QUALITY AND BEST PRACTICES IN PROSECUTION INTERACTIONS

Esther Kepplinger
Wilson Sonsini Goodrich & Rosati
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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 statues
• 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