
A New Approach to Finality: Repeated Grounds of Rejection

In the first article in this series, I presented some preliminary concepts for my proposed new test for Finality. In this second article, I present the full test, then explain how the first part of the test would be applied¹.

The proposed test itself is fairly simply described: A proper Office Action may be made Final if:

- 1) The proper Office Action does not introduce a new ground of rejection of any claim that was previously examined; or
- 2) The requisite number of proper Office Actions has previously been issued.

Applying the First Part of the Test

Now, to say that a proper Office Action² may be made Final if the Office Action does not introduce a new ground of rejection sounds simple. But there are a number of details that go into determining whether a particular ground of rejection is new or not.

First, only Office Actions by the Examiner that actually reject the claims based on the statutes (35 U.S.C. §§ 101, 102, 103, and 112³) count. Thus, for example, a Restriction Requirement is not considered an Office Action for purposes of Finality.

Second, the proposed test is concerned whether *individual* grounds of rejection are new or not. The Examiner does not have to repeat an Office Action as a whole for the test. Thus, for example, assume the Examiner has issued three Office Actions in a patent application that has two claims. If the third Office Action repeats the rejection of claim 1 from the first Office Action and repeats the rejection of claim 2 from the second Office Action, the Examiner could make the third Office Action Final, even though the third Office Action does not repeat the exact rejections from either of the earlier Office Actions.

Third, the test is applied without concern for whether the claims have been amended. So, if the Applicant amends the claims and the Examiner is forced to use a new ground of rejection

¹ How the second part of the test would be applied will be discussed in the next article.

² From this point forward, any reference to “Office Action” is intended to mean a “proper Office Action”, unless otherwise indicated.

³ At this time, these sections are the only statutory grounds for refusing to issue a patent. Should the statutes change some time in the future to remove one or more of these sections and/or to add new sections that provide grounds for refusing to issue a patent, then this list would change.

for the amended claim, the Examiner would not be able to justify Finality based on whether the Examiner is only repeating prior grounds of rejection⁴.

Fourth, what about claims that were added during prosecution (that is, claims that were not in the application when the application was filed)? While newly added claims would not be considered in determining Finality in the Office Action immediately after those claims are added (since they had not been previously examined), in any subsequent Office Actions the Examiner should consider those claims in determining whether Finality is proper based on the grounds of rejection.

So, for example, assume that the Applicant files a patent application with one claim. In the first Office Action, the Examiner rejects claim 1. In response, the Applicant amends claim 1 and adds new claim 2. In the second Office Action, the Examiner only needs to consider whether the rejection of claim 1 is over a new ground or not, since claim 2 was newly added.

Now, assume that the Examiner rejects claim 1 over a new ground of rejection, and therefore cannot make the second Office Action Final. (The Examiner also rejects claim 2, but in the second Office Action the rejection of claim 2 does not enter into the Finality analysis.) In response, the Applicant amends claims 1 and 2, and adds new claim 3. In the third Office Action, the Examiner would need to consider whether the rejection of both of claims 1 and 2 are over new grounds or not.

This concept—that newly added claims do not need to be considered in the Finality analysis—is one of the few parts of my proposed test where it does not matter whether the Office Action is proper or not. That is to say, if the Office Action immediately after a new claim is added was not a proper Office Action, when the Examiner mails the next proper Office Action, Finality would not be proper⁵, since the “new” claim would have been part of the application during the (improper) Office Action.

⁴ A reader might infer from this condition that an Applicant could prevent the Examiner from ever making an Office Action Final. The answer to this concern lies in the second half of the proposed Finality test, which will be described in the next article.

⁵ At least, based on whether or not the Examiner had introduced a new ground of rejection.

A New Ground of Rejection

Now we turn to the heart of the matter: what is a “new ground of rejection”? I propose that there are six sub-tests that can be used to determine whether a rejection is a new ground of rejection.

1) If the rejection relies on a new statutory section, then the rejection is a new ground of rejection.

This sub-test should be straightforward. If the Examiner had previously relied on 35 U.S.C. § 101 to reject a claim, and now relies on 35 U.S.C. § 102 to reject that claim, the rejection is a new ground of rejection. Similarly, if the Examiner previously relied on 35 U.S.C. § 102 to reject a claim, and now relies on 35 U.S.C. § 103 to reject that claim, the rejection is a new ground of rejection⁶.

⁶ Since at least 2016, Office Actions have begun to include form paragraph ¶ 7.06, which can be found in the [Manual of Patent Examining Procedure \(M.P.E.P.\) § 706.02\(i\)](#), which ostensibly authorizes an Examiner to change between 35 U.S.C. §§ 102 and 103 without the change being considered a new ground of rejection if the prior art and the rationale supporting the rejection have not changed. I have discussed this form paragraph with several Examiners, some of whom were not even aware that this form paragraph is included in Office Actions (it is apparently added automatically by the computers at the U.S. Patent & Trademark Office). Most of the Examiners with whom I have discussed this form paragraph have agreed that switching between 35 U.S.C. §§ 102 and 103 should be considered a new ground of rejection, since the rationale must inherently change when the rejection changes between 35 U.S.C. §§ 102 and 103.

In my proposed test for Finality, I expressly disavow the use of form paragraph ¶ 7.06. Even if the entirety of the change in the Examiner’s rejection is limited to the statutory basis, the different rejection is a new ground of rejection.

The basis for form paragraph ¶ 7.06 appears to come from [M.P.E.P. § 1207.03\(a\)](#), at least in part. M.P.E.P. § 1207.03(a) does not discuss examination directly, but rather relates to an Examiner’s Answer to an Appeal Brief (during appeal to the Patent Trial and Appeal Board). Because an Examiner might introduce a “new ground of rejection” in an Examiner’s Answer (whether intentionally or inadvertently), the M.P.E.P. describes how to handle such a situation and (more pertinently here) gives examples of what would and would not be considered new grounds of rejection. But form paragraph ¶ 7.06 is not entirely consistent with M.P.E.P. § 1207.03(a). For example, M.P.E.P. § 1207.03(a) states that changing the statutory basis of a rejection from 35 U.S.C. § 102 to 35 U.S.C. § 103 would constitute a new ground of rejection; form paragraph ¶ 7.06 suggests otherwise.

I also would disagree with the assertion in M.P.E.P. § 1207.03(a) that “[c]hanging the statutory basis of rejection from 35 U.S.C. § 103 to 35 U.S.C. § 102, but relying on the same teachings” is not a new ground of rejection. In my opinion, the analysis used in the M.P.E.P. misreads the case law. M.P.E.P. § 1207.03(a) analyzes *In re May*, 574 F.2d 1082 (C.C.P.A. 1978). According to M.P.E.P. § 1207.03(a), “[t]he court affirmed the rejection [made under 35 U.S.C. § 103], but did so under 35 U.S.C. § 102, stating that ‘lack of novelty is the epitome of obviousness’”.

I would disagree with the presented interpretation of *May*. My reading of *May* suggests that the court thought claims 1 and 6 of the *May* application were anticipated. But if these claims lacked novelty, then these claims were certainly obvious, since no changes to the prior art would need to be made. Therefore the rejection under 35 U.S.C. § 103 was affirmed: the court did *not* substitute a rejection under 35 U.S.C. § 102 for the (affirmed) rejection under 35 U.S.C. § 103. In other words, the court held that the claims *were* obvious, just for a different reason than the U.S. Patent & Trademark Office had rejected the claims.

2) If the rejection relies on different statutory language, the rejection is a new ground of rejection.

As the objective behind this sub-test is not necessarily obvious, let me elaborate. This sub-test is designed to cover the situation where Congress changes the language of the statute (as happened when Congress amended pre-America Invents Act (AIA) 35 U.S.C. § 102(e), or when the AIA was passed (which completely overhauled 35 U.S.C. § 102). Similarly, if the Examiner decides to change between pre-AIA and post-AIA 35 U.S.C. §§ 102 or 103, the Examiner would be applying different statutory language. If the Examiner relies on different statutory language in rejecting the claim, the Applicant ought to be given an opportunity to address the new rejection before the Examiner makes the Office Action Final.

3) If the rejection relies on a new statutory sub-section, then the rejection is a new ground of rejection.

This sub-test might cause some confusion: what does it matter if the Examiner changes the subsection on which he is relying? After all, anticipation is anticipation, and it does not matter if the Examiner relies on post-AIA 35 U.S.C. § 102(a)(1) or (a)(2) (or on pre-AIA 35 U.S.C. § 102(a), (b), or (e)), right? My answer to this concern is that yes, the change does matter.

First of all, consider 35 U.S.C. § 112. 35 U.S.C. § 112 has six sub-sections which are effectively unrelated. If the Examiner changes from, for example, a written description rejection under 35 U.S.C. § 112(a) to an indefiniteness rejection under 35 U.S.C. § 112(b), these are entirely different rejections. The fact that they have been grouped together under 35 U.S.C. § 112 does not change the fact that the different sub-sections have no uniting theme.

But even where the sub-sections are “related” (for example, both relating to anticipation), the different sub-sections can afford the Applicant different response opportunities. Consider,

The court in *May* also relied on an earlier decision in *In re Pearson*, 494 F.2d 1399, 1402 (C.C.P.A. 1974). Like *May*, *Pearson* involved a claim that was rejected under 35 U.S.C. § 103 but was technically anticipated. In *Pearson*, the court stated that it was acceptable to base a rejection on 35 U.S.C. § 103 even though the claim is technically anticipated.

A subtle distinction? Perhaps. But affirming a rejection under 35 U.S.C. § 103 because the court thought the claims were anticipated is not the same thing as substituting a rejection under 35 U.S.C. § 102 for a rejection under 35 U.S.C. § 103. Saying that a claim is obvious because it is actually anticipated is merely affirming the obviousness rejection, not substituting an anticipation rejection for the obviousness rejection.

I also take issue with other portions of M.P.E.P. § 1207.03(a): see footnote 15 and the section entitled **Some More Controversial Sub-Tests**, *infra*.

for example, pre-AIA 35 U.S.C. § 102(a) and (b)⁷. Pre-AIA 35 U.S.C. § 102(b) was commonly referred to as the “statutory bar”⁸: if the prior art had been patented, published, or in public use more than one year before the patent application was filed, there was no avoiding the prior art. The Applicant’s only options were to show that the claimed invention was distinguishable from the prior art, amend the claims, or cancel the claims. Pre-AIA 35 U.S.C. § 102(a), on the other hand, permitted the Applicant to “swear behind” the prior art with an affidavit of prior inventorship⁹: that is, to establish that the Applicant had conceived of the invention first. If the Applicant was able to successfully swear behind the reference, the Examiner could no longer rely on that reference: the Applicant did not need to amend the claims or distinguish the claimed invention.

If the Examiner initially rejects a claim under pre-AIA 35 U.S.C. § 102(a), the Applicant could elect to swear behind the prior art. Since successfully swearing behind a reference would remove that reference as prior art, the Applicant would not need to argue why the claimed invention is distinguishable or amend the claims. But if the Examiner changes from pre-AIA 35 U.S.C. § 102(a) to pre-AIA 35 U.S.C. § 102(b)¹⁰ in a subsequent Office Action, the affidavit of prior inventorship would be useless. The Applicant would then have no choice but to argue how the claimed invention is distinguishable or amend the claims. The Applicant should then be given another opportunity to respond to the rejection now that the Examiner’s new ground of rejection has invalidated the Applicant’s first response.

The reverse scenario is also possible. Consider an Examiner who rejects a claim under pre-AIA 35 U.S.C. § 102(b), when the prior art was not actually available under pre-AIA 35 U.S.C. § 102(b). The Applicant can argue the Examiner’s mistake, but the Applicant cannot submit an affidavit of prior inventorship (since such an affidavit would not be responsive to the rejection under pre-AIA 35 U.S.C. § 102(b)). If the Examiner then changes the rejection to be under pre-AIA 35 U.S.C. § 102(a), the Applicant can now submit the affidavit of prior inventorship, and the Applicant should be given that opportunity.

⁷ Under the post-AIA 35 U.S.C. § 102, the Applicant’s response options are the same regardless of the subsection applied by the Examiner. But Congress could always change the statute in a manner that would offer Applicants different response possibilities. Therefore, while my reasoning does not apply to the AIA as currently enacted, my reasoning might apply to the statutes at some time in the future.

⁸ See [M.P.E.P. 2133.02 II](#).

⁹ See [M.P.E.P. 2132.01 III](#).

¹⁰ I am ignoring the fact that neither the Applicant nor the Examiner noticed that the prior art could have been used under pre-AIA 35 U.S.C. § 102(b) in the first place: after all, mistakes do happen.

In essence, this sub-test (and all the other sub-tests as well) centers on a very simple but important question: has the change in the Examiner's rejection of the claim removed or added avenues of response for the Applicant? If so, the Applicant should be given an opportunity to use the changed avenues of response, and Finality would be wrong.¹¹

4) If the Examiner is relying on a different combination of references, then the rejection is a new ground of rejection.

At first blush, this sub-test would seem clear: if the Examiner introduces a new reference, the rejection is obviously a new ground of rejection. After a little thought, it should also be clear that this sub-test not only covers where the Examiner changes the combination of references used in rejecting a claim as obvious, but also where the Examiner changes the reference he is relying on in rejecting a claim as anticipated.

But this sub-test actually covers more than just situations where the Examiner adds a new reference. Consider the following example: in the first Office Action, the Examiner rejects a claim under 35 U.S.C. § 103¹² over the combination of three references: A, B, and C. The Examiner identifies different features in the claim as taught by each of these references. In the second Office Action, the Examiner rejects the same claim (without amendment) under 35 U.S.C. § 103 over the combination of references A and B—that is, the Examiner eliminates reference C from the combination¹³.

By eliminating reference C in making the new rejection, the Examiner had to identify one of the other references as teaching the feature against which reference C had previously been cited. But the Examiner had not previously thought that references A or B taught the feature in question, which was why the Examiner had added reference C to the combination. In the second

¹¹ This part of my proposed Finality test could have been centered on whether the Examiner had changed the Applicant's avenues of response. But since an analysis of whether the Applicant's avenues of response have changed is a complicated analysis (depending heavily on what the initial and new grounds of rejection are), I have opted for a simpler statement: whether the Examiner has changed to a new ground of rejection.

¹² For purposes of this example, it does not matter whether the Examiner is relying on the pre-AIA or post-AIA statute.

¹³ While this is not a common situation, I have had this exact scenario, or one very similar to it, occur in the examination of at least one patent application.

As an aside, I am well aware of the holding that the Applicant is responsible for everything a reference teaches, whether or not discussed by the Examiner. But that holding should not limit an Applicant in the situation where the Examiner acknowledges that a reference does not teach a particular feature. While the Applicant may have a duty to deal fairly with the U.S. Patent & Trademark Office, that duty should not extend to actively double-checking everything an Examiner has said.

Office Action, the Examiner has changed his mind about the applicability of reference A or B to the feature in question. The Applicant should therefore have an opportunity to respond to the Examiner's new analysis of the references. This harkens back to the concept described earlier, that the Applicant should be afforded an opportunity to respond to changes made by the Examiner: in this case, responding to the Examiner's reliance on a different reference as teaching a particular feature of the claim¹⁴.

I would also apply this sub-test a little more stringently than the U.S. Patent & Trademark Office currently applies related ideas¹⁵. The U.S. Patent & Trademark Office is an agency of the federal government, and therefore is bound by Fifth Amendment to the U.S. Constitution¹⁶. Therefore, the Applicant is entitled to both procedural and substantive due process during examination of a patent application. Substantive due process applies when an Examiner rejects a claim; procedural due process applies to the form the rejection takes. If an Examiner states that a claim is rejected under 35 U.S.C. § 103¹⁷ over a combination of references, then all the references listed are part of the combination, regardless of whether or not the Examiner actually uses the references. Changing the list of references in the summary of the rejection changes the notice to the Applicant.

An example might help to illustrate my point. Assume the Examiner states that independent claim is rejected under 35 U.S.C. § 103 as unpatentable over the combination of references A, B, and C. But in the detailed rejection, where the Examiner identifies where the various features of the claim are to be found in the references, the Examiner only cites to references A and B: the Examiner does not "use" reference C in making the rejection¹⁸. Procedurally, reference C is part of the rejection, even though the Examiner did not point to reference C as teaching any features of the claim. If the Examiner in a later Office Action realizes that reference C did not need to be listed in the summary of the rejection, removing

¹⁴ This concept will reappear again shortly in another sub-test.

¹⁵ [M.P.E.P. § 1207.03\(a\)](#), discussed above in footnote 6, *supra*, asserts that "[r]elying on fewer than all references in support of a 35 U.S.C. § 103 rejection, but relying on the same teachings" is not a new ground of rejection. If an Examiner can make such a change in an Examiner's Answer, the logical implication is that an Examiner could make a similar change in an Office Action without triggering a new ground of rejection. I think M.P.E.P. § 1207.03(a) is wrong on this point, for the same reasons that I think such a change should be considered a new ground of rejection for Finality purposes: the change is procedural, and the Applicant is entitled to notice about the change in the U.S. Patent & Trademark Office's position.

¹⁶ The Fifth Amendment of the U.S. Constitution, in relevant part, states that "No person shall ... be deprived of ... property, without due process of law".

¹⁷ Again, it does not matter whether pre-AIA or post-AIA 35 U.S.C. § 103 is used.

¹⁸ Again, while not a common situation, I have seen this occur in at least one Office Action.

reference C from the summary of the rejection is a procedural change (although not a substantive change), which would mean the second rejection is a new ground of rejection¹⁹.

Some More Controversial Sub-Tests

While the first four sub-tests described above are relatively straightforward, I have encountered two unusual situations where Examiners did things that, in my opinion, should not justify Finality (as they would force the Applicant to address concerns not raised previously), but would not be captured by the first four sub-tests. Thus, I have two additional sub-tests to include.

5) If the Examiner changes the order of references in a rejection over a combination of references, then the rejection is a new ground of rejection.

In the situation that led to this sub-test, the Examiner had rejected a claim under 35 U.S.C. § 103 over the combination of reference A in view of reference B. I had argued that reference A explicitly recited it could not be modified by the teaching of reference B (an unusual circumstance in itself, as references do not usually recite limits on how they can be modified). The Examiner then responded by rejecting the claim over the combination of reference B in view of reference A. I called the Examiner for a telephone interview, because changing the order of the references in the rejection did not address the explicit teaching of reference A. The Examiner explained in the interview that changing the order of the combination to reference B in view of reference A meant that he was now modifying reference B, and the teaching of reference A was not a limit on how reference B could be modified.

Now, in my opinion, any rejection over a combination of references should consider whether *each* reference in the combination can be modified by the others in the combination (individually or as sub-combinations). If there is any reference in the combination that cannot be modified by the teaching of any other reference in the combination, then the claim should not be considered obvious over the combination. What the Examiner did in the above example felt like a huge cheat. In addition, the Examiner's argument all but eliminates the possibility of arguing

¹⁹ Alternatively, the original rejection, which identified but did not rely on reference C, could be considered an improper rejection, and therefore the original Office Action was improper. But personally, I do not see that there is anything facially "improper" with the Examiner listing references in the summary of the rejection that the Examiner does not use in the substantive rejection. Including an unneeded reference in the summary of the rejection is like listing an ingredient one does not need to make a recipe: having the unneeded ingredient on hand does not prevent one from making the recipe, but it forces one to prepare the unneeded ingredient. Removing the reference is therefore, in my opinion, a procedural change, but not an improper rejection.

that one reference teaches away from an obviousness rejection: the only way an Applicant could make a workable argument about teaching away would be when *every* reference in the combination taught away from the overall combination. It is rare enough that a single reference limits its own modification: the probability that even two references each limit modification is so effectively zero, let alone where there are three or more references in the combination. And since the Examiner selects the prior art to be used in rejecting the claim, it is a virtual certainty that the Examiner can find some reference that would not prevent its own modification. A shortcut like the one used by this Examiner is unfair to the Applicant.

There are portions of the Manual of Patent Examining Procedure (M.P.E.P.) that indicate the Examiner was wrong. For example, the M.P.E.P. states that “[i]t is improper to combine references where the references teach away from their combination”²⁰. But while the M.P.E.P. frequently talks about modifying a reference based on the teachings of another reference, I have not found a section in the M.P.E.P. that indicates which references are considered to be “modified” in a combination of references under 35 U.S.C. § 103.

There are also portions of the M.P.E.P. that support the Examiner’s position. M.P.E.P. § 1207.03(a)²¹ states that “[c]hanging the order of references in the statement of rejection, but relying on the same teachings of those references” is not a new ground of rejection. But M.P.E.P. § 1207.03(a) does not address the concern that changing the order of the references “changes” which reference is being “modified”. Even if the Examiner is using each reference in exactly the same way, changing the order of the references can have an impact on how the Applicant can argue in response.

While the use of this sub-test provides a solution to the situation raised by the Examiner, I think a simpler solution can be had. If the M.P.E.P. would state explicitly that in a rejection over a combination of references, each reference must be modifiable in view of every other reference (individually and in all sub-combinations), this sub-test would be unnecessary. With such a statement in the M.P.E.P., the Examiner in my example situation would not have been able to avoid the argument against the modification of reference A by changing the order of the references in the combination. But without such an explicit position, Examiners are free to change the order of the references in a rejection to avoid an argument that a particular reference

²⁰ See [M.P.E.P. § 2145 X.D.2.](#)

²¹ Discussed in footnotes 6 and 15, *supra*.

is being “modified”. Since that change has an impact on the Applicant’s arguments, that change must, of necessity, make for a new ground of rejection.

6) If the Examiner uses an existing reference in a rejection as teaching a feature the Examiner had not previously argued was taught by that reference, then the rejection is a new ground of rejection.

Before getting into the significance of this sub-test, I want to describe a fairly common scenario. Assume that a claim includes five features (let us number those features 1-5). The Examiner, in his search, does not find a single reference teaching all five features, but the Examiner finds two references that the Examiner thinks, in combination, teach all five features. The language the Examiner would use typically looks something like this:

Reference A teaches feature 1 [citation], feature 2 [citation] and feature 3 [citation]. Reference A does not explicitly teach features 4 and 5; however, reference B teaches feature 4 [citation] and feature 5 [citation]. It would be obvious to combine references A and B because [some motivation].

Now, the Examiner has told us exactly what he thinks about reference A: it teaches features 1-3, and does not teach features 4-5. The Examiner has also told us that he thinks reference B teaches features 4-5. But the Examiner has said nothing about whether reference B teaches features 1-3. So what conclusions can we draw from these facts?

The first conclusion²² I would draw is that the Examiner cannot consider reference B as teaching all three of features 1-3. Assume *arguendo* that the Examiner thought that reference B taught all of features 1-3. Then, since the Examiner asserts reference B teaches 4-5, reference B would teach all of the features of the claim. But if the Examiner thought reference B taught all the features of the claim, the Examiner would reject the claim as anticipated by reference B, and not obvious over reference A in view of reference B. Since the Examiner did not reject the claim as anticipated by reference B, the initial assumption that the Examiner thought reference B taught all of features 1-3 must be incorrect.²³

Second, I suggest that the other reasonable conclusion is that reference B does not teach any of features 1-3. The Examiner has had the opportunity to discuss reference B. The Examiner’s decision not to say whether reference B teaches features 1-3 might be motivated by

²² Which I think is an entirely reasonable conclusion.

²³ This is a basic *reductio ad absurdum* argument in propositional logic.

the fact that reference A already teaches those features: but it would cost the Examiner very little to add that reference B also teaches any of those features. After all, the Examiner has reference B in front of him since the Examiner used reference B in rejecting the claim.

On the other hand, putting the burden on the Applicant²⁴ has unreasonable consequences. Assume that the Applicant reads reference B with an eye for whether reference B teaches any or all features of the claim (and not just the features for which the Examiner cited reference B). Assume further that, even though the Examiner does not inform the Applicant, the Examiner thinks that reference B also teaches feature 2. Finally, assume that the Applicant decides that there is an argument (possibly a weak one) that reference B teaches feature 3, but also a counter-argument. The Applicant, being fully forthright, could explain why reference B could be interpreted as teaching feature 3, and then explain why the Applicant does not think that argument is valid.

I could envision an Examiner saying that he agrees that reference B teaches feature 3, and rejecting the Applicant's counter-argument as not persuasive. The Examiner could also point out why he thinks reference B teaches feature 2. And if the Applicant were able to persuade the Examiner that reference A did not teach either or both of those features, the Examiner could switch to reference B for the features in question, and maintain the original rejection.

Under the existing Finality test, the Examiner then would be able to make the rejection Final, since the Examiner has not introduced a new ground of rejection: the same conclusion would also apply based on sub-tests 1-5 of my proposed Finality test. But it does not seem fair for the Examiner to be able to spring his thoughts about reference B teaching feature 2, and even worse for the Examiner to use the Applicant's honest work against him.

The solution, in my opinion, is to permit the Examiner to make change a citation for a feature from one reference in the combination to another reference, but with a caveat: if the Examiner has not previously informed the Applicant that he thinks the reference he is now citing

²⁴ Again, I am aware that the Applicant is responsible for everything a reference teaches. But if the Examiner does not bother to read the entirety of the reference, it is not fair to ask the Applicant to do so. I have held interviews with more than one Examiner where the Examiner freely admitted he did not read a reference in its entirety because to do so would take too much of the Examiner's time. The Examiner bears the burden of proof that the claims are not allowable (*see* 35 U.S.C. § 102 ("A person shall be entitled to a patent unless...")). If the Applicant can demonstrate that the Examiner's rejection does not hold up under sufficient scrutiny, the Examiner has failed to satisfy his burden of proof. To make the Applicant responsible for everything the reference says, even where the Examiner has not considered the reference in its entirety, unfairly shifts the burden to the Applicant to "prove" allowability.

teaches the feature, then the change to the other reference is a new ground of rejection. Thus, the use of sub-test 6²⁵.

Note that this sub-test has one distinguishing feature as compared with all of the other sub-tests: the Examiner has complete control over whether this sub-test can be used. If the Examiner takes the time to explain how every reference in the combination can be used with respect to all claim features, this sub-test will never prevent an Examiner from making a rejection Final.

Comparing This Proposed Finality Test with the Existing Finality Test

Recall the problems with the original Finality test: the test is subjective in nature. Although the test permits Finality when an Office Action introduces “a new ground of rejection that is [not] necessitated by applicant’s amendment of the claims”²⁶, there is no explanation as to what this phrase means; and the test can produce inconsistent results based on the form of amendment used by the Applicant²⁷.

So how does this half of the proposed Finality test compare with the existing test for Finality? I think the comparison is favorable. The one way in which the existing Finality test is superior to the proposed Finality test is in the number of words. The existing Finality test is 60

²⁵ I considered at length about the best solution to the problem covered by this sub-test. Originally, I had a much more complicated solution. If: (1) the rejection where the Examiner changed to another reference in the combination as teaching a feature of the claim was the first Office Action after the Applicant substantively amended the feature in question; AND (2) the Examiner had not applied a different ground of rejection at any point since the Examiner first made the rejection of the claim over the combination; AND (3) the Applicant had not substantively amended the feature at any other time after the Examiner originally rejected the claim over the combination, then the change in the rejection of the feature would not be a new ground of rejection. There was also going to be a caveat: if even if the rejection satisfied all three conditions listed here, if the Examiner made the rejection in an improper Office Action, the Examiner would not be allowed to recover the situation in the next proper Office Action.

I ultimately rejected this solution for several reasons. First, the set of conditions is overly complicated. Second, the test is somewhat subjective: what is a substantive amendment to the “feature”? Would that be an amendment that affects the specific words for which the Examiner is relying on the other reference? Other words in that “paragraph” of the claim? Other language elsewhere in the claim? There are legitimate arguments for all approaches. Third, the guiding principle of this part of the proposed Finality test has been that if the Examiner changes something in the rejection, the Applicant should have an opportunity to respond. Giving the Examiner an opportunity to make such a rejection Final despite presenting a different reason to reject the claims goes against this principle.

But the primary reason I went with the sub-test as described is that, unlike each of the other sub-tests, the Examiner has complete control over the applicability of the sixth sub-test. If the Examiner identifies the teaching in the second reference in the original rejection, the Applicant will have had an opportunity to respond to the argument, and the change in the later Office Action would not be a new ground of rejection. So, I ended up with the simple test described above.

²⁶ See [M.P.E.P. § 706.07\(a\)](#).

²⁷ See [The Problem with Finality \(Part 2\): Inconsistent Analysis](#).

words long; this half of the proposed Finality test is considerably lengthier. But the proposed Finality test is explicit as to when a particular sub-test can be applied or not. This fact also means that this half of the proposed Finality is objective in nature. And as for the inconsistent results under the existing Finality test, those inconsistent results stemmed from ambiguity about whether a particular new ground of rejection was “necessitated” by the Applicant’s amendment or not. As this half of the proposed Finality test has no “necessitation” element (or even a reference to any actions the Applicant might take), there cannot be inconsistent treatment that depends on the form of the Applicant’s amendment.

To illustrate that this half of the proposed Finality test is consistent regardless of the form the Applicant’s amendment takes, let us revisit the Scenario that demonstrated the inconsistency of the existing Finality test²⁸:

An Applicant files a patent application on an invention. The patent application includes one claim that reads, in part, as follows:

1. An apparatus, comprising:
a doohickey;
a widget connected to the doohickey;

....

The Examiner reviews the application, performs a prior art search, and identifies Reference A that, in the Examiner’s opinion, teaches all the features of the invention. The Examiner issues an Office Action, rejecting claim 1 as anticipated by Reference A.

The Applicant reviews the Office Action and the reference. The Applicant concludes that the Examiner is correct to assert that Reference A teaches a widget. The Applicant concludes, however, that Reference A does not teach a *red* widget. The Applicant also concludes that, despite the Examiner’s rejection, Reference A does not actually teach a doohickey.

Under the existing Finality test, if the Applicant amends claim 1 to recite “a red widget...”, the Examiner would likely consider the amendment to necessitate the new ground of rejection, and the next Office Action would be Final, whether or not the Examiner was persuaded that reference A did not teach a doohickey.

On the other hand, if the Applicant leaves claim 1 unamended but adds new claim 2 that recites:

2. (New) An apparatus according to claim 1, wherein the widget includes a red widget.

²⁸ For the full analysis of these scenarios under the existing Finality test, see [The Problem with Finality \(Part 2\): Inconsistent Analysis](#).

then the Examiner can make the second Office Action Final only if the Examiner is not persuaded by the Applicant's argument that reference A does not teach a doohickey. If the Examiner is persuaded by the Applicant's argument, the Examiner would have to issue a new ground of rejection of claim 1. But since the Applicant would not have amended claim 1, that new ground of rejection would not have been necessitated by the Applicant's amendment, which would mean the second Office Action could not be made Final.

By contrast, under the proposed Finality test, the primary question is whether the Examiner is persuaded by the Applicant's argument that reference A does not teach a doohickey. If the Examiner is persuaded by the Applicant's argument, the Examiner will either have to change the rejection from 35 U.S.C. § 102 to 35 U.S.C. § 103 (failing sub-test 1), or will have to change the reference used in the rejection (failing sub-test 4). Either way, it does not matter whether the Applicant amends claim 1 or adds new claim 2²⁹.

So Why Is There More?

While the first half of the Finality test provides a considered analysis of when the Examiner is introducing a new ground of rejection, it should be apparent that this half of the test does not prevent the Applicant from continually amending the claims to force new grounds of rejection, thereby avoiding Finality. Since this problem was the exact reason the concept of Finality was introduced, this half of the proposed Finality test does not provide a complete solution. The other half of the solution is the subject of the next article.

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²⁹ If the Applicant does amend claim 1 and the amendment forces the Examiner to change the ground of rejection, that amendment would be a separate reason why the next Office Action should not be made Final under the proposed Finality test. But such an analysis has independent of the inconsistency that is found in the existing Finality test.

I am well aware that the Examiner could issue a Final Office Action under the proposed Finality test, if the Examiner is still persuaded that reference A teaches a doohickey and the Applicant does not amend the claim to recite a "red widget". But recall that the inconsistency under the existing Finality test was not that one approach would result in a Final Office Action and the other approach would not: the inconsistency was in whether or not the Examiner considered the Applicant's argument that reference A did not teach a doohickey in deciding whether a new ground of rejection was "necessitated" by the Applicant's amendment. Under the existing Finality test, the Applicant must leave the claim unamended to force the Examiner to consider the argument whether or not reference A teaches a doohickey before determining Finality; under the proposed Finality test, the Applicant can amend the claim without concern that the Examiner is going to rush to Finality *because* of the amendment.



industries. He can be reached at 971-254-8967 or Ariel.Rogson@RogsonIPLaw.com. The above article is general information, not legal advice. Regarding a specific situation, seek competent intellectual property legal counsel.