

Is Your Patent Application “Veeerrry Nicee!”?

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The movie Borat was a cinematic masterpiece. Certainly, one of the greatest films of the 21st century. Its release in 2006 set U.S. culture ablaze.¹ A person could not walk down the street without hearing “Veeerrry Nicee!”²

Perhaps, the best scene (if one could even select a best) was when Borat, played by Sacha Baron Cohen, was on a beach surrounded by three stunning bikini models.³ He was wearing what could only be described as a very exposing speedo.⁴ The speedo, rather than being attached around a person's waist like traditional tighty whities, was attached like overall straps over each of Borat's shoulders.⁵ The straps then joined on Borat's back.⁶ The single strap then connected through Borat's butt to his groin. Essentially, the speedo was a giant male thong or “mankini.”⁷

In 2008, an inventor, Donald Quinn, filed a patent application for a “Scrotal Support Garment.”⁸ In his application, Donald described his invention as a “medical support device for male genitalia” to relieve scrotum pain or discomfort.⁹ The invention was seemingly identical to the speedo Borat wore. Upon review, the United States Patent and Trademark Office (USPTO) rejected Donald's application, under Section 102 (novelty) of the United States Patent Act.¹⁰ The examiner specifically cited a picture of Borat's speedo as prior art.¹¹

This example highlights how patents can be rejected. Beyond the novelty aspect of Section 102, other grounds for rejection include lack of patent-eligible subject matter (Section 101), obviousness (Section 103), and specification (Section 112). Additionally, although less common, rejections can also occur under Sections 104-111 for various other legal reasons.¹²

I. Types of Patent Rejections

A. Sections 101 – Patent-Eligible Subject Matter

Rejections under Section 101 occur when the invention is deemed not to be patentable subject matter.¹³ This rejection typically means that the invention falls into a category that cannot

¹ See BORAT (20th Century Fox 2006).

² *Id.*

³ *Id.*

⁴ See Sacha Baron Cohen Offers to Pay Fines of Tourists Who Wore ‘Borat’ Mankinis, The Guardian (Nov. 21, 2017), <https://www.theguardian.com/film/2017/nov/22/sacha-baron-cohen-offers-to-pay-fines-issued-to-tourists-over-borat-mankinis>.

⁵ See *id.*

⁶ See *id.*

⁷ *Id.*

⁸ U.S. Patent No 12/071,878 (filed Feb. 27, 2008).

⁹ *Id.*

¹⁰ See Eriq Gardner, *U.S. Patent Examiner Cites Borat's Famous Swimsuit in Rejecting Claimed Invention*, The Hollywood Reporter (Mar. 26, 2012, 11:09AM), <https://www.hollywoodreporter.com/business/business-news/sacha-baron-cohen-us-patent-examiner-cites-borats-304154/>.

¹¹ See *id.*

¹² See MPEP (9th ed. Rev. 7, Feb. 2023), <https://www.uspto.gov/web/offices/pac/mpep/mpep-1500.html>.

¹³ See *id.*

be patented, such as abstract ideas, laws of nature, or natural phenomena.¹⁴ For instance, a patent application for a mathematical formula without any practical application will face a 101 rejection. This section ensures that patents are granted only for concrete, tangible inventions rather than for abstract concepts or natural laws.¹⁵

B. Section 102 – Novelty

Rejection under Section 102 arises from a lack of novelty; the invention is already known.¹⁶ A 102 rejection indicates that the invention is not new, having been disclosed to the public prior to the applicant's filing date.¹⁷ For example, an application for a commonly used household item that has been in public use. The purpose of this section is to prevent the patenting of something already available to the public.¹⁸

C. Section 103 – Non-Obviousness

Rejections under Section 103 happen if the invention is obvious to someone skilled in the field.¹⁹ This suggests that the invention lacks the necessary inventiveness, being too obvious to a professional in the relevant field.²⁰ For example, a patent application for a smartphone that merely combines an existing phone model with a slightly larger screen will receive a 103 rejection. This section aims to ensure that patents are granted for truly innovative technologies.

D. Sections 104 -111 – Other

Rejections under Sections 104-111 cover various other aspects of patent law not specified in the previous sections.²¹ These can include issues related to the formalities of the patent application, procedural deficiencies, or special requirements for specific types of inventions. These sections serve as a catch-all for various other legal and technical requirements that ensure the integrity and clarity of the patent process.²²

E. Section 112 – Specification

Rejection under Section 112 occurs when a patent application fails to adequately describe the invention or does not claim what the inventor regards as the invention.²³ This includes issues with the written description, enablement, or definiteness of the patent claim language.²⁴ An example of this could be a patent application for a chemical compound lacking sufficient detail

¹⁴ *See id.*

¹⁵ *See id.*

¹⁶ *See id.*

¹⁷ *See id.*

¹⁸ *See id.*

¹⁹ *See id.*

²⁰ *See id.*

²¹ *See id.*

²² *See id.*

²³ *See id.*

²⁴ *See id.*

on how to synthesize it. The focus of Section 112 is to ensure that the patent application is clear, complete, and precise for someone skilled in the art to use the invention.²⁵

II. USPTO Data Analysis

This analysis breaks down the reasons for patent rejections under different sections of the Patent Act based on USPTO data from January 2019 to January 2024.²⁶

A. Section 103 – Non-Obviousness

Section 103, dealing with the non-obviousness criterion for patentability has the highest percentage of total rejections.²⁷ It represents 39% of total rejections, with 81% of office actions containing this type of rejection.²⁸ Interestingly, there has been a decreasing trendline over the past five years in rejections under this section.²⁹

B. Section 112 – Specification

Rejections under Section 112, about the adequacy of the specification in a patent application, constitute 25% of total rejections.³⁰ Additionally, 52% of office actions include rejections based on this section.³¹ Like Section 103, there is a decreasing trend in these rejections over the past five years.³²

C. Section 102 – Novelty

Section 102, which addresses the novelty aspect of patent applications, accounts for 21% of the total rejections.³³ The data shows that 44% of office actions contain rejections under this section.³⁴ There is also a decreasing trendline observed in rejections based on novelty over the past five years.³⁵

D. Sections 104 -111 – Other

²⁵ *See id.*

²⁶ *See Agency Trends: Rejections in Office Actions for Patent Applications*, U.S. Pat. & Trademark Off., <https://developer.uspto.gov/visualization/agency-trends-rejections-office-actions-patent-applications>.

²⁷ *See id.*

²⁸ *Id.*

²⁹ *See id.*

³⁰ *Id.*

³¹ *Id.*

³² *See id.*

³³ *Id.*

³⁴ *Id.*

³⁵ *See id.*

Sections 104-111, covering various other patent process aspects, collectively account for 8% of rejections and are included in 16% of office actions.³⁶ Contrary to the above sections, there's a slight increase in rejections here over the past five years.³⁷

E. Sections 101 – Patent-Eligible Subject Matter

Finally, Section 101, which deals with the basic criteria for patent-eligible subject matter, is responsible for 7% of total rejections.³⁸ It is cited in 13% of office actions.³⁹ This section too shows a slight increasing trend in rejections over the same period.⁴⁰

III. Conclusion

In summary, analysis of the past five years of USPTO data reveals a clear pattern in the frequency of patent rejections by section.⁴¹ The order, from most common to least common, is as follows: non-obviousness rejections lead with 39%, followed by specification at 25%, novelty at 21%, a combined 8% for other sections (104-111), and finally, patent-eligible subject matter at 7%.⁴² The trend shows a general decrease in rejections related to non-obviousness, specification, and novelty.⁴³ Conversely, there's a slight uptick in rejections concerning other sections and patent-eligible subject matter.⁴⁴ Therefore, patent applicants must ensure that their inventions meet the criteria of being on patent-eligible subject matter, novel, and non-obvious to avoid rejection from the USPTO. If not, the patent application will not be deemed “Veeerry Nicee!”⁴⁵

³⁶ *Id.*

³⁷ *See id.*

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ *See id.*

⁴¹ *See id.*

⁴² *Id.*

⁴³ *See id.*

⁴⁴ *See id.*

⁴⁵ BORAT, *supra* note 1.