

## EXAMPLES OF HOW TO RESPOND TO WRITTEN DESCRIPTION REJECTIONS - THE FUNDAMENTALS OF THE WRITTEN DESCRIPTION REQUIREMENT AND STRATEGIES FOR RESPONDING TO WRITTEN DESCRIPTION REJECTIONS – PART II

BY MICHAEL E. KONDOUDIS

THIS POST IS THE SECOND IN A SERIES ADDRESSING WRITTEN DESCRIPTION REJECTIONS. THE FOLLOWING ARE BASIC EXAMPLES OF RESPONSES TO WRITTEN DESCRIPTION REJECTIONS THAT APPLY SOME OF THE PRINCIPLES I DISCUSSED IN MY EARLIER POST ON THE FUNDAMENTALS OF THE WRITTEN DESCRIPTION REQUIREMENT.

### EXAMPLES

#### 1. THE OFFICE ACTION FAILS TO ESTABLISH A PRIMA FACIE CASE

THE OFFICE ACTION REJECTED CLAIM 2 FOR ALLEGEDLY FAILING TO COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT OF THE FIRST PARAGRAPH OF 35 U.S.C. § 112. APPLICANT RESPECTFULLY SUBMITS THAT THE OFFICE HAS, BY ONLY PROVIDING MERE CONCLUSORY STATEMENTS, FAILED TO SATISFY ITS BURDEN TO ARTICULATE A PRIMA FACIE CASE. WITHOUT ADEQUATE NOTICE OF THE BASIS OF THIS REJECTION, THE BURDEN TO REBUT THIS REJECTION WITH EVIDENCE AND/OR ARGUMENT HAS NOT YET SHIFTED TO APPLICANT.

THE MPEP REPEATEDLY WARNS THAT THE OFFICE BEARS AN INITIAL BURDEN OF ESTABLISHING A PRIMA FACIE CASE WHEN MAKING A WRITTEN DESCRIPTION REJECTION. (MPEP §§ 706.07, 2163 (III)(A)). A PRIMA FACIE CASE REQUIRES A REASONABLE BASIS TO CHALLENGE THE ADEQUACY OF THE WRITTEN DESCRIPTION. (MPEP § 2163.04). THE MPEP EQUATES THIS REASONABLE BASIS WITH “A PREPONDERANCE OF EVIDENCE WHY A PERSON SKILLED IN THE ART WOULD NOT RECOGNIZE IN AN APPLICANT’S DISCLOSURE A DESCRIPTION OF THE INVENTION DEFINED BY THE CLAIMS.” (MPEP § 2163(III)(A)). CONSEQUENTLY, THE OFFICE MUST PROVIDE A REASONABLE BASIS TO REJECT A CLAIM FOR FAILING TO SATISFY THE WRITTEN DESCRIPTION REQUIREMENT, AND THIS REQUIRES “A FULL DEVELOPMENT” OF THE REASONS SHOWING THAT, BY A PREPONDERANCE OF THE EVIDENCE, A PERSON OF ORDINARY SKILL IN THE ART WOULD NOT RECOGNIZE A DESCRIPTION OF THE CLAIMED INVENTION IN THE DISCLOSURE. IN THIS REGARD, THE MPEP; EXPRESSLY INSTRUCTS THAT MERELY CONCLUSORY STATEMENTS ARE INSUFFICIENT. RATHER, EVERY WRITTEN DESCRIPTION REJECTION “SHOULD BE STATED WITH A FULL DEVELOPMENT OF THE REASONS RATHER THAN BY A MERE CONCLUSION....” (MPEP § 706.03). STATED ANOTHER WAY, THE OFFICE MUST ADEQUATELY EXPLAIN THE PERCEIVED SHORTCOMINGS OF THE APPLICATION SO THAT APPLICANT IS PROPERLY NOTIFIED AND ABLE TO

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RESPOND. FINALLY, UNTIL THE OFFICE ESTABLISHES A PRIMA FACIE CASE, AN APPLICANT IS NOT UNDER AN OBLIGATION TO REBUT THE REJECTION. (MPEP § 2163.04). APPLICANT RESPECTFULLY SUBMITS THAT SUCH IS THE CASE HERE.

THE WRITTEN DESCRIPTION REJECTION IS SET FORTH IN ITS ENTIRETY AT PAGE 4 OF THE OFFICE ACTION, AND MERELY STATES THAT THE RADIATOR OF CLAIM 2 IS NOT SUPPORTED BY THE SPECIFICATION. ABSENT FROM THIS REJECTION, FOR EXAMPLE, ARE ANY “REASONED OR SUPPORTED STATEMENTS” SUPPORTING THIS REJECTION, AS THE MPEP EXPRESSLY REQUIRES. INDEED, THE REJECTION IS DEVOID OF “EVIDENCE OR REASONS” AS TO WHY THE DISCLOSURE FAILS TO REASONABLY CONVEY TO ONE OF ORDINARY SKILL IN THE ART THAT APPLICANT POSSESSED THE CLAIMED INVENTION. THUS, THE OFFICE HAS FAILED TO SET FORTH EXPRESS FINDINGS OF FACT THAT SUPPORT THE LACK OF WRITTEN DESCRIPTION CONCLUSION AS ITS OWN PROCEDURES REQUIRE. (MPEP §2163.04). RATHER, THE PROVIDED “REASON” IS A MERE CONCLUSION, WHICH THE MPEP EXPRESSLY WARNS IS INSUFFICIENT TO SUPPORT THIS REJECTION. (MPEP § 706.03).

THE OFFICE’S FAILURE TO MEET ITS BURDEN TO ARTICULATE A “REASONABLE BASIS CHALLENGING THE ADEQUACY OF THE WRITTEN DESCRIPTION” WITH “FINDINGS OF FACT” IS FATAL TO THIS REJECTION SINCE APPLICANT IS UNDER NO BURDEN TO REBUT IT. (MPEP §§ 706.07, 2163, 2163.04). FOR THIS REASON, THIS REJECTION IS TRAVERSED.

ACCORDINGLY, APPLICANT RESPECTFULLY REQUESTS FAVORABLE RECONSIDERATION AND WITHDRAWAL OF THE REJECTION OF CLAIM 2 UNDER THE FIRST PARAGRAPH OF 35 U.S.C. § 112.

IN THE EVENT THAT THE OFFICE MAINTAINS THIS REJECTION, APPLICANT RESPECTFULLY REQUESTS, IN ACCORDANCE WITH THE PRINCIPLES OF COMPACT PROSECUTION, THAT THE OFFICE FULLY DEVELOP THE REASONS FOR THIS REJECTION BY ARTICULATING, ON THE RECORD, “PROPERLY REASONED AND SUPPORTED STATEMENTS” THAT SUFFICIENTLY EXPLAIN WHAT, IN THE EXAMINER’S VIEW, IS MISSING FROM THE WRITTEN DESCRIPTION.

## 2. A SUBSTANTIVE RESPONSE

CLAIMS 1-14 STAND REJECTED UNDER THE FIRST PARAGRAPH OF 35 U.S.C. § 112 FOR ALLEGEDLY FAILING TO COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT. SPECIFICALLY, THE OFFICE ACTION CONTENDS THAT APPLICANT’S DISCLOSURE DOES NOT SUFFICIENTLY DESCRIBE THE STEAM VALVE CONTROLLER FEATURES OF AMENDED CLAIMS 1, 6, AND 10. THIS CONTENTION IS RESPECTFULLY TRAVERSED.

WHEN A DISCLOSURE DESCRIBES A CLAIMED INVENTION IN A MANNER THAT PERMITS ONE SKILLED IN THE ART TO REASONABLY CONCLUDE THAT THE

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INVENTOR POSSESSED THE CLAIMED INVENTION THE WRITTEN DESCRIPTION REQUIREMENT IS SATISFIED. (MPEP §2163 (EMPHASIS ADDED)). THIS POSSESSION MAY BE SHOWN IN ANY NUMBER OF WAYS AND AN APPLICANT NEED NOT DESCRIBE EVERY CLAIM FEATURE EXACTLY BECAUSE THERE IS NO IN HAEC VERBA REQUIREMENT. (MPEP § 2163). RATHER, TO SATISFY THE WRITTEN DESCRIPTION REQUIREMENT, ALL THAT IS REQUIRED IS “REASONABLE CLARITY.” (MPEP § 2163.02). ALSO, AN ADEQUATE DESCRIPTION MAY BE MADE IN ANY WAY THROUGH EXPRESS, IMPLICIT, OR EVEN INHERENT DISCLOSURES IN THE APPLICATION, INCLUDING WORDS, STRUCTURES, FIGURES, DIAGRAMS, AND/OR FORMULAE. (MPEP §§ 2163(I), 2163.02). FINALLY, IT IS IMPORTANT TO BE MINDFUL OF THE GENERALLY INVERSE CORRELATION BETWEEN THE LEVEL OF SKILL AND KNOWLEDGE IN THE ART AND THE SPECIFICITY OF DISCLOSURE NECESSARY TO SATISFY THE WRITTEN DESCRIPTION REQUIREMENT. (MPEP § 2163(II)(A)(2)) (INVENTIONS IN “PREDICTABLE” OR “MATURE” REQUIRE A LESSER SHOWING OF POSSESSION THAN INVENTIONS IN MORE “UNPREDICTABLE” ARTS).

AS THE OFFICE ACTION NOTES, INDEPENDENT CLAIMS 1, 6, AND 10 NOW RECITE A CONTROLLER THAT OPERATES STEAM VALVES TO CONTROL THE FEEDING OF STEAM INTO FEED PIPES. APPLICANT SUBMITS THAT ONE OF ORDINARY SKILL IN THE ART WOULD REASONABLY CONCLUDE THAT APPLICANT’S DISCLOSURE ADEQUATELY DESCRIBED THE CLAIMED INVENTION AT THE TIME OF FILING AT LEAST BECAUSE:

(1) THE FEATURE OF THE CONTROLLER IS AT LEAST IMPLIEDLY TAUGHT BY THE PRESENT APPLICATION AS IT WAS ORIGINALLY FILED; AND

(2) ART TO WHICH THE CLAIMED INVENTION BELONGS IS MATURE AND THE PREDICTABLE NATURE OF THE ART MANDATES A GENERALLY LOWER SHOWING OF POSSESSION.

A REVIEW OF THE PRESENT APPLICATION REVEALS THAT APPLICANT DESCRIBES USING STEAM VALVES TO CONTROL OPERATIONS OF STEAM FEED PIPES. (SEE APPLICATION, E.G., PARAGRAPHS [0031], [0032], AND [0036]-[0038]). THOSE OF ORDINARY SKILL IN THE ART WOULD UNDERSTAND THAT SUCH A DISCLOSURE AT LEAST IMPLIES THE PRESENCE OF SOME CONSTRUCT TO CONTROL THE STEAM VALVES, ESPECIALLY IN VIEW OF THE MATURITY AND PREDICTABILITY OF THE SUBJECT ART.

APPLICANT ALSO DESCRIBED AND ILLUSTRATED A CONTROLLER 13 THAT MANAGES BAKING OPERATIONS, INCLUDING BAKING OPERATIONS THAT INCLUDE STEAM. (SEE APPLICATION, E.G., PARAGRAPH [0039]; FIGS. 2 AND 3). THOSE OF ORDINARY SKILL IN THE ART WOULD UNDERSTAND THAT SUCH A DISCLOSURE AT LEAST IMPLIES (AND ARGUABLY EXPRESSLY DESCRIBES) THAT THE CONTROLLER CONTROLS THE DELIVERY OF STEAM TO THE STEAM PIPES. FURTHER, IT IS RESPECTFULLY SUBMITTED THAT ONE OF ORDINARY SKILL IN THE ART WOULD HAVE UNDERSTOOD THAT SUCH A CONTROLLER COULD BE

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USED TO CONTROL VARIOUS OPERATIONS OF A STEAM OVEN THROUGH VALVE CONTROL.

IN VIEW OF THE FOREGOING, APPLICANT RESPECTFULLY SUBMITS THAT ORDINARILY SKILLED ARTISANS WOULD REASONABLY CONCLUDE THAT APPLICANT POSSESSED THE CLAIMED CONTROLLER ON THE BASIS OF THE AFOREMENTIONED AT LEAST IMPLICIT DESCRIPTIONS. APPLICANT FURTHER SUBMITS THAT THIS CONCLUSION IS BUTTRESSED BY THE MATURITY AND PREDICTABILITY OF THE ART AND BECAUSE AN ADEQUATE DISCLOSURE NEED NOT BE EXPRESS OR EVEN IMPLIED. THUS, THE PRESENT APPLICATION ADEQUATELY DESCRIBES THE CLAIMED INVENTION.

APPLICANT THUS RESPECTFULLY REQUESTS FAVORABLE RECONSIDERATION AND WITHDRAWAL OF THE REJECTION UNDER 35 U.S.C. § 112.

IN THE EVENT THAT THE OFFICE MAINTAINS THIS REJECTION, APPLICANT RESPECTFULLY REQUESTS, IN THE INTEREST OF ITS POLICY OF COMPACT PROSECUTION, THAT THE OFFICE EXPLAIN HOW THE AFOREMENTIONED PORTIONS OF THE PRESENT APPLICATION FAIL TO COMMUNICATE TO A SKILLED ARTISAN THAT APPLICANT POSSESSED THE CLAIMED INVENTION.

### 3. ORIGINAL SUBJECT MATTER IS REJECTED

CLAIM 5 STANDS REJECTED UNDER THE FIRST PARAGRAPH OF 35 U.S.C. § 112. SPECIFICALLY, THE OFFICE ACTION CONTENDS THAT THE CLAIM RECITATION “A WIDGET” IS NOT ADEQUATELY SUPPORTED BY THE SPECIFICATION. (OFFICE ACTION, PAGE 5). THIS CONTENTION IS RESPECTFULLY TRAVERSED.

TO SATISFY THE WRITTEN DESCRIPTION REQUIREMENT OF THE FIRST PARAGRAPH OF 35 U.S.C. § 112, A DISCLOSURE NEED ONLY DESCRIBE A CLAIMED INVENTION IN A MANNER SUFFICIENT TO REASONABLY CONVEY TO THOSE SKILLED IN THE RELEVANT ART THAT APPLICANT POSSESSED THE CLAIMED INVENTION. THIS POSSESSION MAY BE SHOWN IN ANY NUMBER OF WAYS AND AN APPLICANT NEED NOT DESCRIBE EVERY CLAIM FEATURE EXACTLY. (MPEP §2163 (EMPHASIS ADDED)). RATHER, ALL THAT IS REQUIRED IS “REASONABLE CLARITY.” ALSO, ORIGINAL SUBJECT MATTER ENJOYS A “STRONG PRESUMPTION” OF COMPLIANCE WITH THE WRITTEN DESCRIPTION REQUIREMENT. (MPEP §§ 2163 (I)(A), 2163(II)(A), 2163(II)(A)(3)(A)).

THE MPEP, IN SECTION 2163 (I)(A), IDENTIFIES SEVERAL FACTORS THAT ARE TO BE CONSIDERED IN A PROPER ANALYSIS OF WHETHER ORIGINAL SUBJECT MATTER COMPLIES WITH THE WRITTEN DESCRIPTION REQUIREMENT, INCLUDING:

- 1) THE LEVEL OF SKILL AND KNOWLEDGE IN THE ART;

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- 2) ANY DISCLOSURE OF PARTIAL STRUCTURE;
- 3) ANY DISCLOSURE OF PHYSICAL/CHEMICAL PROPERTIES;
- 4) ANY FUNCTIONAL CHARACTERISTICS/CORRELATION BETWEEN STRUCTURE AND FUNCTION; AND

INITIALLY, IT IS IMPORTANT TO RECOGNIZE THAT THE REJECTED SUBJECT MATTER IS ORIGINAL TO THIS APPLICATION. THUS, THE OFFICE MUST OVERCOME A STRONG PRESUMPTION THAT THE REJECTED CLAIMS WITH THE WRITTEN DESCRIPTION REQUIREMENT. THIS IS BECAUSE A DESCRIPTION AS ORIGINALLY FILED IS PRESUMED TO BE ADEQUATE, UNLESS OR UNTIL EVIDENCE OR REASONING TO THE CONTRARY HAS BEEN PRESENTED BY THE EXAMINER SUFFICIENT TO REBUT THE PRESUMPTION. (MPEP § 2163.04).

APPLYING THESE AFOREMENTIONED FACTORS TO THE PRESENT APPLICATION REVEALS THAT THE CLAIMED FEATURE OF "A WIDGET" IS ADEQUATELY DESCRIBED. [APPLICATION OF FACTORS REGARDING ORIGINAL SUBJECT MATTER].

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ACCORDINGLY, FAVORABLE RECONSIDERATION AND WITHDRAWAL OF THE REJECTION UNDER 35 U.S.C. § 112 ARE RESPECTFULLY REQUESTED.

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