

Comments On The Amendment In Response To The First Office Action

I. General

- A. Good effort on everyone's part! I tried to make lots of comments
- B. Most people followed the template pretty well. I think it really helped people write their Amendments, right?
- C. It may seem repetitious to write out the claim actions in summary and then write out each of the rejections in a summary, but the process is a check to make sure that you have responded to all of the rejections.

II. You need a certificate of transmission (COT) when transmitting your Amendment to the PTO. The COT may be

- 1. Fax
- 2. Express Mail
- 3. Certificate of Mailing
- 4. Hand Delivery Signature w/PTO's stamp

The COT is your proof that you mailed the Amendment

III. Time for reply

The time for reply is 3 months from the date of mailing as listed on the OA Summary sheet. The OA was mailed on April 11, 2005. Consequently, you can file the response up to and including July 11, 2005 without extension of time. The last day to file a response before the application would be abandoned is October 11, 2005. You would have to file your response on October 11, 2005 with a three-month extension of time.

IV. Claim Identifiers/Labels

- A. Out of 12 Amendments, 6 were compliant and 6 were not.
- B. Attached is a flowchart to help you understand when a claim should be labeled (New), (Original), (Currently Amended), or (Previously Presented)
- C. If you don't have the identifier right, then your Amendment is Non-

compliant. A Non-complaint amendment is not entered and is bounced back to you for correction.

D. Canceled Claims

1. The text of canceled claims should be removed. Not just strike-through, but removed. All that should appear is:

1. (Canceled)

or

Claims 1-10 (Canceled).

2. You can only group canceled claims.

E. Claim identifiers should appear after the claim number

F. If you add a new claim to the application in your Amendment, the patent application does not include the claim until the amendment reaches the PTO and the Examiner enters it in the file. Consequently, if I previously had 40 claims and I am adding claim 41 in the present amendment, then “The present application includes claims 1-40” is correct. The application will include claims 1-41 once claim 41 has been entered by the Examiner.

V. The Examiner’s Actions

A. The Examiner’s Interpretation of the Claims

Notice that the Examiner often did not adopt your preferred understanding of the claim terms. Instead the Examiner adopted the broadest reasonable interpretation of the claims. That is, if the Examiner can find a way to make the PA references teach the claims, then the Examiner is going to do it. Your understanding of the claim terms is irrelevant. Get used to it. Write better claims that the Examiner can’t co-opt or run wild with. Use clear language. Use claim terms with clear boundaries.

B. Sometimes the Examiner is overreaching with regard to a reference. One example is when the Examiner states that Kobayashi teaches a flexible material because K teaches vinyl and vinyl is known to be flexible. K does not actually recite that vinyl is flexible, just that it uses vinyl. Is vinyl always flexible? Regardless, does K recite that the vinyl used in K is flexible? The Examiner here actually pulled the Jedi Mind Trick on

you. You read the Examiner's statement and agreed with it without being rigorous with the teachings of the references. The Examiner just slipped it in and you swallowed it. Learn from this. You can do the same thing back to Examiners in the future.

- C. The Examiner improperly cited the Mills reference as prior art under 102(b) when in fact the Mills reference is PA under 102(e)
1. Good Job to the people who reviewed the references to confirm that they were prior art before buying into the Examiner's rejection. Those that did not should start reviewing the references.
 2. Some people asserted that Mills "was not PA". This is not correct. Mills is PA, but under 102(e) not 102(b). Consequently, your statement may be interpreted as deceptive or fraudulent. Not good.
 3. Most people simply mentioned that Mills was not PA under 102(b), but that leaves the Examiner open to cite the reference in a rejection under 102(e). However, because the rejection under 102(e) is a new rejection that the Examiner could have made before, it would not be proper for the Examiner to make the next Office Action final. However, the Examiner might make the next OA final anyway (perhaps through error or zealotry) and then you are stuck arguing that the OA should not be final.
 4. Some people mentioned that Mills was not PA under 102(b) and proceeded to distinguish Mills from the present claims on the merits. This can be done when the differences between the claims and Mills are clear. However, if this would be a difficult argument, just mention that the rejection under 102(b) is not proper and let the Examiner make the rejection under 102(e). No need to create needless prosecution history. Sometimes the Examiner is so embarrassed that he just drops the reference.

VI. Applicant's Actions

People adopted many different tactics with regard to their responses.

- A. Some people simply argued claim limitations. However, you are unlikely

to sway the Examiner's interpretation of a claim limitation purely based on your say so. Realize that the Examiner is not constrained to adopt your claim interpretation! The Examiner does not have to regard the claim language the same way you do. Instead, the Examiner takes the broadest reasonable interpretation of the claim language. Trying to tell the Examiner that his interpretation of the claim language is too broad is unlikely to persuade the Examiner.

- B. Some people tried to tell the Examiner that the reference did not teach what the Examiner said the reference taught. Sometimes this is true, but you will have to make an absolutely clear and inescapable argument so that the Examiner has no wiggle room in order to get the Examiner to change his position. If the Examiner can wiggle away, he will.
- C. Several people attempted to import limitations into the claims that did not appear in the specification. These efforts drew a rejection under 112, paragraph 1. Remember that if a claim limitation did not appear in the specification, you can't add it now (typically 2-3 years after filing). All of the new terms that you want to use in response to the Examiner's OA should have been in the spec originally if you were to be able to use them here. Think back - could you easily have added the language that you are attempting to use into the spec when you were drafting the spec? Would it have made a good alternative embodiment or an alternative phrasing? Try to think ahead for next time and include these when you draft the application.
- D. Lots of people made admissions about the teaching of the prior art. However, the people typically did not regard their statements as admissions because they had a different vision of the claim limitations than the Examiner did. However, the Examiner was able to use their admission to forward his case. Here's some advice: When you approach a response to an OA, one of the most important things is to understand the Examiner's present understanding of the claim limitations. Then you can approach the response by seeing what you can do to alter the Examiner's

position to conform to your desired position. That is, you can think “how can I get the Examiner’s position on the claims to be where I want it to be.” Think about what you can do to shape and guide the Examiner’s position rather than simply asserting that the Examiner is wrong.

- E. To be effective, link your discussion directly to a specific, short claim limitation that is clear and does not allow the Examiner any wiggle room.
- F. Many people made assertions about the teaching of the prior art, but they failed to explicitly include their actual insertion in their claims. For example, people would assert something about “solar panels” with regard to the prior art when their claim recited “solar system” or “photovoltaic device”. A photovoltaic device, for example, could be interpreted by an Examiner as any device associated with a photovoltaic or having any photovoltaic characteristic.

Often, this error arose because the person in their own mind was equating “solar panel” with “photovoltaic device” and expected the Examiner to adopt the same claim interpretation. The Examiner was not constrained to do so.