

2009 AIPLA Annual Meeting
IP Practice in Japan Committee
October 14, 2009

U.S. Patent Prosecution:

Attorney's Perspective – Richard Beem
Examiner's Perspective – Stephen Wentsler

I. Challenges for the Attorney

- Poorly reasoned first Office actions
- Final rejections on new grounds
- RCEs
- Appeals
- Expense and delay

Example: Fastener for spacing object from substrate

Application #: 10/658,251 (U.S. Pat. 6,918,222)

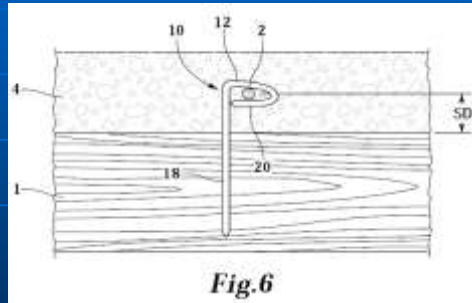


Fig. 6

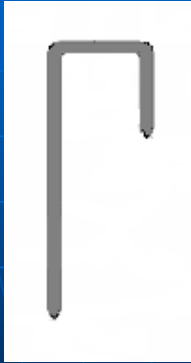
Example: Fastener for spacing object from substrate

Application #: 10/658,251 (U.S. Pat. 6,918,222)

CLAIM 1 [as filed]. A fastener for holding and spacing an object at a predetermined distance from a substrate comprising:
a bridge portion;
a first prong extending in a driving direction from said bridge portion; and
a second prong spaced from said first prong and extending generally parallel thereto in the driving direction from said bridge portion;
wherein said second prong is substantially shorter than said first prong.



“Front Loading” – draft specification with prosecution in mind



Fastener for spacing object from substrate

Application #10/658,251 (U.S. Pat. 6,918,222)

... a fastener 10 is shown for spacing an object, such as wire lath 2, at a predetermined distance from a substrate 1... In one embodiment, the length SL of short prong 20 is between about 75% and about 99% of the length BL of bridge portion 12 and **the length SL of short prong 20 is between about 25% and about 45% of the length LL of long prong 18.**

(Disclose claimable ranges)

II. What Are Examiners Thinking?

- Productivity
- Flow of Applications
- Quality

Productivity

- Productivity –
 - Quantity not quality
- Examiner's goal – as high as possible
 - Monetary awards if exceed expected production (up to 9% of salary)
 - Termination if Examiner does not maintain 95% of expected production

Productivity based on “Counts”

- Every application has two “counts”
 - First count at the beginning
 - The first Office action
 - Second count at the end
 - Abandonment (best)
 - Allowance
 - Examiner's answer
- Nothing else counts

Further “Count” considerations

- Two counts for a first action allowance
- RCE potential three counts
 - Note: In the U.S., a final rejection often means “not yet”, not “no”
- Continuing applications receive two additional counts
(Continuation, Divisional, Continuation-In-Part)

Flow of Applications

- USPTO objective – Maintain the flow of activities that do not “count”
- Examiner’s view –
 - Count obstacle
 - Relatively insignificant reward or penalty

Flow of New Applications

- Special New Applications
(RCE, Continuation, Divisional, Special Status)
- Regular New Applications
- Complete oldest every month

Flow of Amendments

- Special Amendments
(Amendments after final, Special Status)
 - Complete within the earlier of 10 days from examiner receiving or 30 days from applicant mailing
- Regular Amendments and Appeal Briefs
 - Complete within two months

Quality

- Quality = proper allowance
- No penalty for:
 - low quality before allowance
 - being reversed by the Board of Appeals

Understanding the Examiner

- Picking the next application to examine
- Considering an election/restriction
 - Reduce the number of claims?
 - Potential divisional applications?
 - Need to move for flow reasons?
 - Avoid if likely allowable generic claim

Understanding the Examiner

- The first Office action
 - Search strategy
 - Rejection

Understanding the Examiner

- Interview considerations
 - Attorney prepared?
 - Interview approach?
 - Who's making the decision?

Understanding the Examiner

- Response to common arguments
 - Teaching away, lacking claim elements
 - Possibly the most persuasive
 - Hindsight, motivation to combine
 - Secondary considerations

Understanding the Examiner

- Amendment after final
 - RCE likely?
 - Need the “count” now?
 - Time considerations
 - Supervisor involved?
 - Examiner’s amendment necessary?

Understanding the Examiner

- Appeal Brief or Request for a Pre-Appeal Brief Conference Review
 - The dreaded panel review
 - Consider reopening prosecution

III. The Attorney's Opportunity

Moving cases to allowance while working within the Examiner's framework:

- Written response to 1st Office action
- Interviews
- Rule 132 declarations
 - Response to "obviousness" rejections
 - Commercial success, etc.
- Cultural differences: In US, rejection doesn't mean "no" but "not yet"

After Final & RCE

- Written response after final
 - Might still obtain allowance
 - Avoid quick final rejection in RCE
- Request for Continued Examination (RCE)
 - When claims need amendment to distinguish over prior art

Appeals

- Appeal when claims should be allowed as written
- Request pre-appeal conference
 - Examiner may withdraw case from appeal
 - Examiner may reopen prosecution with new rejection
 - Applicant might as well find out before writing appeal brief
- If applicant files appeal brief, Examiner still may withdraw case from appeal and reopen prosecution
- Pursue appeal to decision if necessary
- Appeal to Federal Circuit if case warrants it

Success: Allowed and Issued Claim

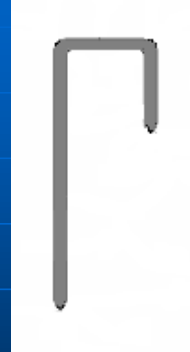
Title: **Fastener for spacing object from substrate**

ITW Inventor: Lat; Geronimo E., et al.

Patent #: 6,918,222

Issued: July 19, 2005

CLAIM 1 [as allowed and issued]. A reinforcement system for fastening to a substrate comprising: wire lath and a plurality of fasteners; wherein each of said fasteners comprises: a bridge portion having a length; a first prong having a length extending in a driving direction from said bridge portion to a distal end for driving into said substrate; and a second prong spaced from said first prong; **wherein said second prong has a length of between about 25% and about 45% of the length of said first prong** and wherein said second prong is bent so as to be generally perpendicular to the first prong and generally parallel to the bridge portion to hold said wire lath between said second prong and said bridge portion at a location wherein the wire lath and second prong are spaced a predetermined distance from said substrate.



Summary

- Prepare (“front load”) application with prosecution in mind
- At every stage, take steps to advance prosecution and obtain allowance
- Keep the Examiner’s interests in mind
- Don’t hesitate to appeal

Questions?

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Thank you!

Richard Beem & Stephen Wentsler