



Mesmer & Deleault, PLLC
 41 Brook Street, Manchester, NH 03104
 Seacoast Office: One New Hampshire Ave., Suite 125
 Portsmouth, NH 03801



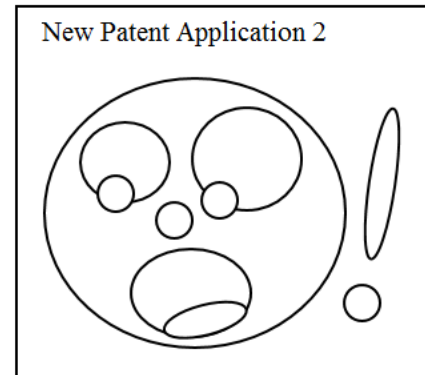
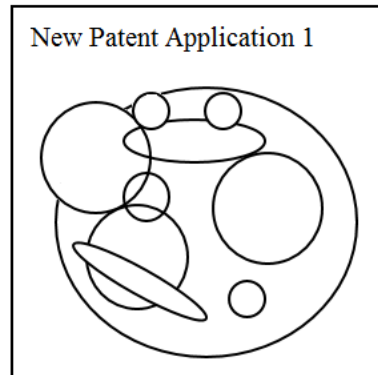
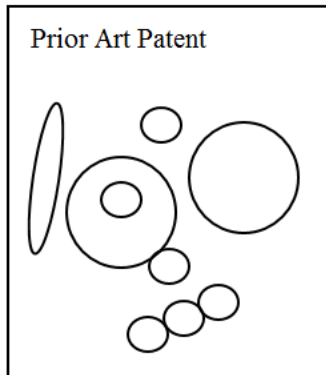
“Tip of the Month”

Overcoming Obviousness in Patenting

One of the most frustrating events for a patent applicant is receiving an “obviousness” rejection. The term “obviousness” comes from 35 U.S.C. § 103 which denies a patent “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious...”.

These “obviousness” rejections are usually issued against inventions which merely involve the tweaking of a variable to produce minor improvements. While a truly obvious invention is unlikely to ever overcome the hurdle of the nonobviousness rejection, there are many inventive products which fail to pass this legal hurdle as well. Why does this happen and how can an inventor distinguish their invention as inventive, rather than obvious?

Let’s use a cartoon illustrating three patent documents to see what happens. The Prior Art Patent discloses known scientific principles (resizing & addition) and known products, while New Patent Applications 1 and 2 both discuss a new product:



It might not surprise you to find out that, while both New Patent Applications 1 and 2 discuss inventions which are “new” and not on the market, an Examiner is going to be more tempted to argue that the first invention is nothing more than a combination of known products altered according to known scientific principles.

What *might* surprise you is that both applications are for the same invention. However, in the second application, the description of the invention was fully fleshed out and included the “best” arrangement of the components—an arrangement that resulted in a completely unexpected reaction.

Proving that your invention is quantitatively better than existing products in some respect is a significant milestone towards securing a patent. However, demonstrating “unexpected results” should also be an integral part of any patent application and will help overcome that obviousness rejection before it becomes an issue.

If you have any questions about protecting your invention, the patent attorneys at Mesmer & Deleault have the experience and ability to help you. Give us a call today at 603-668-1971 or send an email to mailbox@biz-patlaw.com.

Frank B. Mesmer, Jr.
 Robert R. Deleault (USPTO Reg.)
 Sarita L. Pickett (USPTO Reg.)
 Joshua N. Mesmer



(603) 668-1971
 Fax (603) 622-1445
 E-mail: mailbox@biz-patlaw.com
 Website: www.biz-patlaw.com