CIVILITY AND BEST PRACTICES IN PROSECUTION INTERACTIONS

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Practitioners and Examiners

• Our objectives are the same
  – Quality work on both sides
  – Consideration of the closest prior art
  – Issuance of high quality patents
  – No extra work
Best Practice

• Treat each other as you would wish to be treated
• Still best approach
• Maintain professionalism
• Do not make it personal
• Try to see viewpoint of other
• Keep language positive
• Return phone calls
• Assume each party knows what he is doing
Challenges For Examiners

- Limited time/ production goals
- Endless sources of prior art
- Difficulty of balancing quality and quantity
- Pressure of coordinating all work
Challenges For Examiners

• Examination in a fishbowl of public comment
• Repercussions of poor quality or low volume
  – Office does want everyone to succeed
  – Generally a mistake is overlooked
• Keeping up with changes in the law and practice
Challenges for Practitioners

- Obligation to abide by rules and regulations
- Must zealously represent client
- Client satisfaction
  - Meeting expectations
  - Availability
- ACCOUNTABILITY for mistakes
  - Fear of malpractice
  - Fear of inequitable conduct
  - Fear of missing something
- Billable hours = production
Examiner

• Do complete search of claims and ideally invention
• If restrictable, do reasonable groups, no intra-claim
• Provide a complete first action which presents all art and other issues
• Give concise, thorough explanation of positions
• Remain open to discussions without hostility or defensiveness
• Consider small changes after final
• Adopt a cooperative, helpful attitude
Practitioner

• Provide reasonable claim scope
• Identify support for amendment changes
• Understand the nuances of the rejections vs the scope of the claims
• Remain open to productive discussion without anger or bullying
• Work to resolve issues
  – However, any changes are up to the client
Prosecution- Examiner

- Establish *prima facie* rejections
  - Identify sections of references being relied upon
- Review total record based on response
  - Reconsider position based on new record
  - Fully consider submitted evidence (declarations) and provide comment
  - Dropping a rejection is not an admission that the rejection was wrong
    - New facts dictate a change in position
  - Address arguments in response
Prosecution – Practitioner

• Assume Examiner’s rejection has basis and the Examiner understands the concepts
• Really read rejections and look for clues for why the rejection is being advanced
  – Apparatus or product must be on structure and composition limitations, not intended use
• Relook at claim scope to figure out how Examiner is interpreting the claim
• Do not argue references separately, look to why and how combination was made
Interviews

• Keep an open mind
• Don’t adopt rigid view- other side often has a valid point
• Listen carefully – often nuances are key
  – Focus on points made by other
• Actively work to identify solution or middle ground
• Almost all applications have something allowable-scope is the issue
Success

• Our success depends on each other
  – By cooperatively and genuinely working together, we achieve:
    ▶ Less work for all of us
    ▶ Increase in personal and professional job satisfaction
    ▶ Better quality patents
    ▶ A better functioning patent system
    ▶ Fast and appropriate coverage for inventions

• Our patent system and country depend on us