



STRATEGIES FOR MAXIMIZING PROSECUTION EFFICIENCY

Don't Waste The First Office Action, And Make It Thorough!



- How does this application fit into the Applicant's portfolio?
- What is the goal of this application?
- Are we covering a product, a feature of a product, a potential new product?
- What information do we have about competitors?

- Claim scope and claim presentation matter
- Strategically prepare additional independent and dependent claims
 - Are we maximizing claim count?
 - What about the dependent claims - are they meaningful or simply added to increase claim count?
- Address formality issues when filing
 - EP formatting, translation issues, multiple dependent claims

Examine Claims With A Purpose

- When independent claims of varying scope are presented, are all features being considered?
- Are dependent claims being fully examined and considered, or simply grouped and rejected with the independent claims?
- When possible, provide guidance on addressing objections/rejections

Strategy #2

Avoid Piecemeal Prosecution



- After preparing amendments, take a step back and put yourself in the Examiner's shoes
 - Do the amendments really advance prosecution?
 - Are we adding a feature that, while may not be taught, will very likely result in a new reference being applied to support an obviousness position?
- Argue dependent claims
- Add claims

Fully Consider The Response

- Is it really obvious now, or still obvious?
- Address all arguments (including the dependent claims)
- Reconsider claim scope and possible options to advance the prosecution
 - Are dependent claims now possibly allowable?
 - Is there an additional tweak to the independent claims to overcome the art?
- Provide any suggestions - they work!

Strategy #3

Make Use Of Examiner Interviews And Opportunities To Speak With The Applicant



- Gives the ability to present arguments in an off-the-record setting
- Interviews result in shortened prosecution
- Minimize/eliminate arguments made on the record
- Build a rapport with the Examiners who are handling your applications

- Prepare an easy to follow, comprehensive list of discussion points
 - Provide a brief argument addressing the art
 - If the rejection warrants it, provide a proposed amendment to direct strategy for the interview
 - Include reference to specification sections and figures for potential discussion

- Explain the invention and problem being solved
 - The 10,000 foot explanation
- Provide a brief argument addressing the art
 - Different problem, different solution, non-analogous?
- Address the specific discussion points from the agenda
- Ask the Examiner for suggestions
- Remember the ultimate goal of the interview!

- When reviewing the application, try to flag features of the invention (not necessarily in the claims) that you think may be difficult to find in the art or could be allowable

- Remember the ultimate goal of the interview!

Speed Things Up



Speed Things Up

- Accelerated Examination
- First Action Interview Program (FAIP)
- Track One
- Patent Prosecution Highway (PPH)
- After-Final Practice

➤ Important requirements

- File 3 or fewer independent claims and no more than 20 claims total
- File an application for a single invention or agree to elect without traverse a single invention for examination
- Agree to an interview with the Examiner to discuss any outstanding issues arising in the examination process
- Conduct a pre-examination search

- Participants may conduct an interview with the Examiner after reviewing a pre-interview communication providing the result of a prior art search
- Benefits
 - Advance prosecution of the application
 - Enhanced interaction between Applicant and the Examiner
 - Opportunity to resolve patentability issues at the beginning of the prosecution process
 - Facilitate early allowance

- Participants may receive a final disposition within about twelve months
- Application has special status with fewer requirements than the accelerated examination program
- No need to perform a pre-examination search
- Costly

➤ Eligibility

- Received an indication of allowable subject matter (at least one claim) in a related application from a partnering PPH office
- The application with the indication of allowable subject matter and your USPTO application share a common earliest priority date
- All claims in the USPTO application must sufficiently correspond to the claims in the related application
- Substantive examination for USPTO patent application has not started

- Submit an amendment that complies with AFCP 2.0 program
 - Do not broaden the independent claims
 - Consider avoiding significant amendments (when possible) so that a reasonable search can be conducted in the allotted time
 - If an interview occurred prior to filing, discuss this strategy with the Examiner

- Take it seriously!
- At a minimum, indicate whether the Amendment will overcome the current rejections/art
- Whenever possible, contact the Applicant to discuss claim scope/potential next steps
- Preferably, a search will at least be attempted, and references/relevant sections will be identified in the Advisory Action
 - This gives Applicant opportunity to file a supplemental response with an RCE and speed things up

Is There A Smarter Way To Get The Best Outcome?



- What is the purpose of the application?
- RCE or Continuation?
- Can analytics assist the decision?

Avoid The Adversarial Relationship



Thank You!

Paul Gurzo

pgurzo@harrityllp.com

11350 Random Hills Road
Suite 600
Fairfax, VA 22030
571-432-0809
www.harrityllp.com
www.harrity4charity.com



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