

2016 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 and can use that to your advantage in the continuation.
- 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 is 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. Remember the “Filing Date” is the original filing date of the application, not the date of your response to the Office Action.

III. Claims

- A. Non-compliant amendments – 60% of the class was non-compliant. Please be careful. It is really embarrassing to have your response rejected by the PTO for being non-compliant.
- B. A lot of people would have been better off canceling some claims and just trying to argue their best claims. It is usually a one-shot deal for the Examiner. If everything looks acceptable as it is, then you might get allowed. However, if one claim looks good but another looks bad, then your rejection for both will likely be maintained.
- C. Don’t use multiple similar words. Under claim interpretation principles,

every word in the claim has to add a limitation to the claim. Those multiple similar words are adding additional unpredictable limitations that you don't want.

D. Can't use "Etc" in a claim. It is totally indefinite.

IV. 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. Seriously clear – inescapably clear.

B. You have to do the work to bring the Examiner along

Some people just pointed out something about how the prior art worked and then stated to the Examiner that "therefore the claim is allowable". That's not going to work. You have not clearly and concisely given the Examiner a specific claim limitation that is not taught by the prior art. The Examiner is likely not going to take the time to try to go back and figure out which claim limitation you are talking about specifically and exactly how you view that as different from the prior art. Instead, the Examiner is just going to check "requires further consideration" and give you an Office Action. Turning this around, one standard for your argument would be to make it so clear that the Examiner would not think that it requires any further consideration on their part.

IV. Congratulations on completing the course!