workman nydegger

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

October 18, 2024

When responding to an Office Action, as a patent practitioner, you have a variety of tools available in your “toolbox”. A previous posting discussed several such tools. Another tool available in the toolbox is to consider whether the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose”. In such a case, “there is no suggestion or motivation to make the proposed modification” (MPEP 2143.01(V) citing In re Gordon 733 F. 2d 900 (Fed. Cir. 1984). In Gordon, the claim was to a blood filter with the inlet and outlet at the bottom, and a gas vent at the top. The cited art was a gasoline filter very similar in structure, but upside down. Upside-down orientation of the prior art device was important to its function, as the filtered dirt and denser water would go to the bottom, to be released out of a stopcock valve. The court found it is not obvious to flip the gasoline filter of the prior art upside down, as it no longer works for its intended purpose. Can you make an argument that the examiner’s modification of the prior art renders that prior art inoperable or unsatisfactory for its intended purpose?

Another tool available in the toolbox is to consider adding a negative limitation to your claim. Sometimes this can be very helpful in differentiating over the cited art. Examiners’ often do not like negative limitations, but the MPEP is quite clear that they are often acceptable. MPEP 2173.05(i) states “Any negative limitation or exclusionary proviso must have a basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims”. In other words, if your specification described two or more embodiments, you can excise one of the embodiments through the use of a negative limitation. As mentioned, many examiners will resist unless you have explicit near-verbatim support for the negative limitation, but technically, this should not be required and may be worth a try in your particular case.

Finally, another tool available in the toolbox is to present data showing surprising or unexpected results. While this is not helpful in overcoming a 35 USC 102 anticipation rejection, it can be quite helpful in overcoming a 35 USC 103 obviousness rejection. Do you have data, showing that the claimed configuration is surprisingly or unexpectedly improved over the cited art? If you have such data, either in the application as originally filed, or later available that you can present to the examiner in the form of a declaration/affidavit filed under 37 CFR 1.132, this may help you get broader claims than you could otherwise get. Be aware though, that you will likely also need to amend the claims to be “commensurate in scope with the surprising and unexpected results shown”. Still, this can be a useful tool in overcoming an obvious rejection.