

**Applicant's Reply:**  
***A TC1600 WORKSHOP***

**A Workshop to Help Us  
Better Respond  
to Applicant's Reply  
after FAOM**



# Overview of Workshop

- Purpose
- Refresher Training excerpts from Applicant's Reply lecture
- BREAK OUT SESSION
- Report out from Session
- Wrap Up with FAQs related to Applicant's Reply

# Purpose of Workshop



- Recent trainings (e.g. compact prosecution, interview training) has focused on high quality first actions
- Building on that concept, this training was developed to emphasize the careful consideration of Applicant's reply
- **RE-WEIGH ALL EVIDENCE** before moving forward with prosecution
- Look for allowable subject matter

# Mission of USPTO

To foster innovation and competitiveness by:  
**Providing high quality and timely examination of patent and trademark applications**, guiding domestic and international intellectual property policy, and delivering intellectual property information and education worldwide.

From the 2007-2012 Strategic Plan, emphasis added

# Purpose of Workshop

“The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. The examiner then reviews **all the evidence**, including arguments and evidence responsive to any rejection, before issuing the next Office action.

...

Although this part of the Manual explains the procedure in rejecting claims, **the examiner should never overlook the importance of his or her role in allowing claims** which properly define the invention.”

From *MPEP 706*, emphasis added



# Applicant Does Not Have to Amend Claims

However, if applicant's reply *does* include amendments to the claims, the applicant must address how the amended claims are patentable over the prior art references and overcome any objections made in the previous Office action.

See *37 CFR §1.111(c)*

# Reply May Include Other Amendments

- Amendments to the Specification

See *37 CFR §1.121(b)*

- Deletion, replacement, or addition of a paragraph
- Replacement of entire specification sections
- Substitute specification

- Amendments to Drawings

See *37 CFR §1.121(d)*

- by “Replacement Sheet(s)” or “New Sheet(s)”

# Possible Replies by Applicant

To attempt to overcome certain art-based rejections, Applicant might:

- Request Reconsideration
- Amend the Claims
- Address Effective Dates via
  - Perfect domestic benefit (35 USC §§ 119(e) or 120)
  - Perfect foreign priority (35 USC §§ 119(a)-(d))
  - Swear behind date ((37 CFR §1.131 affidavit or declaration) (for rejections under 102(a) and (e) only)
  - File a proper 37 CFR §1.132 affidavit or declaration showing reference is not “by another” (for rejections under 102 (a) and (e) only)

See MPEP 2131 for a discussion of ways to overcome 102(a), (b), and (e) prior art.



## Possible Replies by Applicant (*cont.*)

In addition, with regard to **35 USC § 103 Rejections**, Applicant may be able to:

- Provide Additional Evidence (e.g. *37 CFR §1.132* affidavit or declaration)
- Establish Common Ownership (*35 USC §103(c)*)

See *MPEP 706.02(b)-(l)*

# Issues to be Considered in Applicant's Arguments

## I. Submission of Evidence

- a) Attorney's arguments are not evidence unless it is an admission, such as an admission of prior art
- b) arguments cannot take the place of evidence
- c) arguments can be backed up by evidence found within an affidavit or the originally-filed disclosure, or other relevant evidence, e.g., dictionary, treatises, journal articles.

# Issues to be Considered in Applicant's Arguments, cont.

Evidence drawn to secondary considerations of unexpected results

a) Commensurate in scope  $\neq$  data over entire scope

“Evidence of the unobviousness of a broad range can be proven by a narrower range when one skilled in the art could ascertain a trend that would allow him to reasonably extend the probative value thereof.”

See MPEP 2145 discussing *In re Clemens* (CCPA 1980)

b) Unexpected results, when demonstrated, are added to the body of evidence concerning obviousness and **all is re-weighed** to determine nonobviousness

See *MPEP 716.02* and *MPEP 2145*

# Issues to be Considered in Applicant's Arguments, cont.

## II. Arguing Additional Advantages or Latent Properties

- a) structure of the invention is met by the references
- b) arguments only directed to advantages or properties that were not previously known or suggested by the prior art

# Issues to be Considered in Applicant's Arguments, cont.

## III. Arguing Improper Rationale for Combining References

### a) Impermissible Hindsight:

- i. combination should not be based on knowledge gleaned only from applicant's disclosure
- ii. express motivation in the references is not necessary to combine the references.
- iii. a reason to combine could come from the nature of the problem to be solved or knowledge of one of ordinary skill

b) Obvious-to-try rationale (See *KSR*): choosing from a finite number of predictable solutions with a reasonable expectation of success

# Issues to be Considered in Applicant's Arguments, cont.

## III. Arguing Improper Rationale for Combining References, cont.

### c) Lack of suggestion to combine references:

Federal Circuit decisions support that not all combinations must have some rationale found within the four corners of a reference itself to combine, but a rationale must be provided

# Issues to be Considered in Applicant's Arguments, cont.

d. References teach away from the invention:

- i. prior art criticizes, discredits or otherwise discourages the combination of the references
- ii. one or more reference(s) expressly exclude(s) combining of the references
- iii. secondary reference destroys the functionality of the primary reference

e. Arguing that prior art devices are not physically combinable

- i. secondary references do not need to be “bodily incorporated” into the primary reference
- ii. would the combined teachings of the references direct one of ordinary skill in the art to have made the combination?

# Issues to be Considered in Applicant's Arguments, cont.

## IV. Arguing Against References Individually

- a) If the rejection is based on a combination of references, applicant cannot attack the references individually for what they do not teach

## V. Arguing About the Number of References

- a) Relying on a large number of references does not make the claim unobvious
- b) Court affirmed a 13 reference combination  
(*In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991))



# Issues to be Considered in Applicant's Arguments, cont.

## VI. Arguing Limitations Which are Not Claimed

- a) arguments to 35 USC §§ 102 or 103 rejections
- b) limitations that are argued are not found in the claims
- c) special definitions, lexicographer, or 35 USC §112(6) invoked

# Issues to be Considered in Applicant's Arguments, cont.

## VII. Arguing Economic Infeasibility

- a) arguing that the combination should not be made for economic reasons, such as being too costly

## VIII. Arguing About the Age of the Reference

- a) merely arguing the age of the references is not persuasive for unobviousness
- b) arguing that one of the references is too old to combine with another is not persuasive

# Issues to be Considered in Applicant's Arguments, cont.

## IX. Arguing that Prior Art is Non-analogous

Test for analogous art:

- i. the reference is in the field of applicant's endeavor

See: *MPEP 2141.01(a)*

### **or, if not**

- ii. the reference is reasonably pertinent to the particular problem with which the inventor was concerned

# Next Action

A) Re-evaluate rejections of record:

**weigh all evidence of record anew**

B) Proceed with prosecution:

1. Identify allowable subject matter
2. Withdraw rejections (consider new rejections)
3. Maintain rejections
  - Respond to all points in Applicant's reply
  - Make suggestions for how to overcome if possible

# Next Action, cont.

## Reminders:

Each and every substantive argument/point of discussion must be addressed by the Examiner (whether the Examiner AGREES or NOT)

- Individually addressing applicant's arguments (recommended)
- Combining more than one argument into one rebuttal
  - OK – but be clear what you are addressing

See: *MPEP 707.07(f)*

- Must address all “points” set forth in an timely-filed Affidavit or Declaration
  - This is in addition to all arguments which may have been presented in an amendment submitted simultaneously
- Cannot simply dismiss a timely-filed Affidavit or Declaration as being “non-persuasive” (See: *MPEP 716 and 716.01(a)-(d)*)
  - Must point out deficiencies

# Telephone Practice

- Telephone practice should be used whenever appropriate to save time and reduce the number of formal actions in any one application.
- Using telephone practice to obtain permission to make a proper *examiner's amendment* reduces the number of actions in an application.
- **Interviews (personal and telephone) must include an examiner who has negotiation authority, and who is familiar with the application.**

See *MPEP 408 & 713.01*

# Reasons for Allowance

If the Examiner believes that the record, as a whole, does not make clear his/her reasons for allowing a claim or claims, the Examiner should set forth such reasoning

- Examiner agrees with one or more of multiple arguments set forth by applicant
- Examiner does not agree with any of applicant's arguments, but has reasons of his/her own supporting allowability

See: *MPEP 1302.14*

# Introduction to Workshop

- Provided to you:
  - ✓ Instant application: specification, claims, BIB sheet
  - ✓ FAOM with references
  - ✓ Resource documents

- Break up into groups



- **YOU ARE APPLICANT'S REPRESENTATIVE**



# Instructions for Workshop



- You are Applicant's representative who has received this FAOM
- The application you filed, including the claims, is provided
- Resource materials that might be available to you as the attorney reviewing the FAOM are also provided
- You have reported to the Applicant and have received instructions to traverse the rejection(s) without amending the claims
- Prepare for an interview

# Break Out Session

- Consider the materials for the Examiner's workshop
- Discuss your perception of the training with each other and your facilitator
- Joining us virtually? Please email any comments to [kathleen.bragdon@uspto.gov](mailto:kathleen.bragdon@uspto.gov)

# Focus Session

**Question:**

**How can we work better together to identify allowable subject matter efficiently?**

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## Question:

**How can we work better together to identify allowable subject matter efficiently?**

- QIR Metrics in our Quality Composite
  - Actions per disposal
  - Disposals (not RCEs)
  - Finals not reopened
  - Total actions not 2<sup>nd</sup> action nonfinals
  - Total Restrictions not 2<sup>nd</sup> action

# Focus Session

## Question:

**How can we work better together to identify allowable subject matter efficiently?**

- Interviews (MPEP 713), including first action (FAI)  
[http://www.uspto.gov/patents/init\\_events/faipp\\_full.jsp](http://www.uspto.gov/patents/init_events/faipp_full.jsp)
- Preappeal requests  
[http://www.uspto.gov/faq/pre\\_appealbrief\\_conf\\_pilot.jsp](http://www.uspto.gov/faq/pre_appealbrief_conf_pilot.jsp)
- Ombudsman program  
<http://www.uspto.gov/patents/ombudsman.jsp>

# Conclusion

Thank you

Team Developing the Applicant's Reply Workshop  
for our Examiners

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