

IMPROPER FINAL REJECTIONS AND SUGGESTIONS FOR AVOIDING THEM (AND HOPEFULLY THE EXPENSE OF HAVING TO REQUEST THEIR WITHDRAWAL) BY MICHAEL E. KONDOUDIS

PATENT EXAMINATION IN THE U.S. PATENT OFFICE IS GUIDED BY THE PRINCIPLES OF COMPACT PROSECUTION, WHICH I DISCUSSED IN SOME DETAIL IN AN EARLIER POST HERE. UNDER THE PRINCIPLES OF COMPACT PROSECUTION, SECOND OFFICE ACTIONS ARE TYPICALLY FINAL.

THE FINALITY OF SECOND OFFICE ACTIONS IS ADDRESSED IN SECTION 706.07(A) THE MANUAL OF PATENT EXAMINING PROCEDURE (MPEP), WHICH PROVIDES THAT “UNDER PRESENT PRACTICE, SECOND OR ANY SUBSEQUENT ACTIONS ON THE MERITS SHALL BE FINAL, EXCEPT WHERE THE EXAMINER INTRODUCES A NEW GROUND OF REJECTION THAT IS NEITHER NECESSITATED BY APPLICANT’S AMENDMENT OF THE CLAIMS NOR BASED ON INFORMATION SUBMITTED IN AN INFORMATION DISCLOSURE STATEMENT DURING THE PERIOD SET FORTH IN 37 C.F.R. §1.97(C) WITH [THE APPROPRIATE FEE].”

37 C.F.R. §1.97(C) PROVIDES THAT [UPON SATISFYING CERTAIN PREREQUISITES] AN INFORMATION DISCLOSURE STATEMENT SHALL BE CONSIDERED BY THE OFFICE IF IT IS FILED AFTER A FIRST OR NON-FINAL OFFICE ACTION BUT BEFORE THE MAILING DATE OF A FINAL OFFICE ACTION, A NOTICE OF ALLOWANCE, OR AN ACTION THAT OTHERWISE CLOSES PROSECUTION.

THUS, WHEN THE OFFICE HAS TO INTRODUCE A NEW GROUND OF REJECTION AND THAT NEW GROUND OF REJECTION IS NOT NECESSITATED BY EITHER:

- (1) A CLAIM AMENDMENT; OR
- (2) INFORMATION SUBMITTED BY THE APPLICANT BETWEEN THE IMMEDIATELY PRECEDING ACTION AND A CURRENT OFFICE ACTION

THEN THE NEXT OFFICE ACTION CANNOT PROPERLY BE MADE FINAL.

SO, FOR EXAMPLE, WHEN A NON-FINAL OFFICE ACTION WHOLLY FAILS TO ADDRESS A CLAIM OR FAILS TO EXPLAIN THE BASIS FOR A REJECTION AND THE BASIS IS NOT ALREADY OF RECORD, THE FINALITY OF A NEXT OFFICE ACTION REJECTING THAT CLAIM MAY BE PRECLUDED. IN THE LATTER SCENARIO, THERE ARE TWO ARGUMENTS FOR THIS PRECLUSION. FIRST, ANY DETAILED REJECTION OF THE SUBJECT CLAIM(S) IN A NEXT OFFICE ACTION MAY CONSTITUTE A NEW GROUND REJECTION THAT WAS NOT NECESSITATED BY A CLAIM AMENDMENT OR AN IDS. SECOND, THE FAILURE TO ADEQUATELY ARTICULATE THE BASIS FOR REJECTING A CLAIM IS A FAILURE TO PROVIDE THE ADEQUATE NOTICE THAT SHIFTS THE BURDEN OF REBUTTAL TO THE APPLICANT. THIS IS ESPECIALLY

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IMPORTANT WHEN TECHNICAL (NON-ART) REJECTIONS (E.G., §101 (PATENTABLE SUBJECT MATTER) ARE AT ISSUE BECAUSE OF THE SPECIFIC INSTRUCTIONS OF SECTIONS OF THE MPEP SUCH AS § 706.03 (MAJOR TECHNICAL REJECTIONS (E.G., LACK OF PROPER DISCLOSURE, UNDUE BREADTH, UTILITY, ETC.) SHOULD BE STATED WITH A FULL DEVELOPMENT OF THE REASONS RATHER THAN BY A MERE CONCLUSION COUPLED WITH SOME STEREOTYPED EXPRESSION).

ALSO, WHEN AN APPLICANT SUCCESSFULLY TRAVERSES A REJECTION BY ARGUMENT ALONE (E.G., PRESENTS A PERSUASIVE PATENTABILITY ARGUMENT OR DISQUALIFIES CITED ART), THE FINALITY OF NEXT OFFICE ACTION MAY BE SUSPECT. FOR EXAMPLE, IT IS NOT UNCOMMON FOR AN OFFICE ACTION TO REJECT SOME CLAIMS BASED ON ART (E.G., 35 U.S.C. §102 (ANTICIPATION) AND/OR 35 U.S.C. §103 (OBVIOUSNESS)) AND TO REJECT OTHER CLAIMS BASED ON TECHNICAL (NON-ART) GROUNDS. WHEN THE TECHNICAL REJECTION OF A CLAIM IS TRAVERSED BY ARGUMENT ALONE AND NO OTHER GROUNDS FOR REJECTION OF THAT CLAIM ARE PRESENTED, THE FINALITY OF A NEXT OFFICE ACTION REJECTING THAT CLAIM IS PRECLUDED.

THESE LIMITED CIRCUMSTANCES PRECLUDING FINALITY ARE NOT COMMON AND OTHER ISSUES SOMETIMES CAMOUFLAGE THEM. NEVERTHELESS, WHEN THEY ARE PRESENT, A WELL-INFORMED APPLICANT CAN HELP HIMSELF OR HERSELF AVOID AN IMPROPER FINAL OFFICE ACTION (ALONG WITH THE COST AND INCONVENIENCE OF HAVING TO PREPARE A PAPER ASKING FOR THE WITHDRAWAL OF THAT FINALITY).

THE FOLLOWING ARE SOME EXAMPLES OF WAYS TO ADVISE THE OFFICE, IN A RESPONSE TO A NON-FINAL OFFICE ACTION, THAT A SUBSEQUENT OFFICE ACTION CANNOT PROPERLY BE MADE FINAL.

1. EXAMPLE – THE OFFICE ACTION WHOLLY FAILS TO ACKNOWLEDGE A CLAIM

IN THIS CIRCUMSTANCE, A RESPONSE MIGHT INCLUDE A SECTION SUCH AS:

FINALITY OF THE NEXT ACTION IS PRECLUDED

LASTLY, APPLICANT RESPECTFULLY REQUESTS THAT THE OFFICE CONFIRM THE STATUS OF INDEPENDENT CLAIM 19, WHICH WAS NOT ADDRESSED BY THE OFFICE ACTION. APPLICANT RESPECTFULLY SUBMITS THAT THE OFFICE'S FAILURE TO ACKNOWLEDGE CLAIM 19 PRECLUDES THE FINALITY OF A NEXT OFFICE ACTION REJECTING THAT CLAIM, BECAUSE SUCH A REJECTION WILL NOT HAVE BEEN NECESSITATED BY EITHER A CLAIM AMENDMENT OR BASED ON INFORMATION FROM AN INFORMATION DISCLOSURE STATEMENT. (SEE MPEP § 706.07(A)).

2. EXAMPLE - THE OFFICE ACTION FAILS TO SPECIFICALLY REJECT A CLAIM IN THE DETAILED ACTION – AN ARGUABLE ABSENCE OF A PRIMA FACIE CASE

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IN THIS SITUATION, A RESPONSE MIGHT INCLUDE A STATEMENT LIKE THE FOLLOWING:

FINALITY OF THE NEXT ACTION IS PRECLUDED

APPLICANT NOTES THE OFFICE ACTION DOES NOT SPECIFICALLY REJECT INDEPENDENT CLAIM 19. INDEED, ALTHOUGH THE SUMMARY OF THE OFFICE ACTION INDICATES THAT CLAIM 19 STANDS REJECTED, THE DETAILED ACTION OMITTS ANY EXPLANATION OF HOW ANY CITED ART ANTICIPATES [OR RENDERS OBVIOUS] THIS CLAIM. APPLICANT RESPECTFULLY SUBMITS THAT THIS OMISSION AMOUNTS TO A FAILURE TO ARTICULATE A PRIMA FACIE CASE OF UNPATENTABILITY AND THE BURDEN TO REBUT THIS "REJECTION" HAS NOT YET SHIFTED TO THE APPLICANT. CONSEQUENTLY, A NEXT OFFICE ACTION REJECTING CLAIM 19 CANNOT PROPERLY BE MADE FINAL SINCE ONLY THEN WOULD THE APPLICANT BE OBLIGATED TO REBUT THE REJECTION, PRESUMING THAT SUCH AN OFFICE ACTION SETS FORTH A PRIMA FACIE CASE. (SEE MPEP § 706.07(A)).

3. EXAMPLE - THE OFFICE ACTION MAKES ONLY A REBUTTED TECHNICAL (NON-ART) REJECTION AGAINST A CLAIM

HERE, AN APPROPRIATE RESPONSE MIGHT INCLUDE A SECTION LIKE THE FOLLOWING:

ACCORDINGLY, APPLICANT RESPECTFULLY REQUESTS FAVORABLE RECONSIDERATION AND WITHDRAWAL OF THE REJECTION UNDER 35 U.S.C. § 101.

FINALITY OF THE NEXT ACTION IS PRECLUDED

APPLICANT NOTES THE ABSENCE OF AN ART REJECTION AGAINST INDEPENDENT CLAIM 19 AND RESPECTFULLY SUBMITS THAT A NEXT OFFICE ACTION REJECTING THIS CLAIM UNDER ANY SECTION OF TITLE 35 OF THE UNITED STATES CODE OTHER THAN 35 U.S.C. § 101 CANNOT PROPERLY BE MADE FINAL BECAUSE SUCH A REJECTION WILL NOT HAVE BEEN NECESSITATED BY A CLAIM AMENDMENT OR BASED ON INFORMATION FROM AN INFORMATION DISCLOSURE STATEMENT. (SEE SECTION 706.07(A) OF THE MANUAL OF PATENT EXAMINING PROCEDURE).

CONCLUSION

U.S. PATENT OFFICE RULES PRECLUDE THE FINALITY OF AN OFFICE ACTION IN CERTAIN LIMITED CIRCUMSTANCES. KEEPING THESE CIRCUMSTANCES IN MIND WHEN RESPONDING TO NON-FINAL OFFICE ACTIONS, AND USING TECHNIQUES LIKE THOSE DISCUSSED ABOVE, MAY HELP AN APPLICANT AVOID IMPROPER FINAL REJECTIONS, WITHOUT HAVING TO INCUR THE EXPENSE AND INCONVENIENCE OF HAVING TO REQUEST THE WITHDRAWAL OF IMPROPER FINALITY. SO, WHEN APPROPRIATE CIRCUMSTANCES ARE PRESENT, CONSIDER

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MEMORIALIZING, IN RESPONSES TO NON-FINAL OFFICE ACTIONS, REASONS WHY FINALITY OF A NEXT OFFICE ACTION WOULD BE IMPROPER.

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