

# 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?

## II. Front Page Matters

- A. Spell out the dates.
- B. Must include confirmation number if electronic filing
- C. If fax-filing, fill in date and sign

### III. Amending Spec and Claims

- A. If you don't have an 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.
- C. Everyone did OK with the claim identifiers, but please realize that double BRACKETS are not the same thing as double PARENTHESES

### 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 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. The Examiner improperly cited Paloheimo as prior art under 102(b) when in fact it is PA under 102(e) or 102(a). We want to:
  - Point out that the reference is not properly citable under 102(b).
  - However, we know that the reference may be citable under 102(e) or (a). Consequently, we will proceed to respond to the Examiner's rejection as if the reference had been cited under 102(e). Be careful not to actually assert that the reference IS valid prior art under 102(e) in case you want to swear behind later.Remember to always check the references first!

- C. Please note that just because a reference is not citable under 102(b) does not mean that it can't be cited as part of a 103(a) rejection. For the 103(a) rejection the Examiner does not have to identify the section of 102 that the prior art arises under – and this is pretty clearly 102(e) or (a) prior art.
- D. Don't get aggressive and attack the CarbonFund website as prior art. We know it is because the inventor gave it to us.

V. Applicant's Actions

- A. You must address each of the Examiner's rejections
  - 1. Don't change the Examiner's rejection. If the rejection under 102 is for claims 1-10, then the Examiner has made one rejection for claims 1-10, not two rejections (one for claims 1-5 and one for claims 6-10). If you change the rejection, the Examiner may find that your Amendment is not responsive to his rejection.  
Here's how to phrase it:  
"Turning now to the Examiner's rejection of claims 1-10 under...  
Recite the standard teaches/does not teach  
Claims 1-10 include independent claims 1 and 6. First, with regard to independent claim 1,  
Turning now to independent claim 6, ....
  - 2. Note that if there are a lot of independent claims or you are arguing very different points of novelty for the claims, it may be clearer to handle the teaching of the prior art before each independent claim rather than an incomprehensible and confusing lump up front.
  - 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.

- 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 be in your claims. For example, if you say that the prior art “does not teach measuring” then “measuring” should be in claim element. However, if you recite:

“monitoring distance travelled, wherein said monitoring is performed by said global positioning system communication device generating said data representing said distance between said first position and said second position.”

There’s no “measuring” in the claim element

- C. When making your amendments, do you now have a greater appreciation for why you want to write a detailed specification? It gives you plenty of options to choose from.

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.
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.
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.

- E. Clarity
- To be effective, link your discussion directly to a specific, short claim limitation that is clear and does not allow the Examiner any wiggle room. Too long a limitation gives the Examiner wiggle room. Too short a limitation can also let the Examiner get away. Don't distract the Examiner by trying to recite a laundry list of things that you don't think are in the reference. Often, you will be focusing your response on the new claim element that you are adding.
- F. Many people made assertions about the teaching of the prior art, but they failed to explicitly include their actual insertion in their claims.
- G. Watch out when you make big sweeping statements. They are 1) not needed, 2) not persuasive to the Examiner, and 3) may bite you. For example: Stating that a PA reference "Does not teach monitoring in any way" vs. "Does not teach monitoring as recited in claim 1."
- H. Watch out when you make assertions about what one of ordinary skill would think or do. The Examiner could always request that you make an affidavit in that regard and it is not actually persuasive to the Examiner.
- I. If you are adding new claims, insert "Please add the following new claims" in the claim list to help the Examiner notice the new claims. Also, you would typically remark about the new claims in the Remarks section – especially an 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.
- J. When you are amending a claim, delete a whole word - no "an"
- K. 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.

- L. Watch out – a couple of people were on the edge of inequitable conduct. For example, one person said: “claim 8 recites a ‘communication system’ where the communication system is comprised of machines” however the actual claim limitation was: “a first communication system providing at least unidirectional communication with a computing device” and “machine” did not appear in the claim.
- M. Clarity – One of the biggest problems in general is the lack of clarity in the claims. Because the claim limitations are not clear, it is difficult for people to make clear limitations 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.
- N. Be careful about how much credit you give the prior art – When you say “the prior art teaches”, the Examiner is entitled to use anything that you say as an admission against you – even if it is not true.
- O. Which is clearer? “claims are not unpatentable” vs. “are patentable”