

# **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

(Continued ...)

# 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!!!**