

Practical Tips for Responding to Office Action Rejections (Part I)

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When responding to an Office Action, as a patent practitioner, you have a variety of tools available in your “toolbox”. One such tool includes identifying whether the cited art even qualifies under 35 USC 102(a) at all, or do any of the exceptions available under 35 USC 102(b) apply. It’s definitely worth looking at the priority date(s) for your own application, as compared to the applicable dates of any cited art, to determine if you can remove any of the cited art references as applicable prior art, to make your job in getting the claims allowed easier. Don’t rely on the patent examiner to always get those details right. I typically have several cases a year, where I’m able to remove a piece of cited art as applicable prior art either because it simply does not qualify as prior art, or it falls within one of the available exceptions. Take the time to look.

Another tool available in the toolbox is to consider whether the secondary art being cited is perhaps non-analogous art. Only art that is analogous qualifies for use in a 35 USC 103 obviousness rejection. The art either needs to be (1) “from the same field of endeavor, regardless of the problem addressed” or, (2) if the reference is not within the field of the inventor’s endeavor, the reference “still is reasonably pertinent to the particular problem with which the inventor is involved” (see *In re Klein* 647 F. 3d 1343 (Fed. Cir. 2011)). A key question to consider when evaluating (2) is “Would the reference have logically commended itself to the inventor’s attention in considering his/her problem?” If not, you may be able to argue that the secondary art being relied on is non-analogous, and therefore not citable against the claimed invention under a 35 USC 103 obviousness rejection.

Another tool available in the toolbox is to consider whether the combination being proposed by the examiner requires a greater expenditure of time, effort, or resources than the prior art, where the proposed modification provides no real recognized advantage. MPEP 2143 describes such an example in *In re Omeprazole Patent Litigation* 536 F. 3d 1361 (Fed. Cir. 2008), which concluded that it was not obvious to add a secondary subcoating over an active ingredient pill. In that case, it was the applicant who recognized that the prior art coating was degrading the active ingredient, and for this reason, the applicant added a secondary subcoating to solve this previously unrecognized problem. Even though such subcoatings were known, and there would be a reasonable expectation of success, the claimed configuration “was nevertheless not obvious because the flaws in the prior art formulation that had prompted the modification had not been recognized”. Can you make an argument that the modification proposed by the examiner requires more time, effort, or resources, without any real recognized advantage to doing so?



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