2026 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 an RCE/continuation 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 3.6 Office Actions before allowance – and the numbers are often higher in "high-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.

E. Only one student mentioned the Examiner interview or thanked the Examiner for the courtesy of the interview. It is always a good idea to recognize and thank the Examiner. You want to do what you can to establish a good relationship and make them well-disposed toward you.
- Additionally, you want the Examiner to REMEMBER the interview!
- and hopefully think of you in a positive light.

II. Front Page

A. Remember - Mail stop AF for Amendments after final. All students good!

B. The response if due 3 months from the mailing date of the Final OA –4/5 students good.

III. Claims

A. Most students are 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 some of 112 issues in many of the claims. This makes the claims more difficult to get allowed because it adversely impacts the clarity of your arguments.

C. More clear claim limitations = more effective arguments

D. If adding new claims, the application does not include the claims until your response has been accepted by the Examiner.

E. <u>One student was Non-Compliant –and one other was questionable</u> Just a reminder to be careful, the PTO will refuse to accept your response if it is non-compliant – and the 6 month date for abandonment is still ticking.

<u>Non-Responsive</u>

You MUST address all of the rejections in the Office Action – even if you have canceled all of the claims identified in that rejection. All you have to do is mention the rejection, mention that the claims have been canceled, and then assert that the rejection is now moot – but you must still mention the rejection.

<u>Non-Compliant</u>

Your claim marking must be correct! If language was inserted in your response to the prior office action, it must NOT be underlined in this Office Action. If you are adding new language in your claim with this Amendment, it MUST be underlined. Remember to implement ALL of the changes from your prior response (add what was underlined and remove what was struck though) before indicating any further changes in

the present Amendment. I am not sure if this was an issue, but any "automatic assistance" from Word is NOT your friend because it may accidentally select more than you intend. It is recommended that you turn off the "smart select".

-Claims can also be non-compliant if the claim identifier was wrong. Remember- if the claim was (original) in your previous Office Action, and it is not being amended now, then the correct identifier is still (Original) – not (Previously Presented). (Previously Presented) is only used when the claim was previously amended from the original, but is not being amended in this Office Action.

- The status of ALL claims must be listing – including claims that were canceled in a previous amendment. They would simply be listed as (Canceled) in subsequent Amendments. Basically, if the claim number was ever used, it must be accompanied by a status identifier in all future Amendments.

F. Interpreting claim limitations:

- If your claim recites "a first X" and "a second X" please recall that the claim limitation is open – not closed. If a prior art reference teaches 3 Xs then your claim is anticipated. In other words, the claim limitation does NOT mean "<u>only two</u> (first and second)" it means "<u>at least</u> first and second".

IV. Remarks section

Overall, the current arguments are an improvement from last time. There is still room for improvement, but I could note the improvement in the arguments

A. It all goes back to advocacy and clarity

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. In several instances, the arguments about the prior art were not very clear. Part of this was likely due to claim limitations that were not very clear – which made it difficult to present a clear claim differentiation to the Examiner. In other instances, the

argument about the contents of the prior art was not clear. In still other instances, arguments about the prior art were not linked directly to limitations in the claim.

3. In several instances, 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 – but did not explicitly recite the connections between them or the conclusion that the writer wanted the Examiner to adopt.

   - Or why the Examiner was prevented from adopting an interpretation of the prior art that would fit the claims.

   - Bullet-point arguments only work when the 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 the matter will require further consideration 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.

   - and how those differences make it impossible to satisfy the claim limitations you have identified. 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. Explain why that teaching does not fit the claim limitations.

6. Also – you must then link your statement to a specific limitation in your claim that you want to assert to the Examiner.
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 – but a rejection that is not so outlandish that you will get into trouble. 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.
8. You need to focus your discussion on a clearly explained structural or functional difference in your claim. You want to 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!
9. Also, presenting multiple arguments actually lowers your odds of success. Consider – if you present two arguments for the Examiner to consider and one is clear, but the other is less so, then the Examiner can easily maintain the rejection by stating that more consideration of the less clear argument is needed.

10. Also, there is no need to discuss aspects of the prior art that are not directly on point with the focused argument that you are asserting. Keep your discussion very tight and pointed toward the claim limitation that you are targeting.

11. Only write things in your argument that help you or are neutral. Don't agree in writing that the prior art teaches specific limitations of your claims. You only need to talk about what the prior art DOES NOT teach – not what it does teach.

B. Canceling claims – Some people canceled multiple claims to clarify and minimize the issues for the Examiner's consideration. That's great because it increases the odds that your response will be successful in securing an allowance. If you have 3 independent claims, you basically have to win on all three to get allowance – but with one independent claim, you only have to win on one. Recall that we are after final – we are going to file an RCE, 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 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 a convincing/winning argument for one claim (as opposed to **three** different independent claims) is more likely to be allowed.

- In short, if you argue 3 claims, 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 argued the one claims 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.

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. Reference A or Reference B, alone or in combination."

E. Watch out for 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 – but NOT the claim. That is not in accordance with US law. The specification does not control the interpretation of the independent claim – the Examiner must take the broadest reasonable interpretation based on the claim language.

F. I think that it has likely become clear that CLARITY is really the standard that helps us get claims allowed. We need to be able to make arguments relying on clear, unquestionable claim limitations – or else the Examiner will just adopt a different interpretation.

G. If you are not adding new claims, be sure to write "no new claims have been added" in the header to the Remarks page.

H Remember! – Don't write "the present invention"! It creates unwanted prosecution history estoppel.

V. Last page

A. Date - Please be sure to list the correct filing date. 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! Please consider participating in the IP Clinic next spring!