

Handling Rejection:

Why those three-digit numbers are just the beginning of your patent journey

Patently Strategic Musings

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Daniel Wright

Summary

- How you got here
- Three-digit numbers (35 U.S.C)
 - §101 – Eligible subject matter
 - §102 – Novelty
 - §103 – Non-obviousness
 - §112 – Written description, clarity, enablement
- Big picture forward
 - The **benefit** of rejection

Arriving at Examination

- Act of **Invention**
- Filing of an Application
 - **Specification** – Technical description of the invention
 - **Claims** – Legal definition of the property right
- Patents grant a **limited monopoly** in exchange for **information**
 - Right to **exclude** others from making, using, selling, and importing

Examination

- Review according to legal requirements and existing technology
 - **Prior art** searching
- Office Actions
 - Allowance or **REJECTION**
 - Rejection according to **35 U.S.C. §101, §102, §103, §112**

Examination

- Replies to Office Actions
 - Arguments
 - Amend the claims
 - **CANNOT** amend the specification
- Office Actions come in pairs
 - **Non-Final** -> your response -> **Final** -> your response
- You can pay for more rounds
 - Request for Continued Examination
 - File “continuing” application

§101 – Eligible Subject Matter

- Statutory Categories – i.e., invention **MUST** be:
 - Process
 - Machine
 - Manufacture
 - Composition of matter
- Judicial Exceptions – i.e., invention **CANNOT** be:
 - Abstract ideas
 - Laws of nature
 - Natural phenomena
 - Products of nature
- UNLESS “**significantly more**”

§101 – Eligible Subject Matter

- **Abstract Ideas** – Software and computational technologies
 - Recite more than standard computer equipment
 - Demonstrate a **new or an improved result** for a computer or other tech
 - Recite more than a mathematical equation
 - Recite more than a business practice
- **Laws of Nature** – Diagnoses
 - Recite more than correlations of biomolecules with disease states
 - Recite more than standard lab procedures and data collection
- **Natural Phenomena/Products of Nature** – Drugs, food, etc.
 - Recite a modification or an unnatural combination

§101 – Eligible Subject Matter - Response

- Amend your claims!
- Prepare your specification in advance for §101 concerns
 - Add in **material details** from specification into claims

§101 – Utility

- Must have **specific, credible** use
 - No undefined “**biological activity**”
 - Cannot merely take up space with no function
- Need not be perfect
- **Completely inoperable** means not-useful
 - No perpetual motion machines
- Historical morality implications

§102 – Novelty

- Also called “**anticipation**”
- Invention, as claimed, must be new
- A **SINGLE** prior art reference contains **EVERY ELEMENT** of the claim
 - Prior art’s **technical field** is **irrelevant**
 - Examiner needs to find only **one** example from a list of options

§102 – Novelty – Response

- Argue that the examiner has misidentified an element
 - Unlikely...
- Amend your claims!
 - Something the cited reference **DOESN'T** have
 - Promoting elements from dependent claims
 - Eliminating options from lists
 - Narrowing ranges
 - Need **supporting language** in specification for changes
 - Make the examiner do the work for what needs to be narrowed

§103 – Non-obviousness

- Not previously fully described in one reference but available in a **PREDICTABLE combination**
 - Multiple references
 - Simple substitution
 - Applying known technique
 - Limited possible solutions
- “Teaching. Suggesting. Motivating”
- A showing for **every element** of the claims
- **Predictable results** and/or **MOTIVATION to COMBINE**

§103 – Non-obviousness – Response

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§112 – Written Description, Clarity, Enablement

- Intelligibility of **claims** considering the specification
 - Clarity – grammar, syntax issues
 - Enablement – sufficient technical instruction
- A Person of **Ordinary Skill in the Art**

§112 – Written Description+ – Response?

- **CANNOT** amend the specification
- Argue back with **clear definitions** provided in the **specification**
- Amend the claims
 - Must use terms already within the specification
- File **Continuation-in-Part** Applications
 - US only

Claim Tactics and the Big Picture

- Claims are the **legal definition** supported by the specification
- **Broad** claims grant **more protection**
 - Broad claims “easier” to reject
- Get **rejected ONCE**
 - Asked for too much, narrow it down accordingly
 - **First action allowance** means you may have started **too narrow**
- Rejection is a tool to find the true scope of your invention