

I would like to see consistent treatment of part-one of the test under Alice. Some ideas for topics to study:

- 1) What analysis should examiners be conducting to determine if the patent as a whole is directed to a judicial exception? Some examiners look for a literal line in the body of the claim to describe the patent as a whole, some will consider the preamble, some will consider the specification, some will consider a subset of the claim's limitations and separate the other limitations under the something more part-two analysis.
- 2) How should examiners describe the judicial exception. In describing the judicial exception, some describe it to the greatest level of generality, "an abstract idea", "a mathematical formula" and some will go down to the specific details of the claim or yo-yo between in different office actions.

Case Study on after-final pilot program practice

- 1) Is there enough time for examiner's to consider amendments/arguments? Are the examiners using that time effectively. Often examiners will say they did not have enough time to consider amendments, or will only consider half the arguments where there aren't amendments citing not enough time.
- 2) If you submit amendments, and the examiner concludes that the amendments are too extensive, should the examiner consider arguments directed to claims in their original form in accordance with pre-pilot practice?
- 3) How should examiner decide whether to conduct after-final interviews to determine any amendments for an after-final pilot program or RCE? It seems like it should be an encouraged practice, but some examiners consistently refuse to do after-final interviews as a rule.

Brandee N. Woolard

Patent and Trademark Attorney



1400 Crescent Green
Suite 300
Cary, NC 27518

Work: 919-854-1844
Fax: 919-854-2084

www.coatsandbennett.com

WARNING: This message may contain information that is confidential and/or protected under the attorney-client or other lawfully recognized privilege. If you received this message in error or through inappropriate means, please REPLY to this message to notify the Sender that the message was erroneously received by you, and then permanently delete the message from all storage media, without forwarding or retaining a copy.



Please consider the environment before printing this e-mail