



# QUALITY AND BEST PRACTICES IN PROSECUTION INTERACTIONS

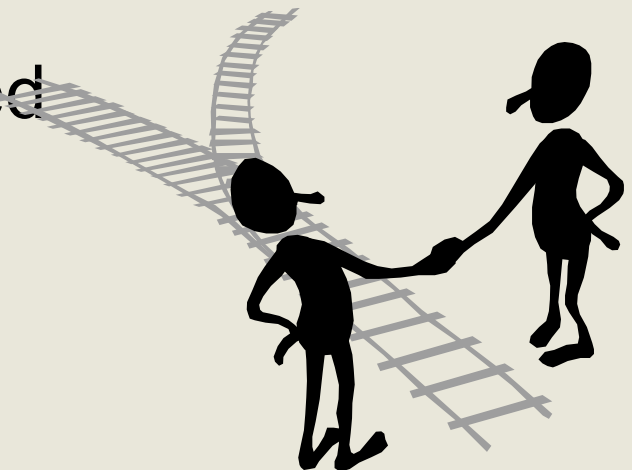
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## Practitioners and Examiners

- Our objectives are the same
  - Quality work on both sides
  - Consideration of the closest prior art
  - Issuance of high quality patents
  - No extra work
  - Broadest claims supported by specification



## Quality Patent

- Complete application of relevant references and laws to all claims
  - Search and /or IDSs identified best prior art
- Complete consideration of all arguments and declarations with explanations
- Proper scope of claims allowed- no new matter
  - Claims are neither too broad nor too narrow
- Claims that are enforceable
- Clear record- applicant arguments or interview record makes it clear why rejection was dropped

## Indicia of Quality Examination

- Complete search of claims and intent of invention
- Reasonable restrictions
- Complete first action presents all art and addresses any appropriate statutes
- Concise, thorough explanation of positions
- Openness to discussions with no hostility or defensiveness, and consideration by supervisor
- Consideration of small changes after final
- Displays a cooperative, helpful attitude

## Quality Application- Practitioner

- Clear description of invention in specification
- Reasonable scope of claims
- Identification of known closest prior art
- Language not chosen to obfuscate
- Specification drafted in anticipation of enablement and/or written description considerations

## 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- Examiner

- Consideration of legal arguments advanced
  - Don't cling to science and ignore legal doctrines
  - Examiners are legal adjudicators
- Complete search and citation of all relevant art to avoid new art in a final following amendments that claim what was clear from the application
- Consideration of some after-final amendments
- Not have pages of form paragraphs and very few sections or explanation
- Provide suggestions if possible



## 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, bullying or condescension
- Work to resolve issues
  - However, any changes are up to the client
- Use case law but also clear, cogent reasoning



## Prosecution – Practitioner

- Assume Examiner's rejection has basis and the Examiner understands the scientific 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

## Best Practices

- Treat each other as you would wish to be treated
- Maintain professionalism
- Do not make it personal
- Try to see viewpoint of other
- Keep language positive
- Assume each party knows what he is doing

Return phone calls



## 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 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



## 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

## Suggested New Initiatives

- Ability to participate in pre-appeal and/or appeal conference with 3 Examiners
- BRI training for examiners and practitioners
  - What is a “reasonable” interpretation?
  - Why claim may be interpreted differently- attorneys often don’t see the other options
- Mandatory supervisory conference after 2 RCEs
- More focus/training on Examiners as legal adjudicators

## 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

