

Comments On The Amendment In Response To The First Office Action

I. General

- A. Good effort! I can tell that most people spent a lot of time drafting their Amendments.
- 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. Front Page Matters

- A. Use your number in place of the attorney's name. Use the date that you are submitting the Amendment as the filing date for the Amendment.
- B. Spell out the dates.
- C. Your Amendment should have indicated that it was being transmitted to "Mail Stop Amendment". Your response to the FOA should be transmitted to "Mail Stop AF"

D. 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 7, 2006.

Consequently, you can file the response up to and including July 7, 2005 without extension of time. Several people seemed to wrongly think that an extension of time was necessary.

III. Claims

- A. Out of 14 Amendments, 9 were compliant and 5 were Non-compliant
- B. I am glad that the flowchart helped, but please review it thoroughly.
- C. If you don't have an identifier right, then your Amendment is Non-compliant. A Non-complaint amendment is not entered and is bounced back to you for correction.

- D. One error was the use of “Previously Presented” instead of “Original”
If the claim was introduced at filing and has not been changed, it’s original.
- E. Two people had the guts to add new claims - even though they were only dependents.

IV. 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. The Examiner improperly cited the Li patent as prior art under 102(b) when in fact the Li patent is PA under 102(e)

Out of 14 Amendments, 11 addressed this and 3 did not. You should have been on your guard, especially after reading last year’s comments.

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. Most people proceeded to address the Li patent on the merits, which was typically a good move in context. If you did not address the Li patent on the merits, the Examiner simply asserted Li as prior art under 102(e).
3. Bald faced assertions are not enough
“Li is not prior art under 102(b). Therefore the rejection is improper.”
Why is it not prior art? This is your chance to get it on the record! Also, your bald-faced assertion is not persuasive to the Examiner. The most likely response to a bald assertion is “Yes it is art under 102(b) - now I’m slapping you with a FOA, .” You need to lay our your reasoning - make a

case! Also, be polite.

The Applicant notes that the Li patent issued on March 21, 2006, which is less than one year before the filing date of the present application on March 30, 2006. Conversely, a rejection under 35 U.S.C. 102(b) requires that the prior art reference forming the basis for the rejection be published at least one year before the filing date of the present application. Consequently, the Applicant respectfully submits that the Li patent does not constitute prior art under 35 U.S.C. 102(b). Thus, the Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-5 under 35 U.S.C. 102(b).

C. It is confusing that the Examiner calls both the Li patent and the Li publication “the Li reference”. The Examiner can be sloppy and often is, but you should try to be as clear as possible, both for the Examiner and the record. Consequently, it may be a good idea to refer to the Li patent as “the Li patent” and the Li publication as “the Li publication” so as to make clear what reference you are talking about.

D. Don’t take it personally -
Remember when I mentioned that people often take it personally and how bad that is? You may have laughed internally and thought that the people who were taking it personally must be a bunch of idiots. However, now that you are in that situation, it’s not so easy to decline to take it personally, is it?

V. 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 simply tell the Examiner that his interpretation of the claim language is too broad is unlikely to persuade the Examiner.

Some Examples:

1. “An External Device”

External to what? How do you define external? Isn't one definition of external “located on the outside of”?

Consider “Connecting an umbrella to an external solar panel”
“Receiving power from an external solar panel”

2. Charge Indicator

Can be interpreted as anything that indicates the presence or absence of charge. If “no charge, no lights”, then the lights being on is a charge indicator.

3. Media Player

Read broadly - Anything that renders any media perceivable.

Question - is text part of “media”?

B. You must address each of the Examiner's rejections

1. If you were rejected under 112,1 or 112,2, you must mention the rejection and review the actions you took to overcome the rejection. You can't just amend the claim and then not tell the Examiner.

2. Don't change the Examiner's rejection. If the rejection under 102 is for claims 1-10, then the Examiner has made one rejection for claims 1-10, not two rejections (one for claims 1-5 and one for claims 6-10). If you change the rejection, the Examiner may find that your Amendment is not responsive to his rejection.

“Turning now to the Examiner's rejection of claims 1-10 under...

Claims 1-10 include independent claims 1 and 6. First, with regard to independent claim 1,

Turning now to independent claim 6,

3. Add some spacing between the rejections to make your Amendment easier to read. Strive for clarify.

C. Arguing the References

1. 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.

2. Bald assertions about the teaching of the prior art are not persuasive, even if accurate. You must lay out your evidence - you must build your case. Your review of the reference is “discovery” and your drafting of the Amendment is advocacy - not findings of facts made by a technical expert. Lots of people seemed to just want to make assertions rather than proving their case.

It's the difference between the two options:

- 1) I say it's this way, therefore give it to me now!
- 2) Do you see this first evidence? Do you see this second evidence? Well then how can you adopt a position contrary to the evidence?

Bald assertions can also be perceived as simply rude and argumentative. You need to present evidence.

3. Support your arguments! Cite to the spec (Col. and Ln.) and the drawings. It builds credibility and comfort with the Examiner.
4. It is almost always easier for the Examiner to say NO than to allow your claims. If the Examiner is uncomfortable or your claim is not clear, the Examiner is likely to maintain the rejection. You must make a clear showing that the Examiner can feel comfortable with.
5. In some cases, for example, claim 1 had been amended, but the first two rejections under 102 did not mention the amendment. Instead the first two rejections attempted to distinguish the claim on other, more tenuous grounds. If you find when dealing with a later rejection that you must make a claim amendment, revisit your

earlier rejections to see if you can use the amendment to strengthen your case in the earlier rejections.

D. Technical Arguments

1. Some people that apparently have some exposure to the subject matter attempted to make technical arguments with regard to how a prior art device may or may not have functioned. However, it doesn't matter what the device IS - it matters what you can PROVE - specifically, what the reference does and does not recite. That's prove with EVIDENCE - not your unsupported statements. Not relevant for 102 rejections:
Device X "normally includes"
"usually connected"
"as everyone knows"
2. When you assert that "this type of device usually doesn't include element X" you have made an ADMISSION that the device does include the element in some cases. That's all the Examiner needs - one PA example. It doesn't matter if all commercial products are configured a different way. Common commercial aspects are irrelevant for 102 rejections.
3. Technical arguments are often a trap. In a couple cases, the Examiner's case was significantly strengthened by admissions the Applicant made in the record. For example, one person speculated "on the record" about how a device likely worked. The Examiner is entitled to take the speculation as an admission. In that case, the Examiner maintained the rejection and cited to the Applicant's admissions.
4. Stick with the references. It usually doesn't matter how a device actually functions or how it is usually configured. The "world" is what exists in the PA reference - that's your reality for the rejection.
5. Even if you are Bill Gates or some high-powered researcher, your bald-faced assertion is not going to be persuasive. The Examiner

is looking for hard evidence and extremely unlikely to just “take your word on it.”

E. Clarity

1. It is the Attorney’s responsibility to make the amendment clear and easy to read for the Examiner. Was the Examiner unclear? Tough. Fix it.

Clearly call out each rejection

Specific cites to supporting quotes in the cited references.

Citing to nice language in the specification is often more persuasive than citing to a drawing.

Use pinpoint cites - the Examiner is not going to go hunting for your evidence

“Li teaches that the umbrella operates this way”

Examiner thinks: Why should I believe you? You are going to have to point out some evidence if you want to be believed.

“In Col. 4-5 of Li

Examiner thinks: No way am I going to waste my time hunting.

2. 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.

Don’t distract the Examiner by trying to recite a laundry list of things that you don’t think are in the reference.

Often, you will be focusing your response on the new claim element that you are adding.

F. Many people made assertions about the teaching of the prior art, but they failed to explicitly include their actual insertion in their claims.

1. Sometimes people would argue a claim limitation in a dependent
2. Sometimes people would confuse language between independent claims

3. Sometimes, limitations really only appeared in people's mind like
"all media is digital"

G. Politeness

The Examiner is the judge and expects you to be polite.

1. "Respectfully request"
2. Bald faced assertions vs. pointing out the evidence
3. Clarity and helpfulness