

## PTO's Prima Facie Case - In Re Jung

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The U.S. Court of Appeals for the Federal Circuit has affirmed that an examiner meets the requirements for establishing *prima facie* invalidity where the examiner provides the statutory basis of the rejection and the references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement under **35 U.S.C. § 132**. *In re Jung et al.*, Case No. 10-1019 (Fed. Cir., March 28, 2011) (Linn, J.).

After the examiner issued an office action, rejecting all claims of Jung's application for anticipation or single-reference obviousness, Jung responded by arguing that the claimed "well-charge-level controller" was different from the reset controller of the prior art. The examiner finally rejected all claims, noting that he found Jung's argument unpersuasive and finding the claimed well-charge-level controller to be the same as the prior art reset controller. Jung appealed to the Board of Patent Appeals and Interferences (the Board).

In the appeal, Jung argued that the claimed "well-charge-level controller" must "more or less continuously adjust the control signal inputs of active charge source and/or active charge sink" as disclosed in one embodiment and thus is different from the reset controller disclosed in the prior art. The Board, however, construed the claimed "well-charge-level controller" as "any component that controls the charge level of a well." In response to Jung's request for rehearing, the Board rejected Jung's argument that the Board erred in failing to address whether the examiner had set forth a *prima facie* rejection. Jung appealed to the Federal Circuit.

On appeal, Jung argued that the examiner failed to make a *prima facie* case of anticipation. Jung argued that establishing a *prima facie* case requires more than just a notice **under §132** and that the *prima facie* case requirement is not met unless the examiner provides a reasonable construction and evidence bridging the facial differences between that reasonable claim construction and the purported anticipatory reference. Further, instead of arguing that the Board's decision constituted a new ground of rejection, Jung argued that the Board acted as a "**super-examiner**" by performing independent fact-finding and applying an improperly deferential standard of review to the examiner's rejections.

In rejecting Jung's *prima facie* invalidity argument, the Court ruled that "[t]here has never been a requirement for an examiner to make an on-the-record claim construction of every term in every rejected claim and to explain every possible difference between the prior art and the claimed

invention in order to make out a prima facie rejection.” Further, the Court wrote, “there is no reason to impose a heightened burden on examiners beyond the notice requirement of §132.” The Court found that the examiner’s discussion of the theory of anticipation, the prior art and the identification of where each limitation of the rejected claims is shown in the prior art by specific column and line number was more than sufficient to meet the burden.

In rejecting the “super-examiner” argument (as applied to the Board), the Court ruled that the findings by the Board were simple factual assertions and the same as the examiner’s findings. The Court further ruled that “[t]o assert that the Board’s thoroughness in responding to his explanation put it in the position of a ‘super examiner’ would limit the Board to verbatim repetition of the examiner’s office actions, which would ill-serve the Board’s purpose as a reviewing body.

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