

Utah Bar IP Section Patent Boot Camp

Practical Tips For Prosecuting Patent Applications

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Roadmap

- Drafting Note
- Interview practice
- My Office Action workflow
- Responding to Common Rejections
- Considerations for Non-Final Actions
- Considerations for Final Actions
 - AFCP 2.0
- Miscellaneous
 - Examiner's Amendments
 - Non-Compliant Amendments
 - Allowance
 - Supervisors

Drafting Note

- Cannot emphasize enough the importance of a quality application with quality claims
- The claims set the stage for prosecution
- Many Examiners don't seem to read the specification, so their understanding of the invention is from the claims
- Quality claims can help avoid bad art (better initial search) and the Examiner entrenching in bad rejections and/or a bad understanding of the invention
- Ensure the specification has adequate and well-supported fall-back positions

Interview, Interview, Interview

- Often the best (and cheapest) way to advance the case is to pick up the phone (or board a plane)
- Gives you informal “off the record” discussions
- Helps build good will
- Opens the door to further collaboration (on this, and future cases)
- Good way to avoid combative correspondence
- Tips:
 - Prepare a quality agenda and send timely
 - Call to set up interview
 - Be well-prepared

Interview, Interview, Interview

- Tips (cont):
 - Let the Examiner talk and don't interrupt! Truly try to understand her position
 - Avoid being combative
 - Okay to request supervisor be present
 - Examiner's often offer helpful suggestions, especially if you ask
 - Great way for you to shift the Examiner's thinking, or for the Examiner to shift YOUR thinking
 - Help drive the interview summary
 - Easier to get an interview on Final if you propose amendments

My Office Action Workflow

- Are there allowed priority cases? Pending related cases?
- Look through and understand all rejections
 - Did the Examiner reject ALL the claims?
 - Allowed claims are usually at the end
- Check prior art status
 - Don't take the Examiner's word for it. Check dates, inventors, provisionals, NPLs, etc.
 - Don't amend due to non-art (be careful of §102(b))!
- Review your specification and claims

My Office Action Workflow

- Review art apart from rejections, and then in light of rejections (highlight); don't ignore secondary references
 - Try formulating your own rejection
- Develop outline amendments (if needed)
- Develop outline arguments
- Interview (leverage outline for agenda)
- Prepare full amendments and response—leverage interview
 - Address each issue in Office Action, in order
 - Avoid combative language / choose your battles
 - Avoid admitting rejections

Responding to Common Rejections

- Objections
 - Usually not worth fighting
 - Fix drawings objections with specification amendments
- §101 (see other presentation)
 - Often not understood by Examiner
 - Interviews are particularly effective
- §102/§103
 - Consider full corpus of art, not just what was cited
 - Focus on independent claims; leverage dependents
 - Don't forget prior-cited art
 - Make sure you are arguing what is actually claimed

Responding to Common Rejections

- Double-patenting
 - Don't just cave—claim scope could change
 - Consider effect of PTA
- §112
 - (a) - Written Description
 - (b) - Particularly pointing out and distinctly claiming
 - (f) - Means-plus-function

Considerations for Non-Final Actions

- Amend
 - ...to overcome art
 - ...to better set up for appeal
 - ...to clarify/restate
 - ...to fix errors (claims, spec, drawings—be proactive)
 - Be sure the amendments are supported
 - I tend to give little deference to existing claims
 - Tell a story
- Traverse
- Abandon
- Appeal (if claim is twice rejected)

Considerations for Final Actions

- Amend w/ RCE
- Abandon
- AFCP 2.0
- Pre-Appeal (hit and miss)
- Appeal
- Amend
 - Talk to examiner!

After-Final Consideration Pilot (AFCP) 2.0

- What is it?
 - Authorizes additional time for examiners to search and/or consider responses after final rejection
 - Free to request; file form PTO-2323
- What's involved?
 - Must amend at least one independent claim, and not broaden the scope of the claim in any aspect
 - Must be available for interviews

After-Final Consideration Pilot (AFCP) 2.0

- Benefits
 - Have amendments considered after Final without RCE
 - A good way to get an interview on a Final
 - Great way to get a feel for whether to amend, appeal, or abandon
 - Build good-will with Examiner
- Drawbacks
 - Still an after-Final response, deadlines don't toll. If Examiner doesn't allow the case, will issue Advisory Action without entering amendments
 - Recommend filing by 2-month date

Examiner's Amendments

- Examiner wants to allow the case and is willing to negotiate
- Examiner is often up against a deadline—be courteous and responsive
- Be sure to understand basis for request—often very arbitrary (again, negotiate)
 - Ask for art
- Send the Examiner the amendment to make sure it's done right - informal
 - Authorization for Internet communications (Form PTO/SB/439)
- Opportunity to proof and correct the claims

Non-Compliant Amendments

- Be careful about running afoul of constructive election

Allowance

- BEFORE paying issue fee:
 - Proof claims
 - Can file 312 amendment
 - Make sure IDS's are in order
 - Reconsider scope (RCE)
- Cull the file
- File comments
- QPIDS
- Consider continuations for broader scope, licensing, sales
- Celebrate!

When all else fails...

- Call the supervisor

Questions?
Comments?
Criticisms?