

## The Inherency Doctrine and How You Can Use it to Obtain Patents

### **Problem**

Imagine you are faced with an obviousness rejection in the US. You have presented your best evidence of unexpected results and narrowed your claims as much as is commercially acceptable. However, the Examiner is still rejecting your application.

Everyone who has relied on an unexpected results strategy to overcome a rejection will eventually realize that the weakness with the strategy is that the factors in consideration and the standards which must be met are very subjective. A stubborn Examiner can easily take the position that anything less than infinite evidence is insufficient.

### **Solution**

Avoid this subjective analysis completely in favor of the objective and predictable Inherency Doctrine analysis.

The following proposal uses the Inherency Doctrine to overcome this difficult situation but requires what can, at first, seem like a counter intuitive strategy.

### **Explanation of the Problem**

An anticipation or obviousness rejection based on the Inherency Doctrine most commonly occurs when applicants claim a property or function along with their structure or composition. The Inherency Doctrine allows the Examiner to reject the claims even when the prior art fails to teach the claimed property or function under the condition that the claimed property or function is inherent in the claimed structure. That is, the claimed property or function always occurs in the claimed structure.

An Inherency Doctrine analysis and an unexpected results analysis contain essentially the same components. Both are arguing that the claims should be patentable because they possess a particular property. The main difference is that claims which do not include the property must rely on a showing of unexpected results, while claims which do include the property must merely prove that the property is not inherent to the structure/composition of the claim. The latter being much more predictable and, in most cases, easier to satisfy.

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.

In the 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. Rebuttal evidence in the context of inherency is merely one example where the claimed property does not appear in the claimed structure/composition. This is entirely logical as inherency requires that the property is always/inevitably present in the structure/composition. Therefore, a single example showing the structure/composition without the property, definitively proves the property is not, as a matter of fact, inherent.

### **Explanation of the Solution**

It is this second phase which is the key to addressing the difficult obviousness situation discussed above. The strategy relies on intentionally provoking an obviousness rejection based on inherency where the specification already contains sufficient evidence to rebut the prima facie case. This will be applicable in most cases where the specification contains examples and at least one counter example (which in practice is very common).

To best explain the strategy an illustrative example will be used:

#### **Illustrative Example:**

Original Claim 1: A composition comprising:  
40%-60% component A  
30%-50% component B

During prosecution, the applicant provides data showing that such compositions possess the unexpected property X. The Examiner is not convinced and rejects the unexpected results evidence as insufficient.

Data: Applicants specification has examples which shows that when the composition has 40%-60% of component A the property X occurs. However, the specification also has a counter example that shows that when the composition has 65% of A (even when B is present within the claimed range), property X does not occur.

Inherency Doctrine: The proposed strategy is to counterintuitively broaden the structural portion of the claim to encompass the counter example in the specification while also claiming property X in the claim. The resulting amendment is as follows:

Claim 1. (Amended) A composition comprising:

~~40%-60%~~ 40% - 65% component A  
30%-50% component B, and  
wherein the composition possesses property X

The effect of this amendment to provoke a inherency rejection because the prior art fails to teach a composition having property X. However, when the Examiner alleges that property X is inherent, applicants can simply point to the counter example in the specification which definitively shows that the when A is 65% of the composition, property X does not occur. This is definitive proof (inherency is a matter of fact, not law like unexpected results) that the property X is not inherent.

If the Examiner can not find property X in a similar composition in the prior art (most of the time they cannot) they must withdraw the prior art rejection.

### **How does this Strategy Effect the Claim Scope?**

The strategy has minimum effect on the scope of the claims. Although the claim scope is broadened by the amendments to the structure, it is similarly reduced by the added requirement that the claims possess a particular property of functional limitation. The total effect is that the application goes from unpatentable under the unexpected results analysis to patentable under the Inherency Doctrine analysis with minimum change in the actual scope of the claims.

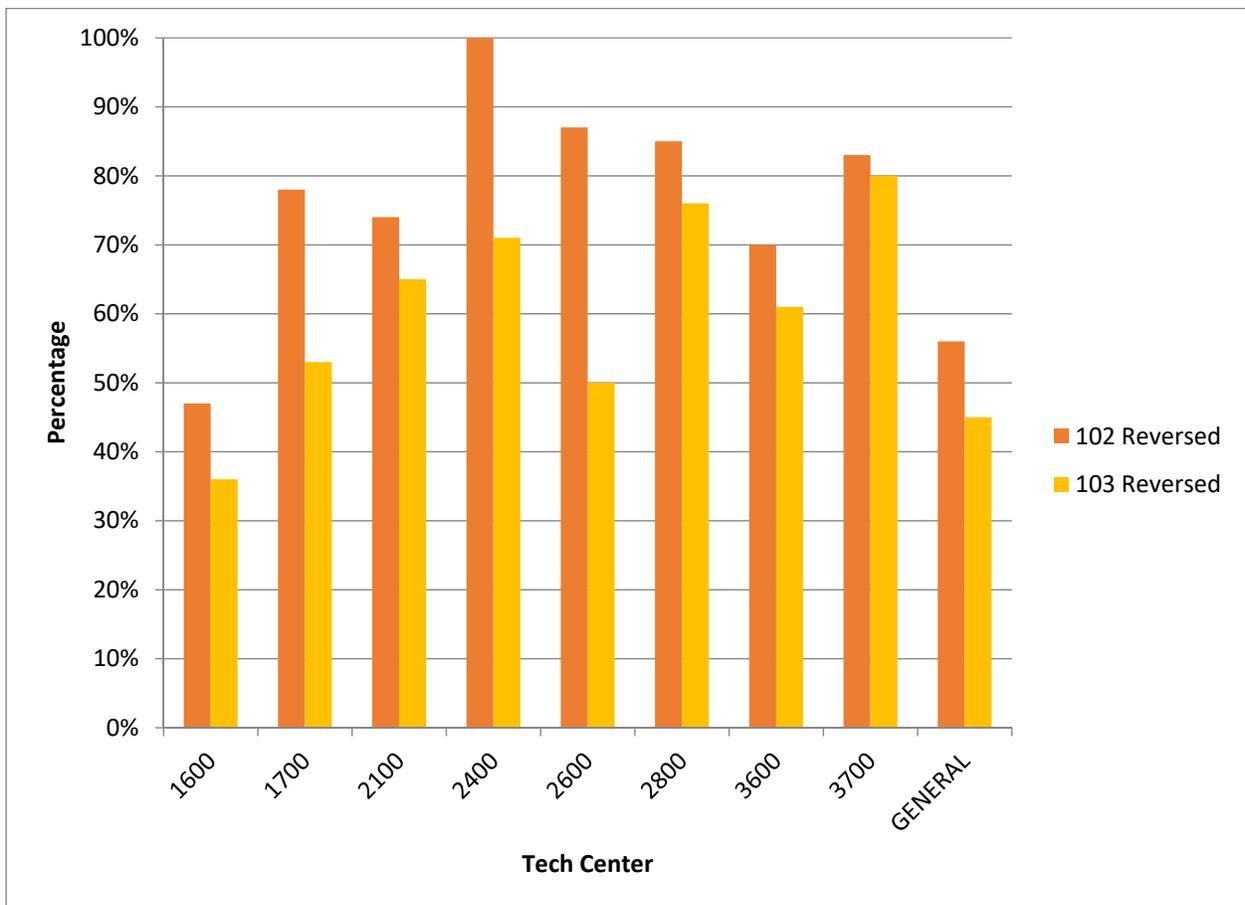
The above is largely what makes the strategy so useful. For inventions whose commercial value is that it possesses some function or property which is desirable or valuable,

using the above strategy offers a claim which is just as enforceable (infringing product must have the valuable property to be competitive) without a reduction in claim scope.

### **Examiner's are Bad at the Inherency Doctrine Analysis**

The graph below shows the reversal rates for rejections based on inherency. 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 (non-inherency-based rejections) of reversal/affirmance of anticipation and obviousness rejection types.



## **How to Deal with Bad Examiner's**

The most common error made by Examiners when evaluating rebuttal evidence in an inherency-based rejection is to ironically apply the standards used for unexpected results. Thankfully, this error is correctable by petition. Specially, applicants can petition that an Office Action which responds to submitted evidence of non-inherency by applying the unexpected results standard is non-responsive.

This author has personally filed five such petitions in the year of 2019 with a 100% success rate. In each case the Examiner was forced to withdraw the Office Action and issue a new Office Action applying the correct standard. Additionally, in each of these cases when the correct standard was applied the case resulted in a withdrawal of the prior art rejections.

## **Conclusion**

The above Inherency Doctrine strategy is useful not only for overcoming obviousness rejections where unexpected results have failed, but also for diversifying and increasing portfolio coverage for inventions. That is, this claim strategy is an alternative or additional way to provide protection of an invention compared to the typical structural claim strategy.

The above post is based on upon a paper by Ryan Pool entitled “The Inherency Doctrine: A Performance Review” which was published in the most recent Volume of the Journal of the Patent and Trademark Office Society (JPTOS). The JPTOS is intellectual property law journal that is housed within the USPTO. The paper provides a statistical and legal analysis of The Inherency Doctrine and also explains the following creative use of the Inherency Doctrine which can help overcome difficult obviousness rejections. A copy of the full paper can be found at <https://www.mwzb.com/2019/11/25/the-inherency-doctrine/>.