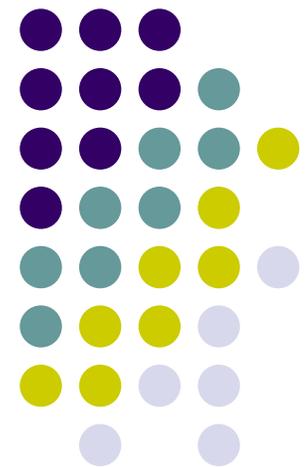


# Best Practices in Compact Prosecution



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Awareness Workshop



## Overview



- Principles of Compact Prosecution
- How Can You Help?
  - Search and Claim Interpretation
  - Clear and Concise First Action on the Merits
  - Treating Applicant's Reply
  - Help Facilitate Prompt Disposal

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## Why Are We Here?



- Why is Compact Prosecution so important?
  - Will facilitate first action issue, abandonment after first action, or a substantive amendment in order to avoid reopening of prosecution
  - Reduces actions/disposal
    - Examiner gets:
      - More efficient update searching after the First Action on the Merits
      - Higher production for the same amount of work (potential bonus money)
      - Demonstrated indicia for Commendable/Outstanding performance rating
    - USPTO gets:
      - Improved overall application pendency
      - Ability to complete its mission and continue operations at current staffing levels
      - Timely examination which will spur innovation
    - Applicant gets:
      - Better ability to make an educated business decision whether to continue prosecution
      - Faster resolution of issues leading to either allowance or abandonment

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## Definition of Compact Prosecution



Compact Prosecution is:

- Conducting an initial search which is as complete as possible;
- Citing pertinent art on the record in keeping with the scope of the claims as well as significant aspects of the disclosed invention;
- Issuing a complete first Office action which clearly explains the examiner's position on each essential issue; and
- Identifying allowable subject matter in an effort to expedite prosecution.

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## Principles of Compact Prosecution



- Examiner should always search the claimed subject matter and the **INVENTION** (i.e. disclosed subject matter which is likely to be claimed)\*
- Examiner makes all suitable rejections, objections and indications or suggestions of allowable subject matter appropriate for Applicant to bring in on amendment
- Applicants and **EXAMINERS** should request interviews to advance prosecution
  - A telephone interview coupled with an Examiner's Amendment is a preferred practice for placing the application in condition for allowance

\* See MPEP 904.03

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## Principles of Compact Prosecution (cont'd)



- Examiner need only update the prior search in most instances and not “re-search” the application
- A proper second action should, in most instances, close prosecution. For example, the examiner may:
  - Allow the application;
  - Write a final rejection\* treating applicant’s arguments on the merits; or
  - Issue an Ex Parte Quayle\* when only formal issues remain.  
\* The examiner should always attempt to advance prosecution and resolve remaining issues through a telephone interview
- **Examiners should always try to facilitate allowance where appropriate!**

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## How Can You Help?



- Proper Claim Interpretation
- Thorough Search of Invention
- Clear and Concise First Action on the Merits
- Complete Response to Applicant’s Reply (clearly document position)
- Expedite Prosecution (facilitate prompt disposal)

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## Search and Claim Interpretation

MPEP § 904



- Ensure a clear understanding of the claim scope and cite the most pertinent art at the time of the First Action on the Merits
- A thorough initial search forms a solid foundation that will:
  - Improve overall efficiency of prosecution; and
  - Minimize the time necessary to reach disposal in the application; and
  - Facilitate identification of allowable subject matter.

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## Search and Claim Interpretation



- Tips for effective searching:
  - Understand the inventive concept
  - Determine the “Broadest Reasonable Interpretation” of claim scope taking into account any special definitions
- Review all evidence in file
  - Develop search strategy and outline field of search
  - Identify need to consult with other technology experts
- Search both the Broadest Reasonable Interpretation of **ALL** claims, and search what it appears Applicant intended the inventive concept to be based on the disclosure

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## Tips for Claim Analysis



- Determine the relationship between the Claimed Invention and the Invention as Disclosed—Factors to consider:
  - Which claims, if any, specifically include the concept of the invention as disclosed?
    - At what level of detail do each of these claims reflect the concept?
  - What does the broadest independent claim in each chain of claims cover?
  - What does the narrowest dependent claim in each chain of claims cover?
  - What is the problem being solved?
  - How does applicant solve the problem?

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## Developing a Search Strategy



- The field of search should cover both the invention as described and claimed and the inventive concepts discussed in the specification reasonably expected to be brought into the claim amendment
- Outline your proposed Field of Search
  - Take notes about what inventive concepts you will be searching for
  - Identify any need for search consultations
    - Any time you search an art area outside your normal field of search, it is best to consult with an experienced examiner in that art and document the consultation in your Search Notes
    - Include proposed areas for conducting non-patent literature (NPL) searches
  - Search Strategy help is available to assist you with difficult cases
  - Identify relevant subclasses and keywords
  - Use class definitions to identify related subclasses

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## Clarity



- Clarity means fully conveying the positions taken
  - Applicant must be able to fully understand your position through your office action to know why you've taken a particular position
  - Arguments can often be avoided through just a few extra words of explanation in the initial action
  - In instances where the examiner is aware of a particular amendment that would clearly resolve an issue, **SUGGEST IT!** (Examiners without appropriate signatory authority should always verify the suggestion with whomever is signing the Office action)
- The positions are Official “USPTO” positions
  - All positions taken **MUST** conform to current Office policy

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## Ways to Improve Clarity



- Concisely present positions taken while providing substantive explanation
  - Make sure all claim limitations are addressed
  - Avoid using “similar in scope” or other boilerplate rationale
  - Include an explanation of your interpretation of broad claim language, to clarify why the feature or element being claimed is taught by the reference
    - if you think something is equivalent, explain **why** in the Office action
  - Avoid merely listing claim limitations and pointing to a large block of text in the reference
    - Point to drawing figures and reference numerals for structural elements and specific text for functional limitations

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## “Cleaning Up” your Actions

### Making reasonable §§101, 102, 103, 112 rejections



- Ensure every claim in the case is properly treated on the merits
  - Draw a claim tree/diagram when necessary
- Consult with experts (i.e., SPE, QAS, etc.) if you are unsure whether your position is consistent with Office policy
- Ensure the date of the reference actually qualifies it as prior art
- Ensure a rejection under §102 is proper
  - Anticipation under §102 requires that the reference must teach every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present
- Ensure a rejection under §103 is proper
  - if not from the reference(s) itself, ensure a reasonable position is made in the Office action as to why it is within the level of ordinary skill in the pertinent art
  - if the question, “why the claimed invention would have been obvious?” has not been answered by what’s written, the rejection is likely incorrect
  - be cautious of further modifying a modifying reference
- Provide suggestions to overcome the rejection whenever practicable

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## “Cleaning Up” your Actions

### Proof-Reading



- Check, then re-check your Office action
  - Ensure it actually says what it was intended to say
  - Ensure all claims have been addressed in a reasonable manner and that all rejections or objections are made
  - Compare statements of rejections against the claim tree
- Avoid a 2<sup>nd</sup> action non-final rejection by catching mistakes yourself
  - It will save you time and effort later
- Check claims for allowable subject matter, including Reasons for Allowance where appropriate

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## Ways to Avoid a 2<sup>nd</sup> Action Non-Final



- Not an exhaustive list, but common items for consideration are:
  - Is Restriction Proper? (MPEP 803)
    - Attempt election via telephone?
  - Informalities in the Claims
    - Typographical errors
    - Claim dependency problems
    - Claimed subject matter not shown in the drawings
    - Claim terminology not present in, or inconsistent with, the terminology in the specification

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## Ways to Avoid a 2<sup>nd</sup> Action Non-Final



- Ensure Claims are Fully Disclosed in Prior Application
  - Don’t assume a CIP or an application claiming benefit of a Provisional application is entitled to the benefit of the prior application. Check the parent document when an intervening reference is discovered and would be the best (or only) rejection
- Double Patenting Rejections
  - **ALWAYS, ALWAYS, ALWAYS** conduct an inventor name search to avoid missing a double patenting rejection
- Foreign Priority Claimed
  - If priority papers are not in the English language and there is no corresponding translation, an intervening reference may apply as prior art

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## Ways to Ensure Completeness



- Make only reasonable rejections (MPEP 706.02)
  - Prior art rejections should ordinarily be confined strictly to the best available art
  - Merely cumulative rejections should be avoided
- If aware of changes that would clearly place the application in condition for allowance, **INITIATE A TELEPHONE INTERVIEW (requires Negotiation Authority)**

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## Treating Applicant's Arguments MPEP § 707.07



- Why worry about a proper reply?
  - Prosecution history
    - A written record of interaction between applicant and USPTO
  - Used to help determine validity and scope of the patent in case of litigation
  - Clarity ensures a timely resolution of issues in order to reach disposal

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## Initial Screening of the Reply



- Initial screening can be a very important examining tool. When a reply first comes back to you take a few minutes to check:
  - Is it fully responsive to your previous action?
  - Is the case clearly in condition for allowance (i.e., all rejected claims were canceled or amended to include subject matter previously indicated as allowable)?
  - Is it an election that elects an invention outside your docket? If so, transfer it. **No one likes receiving a transferred case the bi-week it is due.**

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## How should the examiner then proceed after initial screening?



- As you consider applicant's reply:
  - In writing your Office action, you must answer or address every argument presented by applicant. (See **MPEP 707.07(f)**)
  - Do not confuse "arguments" with "evidence." Unsubstantiated allegations are **not** factual evidence and carry less weight than affidavits, declarations or other factually based documents and are generally not persuasive.
  - Applicant must provide convincing arguments and/or evidence relevant to the claimed invention to overcome the rejection.
    - Arguments more specific than the actual claim language should not be persuasive
    - Partial quotes from case law alone should not be persuasive. Often times, partial quotes may be taken out of context.

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## Final or non-final?

MPEP 706.07(a)



- In treating applicant's arguments you may:
  - Maintain your original ground of rejection (using the same art previously applied) and make the rejection final, responding to each point;
  - Make a new ground of rejection. Final rejection is only appropriate if the new ground of rejection:
    - Is necessitated by applicant's amendment; or
    - Is based on information (e.g., a reference) included in an IDS filed by applicant after your prior Office action and before Final or Allowance, and the IDS was filed with the IDS fee rather than a statement under 37 CFR §1.97(e) (see 37 CFR §1.97(c))

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## Final or non-final? (cont.)



- What is meant by *new ground of rejection*?
  - Maintaining a prior rejection, but restating, clarifying or further supporting the rationale in that rejection is normally **not** a *new ground of rejection*.
  - A rejection based on a **different interpretation of a reference**, an embodiment not previously used in a reference, or on a new reference or on a different or additional statute normally **is** a *new ground of rejection*.

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## Allowance?



- Also, when considering applicant's reply, look for potential allowable subject matter
  - Ensure application meets all remaining formal and substantive (i.e., statutory) requirements
  - Would initiating a telephone interview facilitate an allowance?

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## Responding to Arguments



- **Avoid using** "stock" homemade paragraphs or form paragraphs 7.37.01-7.37.13 without further explanation
- Address ALL arguments raised regardless of your opinion of the argument
  - In many instances, like-arguments can be grouped together in your response
  - Devote most of your response to any arguments which were substantiated with facts rather than just allegations and opinions
- Avoid Piecemeal Examination (MPEP 707.07(g))

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## 3<sup>rd</sup> or Subsequent Actions

MPEP 707.02



- Supervisory Patent Examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.
- How can you help your SPE?
  - By informing your supervisor whenever an action is going to be a 3<sup>rd</sup> or subsequent action on the merits
  - By making every effort to resolve remaining issues or simplify issues for appeal
  - By using telephone interview practice when appropriate (requires negotiation authority) to minimize the issues in, or obviate in total, the 3<sup>rd</sup> or subsequent action

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## Help Facilitate Prompt Disposal



- Make art of record at the time of the First Action which meets both the concept and the wording of the claims as well as other art which is pertinent to significant though unclaimed features of the disclosed invention
- When certain of how to overcome a rejection, make the suggestion
  - If the suggestion would clearly place the application in condition for allowance, initiate a telephone interview

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## Help Facilitate Prompt Disposal



- Grant reasonable interview requests (MPEP 713.01)
- Focus on moving the application towards final disposition in the form of allowance or abandonment
- Don't hesitate to get a second opinion from your SPE, QAS, peers, etc. if you are unsure
- Do not automatically refuse entry of after final amendments.

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## Conclusion



By reviewing how you

- interpret the claims and search;
- write clear and concise first Office action on the merits;
- treat applicant's reply; and
- expedite prosecution through responsible docket management,

you will

- save yourself valuable time by minimizing your searching after the first action on the merits;
- improve efficiency and productivity with same level of effort; and
- further promote innovation.

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