

The Limited Monopoly™

Solemnly Sworn – The Use of Affidavits in Patent Prosecution

by John Hammond, PE and Robert Gunderman, PE

“Claims 1 – 4 and 11 – 24 are rejected under 35 U.S.C. 103 ...”

The words any inventor dreads. Your claims have been rejected. What to do? There are a number of options. This month, we will cover one of them – the use of supporting affidavits in overcoming claim rejections.

First, though, some background information. For an invention to be patentable, it must be found by the Patent Office to be useful, novel, and unobvious. These requirements are codified in the respective federal statutes 35 U.S.C. 101, 102, and 103. When a patent application is examined in the USPTO, the patent examiner may reject the claims of the application under one or more of these laws. In fact, claim rejections are *far* more common than immediate allowances, particularly in view of recent court decisions that have raised the bar for patentability.

“I, John Doe, hereby depose and say that...”

When claims in a patent application are rejected, the applicant (typically represented by a patent agent or attorney) has the right to present arguments and evidence to rebut the rejections made by the examiner. Rule 37 C.F.R. 132, “Affidavits or declarations traversing rejections or objections,” allows the applicant to submit additional evidence not provided in the application itself in support of patentability of the claims.

In general, “Rule 132” affidavits should be used only when absolutely necessary. A rule of thumb is that patent prosecution should be kept as simple as possible, because in the event that the issued patent is ever litigated, everything in the file history is subject to challenge. Nonetheless, an affidavit that presents critical evidence can be a useful tool when basic arguments are insufficient to rebut an examiner’s rejections.

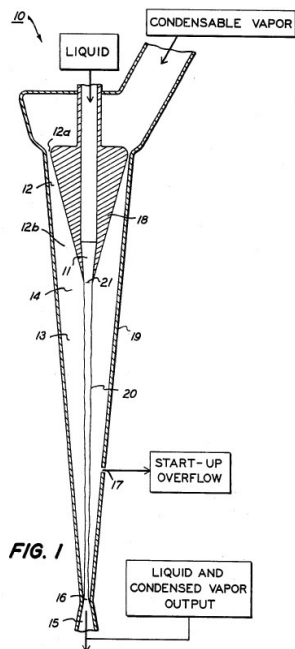
Affidavits can be used to traverse any rejections made under the above cited statutes. However, one of the most common uses is to rebut rejections made under 35 U.S.C. 103, in which claims are rejected as being obvious to “a person having ordinary skill in the art.” In making an “obviousness” rejection, an examiner is obligated to consider a number of factors, including “objective evidence of non-obviousness.” This objective evidence is not always contained in the original patent application and is thus not available to the examiner at the beginning of prosecution. However, it can be introduced by an affidavit by the applicant and/or an independent expert witness during prosecution.

Certain factors¹ have been established by our courts as objective evidence of nonobviousness. These factors include evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results. Accordingly, submitting evidence pertaining to one or more of these factors may be the key in overcoming an obviousness rejection.

“The applicant’s hydro-kinetic amplifier is considered inoperative as it is impossible to build a device as disclosed by the applicant.”²

A Local Example

The use of affidavits in overcoming an obviousness rejection is well-illustrated in the file history of U.S. Patent 4,569,635 granted to inventor Carl D. Nicodemus. Mr. Nicodemus, formerly of Caledonia NY, owned a local mechanical contracting firm in the late 1970s. In the course of his work on steam heating systems, he observed certain phenomena on the behavior of steam and liquid two phase flow, and conceived a “hydrokinetic amplifier” invention. He named his invention the “HelioPAC” (PAC standing for Pressure Amplifier and Condenser), and founded Helios Research Corporation to commercialize it. The device combined inlet streams of steam and low velocity cold water to produce a high velocity outlet stream of hot water; i.e. *very* high velocity – likely strong enough to peel the bark off a tree. The HelioPAC was about the size of a baseball bat and had no moving parts.



Nicodemus filed several patent applications on his invention, including application number 06/612,742 filed on May 21, 1984. This application was filed and prosecuted on his behalf by local patent attorney Eugene Stephens. In January of 1985, the USPTO issued an Office action rejecting his claims under 35 U.S.C. 103 as being obvious. The examiner cited U.S. Patent 1,328,139 issued in 1920 for a “Hydraulic Water Forcing Apparatus,” and a sales bulletin by the Ametek Corporation for an educator condenser. The examiner alleged that

it would have been obvious to combine the teachings of these two references to produce Nicodemus’ invention.

Nicodemus, however, knew otherwise. Under the guidance of Mr. Stephens, he submitted a twelve page affidavit thoroughly documenting the highly unexpected and powerful water jet velocity his invention produced. He also cited seventeen subject matter experts from industry and academia who had studied his invention and were astounded by its capabilities. For good measure, he included a 41 page Appendix with letters and analyses by many of these experts.

One cited expert in particular is well known to many of us. Current RES President Harvey Palmer (then Professor of Chemical Engineering at the University of Rochester) provided 24 pages of material for the Appendix. His testimony included his proposal to the New York State Science and Technology Foundation for a \$25,000 grant (which was subsequently awarded) to study how and why the HelioPAC worked. In a letter in the file, Professor Palmer stated, “I was amazed when I first observed the PAC in operation, and even after sober reflection, I still believe that the device is remarkable.”

The Rochester *Democrat and Chronicle* also covered Nicodemus’ patent efforts in a March 24, 1995 article titled, “Pump with no moving parts has patent office baffled.” In this article, Dr. Palmer succinctly summarized the problem, stating, “There is currently no scientific explanation of why the HelioPAC performs as well as it does.” Let’s see. If how something works is not understood... then it doesn’t matter what results it produces. They’re *unexpected* by definition – and that is convincing evidence of nonobviousness.

“Claims 1 – 4 and 11 – 24 are allowed.”

On July 30, 1985, the USPTO withdrew the rejection of the claims and issued a Notice of Allowance, and on February 11, 1986, U.S. Patent 4,569,635 issued. The sworn affidavit providing evidence of non-obviousness proved to be a winning strategy. □

1. Known as the “Graham factors” from the case of *Graham v. John Deere*, 383 U.S. 1, 17 – 18, 148 USPQ 459, 467 (1966).

2. U.S. Patent Office Examiner’s action, as quoted in the *Democrat and Chronicle*, March 24, 1985.

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