

Improving Clarity and Reasoning in Office Actions Training: Reasons for Allowance

UNITED STATES
PATENT AND TRADEMARK OFFICE



Objectives

- Overview of Reasons for Allowance
- What a statement of Reasons for Allowance includes
- When a statement of Reasons for Allowance should be added to the record
- Examples of suitable and unsuitable content

Overview

- The reasons for allowance is the examiner's statement explaining the findings of patentability for the claimed invention
- We have seen that the courts do consider examiners' statements of reasons for allowance, thus clarity of the record will assist the courts and the public in assessing the extent of the rights being granted

Overview (*cont.*)

37 C.F.R. 1.104(e) Nature of Examination:

"If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning... (*Emphasis added*)"

Overview (*cont.*)

“One of the primary purposes of 37 C.F.R. 1.104(e) is to **improve the quality** and **reliability** of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed.”

Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent. (*Emphasis added*)”

Overview (*cont.*)

- Rule 1.104(e) addresses the examiner's authority to do so and provides applicants or patent owners an opportunity to comment upon any such statement of the examiner
- It should be noted that the setting forth of reasons for allowance is not mandatory
- However, in meeting the need for the application file history to speak for itself (clarity of record), it is incumbent upon the examiner in exercising his or her responsibility to the public, to see that the file history is as complete as is reasonably possible

What a Statement of Reasons for Allowance Includes

The examiner should keep in mind the possible misinterpretations of his or her statement(s) that may be made and its possible effects on the file record. Each statement should include at least:

- (1) The major difference in the claims not found in the prior art of record;
- (2) The reasons why that difference is considered to define patentably over the prior art of record; and
- (3) Any reasons other than prior art issues, such as why rejections under 35 USC 112 or 101 were overcome and withdrawn.

Examples of when Reasons for Allowance should be added

- Examples of when Reasons for Allowance should be added to the record include:
 - Claims are allowed on the basis of one (or some) of a number of arguments and/or affidavits presented, and a statement is necessary to identify which of these were persuasive
 - First Action allowance
 - Withdrawal of a rejection for reasons not suggested by applicant
 - Allowance after remand from the Patent Trial and Appeal Board
 - Allowance coincident with the citation of newly found references that are very close to the claims, but claims are considered patentable thereover

MPEP 1302.14 (II)

Examples of when Reasons for Allowance should be added (*cont.*)

- Examples of when reasons for allowance should be added to the record further include:
 - Allowance based on a claim interpretation which might not be readily apparent, for example, a 112(f) interpretation not previously made on the record
 - Allowance following decision by the United States Court of Appeals for the Federal Circuit or District Court of the District of Columbia
 - Where the claims are considered patentable over the X and/or Y references cited in a search report of a corresponding PCT application and the reasons for allowance are not apparent from the record
 - Where the reasons for allowance are of record but, in the examiner's judgment, are unclear (e.g., spread throughout the file history) so that an unreasonable effort would be required to collect them

MPEP 1302.14 (II)

Examples of Suitable and Unsuitable Content

- Suitable Content (MPEP 1302.14, III)
 - Sets forth a specific claim limitation clearly present in the allowed claim which is neither taught nor suggested by the prior art as a whole, either alone or in combination
 - Sets forth a specific argument commensurate in scope with the claim limitations upon which allowance is based
- Unsuitable Content (MPEP 1302.14, IV)
 - Includes limitations attributed to all claims but not present in at least one independent claim
 - Repeats a claim verbatim
 - References Applicant's arguments in total rather than a specific argument that was found persuasive, although one need reference only the major or important persuasive arguments

Examples of Suitable and Unsuitable Content (*cont.*)

- Where specific reasons are recorded by the examiner, care must be taken to ensure that such reasons are accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims
- If multiple independent claims each have a distinct reasons for allowance, then the record should reflect each of those reasons
- Stock form paragraphs that merely restate the claim language should not be used

Final Thoughts

- When an application is finally acted upon and allowed, the examiner is expected to determine, at the same time, whether the reasons why the application is being allowed are evident from the record.
- In determining whether reasons for allowance should be recorded, the primary consideration lies in the first sentence of 37 C.F.R. 1.104(e) which states:

"If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. (*Emphasis added*)"

Final Thoughts (*cont.*)

In conclusion, the examiner must make a judgment based upon the merits of the case to determine whether or not a reasons for allowance should be set out in that particular case

Summary

You should now be able to:

- Determine when a statement of Reasons for Allowance should be added to the record
- Implement what should be included in a statement of Reasons for Allowance
- Understand the difference between suitable and unsuitable content in the Reasons for Allowance
- Understand and appreciate how a statement of Reasons for Allowance impacts the record of a Patent