



Clarity of Record Pilot: Reasons for Allowance

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Goals of the Pilot:

- Ensure that the reasons for allowance are clear in the prosecution history of issued patents
- Better inform patent owner and public of the decision making during prosecution
- Clearly record the examiner's reasoning to facilitate evaluation of the scope and strength of a patent, which may help avoid or simplify litigation



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The Pilot Will Focus On:

Going beyond the current reasons for allowance by:

- Providing at least limited claim interpretation for all allowable independent claims
- Providing, in the allowance, a road map of all prior statements of allowability
- Improving examiner's recognition of when the record would benefit from additional clarifying remarks



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Providing Claim Interpretation

In this pilot, examiners will provide a limited claim interpretation of the independent claims upon allowance.

Such claim interpretation should include:

- Terms having a meaning that was discussed during prosecution
- Terms not given their plain meaning
 - *E.g.*, terms defined in the specification or limited by an art-specific meaning that is not readily apparent.
- Terms or limitations subject to ambiguity, including:
 - Optional language
 - Functional language
 - Intended use or result (preamble and body of claim)
 - Non-functional descriptive material
 - “Means-plus-function” (35 U.S.C. 112(f))
 - Computer-implemented functions that invoke 35 U.S.C. 112(f) (“specialized” or “non-specialized”)
 - Method limitations in article claims
 - Article limitations in method claims



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Providing Claim Interpretation

In this pilot, examiners will provide a limited claim interpretation of the independent claims upon allowance.

- If terms were previously construed, examiner need only identify the document and location of the earlier interpretation
- Claim interpretation should be used to record the examiner's understanding of claim terms as applied during prosecution
- Claim interpretation should not be used to place unwarranted interpretations, whether broad or narrow, on the claims



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Providing a Road Map

Summarizing the record of allowable features:

- Provide a road map in the Notice of Allowability
- Every independent claim must be represented
- For each independent claim, a pinpoint reference to a prior action/response, or an explicit statement of reasons for allowability will be provided



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Providing a Road Map

Example

The reasons for allowance of the claims is clear from the written record of prosecution.

Attention is specifically drawn to the amendment and arguments filed by the applicant on September 29, 2013. See page 3, paragraph 2 of the amendment.



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Providing a Road Map

What to avoid:

- Copying entire claims is not helpful- the record already sets forth the entire claim
- Overly general statements lead to uncertainty as to what was persuasive
- Overly specific statements may conflict with the prosecution history
 - Goal is to reflect the decisions and the facts relied upon by the examiner
- The reasons for allowance should reflect the prosecution history and should not be a substitute for narrowing amendments



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Recognizing When the Record Requires Additional Clarification

Examples:

- Response to Office Action includes an amendment, remarks, and a 1.132 affidavit alleging unexpected results. Clarification would be needed if, for example, the affidavit was persuasive but the amendment merely added a field-of-use limitation to the claims and the remarks were not persuasive.
- Response amends to include the term “continuously” to the claims. Clarification would be needed if, for example, the new limitation inherently required the claim to have a feedback loop, which was neither anticipated by, nor obvious over, the originally applied rejection. Even if a rejection was later made on different art, the reasons for allowance should explain why the original rejection was overcome.



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Recognizing When the Record Requires Additional Clarification

- Does the record reflect why each rejection was overcome?
 - More than one traversal argument – which was persuasive?
 - Applicant both amends and argues – which was persuasive?
 - Allowable for a reason not in the traversal (found by examiner)?
 - What is the crucial distinction from the prior art, and why does that patentably define over the prior art?
- Were reasons provided where claims were previously allowed in an action?
 - Have later amendments altered such reasons?
- Were claims allowed due to an interview, appeal conference, court decision, or otherwise outside recordation in an Office action?



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See MPEP 1302.14(II) for a comprehensive list.



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Questions

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