

Response to Examination Reports in US Practice

**India Patent Office,
Calcutta**

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Formalities Upon Receipt of Examination Report

1. Note receipt of examination report in incoming mail log
 - = Absence of entry in the log can be used to prove non-receipt
 - = Inexpensive to withdraw abandonment caused due to 'non-receipt'
 - = Petition to revive otherwise expensive

2. Docket time to respond
 - = usually 3 months for 'non-final' office actions
 - = Advantage to respond within 2 months in case of 'final' office actions
 - = Extension automatic upon payment of applicable fees by express rule
 - = Non-extendible 6 month deadline generally

Broad Objectives/Requirements of a Response

1. Respond to every objection/rejection
 - = “Objection” is one of form
 - = “Rejection” substantive
2. Say no more than needed
 - = Responses part of public record
 - = scrutinized during later litigation
3. Estoppels/interpretations a major concern
 - = by unneeded remarks or amendments
 - = by non-rebuttal
 - = remarks/events in foreign jurisdictions can be used in US litigation

Form of Response

1. Expressly specified in rules (37 CFR 1.121) and published documents
2. Separate sections for amendments to description/drawings/claims and remarks
3. Notation/convention specified for insertion and removal of text
4. Drawings: Substitute sheets with changes effected + annotation sheet showing changes

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Form of Response (Cont..)

5. Claims
 - Renumbering by Examiner only at end of prosecution
 - Each claim to have a status identifier (previously presented, currently amended, canceled, original, etc.) in each response

6. Description: Only changes shown in responses (no substitute sheets)

7. Remarks
 - Specifically point out how **each** objection/rejection has been addressed by the changes to claims
 - Traverse rejections
 - Contact information

Determinants of Outcome of Prosecution

1. Patentable subject matter questions (35 USC 101)
2. Novelty/obviousness questions (35 USC 102/103)
3. Questions of boundaries of claims/sufficiency of description (35 USC 112)
 - In software cases, extremely intertwined with novelty/obviousness

Patentable Subject Matter Questions (Software)

- Burden on USPTO to clearly articulate basis for conclusion of non-patentable subject matter
- Broad trend with software based applications
 - Pre-1990: Copyright more appropriate for software protection
 - 1990-recent: Functional aspects best protected by patents
 - Now-Ongoing: Perceived attempts to avoid too much protection

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Patentable Subject Matter Questions (Cont...)

3. Basis for Examination of software related cases
 - Operational basis articulated in MPEP section 2106
 - Based on USPTOs interpretation of statutes/case law

4. Broad Observations
 - Descriptive (non-functional) text not patentable subject matter
 - Form of claims and specific recitations in claim body persuasive for 'functional' subject matter
 - Invention operative by execution of software instructions, not determinative that non-patentable subject matter
 - no 'per se' preclusion of protection for software based technology

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Patentable Subject Matter Questions (Cont...)

5. Claims forms: Required/permitted by legal doctrines
 - 'Direct infringement' – entire claim covers product/act of single party
 - Apparatus/system claims – infringement on use/sale/making
 - Method – infringement when used/practiced; Infringement to import product of practiced method
 - 'means/step for' (35 USC section 112)– Arguably 'narrow' protection

6. Claim forms: Required by business/technological nature
 - = Computer readable medium storing instructions
 - = transmission media/carrier wave claims

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Patentable Subject Matter Questions (Cont...)

7. MPEP 2106
 - Utility/practical application
 - Within enumerated statutory category (process, machine, manufacture, or composition of matter)
 - Covers judicial exception (laws of nature, natural phenomenon, abstract ideas): non-statutory
 - = 'abstract idea' – not precisely defined (Burden on USPTO)
 - Practical application of judicial application (statutory)
 - = Physical transformation
 - = produces a useful/concrete and tangible result

Novelty/Obviousness Issues

1. Burdens
 - 35 USC 102: “A person shall be entitled to a patent unless ...”
 - 35 USC 103: Burden on USPTO to establish a prima facie case
 - PTO entitled to broadest reasonable interpretation of claim terms
 - PTO does not generally read into the claims unrecited limitations even if present in the description

 2. Definitions
 - Anticipation (35 U.S.C. § 102): based on single reference/product
 - Obvious (35 U.S.C. § 103): based on multiple references/products

 3. Claims of adequate/acceptable scope indicated to be allowable?
 - Yes: Amend independent claims to reflect allowed scope
- (Continued)

Novelty/Obviousness Issues (Cont.)

4. Mental formulation of response strategy
 - = Confirm each reference is 'prior art' under 35 USC 102
 - First to invent (102(a) and 102(e)) and joint ownership issues
 - = Removal as prior art reference if appropriate
 - = Review references to check if Examiner's assertions are supported
 - = Determine claim strategy based on review

5. Preparation of response based on claim strategy
 - = Option 1: Show Examiner's logic is erroneous (traversing)
 - Not effective to show your logic is superior logic in report
 - = Option 2: Amend to clearly overcome the references
 - In computer/software arts, normal to amend if the facts of record create 'threshold mental confusion'
 - = Point out in the remarks why the presented claims are allowable

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Novelty/Obviousness Issues (Cont.)

6. Overcoming anticipation rejection under 35 USC 102
 - = Point out at least some minimal difference in the CLAIM language from the cited prior art
 - = Request sworn affidavit from Examiner if relying on public knowledge
 - = In software cases, questions of inherency more often present

7. Overcoming prima facie case of obviousness under 35 USC 103
 - = Show defective
 - = Rebut the rejection

8. Defective rejection under 35 USC 103
 - = Show none of the references teaches a claimed limitation
 - = Absence of motivation to combine

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Novelty/Obviousness Issues (Cont.)

9. Motivation to combine
 - = Legal requirement: no hind-sight reconstruction by the PTO
 - = PTO general practice is to 'almost always' assert it exists
 - = Do the concepts/embodiments work naturally?
 - Yes: PTO will maintain motivation to combine
 - = Operation of concepts/embodiments inconsistent?
 - Yes: No motivation to combine
 - = In between
 - Difficult question
 - = Very fact dependent and extremely complex issue (in software cases)

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Novelty/Obviousness Issues (Cont.)

10. Rebut rejection
 - = Affidavit from experts with 'secondary considerations'
 - = Goal is to demonstrate hindsight construction
 - = Long felt market need, commercial success, several unsuccessful attempts, etc.
 - = Usually the nexus/causation will be questioned

11. Present arguments on dependent claims
 - = Dependent claims to check whether claims of acceptable scope will be allowed

Rejections Under 35 USC 112

1. Written Description/Enablement/Best Mode rejections
 - = Avoid by writing complete specifications upfront
 - = Software: predictable arts
 - = Written description rejections if scope sought to be enhanced during prosecution contrary to assertions in the specification
 - Mere support in the specification not sufficient
 - = Precise antecedent basis in the description often enquired

2. “... claims particularly pointing out and distinctly claiming... invention”-
 - = Indefiniteness: Comply with rejections based on dependency issues
 - = Examiner usually does not ask ‘what is new?’
 - Undertakes the burden of showing every claimed recitation in prior art
 - Relies on applicants remarks to continue more precise searches

Restriction/Division Practice

1. Required to elect one of the groups proposed by the Examiner with or without traverse
2. Restriction practice by telephone interview permitted
= Requiring formal action an option for the applicant
3. Traverse rarely successful
4. Recourse is to petition the director (not appeal to board)
= Traversal at time of election a pre-condition
5. Burden on applicants vs. on patent office

Double Patenting

1. “statutory category”
= show not identical scope
2. Non-statutory obviousness type rejection
= In software cases, file a terminal disclaimer
= Reduced term acceptable in software cases

Examiner Interviews

1. Timing
 - = None before the first examination report
 - = Usually matter of right after first examination report
 - = Discretionary after “final” action

2. Formalities
 - = Applicant to set forth the agenda (not part of record)
 - = Telephone interviews fairly common
 - = Substance of the interview MUST be made of record
 - Participants
 - What was discussed
 - Agreement reached?
 - Exhibits?

Duty of Disclosure

1. Affirmative duty to disclose 'known material information' to USPTO
 - no duty to search, but have to disclose known information
 - 'material' if a reasonable Examiner would have wanted possession
 - duty of candor and good faith
 - Inequitable conduct a basis for unenforceability of later issuing patent

2. Applies to all individuals associated with filing and prosecution
 - covers attorneys/agents, inventors, inhouse support staff

3. Submitted in an 'information disclosure statement' (IDS)

Questions and Answers

THANK YOU!!!