

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.
- 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. Spell out the dates.
- B. If fax-filing, fill in date and sign with your code.
- C. The period for reply is 3 months – until July – as per the Office Action.

III. Amending Spec and Claims

- A. 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. This is a pretty big embarrassment. FYI – Here's how picky the PTO is about claim identifiers - The PTO has rejected me for (Current Amended) instead of (Currently Amended).
- B. You MUST underline new additions to your claim and strike out the parts that you are removing – otherwise you are non-compliant. Remember that you can only use double brackets when deleting 5 characters or less.
- C. If you mis-stated the Examiner's rejections, you are non-compliant. You can't separate out a rejection of claims 1-10 into a rejection of claims 1-5 and a rejection of claims 6-10.

Improper: Actual rejection of claims 1-10.

“Turning now to the Examiner's rejection of claims 6-10 under 102(b).”

OK: Claims 1-10 were rejected under 102(b).... Turning now to claim 1.....

Turning now to claim 6.

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.

Some Examples:

“media” = just about anything, text included

V. Applicant's Actions

A. Clarity

1. Several Office Actions were not very clear. Your argument to the Examiner must be clear and capable of immediate understanding. This is an opportunity to practice your advocacy,
2. Add some spacing between the rejections to make your Amendment easier to read. Strive for clarity.
3. Clarity is what really gets claims allowed – a clear claim distinction from the prior art.
4. It may be more clear to just focus your argument on one or two big, clear distinctions rather than potentially confusing the issue with marginal distinctions. Additional arguments may not be helpful.
5. One of the biggest problems in general is the lack of clarity in the claims – there are often few “solid” limitations created by well-defined structural or functional language. Because the claim limitations are not clear, it is difficult for people to make clear arguments as to why a specific claim should be allowable. Now that we are working on the final Office Action, you may want to consider a sizable amendment.
6. You can see now how important it was to include very clear and step-by-step language in your original specification. That clear language may be what you need to add to a claim to get around a rejection. The problem is that you never know exactly which step will be implicated by the prior art. The fix? disclose everything very rigorously because you never know.

- B. In many cases, people argued claim limitations that did not appear in their actual claim. The element that you say is missing from the prior art must be in your claims – pretty much word for word

- 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. Support your arguments! Cite to the spec (Col. and Ln. or Paragraph) and the drawings. It builds credibility and comfort with the Examiner.
 3. 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.
 4. 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.
 5. Some people gave me a feeling that they were just kind of “raising the issue” and their thought was that is they referred to the issue then the Examiner would go back and reconsider his previous position. It doesn’t work like that. Unless the Examiner finds something very persuasive in your Amendment, then he will just keep the rejection in place and not second-guess himself.
- E. Watch out when you make big sweeping statements. They are 1) not needed, 2) not persuasive to the Examiner, and 3) may bite you. For example: Stating that a PA reference “Does not teach any transmission of media” vs. “Does not teach transmitting media as recited in claim 1.”
- F. NEVER refer to “the present invention”! Always just say “as recited in claim 1 ...” This is terrible prosecution history estoppel

- G. Watch out when you make assertions about what one of ordinary skill would think or do. The Examiner could always request that you make an affidavit in that regard and it is not actually persuasive to the Examiner.
- H. If you are adding new claims, insert “Please add the following new claims” in the claim list to help the Examiner notice the new claims. Also, you would typically remark about the new claims in the Remarks section – especially an independent claim. If it was a new independent claim, you would typically point out the claim element that you think makes the claim allowable over the prior art.
- I. When you are amending a claim, delete a whole word - no “an”
- J. It is typically clearest to respond to the Examiner’s rejections in order – otherwise, the Examiner may assume that you missed a rejection and bounce your response as non-compliant. Keep in mind that the Examiners are just interested in getting your file off of their desk as quickly as possible.
Also - You must address ALL of the Examiner’s rejections
Even if you are cancelling the underlying claims, mention the rejection and mention that the claims have been cancelled.
- K. Be careful about how much credit you give the prior art – When you say “the prior art teaches”, the Examiner is entitled to use anything that you say as an admission against you – even if it is not true.
- L. Remember – If you had claims 1-30 rejected and are now adding claims 31 and 32 with your Amendment, then your application still only includes claims 1-30 until claims 31-32 are entered into the Application by the Examiner.

Proper: The present application includes claims 1-30. By this Amendment, claims 31-32 have been added.

Improper: The present application includes claims 1-32.