

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. Always check to make sure that the references cited are cited correctly by the Examiner. Also, you should address any error in your Amendment. Remember, it is your responsibility to make sure that the record is correct.

II. Front Page Matters

- A. Recommended to spell out the mailing date
- B. Fancy fonts like smallcap are not allowed

III. Amending the Claims

- A. If you don't have a claim 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.
 - However! When adding an entirely new claim, the new claim is not underlined, just identified as (New).
 - When cancelling a claim, just remove claim, no strikeout.
 - Can't have color markups or extraneous marks at the edge of the paper indicating amendments.
 - Drawings sections and other sections are required to begin on new pages.
- C. If you failed to address an Examiner's rejection, then you are non-responsive. That's worse than being non-compliant. If you mis-stated the Examiner's rejections, you run the risk of being found to be non-responsive for not addressing the actual rejections. For example, 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.
- D. Only 2 of the 8 Amendments were Non-Compliant – better than usual!
- E. Several people misidentified the rejection as 102(b) as opposed to 102(a)(1). The Examiners usually accept it, but it won't look good to a partner reviewing your work.

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" (what they think is 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(b) 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 an 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 must connect the dots for the Examiner! They will not go out of their way to investigate. If the answer is not immediately apparent, they will just maintain the rejection.
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.
- C. “streetlight processor” vs “streetlight processor attached to a streetlight”
- D. 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. 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.
 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.

For example, a general, non-claim-language-specific statement of what the prior art does not teach using language that does not

appear in the claim – followed by a lengthy block quote of the claim without identifying specific elements to the Examiner – will not be persuasive. The Examiner is not going to hunt and search for something to shoot down his own rejections.

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. Your just attempting to tell the Examiner that he is wrong is not going to be persuasive.
 - One person literally just asked the Examiner to go back and take another look. Sorry, it is very unlikely that they will do so. They will just maintain their rejection and move on.
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?” Note the “focused” part – and clarity.

E. 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."

- F. 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.
- G. If you are adding new claims, insert "Please add the following new claims" in the claim list before the new claims to help the Examiner notice the new claims.
 - Also, you would typically remark about the new claims in the Remarks section – especially a new 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 added to the end of the claim set.
- H. 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 must be shown – and it would be a good time to use the double brackets.
- 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” 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.

- 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.

- M. 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 advocacy – 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 reason – or they simply will not change their mind and remove the rejection.

- N. If you have a 102 for independent claims and a later 103 for dependents only, then you can respond to the 103 by noting that the claims depend from the independent claims that were submitted to be allowable above. However, if you have a later rejection that also involves the independent claims, you must substantively address the later rejection.
- Example – someone addressed the first 102 and then just “submitted that the claims were allowable above” for the second 102, even though it involved independent claims. No can do.
- O. Don’t copy and paste the Examiner’s statements about what the prior art teaches – and then recite that the prior art actually teaches that. Note that the Examiner’s statements are often wrong – or at least over reaching. However, if you copy their statement into your Amendment and say “the prior art teaches X”, where X is copied from the Office Action, then the Examiner is entitled to cite your Amendment as an admission that the prior art actually teaches that – even if it was not actually there in the initial reference.