

2010 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.
- D. It’s hard to be “brutally honest” and “ruthless” with your claims, isn’t it?
- E. Whoops, apparently my change of the Paloheimo rejection from 102(b) to 102(e) did not go through on all responses where I meant it to – sorry about that. For those that pointed out the error in the first Response, I meant to shift the rejection to a 102(e) – those that did not point out the error were to still get a 102(b). This would be similar to what an Examiner would do. Of course, the present situation has actually happened to me more than once!

II. Remarks section

- A. There still seems to be an issue with regard to reciting which claims are pending in the application for some people. Let’s go over an example:

Say that your application was originally filed with claims 1-20.

In the first Office Action, claims 1-20 are pending and claims 1-20 are rejected

In the Amendment, you mark claims 1-5 as canceled.

The Examiner enters your Amendment

NOW THE PENDING CLAIMS ARE CLAIMS 6-20

It is when the Examiner enters your amendment that the “Pending” claims become what you want them to be

In the second, Final Office Action, claims 6-20 are pending

Thus, in your Amendment in response to Final, you would say “Claims 6-20 are pending”

Q: But what if you “cancel” claims 6-10 in your Amendment in response to Final?

A: In the Remarks section of the Amendment in response to Final, you would still say “Claims 6-20 are pending” - because the Examiner has not yet entered your amendment into the application.

Q: What if the Examiner screws up the claim numbering and does not appear to acknowledge my canceling of a claim?

A: In response to a non-final Office Action, you have the ability to cancel claims as a matter of right. Consequently, (absent non-compliance) if the Examiner sends you another Office Action, then unless the Examiner explicitly refuses to enter the claim cancellation, the cancellation has been made.

Consider an example where you file with 1-20, cancel claims 5-10 in response to a first Office Action, and then the Examiner sends you another Office Action rejecting claims 1-20 – without making a specific refusal to enter your cancellation. In this case the Examiner has made a mistake and the pending claims are 1-4 and 11-20.

B. 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. You have to be absolutely clear – so clear that the Examiner can't wiggle away.
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.