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?

    E.   There was a mailing date error on the front page of the OA – should have been 4/7, but it was 4/17. That was not a test.

II.   Front Page Matters – Really no errors on the front page – good job!

III.   Amending the Claims

    A.   Usually people have issues with non-compliant Amendments (wrong claim identifiers, not properly underlining/striking out, mis-stating or just missing a rejection.) But there was only one person who had a claim identifier issue and one potential issue with a change in the claim not being shown. Good Job!

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.

    B.   If your claim suffered from 112,2 rejections, then you likely did not get very far with the Examiner in attempting to address the prior art rejections. Frankly, if the Examiner is not sure as to the scope of your claims, the Examiner is unlikely to be swayed to eliminate a rejection that the Examiner has previously made. This was a major issue for several people.

    C.   I think that it is sinking in how precise you have to be with your claims.

V.   Applicant's Actions

    A.   Clarity

        1.   Most 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.
            - You need to clearly indicate a claim limitation that is missing – and then direct the Examiner to the claim language and the conclusion that follows from it. You much connect the dots!

        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.   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.

5.   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 actually be in your claims – pretty much word for word. Also, directly quote it from your claim – this helps you stay identical to the claim language and helps the Examiner find it in the claim.

- This was actually a pretty major issue this year. In many cases, it wasn't just a small language tweak, but something major. You don't want to do that because you don't want to end up making material misrepresentations to the PTO -> potential discipline.

EXAMPLE

"B does not teach the a ability to measure hydration levels, glucose levels, lactate levels, electrolyte levels, or pH levels and adjust the nutritional products composition according to such measurements as <u>stated in claim 1</u>"

- Problem – claim 1 only recites lactate level

- Material false statement to PTO?

- NOTE: Claim 1 only "recites/states" what is actually there. It does not matter what the embodiment in your spec does, only what is literally recited in the claim.

C.   Another often-occurring issue was confusing "data" with the "informational content of the data" in the claim. Instead, measure a glucose <u>value</u> and transmit it as glucose <u>data</u>. At the server, the <u>value</u> is

subtracted from a stored <u>value</u> – you don't subtract the data itself (it is just 1s and 0s).

Example - "measuring a current blood glucose level and storing it as a current blood glucose level data"

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 <u>absolutely clear and inescapable argument</u> 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. Also note that if your claim limitations are not clear and solid (or are open to interpretation), then the Examiner will likely adopt a broader interpretation.
Example – "sensor" is anything that senses

    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.
-One example of this is just making a huge block quote when you are actually trying to assert that several different limitations within the block quote are not taught by the prior art. It would typically be clearer to break them out and discuss them individually.

    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 if they just 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. You just attempting to tell the Examiner that he is wrong is not going to be persuasive.

6. You have to make the argument extremely clear and un-escapable. The Examiner wants to do the easy thing, which is to maintain the rejection unless there is really no way for him to do so.

7. People also made a lot of extraneous comments. Basically, if something in the PA is not relevant for the specific claim limitation that you are using to differentiate from the PA, then why are you bringing it up? Instead, re-read your argument and for each sentence as yourself "how does this sentence help make my focused argument?"

D. SPELL out your conclusions very explicitly. It is not enough to say "Reference C teaches X, therefore claims 1-10 are allowable." First of all, what really matters is not what Reference C teaches, but that Reference C does NOT teach something in the claim. Second, we need to point that something out very explicitly to the Examiner.
The Examiner is not going to go out of his
way to investigate an issue that you raise. If the Examiner reads something and is not immediately convinced, then the rejection is maintained. They are also not necessarily going to make the same connections that you are. Therefore, explicitly spell it out. Remember those old geometry proofs where you had to go step by step until you reached Q.E.D.? That's the step-by-step, explicit process that we want here. Don't leave "gaps of assumption" in your argument. Carefully place each "brick" of your argument on top of the last.
"X therefor Y therefor Z."

E. NEVER refer to "the present invention" or "the present application"! Always just say (for example) "as recited in claim 1 …" Otherwise it may

be terrible prosecution history estoppel.

F.   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. New claims can only be amended at the end of the claim set.

G.   ALL changes to the claims must be shown. If you are deleting a claim element and replacing it with another, you must show the old claim element in strikethrough – not just replace it with a new, underlined claim element. Additionally, if you are replacing semicolons with commas, they much shown – and it would be a good time to use the double brackets.

H.   When you are amending a claim, delete a whole word - no "a~~n~~"

I.   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.

J.   Be careful about how much credit you give the prior art – When you say "the prior art teaches" or "Reference C teaches", the Examiner is entitled to use anything that you say as an admission against you – even if it is not true.

K.   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.

L.   You need to do much more than just saying "I disagree" in order to convince the Examiner. You also need to do more than just say "I amended the claims to take care of it". You need to point out the specific claim limitation, why it is different from the prior art, and why that is important and meaningful. This is <u>advocacy</u> – you can't just say what you think. You have to convince the Examiner to adopt your thinking. Just saying "you are wrong, you should think like this" is unlikely to work. You need to give the Examiner a <u>reason</u> – or they simply will not change their mind and remove the rejection.

M.   One issue that was difficult for people this year was 101 rejections. You need to include specific, structural limitations to your claim to get around the 101 rejections. Further, just specifying "functions" that you perform will not help. Also, you really have to watch your admissions.

Example – Quote from Amendment –

"However, the claims are directed toward measuring data, storing data, comparing data to stored threshold data and calculating data. These are complex functions which improve the supplement drink dispenser by dispensing ingredients according to the comparisons and calculations of data."

Examiner Response - In the Amendment, the Applicant admits that the claims are merely directed to "measuring data, storing data, comparing data to stored threshold data, and calculating data". As per the Examiner 101 materials, these are all abstract functions and do not cite limitations that limit their use to a specific technological implementation and thus do not recite significantly more as required for compliance with 101. The rejection is thus maintained.