

## Top 5 reasons for receiving a rejection on a Patent Application



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March 21, 2017

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### Summary

After a regular or non-provisional patent application is filed with the US Patent Office (USPTO) the patent application is assigned to a Patent Examiner for review. The review process is also referred to as the prosecution stage or process of a patent application.

During the patent application review process it is the job of the Patent Examiner to determine whether the patent application is eligible to be awarded patent status based on a number of criteria. In most cases after review the Patent Examiner will issue some sort of refusal or rejection of the patent application, which is usually referred to as an “office action” that must be responded to within a prescribe time period or else the patent application will become abandon. This article will discuss the top 5 reasons for receiving a patent application rejection or for receiving a patent office action.

## **Reason 1: The invention not Novel**

The first common reason for receiving a rejection on a patent application is based on Novelty. Generally speaking, as a condition for patentability (awarded patent status) is that the patent application must be “novel”. The criteria for novelty is that the invention described in the patent application must be substantially different from anything else that is known to the public. Public knowledge includes (1) anything that has been previously patented, (2) anything that has been written about in a publication, and/or (3) anything that has been or is currently sold in the open market.

The scope of this public knowledge extends worldwide so if the invention has already been patented elsewhere such as in Asia but not necessarily in the United States, the invention is not novel and may not qualify for a patent based on novelty. However, an invention can be novel even if it simply combines two existing devices or ideas in a unique manner.

During the patent application review process if the Patent Examiner discovers an existing invention or product, often in the form of a previously issued patent or previously filed patent application (which is usually referred to as “prior art”) that is similar to or identical to the invention that is being covered in the patent application the Examiner will issue a refusal office action citing the previously filed patent or previously filed patent application as the reason why the patent application is not novel.

Some of the arguments to try and get around a Patent Examiner’s novelty rejection would be to argue that the invention is somehow different than the prior art that the Patent Examiner is citing either by their parts, function, and/or use.

## **Reason 2: The invention being obvious**

The second common reason for receiving a rejection on a patent application is based on the criteria of “unobvious”. Generally speaking, even if an invention is new, a patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains", which is also known as being non-obvious.

What this means is that during the patent application review process even if the Patent Examiner cannot find prior art that is identical to the invention that is being covered in the patent application, the Patent Examiner may still issue a refusal office action citing several prior art references that, while not being individually identical to the invention being covered in the patent application, contains elements or parts which would have been “obvious” for the Patent Examiner to “combine” to arrive at the invention being covered in the patent application.

Some of the arguments to try and get around a Patent Examiner's obviousness rejection would be to argue that it would not have been obvious to combine the prior art references in the manner as reference by the Patent Examiner and that the invention being covered in the patent application contains certain features and/or components that are not disclosed in the Patent Examiner's cited prior arts.

### **Reason 3: The invention being an Abstract Idea**

The third common reason for receiving a rejection on a patent application is that the invention being covered in the patent application is an "Abstract Idea". Traditionally an "Abstract Idea" rejection covered "Mathematical Formulas", "Physical Law of Nature", "Natural Phenomena", "Naturally-occurring products", and "Printed Matter".

The old guideline for refusing to protect Abstract Ideas were that they were not patentable since they are neither a process, machine, manufacture, nor composition of matter and thus lack utility because they have no particular use. However, recent court holdings against the patentability of software, computer-based inventions, and business methods inventions have created a shift in the landscape for some utility/apparatus applications in which it is now more common to see Patent Examiners using the Abstract Ideas rejection as an all encompassing refusal.

For example in a patent application on an invention covering an electronic device in which the electronic device includes "a processor," "a memory," and "a module," it is now not uncommon to see a Patent Examiner listing the claimed components, alleging that the claimed component requires the use of an algorithm or data processing and then taking the position that the claimed limitations, considered individually and as a whole, is not significantly more than the abstract idea.

Some of the arguments to try and get around a Patent Examiner's Abstract Idea rejection would be to argue that the Abstract Idea rejection is in error and cite granted patents contain some of those components or that the Abstract Idea rejection is a procedural error and fails to analyze all of the elements of the claim limitations, that the assertion that the claim limitations considered as a whole are not significantly more than the abstract idea is an unsupported allegation.

### **Reason 4: Patent application improperly written**

The fourth common reason for receiving a rejection on a patent application is due to errors in the patent application. There are two types of common errors in a patent application, namely "informalities" and "enablement/insufficiency".

#### **Informalities errors**

Informalities errors usually are where certain minor rules and procedures of the patent application are missed and include for example issues with paragraph numbering, line numbering, inconsistencies in the numbering in the description section versus numbering

on the corresponding drawings, grammatical or punctuation issues, improper language such as using ‘the’ when it should ‘a’ to reference a component and exceeding word count on the abstract section. Informalities errors usually are relative easy to fix and are considered minor issues.

### **Enablement/insufficiently errors**

Enablement/insufficiency errors are where the written description section of a patent application contains insufficient information or not enough detailed information to enable the reader to understand how the invention operates or works.

One main criteria of a patent application is that the patent application, when filed, must contain a complete disclosure of the invention including vital components of the invention and how the invention works and operates. The problem is that once filed there is little that can be done to change the patent application since “new material” or “new matter” cannot be introduced into the patent application after filing.

So, if a patent application is written with insufficient disclosure and the Patent Examiner issues an enablement/insufficiency rejection, it is usually an issue what cannot be easily fix as it is not possible to add in more details to the patent application at that time to fill in the missing information. Therefore, it is important to have the patent application properly drafted and when initially filed.

If your patent application receives a rejection for insufficient information, the most likely approach would be to file for what is referred to as a branching continuation-in-part (CIP) patent application to include the additional information.

## **Reason 5: Confusion over the subject matter being sought**

The fifth common reason for receiving a rejection on a patent application may be that based on the Patent Examiner’s review of the patent application the Patent Examiner might be unclear as to the subject matter being sought for patent coverage. These situations are identifiable by the Patent Examiner issuing prior art that is unrelated to the subject matter being sought for patent coverage and/or interpreting the claimed subject matter in an un-intended way.

One of the best strategy in responding to confusion over the subject matter being sought for patent coverage would be to set-up an Examiner’s interview to verbally discuss the invention and clarify to the Examiner the subject matter being sought for patent coverage.

Please feel free to contact Jacobson and Johnson LLC if you have any questions regarding rejections to patent applications.