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## Reversing *In re Ruscetta*

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The question addressed in this note is whether the PTO should continue to follow and apply *In re Ruscetta and Jenny*, 118 USPQ 101 (CCPA 1958) (hereinafter *Ruscetta*). In order to address the question in a logical manner the basic facts and holding of *Ruscetta* will be presented. This will be followed by a discussion of how specific cases have severely limited the situations wherein a *Ruscetta* type rejection might be sustainable.

### RUSCETTA — THE FACTS AND HOLDING

In *Ruscetta* a first application was filed disclosing etched tantalum electrodes. A second divisional application was filed claiming priority to the first application. Foreign applications corresponding to the first U.S. application were filed and published. More than one year after the publication of the British specification corresponding to the first U.S. application a third U.S. application was filed as a continuation-in-part. The CIP case disclosed additional metals beyond tantalum (the only metal disclosed in the first case) and included generic claims to all the metals. The generic claims of the CIP were rejected as obvious over a combination of (1) a U.S. patent to *Taylor* showing that the additional metals were known equivalents of tantalum; and (2) the published British specification corresponding to the first U.S. application. In *Ruscetta*, on these facts the CCPA affirmed the Board and held:

It being shown in the British specification that tantalum can be etched for use as an electrode metal by appellants' process it seems to us that it would be most obvious to one skilled in the art, in view of the teaching of *Taylor*, to apply the same etching process to other known electrolytic capacitor metals or to alloys of two of these metals. Appellants' method as originally disclosed was designed to etch a metal most resistant to corrosion and hence difficult to etch, namely tan-

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talum, and if it would etch tantalum one would not be surprised if it etched the others. Certainly *it would be obvious to try it* and mere proof that it worked would not make it patentable over the disclosure of the British specification. 35 U.S.C. §103.

The decision of the board is affirmed. (emphasis added)

The basic legal reasoning of *Russetta* is sound, i.e., different legal standards are applied for judging (1) the amount of disclosure needed to describe and disclose an invention (35 USC §112) and: (2) that needed to render an invention obvious (35 USC §103). In that different legal standards are applied under §112 and §103 it is possible to have a disclosure which simultaneously: (1) fails to disclose a claimed invention under §112 but: (2) renders that invention obvious under §103. Because such a possibility exists, at least a portion of *Russetta* remains valid. However, other portions of *Russetta* are no longer the law and the case is generally misapplied by the Patent Office.

#### PRESENT APPLICATION OF *RUSSETTA*

Examiners generally apply *Russetta* to reject claims in the following scenario: (1) a CIP application is filed more than one year after the publication of a foreign patent application; (2) the foreign patent application is a published foreign counterpart of the original patent application to which the CIP claims priority; and (3) the claims of the CIP application are rejected under 35 USC §102 as anticipated by the published foreign application. To support such a §102 rejection the PTO must argue that the claims of the CIP are limited to the filing date of the rejected CIP in that the disclosure of the parent was insufficient to support the rejected claims of the CIP. If such an argument were valid then the published foreign application would (at law) be insufficient to anticipate the rejected claims under 102(b).

The holding of *Paperless Accounting v. Bay Area Rapid Transit System*, 231 USPO 649,654 (Fed. Cir. 1986) supports this position as follows:

If the disclosure of the '196 parent application is insufficient to place the claimed invention in the possession of the public, then its British, French, and Canadian counterparts are also insufficient to do so.

Thus, if any claim of the '300 parent is determined to be limited to the filing date of the '529 c-i-p on the basis that the disclosure of the '196 parent is insufficient to support such claim, a corresponding foreign publication that is substantially the same is also insufficient to anticipate such claim under §102(b). The correct role of the foreign publication in such case is as a reference under §103.

*Reading & Bates*, 748 F.2d at 652, 233 USPQ at 1173. Such analysis has not been made, and is not before us in appeal.

#### REVERSED AND REMANDED

The first point made by this note is that *Paperless* holds that 102(b) rejections of the claims of a CIP in a *Ruscetta* type scenario is inconsistent at law. The PTO should stop making such rejections. Examiners who read this will no doubt conclude that although 102 rejections are improper, the rejection can still be maintained as a single reference §103. Accordingly, the invalidity of any such rejection under §103 will now be addressed.

#### RUSCETTA NO LONGER THE LAW

*Ruscetta* was decided in 1958, prior to *Graham v. John Deere Co. of Kansas City*, 148 US PQ 459 (1966) and as such was not governed by the criteria for judging obviousness laid down in *Graham* as follows:

Under § 103, the scope and content of the prior art are to be determined; difference between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. (*Graham* at 467)

To the extent that *Ruscetta* does not apply the criteria of *Graham*, *Ruscetta* is modified by *Graham*. In addition, to the extent that *Ruscetta* uses a standard for determining obviousness which standard has been held improper by current decisions, *Ruscetta* is modified by and in part overturned by those current decisions.

When rejecting a case in a *Ruscetta* type scenario the "scope and content of the prior art" is the disclosure of the foreign Application which corresponds to the parent of the rejected application. The "difference between the prior art and the claims at issue" can be readily ascertained. If there were no differences then the rejected case would be entitled to the parent filing date and there could be no rejection of such claims over the foreign Application. Therefore, the differences (if they exist) must be the difference between the disclosure given in the parent application and the manner and breadth of claiming that disclosure in the claims of the CIP application. Stated differently, the parent application must (1) fail to teach (35 USC § 112) one skilled in the art how to make the invention claimed in the CIP while (2) simultaneously (via its foreign counterpart) rendering the claimed invention obvious under 35 USC § 103. Lastly under *Graham* we must resolve "the level of ordinary skill in the pertinent

art". For the rejection of the claims of the CIP application to be maintained that level of skill must be resolved such that: (1) those skilled in the art could not make some part of the invention (claimed in the CIP) based on the disclosure of the parent application yet; (2) the invention claimed in the CIP application would be obvious to those skilled in the art in view of the parent disclosure. To render the invention claimed in the CIP obvious the teachings (in the parent disclosure) must be sufficiently enabling to place those skilled in the art in possession of the invention.

The position that such teachings must be "sufficiently enabling..." is supported by the holding of *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985) which held:

It is well settled that prior art under 35 U.S.C. § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. *In re Sasse*, 629 F.2d 675, 681, 207 USPQ 107, 111 (CCPA 1980); *In re Samour*, 571 F.2d at 562, 197 USPQ at 4; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 64, 651-52, 223 USPQ 1168, 1173 (Fed. Cir. 1984). Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. See *In re LeGrice*, 301 F.2d at 939, 133 USPQ at 373-74. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. *In re Borst*, 345 F.2d 851, 855, 45 USPQ 554, 557 (CCPA 1965), cert. denied, 382 U.S. 973, 148 USPQ 771 (1966).

This rule is based on the "described in a printed publication" language in 35 U.S.C. § 102(b). See *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 371 (CCPA 1962).

By applying the criteria of *Graham* to the facts of a CIP application rejected in a *Ruscetta* type scenario the impropriety of applying a 103 rejection becomes apparent. More specifically, the obviousness of the invention claimed in the CIP (in view of the parent disclosure) can generally only be demonstrated by applying the "obvious to try" standard of *Ruscetta*. Current case law has repeatedly held that "obvious to try" is not a proper standard for judging obviousness. For example, *In re Fine*, 5 USPQ 2d 1596, 1599 (Fed. Cir. 1988) held:

The Eads and Warnick references disclose, at most, that one skilled in the art might find it *obvious to try* the claimed invention. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability. *In re Geiger*, 815 F.2d 868, 688, 2 USPQ2d 1276, 1789 (Fed. Cir. 1987); *In re Goodwin*, 576 F.2d 375, 377, 198 USPA 1, 3 (CCPA 1978). (Emphasis added.)

As another example *In re Goodwin*, 198 USPA 1,3 (CCPA 1978) held:

At best, the PTO has shown evidence that it would have been obvious to the skilled artisan to try Margrave's carbon monofluorides. However, this court has consistently refused to recognize "obvious to try" rejections. "As we have said many times, obvious to try is not the standard of 35 USC 103. In *re Tomlinson*, 53 CCPA 1421, 363 F.2d 928, 150 USPA 623 (1966). Disregard for the unobviousness of the results of "*obvious to try*" experiments disregards the "invention as a whole" concept of §103\*\*\*." In *re Antonie*, 559 F.2d 618,620, 195 USPQ 6,8 (CCPA 1977) (emphasis in original). Accordingly, we reverse the decision of the board rejecting claims 1-4, 14-20, and 21-23 under 35 USC 103.

To maintain a *Ruscetta* type rejection the Examiner must argue that (1) the parent application does not teach how to make the invention claimed in the CIP application and (2) that based on the teachings of the foreign Application it would be "obvious to try" other methods of making the invention. Such an "obvious to try" rejection may have been the law under *Ruscetta* but it is clearly not the law today. Accordingly, in nearly every situation an obviousness rejection of the claims of the CIP application can not be sustained.

#### CONCLUSION

Making 102 rejections in a *Ruscetta* type scenario is clearly erroneous under *Paperless*. In rare situations the claims of a CIP may be rejected under 103 over a published foreign counterpart of the parent of the CIP combined with other prior art. However, most such 103 rejections are not sustainable in that most of these rejections (like the one in the *Ruscetta* decision) are based on a holding that determines obviousness by applying an "obvious to try" standard. The "obvious to try" standard is not now the law. To the extent that *Ruscetta* relies on the application of the "obvious to try" standard, *Ruscetta* is no longer the law and should not be followed.