



# REJECTED:

embracing and overcoming  
patent rejections



ZARLEY LAW

## REJECTION: PERFECTLY NORMAL

**IT DOESN'T MATTER IF IT IS BY YOUR CRUSH AT THE MIDDLE SCHOOL dance or HR at a job you always wanted.** The bad news is that if you file for a patent, there is a very good chance that you will be rejected. Sometimes repeatedly.

Rejection is a perfectly normal part of patent examination. This guide intends to help you understand the variety of ways an application can be denied.

Only 20% of recent applications were deemed suitable for receiving patent protection without a single rejection, objection, or other change to the application. On average, applications are rejected 2.7 times before they either become a patent, or the inventor gives up on getting one.

No one  
likes being  
rejected.



## PROSECUTION

**YOU MAY HAVE HEARD THE WORD “PROSECUTION”** before when talking about the criminal justice system. In that context, prosecution is about the government going after an alleged criminal in a contentious and adversarial environment.

The examination of a patent is also referred to as “prosecution,” but the process is not supposed to be adversarial. Instead, the examiner assigned to review the patent application is supposed to work with the applicant to determine if anything is patentable. That doesn’t mean that the examiner is going to do the heavy lifting; that falls on the applicant.

In this guide, we will use examination rather than prosecution, but the terms are interchangeable.

*The Patent Prosecution Highway is a collaborative agreement between the patent offices of different countries to share information between each other to expedite examination. To learn more, see our video on [Accelerated Prosecution](#) through the Patent Prosecution Highway at [www.zarleylaw.com/resource..](http://www.zarleylaw.com/resource..)*





## OFFICE ACTIONS

### *Patent examination goes through rounds of review*



### **GETTING A FINAL OFFICE ACTION IS FAR FROM FINAL.**

Check out our webinar, ***‘Does Final Really Mean Final?’*** that discusses options available when receiving a final Office Action at [www.zarleylaw.com/resource](http://www.zarleylaw.com/resource).

**THERE ARE A WIDE RANGE OF REASONS THAT AN EXAMINER** may send out an official communication to an applicant. These are referred to as Office Actions. When a patent application is rejected or objected to, there are two core types of Office Actions, non-final and final.

The use of the term “final” is pretty daunting, but it isn’t. Patent examination goes through rounds of review.

round  
**1**

The first time an Office Action with a rejection is sent out, it is considered ‘non-final.’ The applicant can respond to a non-final Office Action without paying a fee.

round  
**2**

The second Office Action is final, which means that the examiner will not work on the application further without a fee being paid. After the fee is paid, a new round of examination begins.

## THE PERSON HAVING ORDINARY SKILL IN THE ART

**WHEN A PATENT APPLICATION IS BEING EVALUATED,** the invention is based on a “**person having ordinary skill in the art.**” This is a bit misleading as this skill is anything but ordinary. Instead, this person knows about everything in your field and related fields. It is probably better to think of this person as a Wikipedia page where everyone who has ever worked on something similar to your invention has contributed their knowledge.

*Nearly all countries use some form of the person having ordinary skill in the art. The Fachmann, is used in German patent law. Fachmann simply refers to an expert.*





## PRIOR ART

### **PRIOR ART IS A FANCY WAY OF SAYING INFORMATION**

that is publicly available. This means any other patent application filed in the United States or abroad, any and all books contained in any library, and just about everything available on the Internet.

The only information that is off limits to the Patent Office is information that was created after the patent application was filed. This can be tricky for examiners who must avoid using hindsight based on information that they gather as time moves away from the date of filing.

The Patent Office wants inventors to file for their inventions quickly in exchange for the possibility of getting a patent. If you don't act quickly, your own publications about or sales of your invention can prevent you from obtaining a patent. After only one year, your own actions can be considered prior art.

### **THE AMERICA INVENTS ACT**

*The America Invents Act went into effect in 2012, which set up the “first to file” system that is used in most other countries. Before that, the United States was a “first to invent” country. Under the “first to invent” system, an inventor could avoid some prior art by proving that their invention came before the prior art was created.*



## REJECTION VS. OBJECTIONS

**WHEN A PATENT APPLICATION IS EXAMINED, ALL PARTS** of the application are reviewed to ensure that they are in proper form for being granted patent protection. If a problem is found, that part of the application will be objected to or rejected. Either way, the applicant will be denied a patent.

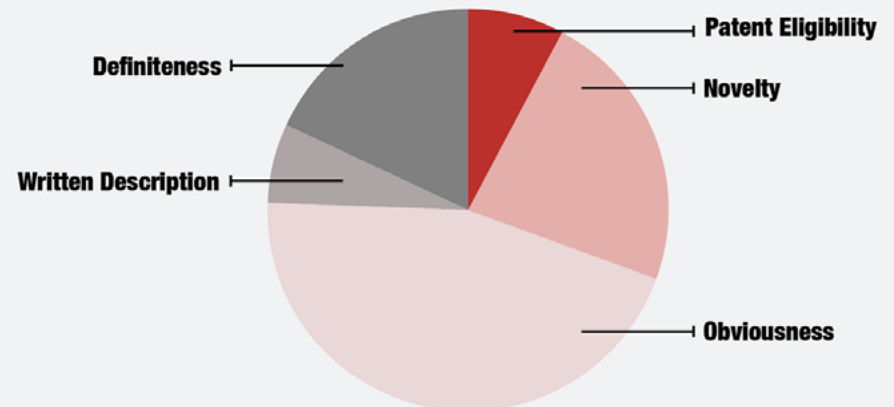
Objections and rejections share many similarities and in some instances even overlap resulting in an objection and rejection being made for the same reason. Objections, however, are geared more toward mistakes in the application like typos and other formalities not being followed. On the other hand, rejections are made when the claims of the patent are not patentable as requested in the application.

Because most objections can be resolved fairly easily by correcting the error and objections can be made for any number of reasons, this guide will not dig into objections any further. Instead, this guide will hone in on the most common rejections, why they are made, and how to respond to them.

*Another key difference between objections and rejections is that only rejections can be appealed to the Patent Trial and Appeal Board. Objections are reviewed by making a request for one of the USPTO directors.*

### Rejections

**ALMOST ALL REJECTIONS ARE BASED ON STATUTES AND THE** court cases that have interpreted them. All of the statutes are found in Title 35 of the U.S. Code. When a rejection is made, it is common to refer to them based on the section of the Code that they relate to. For those who enjoy getting the details, we will let you know what section we are referring to when discussing each rejection.



## PATENT ELIGIBILITY, SECTION 101

*Section 101 rejections occur in 7.9% of applications.*

THERE ARE SOME CORE THINGS THAT CANNOT BE PATENTED EVEN IF THERE ARE RECENT BREAKTHROUGHS OR DISCOVERIES.

### LAWS OF NATURE

The first is laws of nature, which includes things such as gravity. If someone could get a patent on something like gravity, then everyone else would be in hot water because we all need gravity.

### NATURAL PHENOMENA

The second is natural phenomena. An example of this subject matter would be naturally occurring substances, like water. Again, it would be really bad if someone could sue people for using water.

### ABSTRACT IDEAS

The last one is a bit trickier, abstract ideas. Abstract ideas are things that can a person can do in their head. For instance, if the invention is a new mathematical formula, even if it is intensely complex, it would be an abstract idea because it could theoretically be done in a person's mind—they would just have to be insanely intelligent. The difficulty in deciding when something is just an abstract idea has led to multiple changes at the Patent Office on what does and doesn't fall into this category. Abstract ideas are also the culprit for the heartache involved with software and diagnostic medicine patent applications.

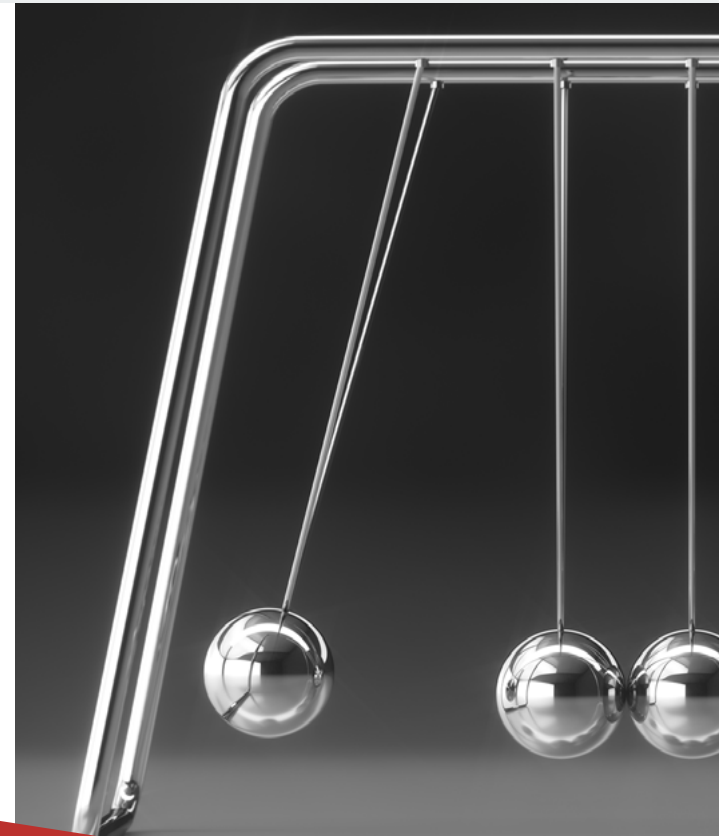
If the Patent Office decides that the invention you are claiming as yours falls into one of these categories, it won't matter if your invention is the best thing since sliced bread. You won't be getting a patent.

The good news is that you can take steps to respond to this type of rejection. You can either change what your invention is so it doesn't fall into one of the categories above or you can explain to the examiner why they incorrectly put you into one of those groupings.

Overcoming or avoiding eligibility rejections typically begins before you even file your application. You must work closely with your patent attorney or patent agent to put together a detailed explanation of what your invention is and what its benefits are. This is especially true if your invention is a new smartphone app or computer software.

**THE RULES AND LAWS ON WHAT IS AND ISN'T PATENT ELIGIBLE IS QUICKLY EVOLVING.**

To keep up to speed with this area of patents follow us on [LinkedIn](#), [Facebook](#), or just check out [our blog](#) from time to time at [www.zarleylaw.com](http://www.zarleylaw.com).





## WRITTEN DESCRIPTION, SECTION 112(A)

**THE WRITTEN DESCRIPTION REQUIREMENT MEANS THAT** the inventor has to disclose their invention to the public in exchange for getting a patent. By doing so, it also proves the inventor actually invented it. To meet this requirement, the application must describe the invention that the inventor is claiming. This seems fairly straightforward, right? Unfortunately, it can be a bit tricky.

One possible problem area is if the claimed invention includes something not described in the application when it was filed. This can occur when the aspects of the invention are modified during examination and the modifications are not in the original application.

The obvious remedy is to add a description of the new information. Bad news, this is strictly prohibited. No new information can be added to an application once it is filed. This is because the application is given a filing date and that date is used to limit what can be used against the application. If new information is added after the filing date, there is no way of knowing if this information was known to the inventor before or after the filing date.

*If your invention develops over time and evolves in some way, you can still get patent protection by filing applications on those improvements. Keep in mind, though, that the Patent Office may be able to use your first application against you.”*

## ENABLEMENT

**THE ENABLEMENT REQUIREMENT IS RELATED TO THE WRITTEN DESCRIPTION** requirement. It essentially requires that the application gives enough information to the public so that they can make or do the same thing as the invention. The reason behind this is that it drives innovation. When you know what someone else is inventing you can try to improve on it.

This doesn't mean others can infringe a patent though. In exchange for enabling the public to make and use your invention, the applicant gets a 20-year period to prevent people from using their invention if they are given a patent. This is the trade-off of the patent, giving away the secrets of your invention in exchange for a possible monopoly on the technology on your invention.

If the application does not include enough detail, it is possible that the Patent Office will decide you didn't hold up your end of the bargain and reject your application.

To overcome written description and enablement rejections, you can often remove the changes that caused the problem in the first place. Another option is looking for something in the application that implies the addition or makes it so the addition is necessarily present.

Sometimes a simple change or explanation isn't the answer. Instead, the inventor has to explain why the Patent Office got it wrong. This can be the case when an application is rejected based on the enablement requirement.

Like patent eligibility, working closely with a patent attorney or agent will greatly limit receiving these types of rejections.

Section 112(a) rejections occur  
in 6.3% of applications.



Section 112(a) has a third requirement that is less important since the adoption of the America Invents Act, which is the 'best mode' requirement. This requires that the inventor detail the best way of making or using their invention. This prevents inventors from holding back the "secret sauce" for themselves.

## DEFINITENESS, SECTION 112(B)

*Section 112B rejections occur in 18% of applications.*



*The inventor is their own lexicographer. This means they get to define what words mean as long as they don't stray too far away from how the word is normally understood.*

**DEFINITENESS REJECTIONS ARE GOOD FRIENDS WITH** objections. These two often overlap because a typo or other error often means that something is unclear. As a result, the Patent Office will both make an objection because of the error and also a definiteness rejection because of that same error.

The inventor has a lot of leeway on how they present what they believe their invention is. However, there are a number of formalities that have to be adhered to. Some are simple, like the sentence that claims the invention must end in a period. Others are stylistic, such as using the word “a” the first time you introduce an element of the invention, e.g., a wheel, and then using “the” every time after, e.g., the wheel.

It is usually a simple process to correct the problems causing the rejection. It normally involves making changes (called amendments) to the application.

Sometimes, this type of rejection is made because the way the invention is described is too general. If that happens, the Patent Office rejects the application because they are worried that the public won't understand what is and isn't covered by the patent.

When the rejection is based on this sort of ambiguity there are a few ways to respond. One way is modifying the application to clearly describe what the invention is — you just have to make sure no new information is added to the application or you will get a written description requirement. Another approach is explaining to the Patent Office that people who know about your technology would clearly understand what the language means so no change is needed.

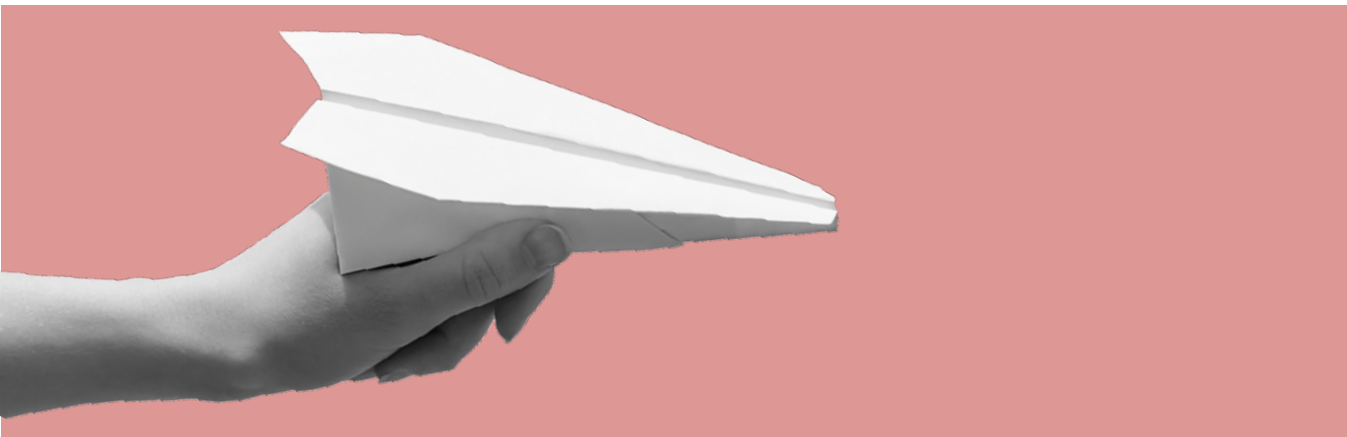


## NOVELTY, SECTION 102

*Section 102 rejections occur in 22.8% of applications.*

### OUTSIDE OF MAKING SURE THE APPLICATION IS ERROR FREE AND

understandable, the Patent Office has to decide whether the invention is actually an invention by legal standards. The first hurdle is that the invention must be novel.



Let's imagine that you just invented the first airplane. You might say that your invention has four components. There are tires, a chassis or frame, a steering device, and an engine. The way the invention is being claimed would result in it being rejected—by a car. The car has those same things even though it isn't an airplane.

From that example you see that it is possible to be rejected over something that already exists even though it definitely is not the invention. The easy way to take care of a rejection like that is to add elements that you put into your application that you maybe didn't use when you

were writing out the elements of your invention. Using the hypothetical above, you would probably want to add wings to your list of components.

In some instances what the inventor thought was an invention has already been thought of or made by someone else. This does happen. There are millions of patent applications and patents in the United States alone. There are millions and millions more worldwide. On top of that are countless books, scientific articles, blogs, and webpages that could have beat the inventor to the punch. If this is the case, it is probably time to go back to the drawing board to work on the invention.

## NOVELTY

Novelty means that the invention doesn't exist and no one has ever described it before. This is another area where the simplicity of the requirement is misleading. Because an inventor has to describe the elements that make up their invention when they "claim" their invention, things can and do go wrong.

## OBVIOUSNESS, 103

**THE BIGGEST OBSTACLE TO GETTING A** patent is usually obviousness and it is undoubtedly the hardest to understand. The test for whether an invention is obvious or not looks at all of the prior art. Then, using that superhuman power we talked about earlier, the person of ordinary skill in the art, the Patent Office decides whether the invention would be obvious—even if it never existed before the patent application was filed.

When the Patent Office rejects an invention as obvious, they combine different references together that describe all of the features of the invention. The Patent Office isn't limited in how many pieces of prior art they can combine to decide an invention is obvious either. Sometimes an obviousness rejection will combine many references together.

Going back to our airplane, imagine that you didn't make the first airplane but you did invent the first seaplane. Your seaplane

has a chassis or frame, an engine, a steering device, wings... and floaters that allow it to land and take off from water. No airplane or car has ever done this before. The invention might still be rejected if the Patent Office decides that the person of ordinary skill would think combining an airplane with a boat would be obvious.

Sometimes the Patent Office doesn't combine references but applies common sense. For example, if you make the first metal door it might be seen as obvious. This is because everyone knows what a door is and they also know that metal makes things more durable.

Showing that an invention isn't obvious can be a difficult task. It typically requires a combination of modifying the application and trying to persuade the Patent Office they are wrong. Trying to persuade the Patent Office often requires pointing to court cases that support the inventor's point of view.

*Having your invention rejected as being obvious can be frustrating and sometimes it will seem that the Patent Office is being cruel. Working with an experienced patent attorney or agent can make all the difference because they deal with these sorts of rejections all the time.*



## EMBRACING AND OVERCOMING REJECTION

**IN THE END, BEING REJECTED OFTEN MEANS THAT** your patent application wasn't ready to go out into the world. A rejection gives the patent application a chance at coming out of its examination stronger than it started.

A patent that hasn't been thoroughly examined has a big risk of being rendered useless during a lawsuit. At that point, there are limited options to breathing new life into your patent.

So if you are reading this after you received your first rejection, remember it is ok and is for your own good. If you haven't filed your patent application yet, ready yourself for one or more rejections.



To make sure you are ready  
to file your application,  
check out our *5.5 Things  
You Need to Know Before  
Filing a Patent.*



## WHAT'S NEXT?

**REJECTION NEVER FEELS GOOD. BUT, AT LEAST NOW YOU HAVE** a better idea of what to expect. Remember, working with a good patent attorney can make all the difference. They will have a variety of strategies handy to limit the number of rejections you get and know just how to respond to a rejection, regardless of what type it is.

*If you are still leery about the inner workings of your invention being put on display for the world, check out our Trade-Secret In-House Assessment to see if you have any trade secrets and if you are taking the right steps to protect them.*



**WE PROTECT YOUR IDEAS**

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