REDACTED CASE STUDY | PUBLIC VERSION

Preserving Claim Scope in a Difficult CNIPA Inventive-Step Rejection

How a first office action was overcome without narrowing the independent claim

This anonymized case study illustrates our prosecution-strategy method: rejection-logic breakdown, technical-effect reconstruction, system-level prior-art analysis, and claim-scope preservation. It is not legal advice and does not identify the applicant, invention, or application number.

Past outcomes do not guarantee similar results.

Executive Summary

CHALLENGE

A first office action rejected all claims for lack of inventive step under Article 22(3) of the Chinese Patent Law. The examiner relied on a single prior-art reference from a different technical context and treated the remaining differences as routine substitutions or common general knowledge.

STRATEGY

We recommended a first-round argument-only response because the procedural timing, commercial importance of claim scope, and technical record all supported holding the original independent claim. The response reframed the actual technical problem and challenged unsupported common general knowledge assertions.

OUTCOME

The application proceeded to grant after one response. The independent claim was maintained without narrowing amendment, without merging dependent claims, and without importing additional limitations from the specification.

The Matter

An industrial equipment applicant engaged us after receiving a first office action that rejected the claims for lack of inventive step. The rejection was framed in unusually broad terms: the examiner considered the claim set to lack a patentable technical contribution, and the rejection posture left the applicant facing a likely choice between abandonment and substantial narrowing.

The cited reference was not a close technological roadmap. It came from a different technical context and disclosed a much simpler fluid-circulation device. The examiner nevertheless decomposed the applicant system into individual components, identified superficial structural parallels, and dismissed the remaining differences as conventional measures.

This is a common difficult posture in CNIPA prosecution. Once the analysis is reduced to component-level matching, a complex system can appear obvious even when the invention's real contribution lies in how the components cooperate to solve a different technical problem.

Strategic Assessment: Amend or Hold?

Before drafting the response, we first assessed whether the case should be narrowed or defended on the original claim set. The answer depended on three factors.

- Procedural timing: this was a first office action, so there was still procedural room to reshape the examiner's understanding before the examination position hardened.
- Commercial scope: the independent claim captured the applicant's commercially meaningful protection. Premature narrowing would have surrendered design-around space before testing whether the rejection could be overcome by argument.
- Technical leverage: the distinguishing features reflected a different system architecture and a different engineering objective from the cited reference.

For these reasons, we recommended a first-round response without claim amendment. This was a calibrated strategy, not a default preference. In a later-stage office action, or where the claim record is weaker, amendment may be the more prudent route.

Pillar 1 - Reframing the Actual Technical Problem

The examiner's analysis treated the invention as if the task were merely to apply a known fluid-circulation structure to another piece of equipment. Under that framing, the conclusion of obviousness was almost inevitable.

We shifted the analysis back to the technical effect produced by the distinguishing features. The real problem was not simple field-of-use transfer. It was how to design a coordinated closed-loop system in which the working medium, flow path, energy architecture, and internal process structure cooperate to achieve multiple technical functions in a specific industrial environment.

This reframing mattered because CNIPA inventive-step analysis depends heavily on the actual technical problem. If the problem is defined too narrowly or too abstractly, the invention can be made to look like a routine adaptation. When the problem is defined by the technical effect actually achieved by the distinguishing features, the inventive contribution becomes much harder to dismiss.

Pillar 2 - Showing System-Level Incompatibility With the Cited Art

Rather than arguing only that individual features were absent from the prior art, we focused on why the cited reference would not have motivated a skilled person to arrive at the claimed system. The response emphasized three forms of incompatibility:

- Different function of the working medium: in the cited art, the circulating medium served a simple physical role. In the claimed system, the medium's role was integrated with the broader technical function.
- Different energy architecture: the cited art used a conventional power arrangement. The claimed system used a coordinated energy architecture as part of the inventive concept.
- Different internal process logic: the claimed chamber and flow structure were designed for a multi-function industrial system, not for the simpler operating context of the cited reference.

The point was not that every component was unknown in isolation. The point was that the cited art's design philosophy would not naturally lead a skilled person to the claimed configuration, and in several respects would discourage that path.

Pillar 3 - Challenging Unsupported Common General Knowledge Findings

The office action repeatedly characterized important features as routine technical means or common general knowledge without supporting evidence. For each feature, we explained why the feature's function in the claimed system was materially different from its generic function in ordinary equipment.

This shifted the issue from whether a component was known in the abstract to whether the specific functional use and integration asserted by the examiner were supported by evidence. Where an examiner relies on common general knowledge to bridge a technical gap, a substantiated applicant objection can require an evidentiary basis, such as textbooks, reference works, or additional prior-art documents.

Result

The case proceeded to grant after the response. The original independent claim was maintained without narrowing amendment. No dependent claim was merged into the independent claim, and no additional limitation was imported from the specification. The result does not mean that zero-amendment responses are always advisable. It means that, in the right procedural posture and with the right technical record, preserving claim scope can be a rational prosecution strategy rather than a gamble.

Practical Takeaways for Patent Firms

1. Do not let the examiner's problem formulation control the case if it fails to reflect the technical effect of the distinguishing features.
2. Treat the first office action as a strategic window. It may be the best time to correct the examiner's framework before a rejection posture hardens.
3. In system inventions, do not rely only on feature-by-feature non-disclosure arguments. Explain why the prior art's overall design logic points away from the claimed system.
4. When common general knowledge is asserted without evidence, challenge the specific functional context, not merely the label.
5. Preserving claim scope should be a deliberate strategy. It requires technical leverage, procedural timing, and a clear fallback plan if the examiner does not accept the argument.

How This Reflects Our Support Model

This case illustrates the type of behind-the-scenes prosecution strategy support we provide to patent firms: rejection-logic breakdown, prior-art feature mapping, technical-effect reconstruction, amendment-option planning, and argument frameworks for the responsible attorney's review.

For a first cooperation, we can use a review-before-payment model. After scope and fee are agreed in writing, your team reviews our strategy package before payment. If the work does not provide practical professional value and no substantial part is used, no professional fee is due. If any substantial part of our analysis, arguments, amendment options, or draft is used in client advice, prosecution strategy, or filing, the agreed fee applies.

We work behind your firm. We do not contact your client unless expressly instructed. Final legal advice, client communication, and filing decisions remain with your firm or responsible local counsel.

Although this example is a CNIPA case, the underlying method - technical-feature mapping, rejection-logic analysis, technical-effect reconstruction, and claim-scope preservation - can be adapted to other patent offices under the supervision of the responsible firm or local attorney.