

# 2019 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 a 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. (6/8 people got it.)
- 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 –
  - 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.
  - Congrats! 8/9 of your Amendments were compliant. This is a substantial increase from last year’s 4/8.
- D. Remember not to include the text of the canceled claim when you are canceling the claim.

#### 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. - You can't just block quote the claim and hope that the Examiner sees the claim differences that you want him to see. Even if you clearly explained a structural or functional difference in the paragraph before, the Examiner is going to get lost/bored with long claim quotes. However, you can underline, italicize, or focus the Examiner's attention in some way on the one specific part of the claim that clearly and inescapably shows that the Examiner is wrong and the claim must be allowed – and if that is not there, then it is time to amend your claim – or cancel it!
  3. - Also, many times the Arguments were “bullet-pointy” in that they present a first fact bullet point, a second fact bullet point, and a third conclusion bullet point. That can only work when a reader of the bullet points a) understands the bullet points in exactly the same way that you understand the bullet points, and b) is willing to make the same logical conclusions that you are from the same bullet points. Unfortunately, you have NEITHER of those when it comes to an Examiner. The Examiner is not trying to work with you. Simply asserting bullet points gives the Examiner plenty of room to assert that he didn't see a logical connection between them and then maintain his rejection. You need to block the Examiner's ability to do that by being clear and tighter with your writing and not allowing him to have the logical “gaps” between the bullet points. Instead, constrain the Examiner by explicitly reciting the logical steps that must be made.
  4. 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 gives you valuable facts to back up your assertion.

5. 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.
  6. 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.
  7. 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. Canceling claims – Very few people canceled any of their independent claims. Unfortunately, that really lowers the odds that your response after final will be effective in securing an allowance. Recall that we are after final – we are going to file a continuation, so we just want to see if there is anything at all that we can get issued, even if it is only a very narrow

claim. You have to be ruthless in canceling your claims. I know it hurts, it's a terrible "Sophie's choice" after you have put so much work into the claims. However, a final Office Action that only has one independent claim and consequently only has to make **one** convincing/winning argument (as opposed to **three** different convincing/winning arguments – one for each independent claim) is more likely to be allowed. In short, if you make three arguments, you have to win them **ALL** in order for the application to be allowed. If you win two out of three, the examiner will just say that the application "requires further consideration". Conversely, if you only made the one argument that you think is a winner and dropped the other claims, then you might have an allowance.

- C. 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, or by taking an expansive reading of the teachings of the prior art) 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.

- Actual Example "Lee teaches that audio-related data such as time of generation and play time are being obtained by the processor 120 in the streetlight based electronic apparatus 101." This actually goes beyond the explicit wording of Lee and pieces together several elements that are bad for us. The actual "piecing together" is the Examiner's job – and it is not apparent that these things have been pieced together in an enabling way in which it would be appropriate to reject your claim. However, the Examiner can now rely on your admission and you have lost the ability to attack the Examiner's "piecing together".

- D. 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 and

potentially be used to render unenforceable an issued patent. 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 (actual example) “City IQ does not teach receiving data from a server” and what you really mean is that “City IQ does not teach receiving audio data and time data from a server as recited in claim 1” – and CityIQ does indeed teach receiving data from a server - for example to provide updates to the software on the streetlights.

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. Not good. Try to be very specific in your language. Do not assume that a reader will import any limitation into a statement that is not explicitly written.

- E. For 103 rejections, you need to argue both references alone and in combination – or else the Examiner will just claim that you are arguing against the references individually, which allows her to maintain the rejection. If you are arguing that there is a claim limitation that is not taught by either reference, then at some point in your response you need to say something like “Thus, limitation X is not taught or suggested by Reference A or Reference B, alone or in combination.”
- F. 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 the specification. That is not in accordance with US law. The specification does not control the interpretation of the independent claim.
- G. 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”

V. Last page

A. Date - Please be sure to list the correct filing date (some people did not). Remember that this is a signed document that you are submitting to the PTO. Inaccuracies may subject you to discipline.

B. Signature – always remember to electronically sign with “/name/”  
The PTO will refuse the amendment as non-compliant if “unsigned” (not properly electronically signed)

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