A, B, and C and possessing property X. This would not be true if, in fact, property X was inherent to a composition having components A, B, and C. Therefore, claims directed to components A, B, and C and possessing property X are dis-

<sup>6</sup> See *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

<sup>7</sup> *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

<sup>8</sup> See *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997); See also MPEP § 2112 (V).

<sup>9</sup> MPEP § 2113 (III) (regarding evaluating product by process claims with similar logic).

<sup>10</sup> *Best*, 562 F.2d 1252, 1255 (CCPA 1977) (stating, “[w]here . . . the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”).

<sup>11</sup> See *Ex parte Watanabe*, No. 2016-5113, 2017 BL 311735 (P.T.A.B. August 25, 2017) .

<sup>12</sup> *Id.*

tinguished from the prior art teaching components A, B, and C but not property X.

Upon a showing that the claimed property is not inherent the rejection must be withdrawn. The Examiner has the option of providing additional teachings from the prior art directly showing the presence of the claimed property in a standard prima facie case of anticipation or obviousness, but may no longer rely upon inherency.

## Measuring how Applicants and Examiners are handling the Inherency Doctrine

In order to properly evaluate how the Examiners and Applicants are handling the Inherency Doctrine there is a need for a method for objectively measuring this single argument type. The method used herein, relies on decisions by the Patent Trial and Appeal Board (PTAB) as a proxy for determining whether an Examiner was correct or not when rejecting a particular claim under the Inherency Doctrine. The method compares Examiner affirmance and reversal rates in rejections which relied on the Inherency Doctrine to general affirmance and reversal rates of the same type, i.e., anticipation or obviousness.

The data below was acquired by reviewing every PTAB decision from December 1, 2016 to December 1, 2018 which included the word "Inherency." Each decision was reviewed to determine whether the Inherency Doctrine was actually at issue. In the cases where the Inherency Doctrine was at issue, the decision of the case was recorded.

The data is separated by Technology Center and by whether the rejection was made in the context of anticipation or obviousness. This data is then compared to the general rates of reversal/affirmance of anticipation and obviousness rejection types.<sup>13</sup>

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<sup>13</sup>Ryan Pool, *Should You Appeal? A Look at Success Rates Before the PTAB on an Individual Rejection Basis*, 100 J. PAT. & TRADEMARK OFF. SOC'Y 320 (2018).

## Inherency Rejection Data

Tech Center	102 Affirmed	102 Reversed	103 Affirmed	103 Reversed
1600	53%	47%	64%	36%
1700	22%	78%	47%	53%
2100	26%	74%	35%	65%
2400	0%	100%	29%	71%
2600	13%	87%	50%	50%
2800	15%	85%	24%	76%
3600	30%	70%	39%	61%
3700	17%	83%	20%	80%

Table 1: PTAB's Reversal/Affirmance Rate of *ex parte* Appeals having Inherency Issues

For comparison, the general rates of reversal/affirmance of anticipation (35 USC 102) and obviousness rejection (35 USC 103) types are as follows:<sup>14</sup>

35 USC 102:	Affirmed 40.5%	Reversed: 50.5%	Affirmed-in-Part: 9.0%
35 USC 103:	Affirmed 49.7%	Reversed: 40.5%	Affirmed-in-Part: 9.7%

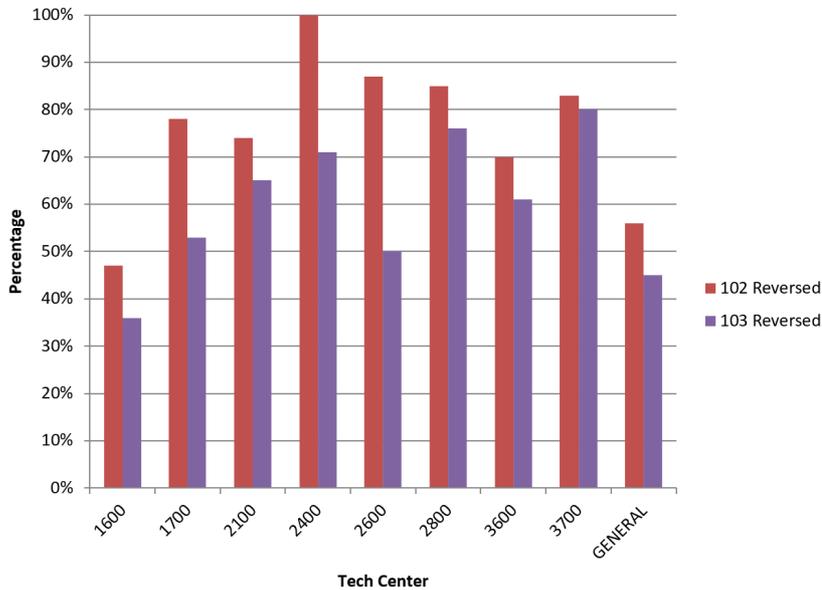
To account for Affirmed-in-Part percentage and allow for a more direct comparison to the data above the above data is converted to a general rate calculated by assuming the same affirmance to reversal ratio is maintained in the Affirmed-in-Part decisions.

35 USC 102:	General Affirmance Rate: 44.5% - Average Reversal Rate: 55.5%
35 USC 103:	General Affirmance Rate: 55.1% - Average Reversal Rate: 44.9%

Applicants have a small advantage when appealing anticipation rejections while Examiners have a similar advantage with obviousness rejection appeals. While the comparison to these general decision rates for rejections under 35 USC 102 and 35 USC 103 is not exactly a perfect comparison, it useful of viewing the data in a relevant context.

For ease of comparison the above data is compiled in the graph below. The graph shows the reversal rates for rejections based on inherency. The data is organized by Technology Center and the last data group is composed of the general rates of reversals for both rejections under 35 USC 102 and 35 USC 103.

<sup>14</sup>*Id.*



## Sample Sizes

Not shown above is the rate at which each rejection is appealed to the Board for each Technology Center. The total number of decisions reviewed over the two year period of the study is as follows:

Tech Center	102	103
1600	49	124
1700	32	139
2100	19	17
2400	9	17
2600	15	18
2800	34	38
3600	40	62
3700	66	118

Table 2: Total Decisions involving Inherency Doctrine over Two Year Period

Accounting for the fact that there is some overlap in the cases above, the PTAB hears about 300-350 cases a year involving the Inherency Doctrine.

## Analysis of Data

As can be seen from the data above, proper application of the Inherency Doctrine appears to be a problem area for most Examiners. Rejections both under 35 USC § 102 and 103 see a substantial increase in their reversal rates when the rejection is based on inherency. All but one Technology Center has a reversal rate which is higher when an inherency is required to support a rejection as compared to a generic rejection under 35 USC § 102 or 103. Also, the best performing Technology Center (1600) is only slightly better than a generic rejection while the worst performing Technology Center (3700) has a reversal rate almost double the average when asserting inherency in a 35 USC § 103 rejection.

The reversal rates do not appear to be related to the number of inherency rejections appealed by a particular Technology Center. That is, whether a Technology Center makes fewer or more rejections relying upon inherency does not appear to determine their performance before the Board. For example, the reversal rates for the 3 largest samples (1600, 1700, and 3700) fall on the relative low end, middle, and high end of the data set, respectively.

While properly applying the Inherency Doctrine appears to be a general problem for most Examiners, the relative degree to which this is a problem appears to be Technology Center dependent. It is difficult to determine exactly why reversal rates among Technology Centers have such a high variance. It may simply be a training issue. However, an alternative possible explanation (or contributing factor) might be found in the nature of the inventions each Technology Center examines.

Technology Centers 2800 and 3700 have the highest reversal rates for inherency rejections. These Technology Centers tend to examine tangible articles of manufacture where the claims are defined by physical structures. Specially, 2800 relates to "Semiconductors, Electrical and Optical Systems and Components," while 3700 relates to "Mechanical Engineering, Manufacturing and Products."<sup>15</sup>

Technology Centers 1600 and 2600 have the lowest reversal rates for inherency rejections. These Technology Centers tend to examine claims which are not defined by physical structures but instead chemical formulas and systems. Specially, 1600 relates to "Biotechnology and Organic fields," while 2600 relates to "Communications."<sup>16</sup>

Common mistakes made by Examiners with regard to the inherency analysis are discussed below. These common mistakes tend to be more applicable to inventions defined by physical structures. However, this evidence is only correlative. An actual cause for the relative differences between Technology Centers' reversal rates or the overall struggle Examiners seem to have with the Inherency Doctrine is not apparent from the data.

<sup>15</sup>See USPTO Technology Center definitions <https://www.uspto.gov/patent/contact-patents/patent-technology-centers-management> (last visited February 11, 2019).

<sup>16</sup>*Id.*

## Common Mistakes Made by Examiners Leading to Reversal on Appeal

A common mistake made by Examiners is to dismiss a functional limitation or claimed property as inherent without citing any evidence or technical reasoning to support the determination. For example, in *Ex parte Camille Schreiber* Applicants claimed a cosmetic product made of various components but also a spatula portion which was “configured to bend.”<sup>17</sup> The Examiner alleged that it would be obvious to combine the cited prior art to form the claimed product and that the product would inherently be confirmed to bend. The Board reversed the rejection on the basis that the Examiner failed to cite any evidence supporting the inherency finding.<sup>18</sup>

Another common mistake made by Examiners is to argue that a particular structural feature of a claim is inherently present. For example, in *Ex parte Duppert* the claims required a drive shaft having a locating feature for a counterweight.<sup>19</sup> The Examiner alleged that this feature was inherent because the prior art taught a drive shaft which must include the claimed locating feature of a counterweight for balance reasons.<sup>20</sup> The Board reversed the rejection on the basis that there were other possible ways to secure a counterweight.<sup>21</sup>

It will almost never be the case that a structural feature of a claim is inherent. Just like *Ex parte Duppert*, it will most likely be the case that some other possibility for the claimed structural feature exists. This possibility alone is sufficient to defeat an inherency allegation.<sup>22</sup> This mistake is made more frequently in art areas where the inventions are mechanical. As noted above, this issue may at least partially explain why, for example, Technology Center 3700 which provides examination for patent applications including Mechanical Engineering, Manufacturing and Products has the most appeals including inherency rejections and the highest rate of reversal of those inherency rejections.

Lastly, but perhaps the most common issue shared across all Technology Centers, is failure to properly consider evidence presented to refute a prima facie case of evidence.<sup>23</sup> Examiners often apply the wrong standard for evaluating Applicants’ presented evidence. Specifically, Examiners regularly confuse the standard for traversing a rejection based on inherency with the standard for showing unexpected results. Notably, in some cases this mistake may be

<sup>17</sup> *Ex parte Camille Schreiber*, Appeal No. 2018-000676, 2018 BL 337357 (P.T.A.B. August 31, 2018).

<sup>18</sup> *Id.* (stating, “The Examiner does not provide sufficient evidence or technical reasoning to establish that the use of these materials in Schefer or Ornoski must necessarily produce objects that are ‘configured to bend.’ See *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). Accordingly, the rejections cannot be sustained on the basis of inherency as set forth by the Examiner.”).

<sup>19</sup> *Ex parte Duppert*, No. 2015-8120, 2017 Pat. App. BL 275613 (P.T.A.B. August 4, 2017).

<sup>20</sup> *Id.* (“The Examiner further finds that the drive shaft inherently has a locating feature in that the balance weight of Ignatiev “must be fixing [sic] attached to the shaft in order to balance the eccentric motion of the orbit scroll.”).

<sup>21</sup> *Id.* (“As the Appellant points out, that the flat portion of Ignatiev to which the Examiner refers as the locating feature may be used to affix the counterweight (see Final Act. 4; Ans. 4) is not sufficient to establish the inherency of a locating feature, because there may be other possible ways to secure a counterweight.”).

<sup>22</sup> *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”).

<sup>23</sup> See *Watanabe*, Appeal 2016-5113, 2017 BL 311735.

correctable by petition.<sup>24</sup>

The burden for proving unexpected results is rightfully higher than refuting an inherency rejection. An unexpected results analysis has some degree of subjectivity. It requires consideration of Graham factors and making an obviousness determination based on the consideration of the evidence presented and the teachings of the cited prior art.<sup>25</sup> Inherency is a question of fact and requires inevitability.<sup>26</sup> A prima facie case of inherency can be defeated by a single example showing that the assumed fact is not necessarily true.<sup>27</sup> Notably, MPEP § 2112 which address the Inherency Doctrine, makes clear that once a prima facie case of obviousness is established, the burden shifts to applicants to show that the claimed property is not inherent. However, the MPEP fails to clearly articulate how applicants can satisfy this burden. This may be the cause for the general confusion of Examiners on this issue. Updating the MPEP to address this issue may be sufficient to resolve this issue.

### Common Mistakes Made by Applicants Leading to Affirmance

The most common argument made by Applicants in losing appeals to the PTAB is that the Inherency Doctrine is only applicable to anticipation rejections, not to obviousness rejections. This argument has a 100% loss rate and simply does not accurately reflect the current state of the caselaw.<sup>28</sup>

Applicants also lost many of their appeals based on their failure to properly identify when the Examiner has met their burden of establishing a prima facie case under the Inherency Doctrine. In these cases, Applicants did not provide any rebuttal evidence and merely argued that the Examiner did not provide sufficient proof that the property or functional limitation was inherent. This argument regularly fails where the claims and prior art composition or structure are identical or substantially identical. Under these circumstances the characteristics of this claimed product are assumed to be present in the prior art as well.<sup>29</sup> That is, to form a prima facie case under the Inherency Doctrine the Examiner need not prove that a claimed property is present if the prior art teaches an identical or substantially identical structure/composition to the claims.

Applicants also commonly failed to correctly identify when Examiners are relying upon inherency to support their prima facie case. In cases where the support for the prima facie case is unclear, Applicants should request clarification on the record before proceeding to appeal.<sup>30</sup>

<sup>24</sup> See the Decision on Petition in US 14/758,050 issued July 19, 2018.

<sup>25</sup> See *Graham v. John Deere Co.*, 383 U.S. 1 (1966); see also *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. at 406-07, 82 USPQ2d at 1391 (2007).

<sup>26</sup> *Howmedica Osteonics Corp. v. Zimmer, Inc.*, 640 Fed. Appx. 951, 957 (Fed. Cir. 2016); see also MPEP § 2112 (citing *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)); See also *Par Pharma., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186 (Fed. Cir. 2014).

<sup>27</sup> See *Watanabe*, No. 2016-5113, 2017 BL 311735.

<sup>28</sup> MPEP § 2112 (citing *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (“The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.”); See also *Par Pharma., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186 (Fed. Cir. 2014).

<sup>29</sup> *Best*, 562 F.2d at 1255.

<sup>30</sup> *KSR*, 550 U.S. 398, at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) for “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

Finally, while this is not a mistake per se, Applicants are missing opportunities to use the relatively favorable framework of the Inherency Doctrine to aid in the prosecution of cases where they have met substantial resistance using arguments under the more traditional obviousness framework. Two such instances are discussed in depth below.

## Inherency Doctrine Framework Useful Where a Meaningful Process Step Exists

Where an Applicant's invention includes a particular process step which imparts some desired property to the finished product, the Inherency Doctrine framework can be very useful. This is because Applicants can distinguish the prior art which does not teach the relevant process step without the necessity of claiming the process step.

Consider the example of this in *Ex parte Watanabe*.<sup>31</sup> In this case, Applicants claimed a toner including:

a releasing agent having a melting point of 60 C° to 75 C°; and  
a crystalline polyester resin having a melting point of 60 C° to 80 C°, and  
wherein the toner satisfies Formulae (1), (2), and (3):  
40C < X < 55C Formula (1),  
85C < Y < 92C Formula (2), and  
35C < Y - X < 50C Formula (3)

Applicants provided data in the form of two data points showing that even if the toner had the claimed releasing agent and claimed crystalline polyester resin, the toner would not satisfy Formulae (1), (2), and (3) unless the toner particles underwent an annealing step after pulverization.<sup>32</sup> Specifically, applicant's specification showed two otherwise identical compositions where one had undergone an annealing step after pulverization and one had not. The composition which had not undergone the annealing step after pulverization did not satisfy the claimed Formulae (1), (2), and (3).<sup>33</sup>

The annealing step after pulverization was not part of the claims. This did not matter. Instead the relevant showing to overcome a prima facie case based on inherency is only that the claimed composition does not necessary possess the claimed property. Therefore, the Board held, "Because Appellants have produced rebuttal evidence, they have met their burden of production." The Board also emphasized that the necessary showing to overcome a prima facie case under the Inherency Doctrine is minimal, holding, "The only actual data on record—scant though it may be—supports Appellants' theory that an annealing step is necessary before the prior art toner compositions will met claim 1's formulae."<sup>34</sup>

reasoning with some rational underpinning to support the legal conclusion of obviousness.").

<sup>31</sup> *Watanabe*, No. 2016-5113, 2017 BL 311735.

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*

<sup>34</sup> *Id.*

The Examiner in this case also made the common mistake referred to above of applying the unexpected results standard to a showing to the evidence of non-inherency. The Board specifically rejected this allegation that Appellants' evidence was "too narrow" and "not reasonably found to be commensurate in scope with broadly claimed embodiments" holding:

In this situation, this is an improper reason for discounting Appellants' evidence. Whether or not the proffered evidence is commensurate in scope with the claims is a proper consideration in assessing the sufficiency of evidence of unexpected results, where Appellants have the burden of establishing that the *claimed invention* provides unexpected results relative to the closest prior art. It, however, is not a proper consideration whereas here Appellants have the burden of rebutting a presumption that a *prior art composition* necessarily possesses or renders obvious the particular properties set forth in the claims. The scope of the claimed invention is not relevant to Appellants' burden regarding the latter question.

In view of the above, if applicant's invention involves a process step which imparts some desired property to the final product, an option for pursuit of patentability is to claim that property rather than the process step. A rejection relying on inherency can be overcome by a minimal showing that the claimed product without the process step does not possess the claimed property.

### When Unexpected Results Fail, Consider using the Inherency Doctrine Framework

The Inherency Doctrine framework can also be useful in cases where the Examiner has rejected data presented by Applicants to establish unexpected results as being insufficient for some reason. For example, imagine the following scenario:

A prima facie case of obviousness is presented based on a prior art range which partially overlaps the claimed range. Applicants have attempted to rebut the prima facie case of obviousness by pointing to data in their specification showing that certain points in the claimed range have a particular property X while some points outside the claimed range do not have that particular property X. The Examiner has considered the data and alleged that the showing is not sufficient to establish unexpected results for some reason, for example, the data is not commensurate in scope with the claims.

Assuming that the prior art does not teach property X, Applicants should consider amending their claims to directly claim property X. Doing so will likely illicit an inherency rejection where the Examiner will allege that property X is inherent in the claimed range taught by the cited prior art. To rebut this prima facie case, Applicants merely need to show that at least one data point within the claimed range does not have property X. Assuming the claimed range does not already include such a data point, Applicants can broaden their claimed range to include the closest counter example data point in their specification.

The combination of broadening the claimed range to encompass a data point which does not have property X while simultaneously requiring that the claims include property X should be sufficient to overcome the prior art without need to do battle in the arena of Unexpected Results.

The above strategy has practical advantages over arguing within the framework of Unexpected Results. For example, it is likely that additional data will not need to be provided.

Also, the Unexpected Results framework has a certain degree of subjectivity that is not present in the Inherency Doctrine framework. For example, a showing of Unexpected Results requires a determination regarding whether the showing provided by Applicants is commensurate in scope with the claims. This determination is largely subjective.<sup>35</sup> In contrast, a single example showing some point within the claimed structure/composition does not have the claimed property is sufficient to prove that the claimed property is not inherently possessed by the claimed structure/composition. There is little to no subjectivity to this determination.<sup>36</sup>

The Board in *Ex parte DAI-ICHI F R CO., LTD* was even kind enough to suggest the above strategy to Applicants.<sup>37</sup> In this case, Applicants argued that their claims possessed unexpected properties. The Board disagreed and affirmed the rejections of the Examiner. However, the Board also made an additional observation where it specifically suggested that Applicants could “further prosecute the application” by claiming the unexpected properties.<sup>38</sup> The Applicants in that case took the Boards advice and the application was allowed.

## Conclusion

Unlike many issues brought before the PTAB, the Inherency Doctrine is a question of fact which is almost entirely objectively determined. These are not case where reasonable minds can disagree. In other words, for the Inherency Doctrine to be brought before the Board, Applicants, the Examiner, or both must have made a clear error in their inherency analysis.

While the Inherency Doctrine only appears in about 300-350 appeals a year, these appeals could almost entirely be eliminated if Applicants and Examiners conducted a proper analysis under the doctrine. Eliminating the common mistakes discussed above would likely eliminate 90% of the appeals where the Inherency Doctrine is at issue.

<sup>35</sup> *In re Lindner*, 457 F.2d 506, 508 (CCPA 1972); “Commensurate in scope” means that the evidence provides a reasonable basis for concluding that the untested embodiments encompassed by the claims would behave in the same manner as the tested embodiment(s).

<sup>36</sup> MPEP § 2112 citing *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (“The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.”).

<sup>37</sup> *Ex parte DAI-ICHI F R CO., LTD*, No. 2013-001757 (P.T.A.B. July 25, 2013).

<sup>38</sup> *Id.* at 31 (holding that “[a]s noted earlier, we believe applicant has presented an impressive, albeit limited, showing of unexpected results of some embodiments within the scope of Claim 1. The results establish that the three desirable properties sought by applicant may be simultaneously achieved using limited combinations of elements within the scope of Claim 1. Applicant may wish to further prosecute the application on appeal with an amended Claim 1 limited to compositions (1) comprising the elements recited in Claim 1 and (2) having all three of the important properties identified above.”).

The USPTO should consider additional training and/or revision of the MPEP to more thoroughly address the entire Inherency Doctrine analysis, particularly in art areas which commonly examine tangible articles of manufacture. Applicants should consider strategic use of the Inherency Doctrine in cases where favorable evidence is available and where claiming a property or functional limitation does not create a predictable difficulty in proving infringement.

Proper treatment and strategic use of the Inherency Doctrine could reduce the total number of appeals to the PTAB and increase the efficiency of patent prosecution. This benefits both the USPTO and Applicants and results in high quality patents.