

Comments On The Amendment In Response To The First Office Action

I. General

- A. Most people followed the template pretty well. I think it really helped people write their Amendments, right?
- B. 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. Some people did not write out the rejections and missed one or more.
- C. Did the rejection look scary in the beginning? Did you keep a positive attitude? How did it feel to be rejected?
- 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?

II. Front Page Matters

- A. 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 March 30, 2007.
Consequently, you can file the response up to and including June 30, 2007 without extension of time. Several people seemed to wrongly think that an extension of time was necessary.
- B. Spell out the dates.

III. Amending Spec and Claims

- A. If you are amending the spec, you must recite why in your Remarks. As a general rule, whenever you are doing anything, make sure to mention it in your remarks.
- B. No new matter. A few people tried to amend the spec to include new matter to support their claims, but were not allowed to by the Examiner.
- C. Some people fixed some problems with their Background sections. Kudos to you.
- D. 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. It would never even make it to the Examiner and you would be fixing it for free. The majority of people were compliant.
- E. A couple of people had the guts to add new claims. Don't underline the new claim when adding it. However, add the phrase "Please add the following new claims" between the old and new claims.

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.
Example – "Removable device" is found in Barrett when wireless communication ceases.

B. The Examiner improperly cited Barrett and Sprovieri as prior art under 102(b) when in fact they are PA under 102(e). The majority of people caught this. 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.

How to respond – three choices:

1. Say nothing. However, you might be waiving your right to swear behind or it could be taken as your assertion that it is 102(b) art.
2. Simply assert that the rejection is improper. However, the Examiner can just turn it into a 102(e) rejection, so this only works if you are trying to draw the 102(e) rejection.
3. Point out that the reference is not properly citable under 102(b), but may be citable under 102(e) and you will proceed to respond to the Examiner's rejection as if the reference had been cited under 102(e). Be careful not to actually assert that the reference IS valid prior art under 102(e) in case you want to swear behind later.

C. Be careful with regard to what you say about the references – the Examiner can use your admissions against you. For Example:
“Although it may be assumed that the handset described in Barrett includes a memory and is removable from communication with a computer ...”

It is now admitted that the handset is removable from communication with a computer.

D. Reciting “web presence” in your claim bought you a 101 rejection. Only four categories of patent eligible subject matter are recited in 35 USC § 101 (process, machine, manufacture, or composition of matter). Which one is a “Web presence”? No more web presence.

V. Applicant's Actions

A. 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 what was done. The Examiner is not going to go hunt.
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.

Here's how to phrase it:

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

Recite the standard teaches/does not teach

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 clarity.

B. 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. “A Personal Computer” or “a user computer”
Without further limitations, it could really be any computing device.
2. “a coupon storage device” – where the claim does not recite that coupons are actually stored in a memory in the device.

C. Discussing 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? The necessary conclusion is X.

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. or Paragraph) and the drawings. It builds credibility and comfort with the Examiner.
4. However, when we cite, we want to use in-line citing. We want our arguments to be well supported, but we don’t want to sound like a lawyer. We don’t need to have citation after every sentence.

“As recited beginning at paragraph 12 ...”

5. If something is really important and it works in context, quote it. However, be careful not to over-quote or quoting loses its ability to stand out.
6. 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.

D. Technical Arguments

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.

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 language/quotes in the cited references.
Use pinpoint cites - the Examiner is not going to go hunting for your evidence
NO - “Barrett teaches the use of bar codes.”
Examiner thinks: Why should I believe you? You are going to have to point out some evidence if you want to be believed.
NO - “In paragraphs 2-100 of Barrett,
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. Too long a limitation gives the Examiner 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 or argue both limitations at the same time and lose clarity
3. Sometimes, limitations really only appeared in people's mind like "associating a search term with a higher bid" means "associating a search term with ONLY the higher bid"

- G. Also, with regard to 112 rejections, some people were confusing lack of antecedent basis with lack of support. Support is found in the specification – the spec must recite the element that you are claiming. Antecedent basis is lacking when you refer to "said device" or "the device" in a claim and you have not introduced the device.

- H. 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