

2017 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. Everyone did pretty well!

III. Claims

- A. Non-compliant amendments – even if you cancel a claim, the status of the claim as canceled must appear in your listing of claims. All claims must be accounted for.
- B. Some people might 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. Still pretty serious 112 issues in many of the claims. Take a look at your claim language and the language of the claims of others and see comments.
- IV. Remarks section
- A. This one applies to pretty much everyone – We need to work on advocacy.
- We need clarity and a step-by-step argument that leads the Examiner inescapably to our conclusion. You have to do all of the mental work for them in your writing.
 - Just baldly asserting that something is not taught by a reference is not likely to be enough. The Examiner will just say “I disagree” and maintain the rejection. Instead, you need to clearly point out HOW the Examiner is wrong. It seems like people might think that if they just “alert” the Examiner that the prior art reference does not show X, then the Examiner will very conscientiously go and look through the entire reference for it – or would just take their word. Neither will happen, the rejection will simply be maintained. Cite to the spec to bolster your claim. Discuss what the PA teaches (and cite to where) to illustrate that it can’t possibly teach what the Examiner is asserting.
 - You have to be absolutely clear – so clear that the Examiner can’t wiggle away. So how do we do that?
 - You need a “solid” structural or functional claim limitation to convince the Examiner. Seriously clear – inescapably clear.
 - As a thought Experiment, imagine you were the Examiner and all that was standing between you and going home for the weekend was if you could come up with some rejection to bounce back to the Applicant. You just need to find something. Is there anything that you can exploit? Now switch back to yourself and fix that.
- 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 is 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.

- C. Use proper English it is “The Examiner asserts ...”, not just “Examiner asserts ..” “Examiner” is a title, not a name.
 - D. Watch out for admissions. If the Examiner asserts that the prior art teaches X, it may not be the truth and it is not going to be prosecution history estoppel against you. However, if you phrase your argument sloppily, (for example by merely copying and pasting the Examiner’s language) then it becomes an admission and is now prosecution history estoppel against you. Always use something like “The Examiner asserts that ...” or “The Office Action recites that ...”
- IV. Congratulations on completing the course! Good luck in your careers! Consider the IP Clinic next spring!