



Wilson Sonsini Goodrich & Rosati
PROFESSIONAL CORPORATION

CIVILITY AND BEST PRACTICES IN PROSECUTION INTERACTIONS

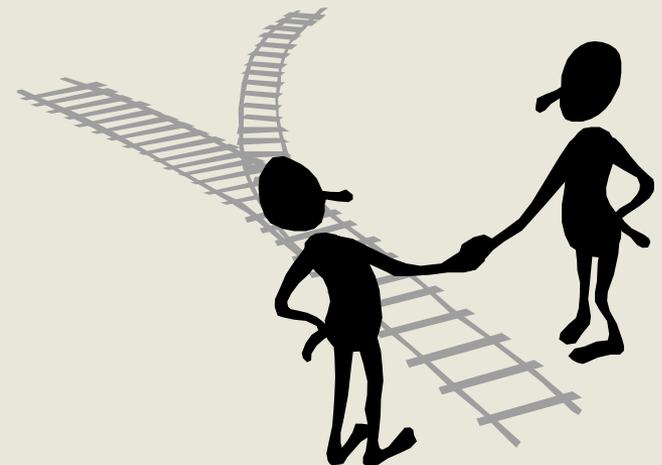
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Practitioners and Examiners

- 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

