

# Comments On The Response To The Final OA

## 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. Everyone sent the response to the correct Mail Stop AF. Congrats!
- B. Remember that if you use the certificate of fax transmission you can NOT use an electronic signature. If you just type in your name and fax it in, then the PTO will regard your submission as unsigned and non-responsive.

## III. Amendments to Claims

- A. Double brackets are only usable when 5 or fewer characters are being deleted - 37 CFR 1.121 MPEP 714  
Also, you must use DOUBLE brackets not single brackets.

## 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 in the rejection, 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 were still talking about “the present invention” or “the application” in their remarks. Don’t do it. We have discussed many time that it may be construed to be binding on all claims and consequently should be avoided. Also, it’s not correct. The Examiner is not rejecting “your invention” or “your application” - the Examiner is ONLY REJECTING THE CLAIM.

D. This one applies to almost everyone -  
TIGHTEN AND FOCUS YOUR RESPONSE!

This is a response to a FINAL Office Action. It needs to be a lot more short, concise, and persuasive than a response to a regular Office Action.

1. Don’t just repeat your discussion of the prior art from the first OA.
2. Group your discussion of similar claim limitations so that it appears that fewer issues remain in the application.
3. Don’t be afraid to cancel claims to remove a rejection. If you try to keep too many claims, then you end up getting none allowed. In this regard, 112s and 101s are prime targets. Drop them and focus on the prior art rejections.
4. Only arguing that a cited reference does not qualify as prior art is not likely to be persuasive. The Examiner would be more interested in a clear claim limitation. There is very little chance that they are going to call attention to themselves with quality control by backing down and allowing your patent application when you find a shortcoming. Instead, they are going to be all the more definitive about pushing you into an RCE.
5. If there is only one rejection in the application, then you don’t have to do the listing plus “Applicant now turns”. Instead you can just list “Claims 1-20 were rejected under... “ and start your response.