

# 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? Many people just want to hang on and only give up a little, but that’s not going to work here. It helps to see the final office action in context – it’s not a one-time-only negotiation and if you can get any claims allowed – any claim at all – it is going to help you the next time around.

## II. Front Page

- A. Several people got the Mail Stop wrong – it is “Amendment” for responses to non-final Office Actions and “AF” for responses to final.
- B. Please pay close attention to dates, several people got either the date of mailing or the date a response is due wrong.

## III. Remarks section

- A. 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. You need a “solid” structural or functional claim limitation to convince the Examiner/

## IV. Congrats!

- A. Congratulations on completing the course!