AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
COMMITTEE ON RELATIONS WITH THE PTO
SUBCOMMITTEE ON QUALITY OF EXAMINATION

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Some Tips For Examiners On Ways To Improve Examination And Simplify The Prosecution Process

1. If You Make A Rejection Based On "Official Notice" or "Obvious Design Choice," Without Prior Art References, Make Sure You Can Back It Up.

Reference-less rejections add to the cost and length of the responsive Amendment, yet obtain essentially no advantage for the Examiner. Unless such a rejection is supported by a reference, it will be reversed on appeal.

If a rejection is based only on the Examiner's idea of what is well-known, then the rejected claim is clearly allowable over the art of record, since no prior art has been cited. References must be supplied to support a prior art rejection. In re Newell, 13 U.S.P.Q.2d 1248 (Fed. Cir. 1989); In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986); Ex Parte Cutler (B.P.A.I. 1991). The applicant is entitled to an allowance unless you supply the omitted prior art under M.P.E.P. 706.02(a), or an affidavit detailing your prior art information under 37 C.F.R. 1.107(b).

Thus, the PTO's own regulations discourage so-called "Official Notice" or "design choice" rejections. Without actual references or tangible evidence of the state of the art, neither

the applicant nor the Examiner can make a proper determination of the issues relevant to obviousness.

In other words, rejecting a claim without prior art support is merely an inefficient way to delay completing your search. You will be more efficient if you search for all the claimed features at once.

Often, dependent claims are dismissed as unpatentable on this "obvious design choice" basis. Such claims should instead be allowed, since a more specific claim limitation is much less likely to be a matter of choice.

In particular, remember that the subject matter of each dependent claim must be searched and considered separately from the independent claims from which it depends. M.P.E.P. 904, 904.02. The Examiner should also keep in mind his/her duty to indicate allowable subject matter. M.P.E.P. 707.07(j).

If you are reluctant to allow a claim, but must allow it because you have no art, you may want to consider writing an Examiner's Statement of Reasons for Allowance (to which the applicant may respond) such as "Claim 48 is allowed because no reference has been found that suggests a widget with a built-in thermometer as claimed." You will have done your duty to allow the claim in the absence of prior art. You also will have done you duty to protect the public from invalid patent claims. An accused infringer will understand why the claim was allowed, and

will be alerted as to the searching that must be done in order to attack the claim.

2. Verify That A Foreign-Language Reference Supports Your Rejection Before You Cite It.

Foreign-language art is, of course, a burden on the Patent Office. It does not follow that that burden should be shifted to the applicant. If the Patent Office cites a foreign reference, shouldn't the Patent Office figure out what the foreign art is, and what it means? 37 C.F.R. 1.107(a) requires that: "In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon must be identified." It follows that the PTO must know what a foreign reference says before citing it. If you can't read the foreign language, request a translation of the applicable portions from the Translations Division, and/or get the "patent family" and an abstract from Derwent or another data service. Then send that translation to the applicant.

3. New Examiners: Talk Over 112 Rejections With Your Supervisor.

New Examiners sometimes issue unnecessary 112 rejections because they are inexperienced as to what is acceptable claim language. Many claim terms are adequately

supported by inherency and do not need explicit antecedent support. For example, it is acceptable to claim "a solution, the temperature of said solution being under 70° C. . . ." It is not necessary to first recite that the solution has a temperature, because everything has a temperature. Similarly, every shaft has an axis and every impedance has a resistance component.

Remember, too, the caution in M.P.E.P. 706.03(d): "Under no circumstances should a claim be rejected merely because the Examiner prefers a different choice of wording."

And remember that claims are also to be interpreted in light of the disclosure. Before rejecting seemingly broad claim language, such as "wherein R is alkyl," be sure to check for a definition in the specification.

Likewise, new Examiners sometimes may find a disclosure inadequate or non-enabling because they personally do not understand part of it. Bear in mind that you may not have the "ordinary level of skill in the art." Claims are to be interpreted against the background of the prior art. Use your dictionaries, particularly if English is not your native language, or ask someone more experienced whether the disclosure would be understandable to an ordinarily skilled individual. At least tell the applicant what is not understandable.

4. A 103 Rejection Must Include A Justification For Modifying The Main Reference

M.P.E.P. 706.02 (paragraph bridging pages 700-8 and 700-9) requires an explanation in writing of why it would have been obvious to a skilled individual to modify the main reference or to combine it with other references. If that motivation is missing from the Office Action, the applicant's representative will notice. The result will surely be a reversal on appeal. See Quality Update, No. 89-1 (USPTO August 1989) for a full discussion.

5. Preparing A "Claim Tree" May Help You Issue More Effective Office Actions

When rejecting claims under Section 102 or Section 103 based on prior art, a "claim tree" diagramming all of the independent and dependent claims may be useful. The grounds for rejection of each claim are entered on the claim tree. The claim tree ensures that all the claims you intended to reject have been rejected, and that the rejections are internally consistent. For example, a claim tree will avoid the situation (which we see fairly often) where an independent claim is rejected over references A and B, while its dependent claim is rejected over A alone, or B alone. When an Office Action is mailed with this type of substantive error, you may be asked by the attorney to

issue a substitute Office Action and reset the period for response, which will create additional work for you.

6. Make Suggestions As To How To Correct Minor Informalities

Sometimes, when the Examiner objects to minor informalities in the disclosure or in the claim language, the applicant has trouble seeing exactly what the problem is. The applicant may think it is a much more serious matter than the Examiner intended. The result may be an unnecessarily long and involved Amendment. You will help the applicant, and probably simplify the next Amendment, if you suggest how the disclosure or claims should be corrected. Most of the time, the applicant will give you exactly the changes you have suggested. M.P.E.P. 706.03(d).

7. Please Be Precise In Rejections. Deal With Every Recitation Of A Claim Under Rejection, And Key The Rejection To the Exact Words Of The Claim

For example, a "predetermined offset value" in a reference does not anticipate a claim requirement for both a "predetermined value" and a "prescribed offset value." Likewise, when a claim that recites A, B, and C is rejected by ignoring B and applying a reference (or combination of references) showing only A and C, there will be wasteful round of action and amendment that will accomplish nothing. Actions that are unclear

in these respects are both unproductive for the Examiner in terms of disposals and costly for the applicants.

8. Final Action Must Be Responsive To Applicant's Arguments

A final Office Action should not be issued until the issues between the Examiner and the applicant are clearly defined. M.P.E.P. 706.07. Don't merely copy your arguments from the previous action and call it the "Final Action." Those arguments probably don't apply any more. Rather, specifically respond to all of the applicant's latest arguments, and point out their deficiencies.

Also keep in mind that a rejection cannot be made final if any new ground for rejection is applied, even if the art was previously of record, unless all claims rejected on that new ground for rejection were amended so as to require the new ground for rejection. M.P.E.P. 706.07(a).

9. Unity of Invention

Be aware of the difference between "restriction" and "election of species."

An "election of species" becomes moot if a generic claim is found allowable, and all the withdrawn claims must be allowed immediately.

"Restriction" requires substantial factual support, which Examiners sometimes omit. For example, a method-apparatus restriction requires a statement by the Examiner of another way the method can be practiced, or another possible use for the apparatus. Examiners sometimes make unrealistic and impractical arguments as to these alternatives. Such a restriction is easily traversable, unless the Examiner can support it by a reference. The burden is on the Examiner to provide reasonable examples that recite material differences between the inventions. M.P.E.P. 806.05(e). Remember, you may not have the level of skill necessary to propose realistic manufacturing processes in the relevant industry.

10. Be Sure To Initial The References On Each Form PTO-1449, Sign It, and Return A Copy To The Applicant's Attorney With The Notice Of Allowance, If Not Sooner.

The applicant must have the signed and initialled PTO-1449 form on file so the record will confirm that the applicant has fulfilled the duty of disclosure. If you do not return the PTO-1449, the applicant will have to telephone you after receiving the Notice of Allowance, and you will then have to get the file back from Allowed Files.

Returning the PTO-1449 with the first Office Action after you receive it, while the cited art is still fresh in your mind, will benefit both yourself and the applicant.

Please address all comments on this Interim Draft to the Chair of the Subcommittee on Quality of Examination:

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