

2018 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.” Anything that is not absolutely clear will not result in allowance. Anything that is open to a difference in opinion between you and the Examiner will not result in allowance.
- B. Recognize that all is not lost if you don’t get claims allowed. You can file an RCE/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/RCE early in the prosecution process. it is probably going to happen. If it does and you informed them beforehand, then you look knowledgeable because you were able to predict the PTO – it boosts your credibility. Remember that on average there are currently 3.4 Office Actions before allowance – and the numbers are higher in higher tech areas.
- 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 - Mail stop AF for Amendments after final.
- B. It is recommended to write out the dates. You don’t know if the person at the PTO is going to expect DMY or MDY format.

III. Claims

- A. Some people might have been better off canceling some claims and just trying to argue their best claim. 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.
- B. Still a lot of 112 issues in many of the claims.
- C. Non-Compliant amendments – only 4/8 were compliant, although that is an improvement from the 2/8 that were compliant last time.
 - Note: You really want to be sure that your work at your firm is Compliant. Lawyers may differ somewhat about what they think about your claims, but if you are Non-Compliant it sends a message to them that you maybe are not careful – which then might make them think you might be a liability risk. That’s not a reputation that you want. It will also be very clear when you are Non-Compliant because the docketing department will have to docket it. You will also have to be performing all the work to fix it and re-file on your own non-billable time.
- D. People were Non-Compliant in many different ways:
 - 1. Strike through and underlined same words in claim (example)
 - 2. Claim identifier read “Previously Amended” instead of “Previously Presented”.
 - 3. Identified claim as (Original), but included amendments
 - 4. Claim 8 vanished– no identifier or anything, it’s just gone
 - 5. Added new claim, but underlined it (should not have been)
 - 6. Included the text of a Canceled claim
 - 7. Improper block cancellation (“14-17. (Canceled)” instead of “Claims 14-17 (Canceled).”

IV. Remarks section

Overall, the current arguments are an improvement from last time, but there is still plenty of work that can be done to improve.

- A. This one applies to several people – We need to work on advocacy.
1. 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.
 2. For example, instead of just saying what the prior art does not do X, describe what it does instead of X and point out the differences. That give you valuable facts to back up your assertion.
 3. 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.
 3. To put it a different way, the Examiner is not going to just take your word that something is not taught in the Prior Art – and he is not going to expend effort looking through the Prior Art. However, if you put all the relevant facts clearly and inescapably in front of him, then you might get an allowance.
 4. 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? Any lack of clarity that you can have any reasonable basis to say requires further consideration? Now switch back to yourself and fix that.

- B. 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 ..." Instead of "Reference X teaches ..." unless you are absolutely sure.
- C. If you state in your Amendment that a Prior Art reference "does not teach" something and you are wrong, then it may very well be used to support an allegation of inequitable conduct and failure to comply with your duty of candor to the PTO. That can expose you to discipline. At the very least you should be doing a text search of the reference to verify your statement. That usually seems obvious to people – but what is less obvious is that you have to be careful with your language in the argument – lest you be making a broader statement than you intended to make.
- For example, if you state "London does not teach any system for smartphone tracking" and what you really mean is that "London does not teach the system for smartphone tracking that is recited in claim 1" – and London actually does discuss the use of smartphones in tracking, for example at paragraphs 53-54, 71, 77, and 110. Well, now you have a statement on the record that is literally untrue. It's probably not what you meant, but due to your sloppy drafting, you have now handed the enemy an argument to invalidate your patent based on your misrepresentation to the PTO.
- D. Some people were attempting to argue the contents of a dependent claim as part of their argument that an independent claim should be allowed. Recall that this is a response to a final rejection. You have only one shot and you want to go with your best arguments. If you believe that your

best argument is the limitation shown in the dependent claim, then incorporate the limitation in the independent claim and argue it with the limitation added. Otherwise, just stick to the independent claim.

- E. Some were suggesting that a claim term in the independent claim must be interpreted by the Examiner in a specific fashion because of a limitation that appeared in a dependent claim. That is not in accordance with US law. The dependent claim does not control the interpretation of the independent claim.
- F. There are still some areas where people are arguing “definitional” aspects that are unsupported by limitations in the claim – those are very unlikely to win. For example, if you recite “a server” in your claim and you don’t add specific structural or functional limitations, then the breath of that term is really quite broad – and probably broader than you think. For example, the IEEE Dictionary recites 6 different definitions for “server” including both hardware-based and software-based definitions. For example, definition (3) is “In a network, a device or computer system that is dedicated to providing specific facilities to other devices attached to the network”
- Some students attempted to argue that the “controller” shown in one of the prior art references was not a “server”. They reached this position because they had a particular, specific definition of a server in mind – however, they did not include the specific limitations that they had in mind in the actual claim. However, the Examiner would be very safe on the basis of the definition above in taking the position that the “controller” is inside the broadest reasonable interpretation of “server”.
 - So how do you get around it? Well, you don’t argue the definition of what is or is not a server – you just add additional structural or functional limitations that are not shown in the prior art, and then argue those limitations rather than the definition of “server”.
- G. If you had a rejection and you canceled the rejected claims, then you can’t say “The claims are respectfully submitted to be allowable” because the claims no longer exist in the application. Instead, you can say something like “Consequently, the present rejection is now moot.” Or

“Consequently, the Applicant respectfully submits that the present rejection has been traversed.” or something similar.

V. Last page

- A. Please be sure to list the correct filing date (2 people didn't). Remember that this is a signed document that you are submitting to the PTO. Inaccuracies may subject you to discipline.

IV. Congratulations on completing the course! Good luck in your careers! Consider the IP Clinic next spring!