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# Arguments of Impermissible Change in the Principle of Operation in Ex Parte PTAB Decisions

by Chris Francis on [April 7, 2017](#) in [Patent Appeals](#), [PTAB](#)

In roughly the last month, the PTAB has decided 41 *ex parte* appeals involving arguments that the proposed modification in an obviousness rejection impermissibly changes the principle of operation of the primary reference. By way of background, this type of argument, including caselaw, is outlined in [MPEP §2143.01 IV](#). Of the 41 recent decisions, only five have resulted in the PTAB reversing the obviousness rejection. One example of a successful application of this argument by an Appellant is *Ex parte Zha*, Appeal No. 2014-004074 (March 6, 2017).

The claims in *Ex parte Zha* are directed toward a method of cleaning a porous polymeric membrane. The primary reference in the obviousness rejection discloses a method for cleaning a membrane device. This method of the primary reference includes a “concentration” step in which bursting air bubbles are created and cause a scouring of the membrane surface to dislodge accumulated sludge. The Examiner proposed that it would have been obvious to replace this “concentration” step in the primary reference with a “filtering down” step from a secondary reference that includes backwashing. The PTAB reversed this rejection because this proposed modification would have resulted in the reintroduction of dislodged sludge back into the membrane, which is entirely contrary to the intended cleaning described in the primary reference, and thus would have changed the principle of operation of the primary reference.

In *Ex parte Zha*, the Applicant provided a detailed argument supporting the assertion of impermissible change to the principle of operation of the primary reference. In contrast, in some of the 36 recent *ex parte* PTAB decisions in which this type of argument was unsuccessful for the Application, the decisions noted that the Appellant arguments lacked an identification of factual evidence or reasoning to support such an argument.

These cases illustrate the obvious point that a detailed argument with factual evidence and reasoning strengthens the likelihood of successfully asserting that a modification would change the principle of operation of the primary reference. Finally, it is worth noting that these types of arguments may also create only limited prosecution history because the arguments are focused on the combinability of the prior art, not the claims of the pending application.

