

Clarity of the Record Pilot Best Practices

This list of best practices for enhancing the clarity of the prosecution record was collected by Pilot participants during focus sessions and other meetings. These best practices have been grouped by the Pilot's focus areas and are as follows:

1. Claims Interpretation / Rejections

- In general, assume that the audience is not as knowledgeable about the subject matter as you are. Do not leave the applicant to guess what your position is for any claim feature, as this invites arguments and prolongs prosecution.
- Indicate not only where in the prior art the limitation is taught, but also summarize why that limitation is met.
- If terminology in the prior art reference is different than that in the claims under examination, include the prior art terminology in your rejection, e.g. in square brackets.
- When applying prior art rejections to a claim rejected under 35 USC 112(b), make the broadest reasonable interpretation and state on the record how you interpreted the limitation at issue.
- Discuss rationale to combine for each and every reference cited in a 35 USC 103 rejection. Specifically, if you have a 35 USC 103 rejection in view of X in view of Y in further view of Z, then discuss the combination of X and Y and then discuss why it would be obvious to combine the teachings of XY with Z.
- Use SnagIt tool to include pertinent figures or chemical formulas in the office action. Use the tool to annotate the images to more clearly convey your position.
- State on the record how much patentable weight is given to the preamble, when applicable.
- Do not “lump” claims into one rejection.
- Include a claim interpretation section in the office action, if necessary.
- If relying on KSR, ensure the rationale is applied in a clear fashion. For example, for “Combining Prior Art Elements According To Known Methods To Yield Predictable Results,” make sure to state what the known method and the predictable results are.
- If a term has a special definition, state where it is defined in the specification as support for your interpretation.
- If 35 USC 112(f) is invoked, use the appropriate form paragraphs and cite from the specification the structure that performs the function. Note if support is not found in the specification, then make appropriate 35 USC 112(b) rejection(s).
- If using case law in the rejection, only use it to support the rationale in an obviousness rejection.
- If claim language suggests or makes optional some structure or steps, identify that language and provide an explanation as to whether it imposes a limitation on the claim scope.
- When functional language is recited in the claim without invoking 35 USC 112(f), add a statement as to whether it has been given patentable weight along with an explanation.

2. Allowances

- State the particular allowable subject matter and how the prior art teachings neither anticipate nor render obvious the allowable subject matter in combination with the other claimed limitations.
- Cite the pertinent arguments by the applicant (e.g. affidavits/declarations) that were persuasive.
- Cite to the document(s) in the prosecution history where allowable subject matter was described if not rewritten in the notice of allowability to provide a “roadmap” to allowance by referring back to previously described reasons for allowance during prosecution.
- Cite any newly discovered prior art and explain why it is relevant to the allowable subject matter to have a complete record of the state of technology at the time you indicated the allowability of the claimed subject matter.
- Address each independent claim separately.

3. Interview Summary

- If prior art was discussed, explain the specifics of how the applicant viewed your position and vice versa. If the applicant clarifies to you how they are reading the prior art, detail your position in writing in the interview summary.
- If applicant deviates from the agenda to talk about other arguments and/or claims, address that in the interview summary and how you responded.
- State if proposed claim amendments were discussed during the interview and indicate whether or not they overcome the prior art of record.
- If you decide to change your perspective about how the search was conducted in view of applicant’s arguments, consider addressing on the record that you will follow a new search approach and describe what that approach will be (e.g., other classes not previously searched, new search strings that were not searched before, etc.).
- Indicate whether or not an agreement was reached for all issues (e.g. arguments and/or proposed amendments).
- Consider conducting pre-search interviews or other timely interviews with the applicant to resolve any issues to claim interpretation or clear up issues to promote compact prosecution.

4. Other

- If relying on new prior art for an amendment, consider going the extra step of addressing why this new prior art overcomes the claim limitations, rather than simply stating the arguments are moot.