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.

F. Recall that it takes on average about 3.6 Office Actions to get some claims allowed. That's including fully-trained patent attorneys. Examiners don't immediately capitulate. It is often difficult to get claims allowed. Don't have unrealistic expectations.

G. 4 out of 5 Amendments were Non-Compliant

1 was non-responsive

II. Front/Last Page Matters

A. Recommended to spell out dates

B. Response is due 3 months from Notification Date on face of Office Action

C. Mailing Date of OA is the date on the front page of the OA

D. Must have the proper signature - /your number/ - need / /

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 the claim and identify it as canceled, no strikeout.

- Also, you must get the claim numbering right. You can't cancel a claim and then re-use that claim number.

-Drawings sections and other sections are required to begin on new pages.

- No claims in THIS Amendment can be "Previously Presented" or "Withdrawn"

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. Add a line return between claims and rejections to increase readability.

E. Objected vs. Rejected – Rejections are in light of 101, 102, 103, 112. Objections are minor grammatical errors or drawing errors. Do not misidentify rejections as objections.

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.

-Remember – if your CLAIM does not actually recite a structural or functional limitation, then the Examiner is not obligated to import it into the claim from your specification.

B. If your claim suffered from 112 rejections, then you likely did not get very far with the Examiner in attempting to address the prior art rejections unless you resolved the 112 rejections to the Examiner's satisfaction.

- Frankly, if the Examiner is not sure as to the scope of your claims, the Examiner is unlikely to be swayed by your argument to eliminate a rejection that the Examiner has previously made. This was an issue for everyone at least a little.

C. I think that it is sinking in how precise you have to be with your claims.

D. That being said, most people made good progress toward making their claims more solid and clear.

V. Applicant's Actions

A. Clarity

1. Some 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.
   - For 102 rejections - You need to clearly indicate a specific claim limitation that is present in your claim, but missing from the cited reference – and then direct the Examiner to the claim language and the conclusion that follows from it. You must connect the dots for the Examiner in a clear and inescapable conclusion. They will not go out of their way to investigate. If the answer is not immediately apparent and overwhelming, they will just maintain the rejection.
2. Add some spacing between the rejections to make your Amendment easier to read. Strive for clarity. Also, if the Examiner misses your response to a rejection and thinks your Amendment is non-compliant, it causes you a lot of extra work.
3. Clarity is what really gets claims allowed – a clear claim limitation that is a 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 with specific, "solid" limitations.
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 some 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 –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.

- You also can't "embellish" the claim language in your argument. No arguing that "Claim 1 teaches the X is permanently attached" when claim 1 only recites that "the X is attached." Recognize that you are misrepresenting your claim language. It might be considered inequitable conduct to make a misrepresentation to the USPTO

C. 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 specific and very persuasive in your Amendment, then he will just keep the rejection in place and not second-guess himself. You just attempting to tell the Examiner that he is wrong is not going to be persuasive.
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. Some people also made some 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.
8. Be careful! If only claim 1 includes limitation A – and independent claims 5 and 10 do not, then don't argue claim 1 on the basis of limitation A and then assert that claims 5 and 10 "include similar limitations". This is potentially a misrepresentation to the PTO that can get you into ethical trouble. -You are making a factual misrepresentation on the record

D. 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 your response 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."

E. NEVER refer to "the present invention" or "the present application"! Always just say (for example) "as recited in claim 1 …" Otherwise it may be undesirable prosecution history estoppel.

F. 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.

G. 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 much shown – and it would be a good time to use the double brackets.

H. When you are amending a claim, delete a whole word - no "a~~n~~" (just striking through the "n")

I. 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.

-"Thus, the present rejection is now moot."

J. 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. Don't be too generous.

K. Also, for 112 rejections - Don't make an admission! "these limitations <u>are</u> unclear" vs. "these limitations were found by the Examiner to be unclear" or "these limitations were identified in the Office Action as being unclear."

L. 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 <u>advocacy</u> – 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 <u>reason</u> – or they simply will not change their mind and remove the rejection.

M. 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.

N. In the header to your Amendment, include information about amended, canceled, and added claims – just to summarize the status of all the claims.
- For example, even if you are only amending claims, then write "claims 1-X have been amended and no claims have been added or canceled."

O. Be careful when talking about "the prior art" as a whole when you really only want to make a statement about one specific prior art reference
Example - "the prior art teaches" vs. "Rebro teaches"
- Especially when you have multiple prior art references with different teachings cited against you.

VI. Going forward from here

A. If an average Examiner would not be convinced by your argument to abandon their rejection, then the rejection is maintained.

B. I am happy to discuss your claims or response to Office Action if desired – please remove your secret code.

C. Question for thought for some students– as we head into the final Office Action, it would likely be best to focus on the claim that has the best chance of being allowed – and think about what amendments might help make it absolutely clear that it must be allowed.