

Comments On The Response To The Final Office Action

I. General

- A. Remember that it is difficult to convince an Examiner to allow your claims – it is so easy for them to just check the box “would require further consideration.”
- B. Recognize that all is not lost if you don’t get claims allowed. You can file a continuation application and keep prosecuting. Also, hopefully you learned something about the prior art, the claim structure, and the Examiner’s preferences in the first application.
- C. Prepare your client for the possibility of a final rejection and a continuation early in the prosecution process.

II. Front Page Matters

- A. “Filed” at the top of the first page is when the application was filed, not when the response to the FOA was filed.
- B. You will need a certificate of mailing – fax, postal, or express

III. Amendments to Claims

- A. If you made the amendment in a previous Office Action, you do NOT show it again in the present Office Action using the underline/cross-out notation. You only use underling/cross-out to show amendments that are being made in the present Amendment.
- B. If a claim is canceled, eliminate the text of the claim
“21. (Canceled)”
- C. Double brackets are only usable when 5 or fewer characters are being deleted - 37 CFR 1.121 MPEP 714

IV. REMARKS

A. All of the rejections from the FOA must be mentioned, even if you intend to cancel all of the claims pertaining to a rejection.

B. If you are rejecting all of the claims, you can simply follow this format:

“Claims 1-9 were rejected under X in light of Y. However, claims 1-9 have been canceled. Consequently, the present rejection is respectfully submitted to be moot.”

OR

“Claims 1-9 were rejected under X in light of Y. Claims 1-9 have been canceled”

C. Some people we starting to talk about “the present invention” in their remarks. Don’t do it. Also, you probably don’t need to discuss specific features of your invention. Keep the comparison between your claims and the prior art.