An Examiner’s Perspective on Office Actions

Texas Regional Office (TXRO) – Advanced Patent Seminar
What is an Office Action?

• The Office Action is a Legal Record. MPEP § 707.07

• All business with the Patent and Trademark Office should be transacted in writing. 37 CFR §1.2

• The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. See 37 CFR §1.2
What sort of legal records, in writing (other than an allowance) might you get?

- Restriction
- First Office Action on the Merits (FAOM)
- Interview Summary
- Final Rejection
- Advisory Action (After Final)
Restriction Practice
35 U.S.C. § 101
“Whoever invents or discovers any new and useful process, machine, manufacture, composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,...”
35 U.S.C. § 121

“If two or more Independent and Distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.”
Examples of Independent Inventions

*In most technologies, it is rare to see independent inventions in an application.*

Or, “a process of painting a house” is an independent invention from “a process of boring a well”.

See MPEP 806.06
Examples of Distinct Inventions
Even though they are related, are they “distinct”? If yes, this is the most common basis for restriction

Restriction is proper between related inventions if they are “distinct”. An electrical cash register versus a mechanical cash register would be one example of related, yet distinct inventions.
Rejoinder – MPEP § 821.04

• Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected (withdrawn) invention on the merits.

• **Eligibility for rejoinder**, a claim to a nonelected invention
  – must depend from or otherwise require all the limitations of an allowable claim
  – In order to retain the right to rejoinder, applicant is advised that the withdrawn claims should be amended during prosecution to require the limitations of the elected invention. Failure to do so may result in a loss of the right to rejoinder.
First Office Action on the Merits (FAOM)
Suggested Office Action Format

1. Housekeeping
2. Restriction
3. Objections and formal matters
4. Non-prior art rejections and analysis of claims
5. Double Patenting
6. Prior art rejections
7. Discussion of allowable subject matter
8. Response to applicant's remarks
9. Discussion of prior art cited but not applied
10. Contact information and signature

NOTE: You do not need to include all items. If it doesn’t apply, do not include it.
1. Housekeeping

Acknowledge any communications from Applicant such as Amendments, IDS, etc.

- Note any missing papers
2. Restrictions

See *MPEP §800*

– Arises when applicant attempts to claim more than one invention in a single application

– Basically two categories of restrictable inventions
  • Genus and/or Species (*MPEP § 806.04*)
  • Related but Distinct (*MPEP § 806.05*)

– Restrictions are made at the discretion of the examiner
3. Objections and Formal Matters

- Objections to the Claims
- Improper dependency
- Inconsistent terminology
- Objections to the Application other than the Claims
- Specification
- Drawings
- Formal Matters
- Information Disclosure Statement (IDS) nonconformities
- Improper Domestic Benefit or Foreign Priority Claims
- Title and Abstract nonconformities
4. Claim Interpretation

• Document claim interpretation when appropriate
  – State the broadest reasonable interpretation in light of the specification if not apparent from the claim language and the applied prior art
  – Claim limitations being treated under 35 USC 112(f) should be identified in accordance with MPEP 2181 VI
5. Non-Prior Art Rejections Including Double Patenting

- Non-Statutory Double Patenting
- Rejections under 35 USC §101
  - § 101 Double Patenting
  - Inventorship (35 USC §§ 101 and 115)
  - Utility
  - Subject Matter Eligibility
- Rejections under 35 USC §112
  - 35 USC §112(a)
    - Written description
    - Enablement
  - 35 USC §112(b)
    - Failure to particularly and distinctly claim invention
  - 35 USC §112(d)
    - Failure of dependent claim to further limit claim from which it depends
6. Rejections Based on Prior Art

• 35 U.S.C. §102
  – Anticipatory type rejections
• 35 U.S.C. §103
  – Obviousness type rejections

For either type of rejection, a reference must qualify as prior art under 35 U.S.C. §§ 102(a)(1) or 102(a)(2) for AIA applications, or §§ 102(a)-(g) for pre-AIA applications.
Rejections Under 35 U.S.C. § 103
Graham v. John Deere Co.


Four Factual Inquiries:
- Determine the scope and content of the prior art
- Ascertain the differences between the prior art and the claims at issue
- Resolve the level of ordinary skill in the pertinent art
- Evaluate evidence of secondary considerations, such as commercial success, long felt but unsolved needs, or failure of others.
Forming a Basis for a Prior Art Obviousness Rejection: Factual Inquiries

The Graham v John Deere factual inquiries help outline the statement of facts in an obviousness rejection.

For example, in accordance with the 1\textsuperscript{st} factual inquiry, the examiner should set forth “the scope and content of the prior art.” Then, in accordance with the 2\textsuperscript{nd} factual inquiry, the examiner should identify “the differences between the prior art and the claims at issue.” Regarding the 3\textsuperscript{rd} factual inquiry, the applied prior art may itself reflect the appropriate “level of ordinary skill in the pertinent art.” See MPEP 2141.03. Regarding the 4\textsuperscript{th} factual inquiry, evidence of “secondary considerations” must, when present, be considered and addressed by the examiner.
Reasons for a Prior Art Obviousness Rejection
- Rationales Suggested by the KSR Decision

These are examples of some rationales that may be employed in determining whether a claimed invention would have been obvious:
A. Combining prior art elements according to known methods to yield predictable results.
B. Simple substitution of one known element for another to obtain predictable results.
C. Use of known technique to improve similar devices (methods or products) in the same way.
D. Applying a known technique to a known device (method or product) ready for improvement to yield predictable results.
E. “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success.
F. Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces/market place incentives if the variations are predictable to one of ordinary skill in the art.
G. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

7. Discussion of Allowable Subject Matter

• Claims considered allowable, as written, over the prior art of record can be discussed in this section
• You should include a statement or rationale regarding a designation of “allowable subject matter”
Interview Practice
Interviews – MPEP § 713

• Discussions between an applicant and an examiner are often indispensable to advance the prosecution of a patent application. Generally, interviews that improve the mutual understanding of specific issues in an application should be promoted. Properly conducted, an interview can bridge the gap between an examiner and an applicant with regard to the substantive matters at issue in an application. Interviews often help to advance prosecution and identify patentable subject matter.
Examiner Must Make the Substance of an Interview of Record – MPEP 713.04

- In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. 37 CFR 1.133(b)

- Communications submitted for discussion purposes only, “information necessary to protect the legal and financial rights ... of persons directly affected by the agency’s activities.” 44 U.S.C. 3101, 44 U.S.C. 3301, 37 CFR 1.133, 37 CFR 1.2, and MPEP 713.04.
Final Rejection
8. Responding to Applicant's Remarks

• All material traversed in Applicant’s remarks should be answered. *MPEP § 707.07*

• Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

• Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.
Responding to Applicant's Remarks (cont.)

• If the withdrawal of the previous rejection results in the allowance of the claims, the reasons, which form the basis for the withdrawal of the previous rejection, may be included in a reasons for allowance. *MPEP § 1302.14.*

• If applicant’s arguments are persuasive and the examiner determines that the previous rejections should be withdrawn but that, upon further consideration, a new ground of rejection should be made, form paragraph 7.38.02 may be used.
The reply by applicant must:

- Be signed by a person having authority to prosecute the application
- Be in writing and distinctly and specifically point out the supposed errors in the examiner’s action
- Reply to every ground of objection and rejection in the prior Office action
- Present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references
- Clearly point out the patentable novelty of amended claims in view of the state of the art disclosed by the references cited, or the objections made

See 37 CFR 1.111(b),(c), 1.33(b), and MPEP § 714.01(a) and § 714.02
The Reply Must Be Fully Responsive (cont.)

- For amendments not fully responsive, see MPEP § 714.03 for actions that can be taken by an examiner
  - However, if the claims as amended are clearly open to rejection on grounds of record, a final rejection should generally be made
- Claims should not be allowed if no attempt is made by applicant to point out their patentable novelty.

  See MPEP § 714.04
Finality

• A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 et seq. However, note that an examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection (MPEP 706.07(a))
Finality (cont.)

• Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). – MPEP 706.07(a)
After Final Practice and
After Final Consideration Pilot (AFCP) 2.0
Traditional After Final Practice – MPEP 714.12(b), (d)

• After ... an action closing prosecution ..., but before or on the same date of filing an appeal ...:
  – (1) An amendment canceling claims or complying with any requirement of form expressly set forth in a previous Office action may be admitted;
  – (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
  – (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

• An affidavit or other evidence submitted after a final rejection or other final action may or may not be admitted, according to MPEP 714.12.
After Final Consideration Pilot (AFCP) 2.0

- For amendments that change the scope of the claim, narrowing them further, Examiner is allowed three hours for consideration and write up (including interview time if deemed necessary)

Questions?

Hezron Williams  
Supervisory Patent Examiner  
(469)295-9208  
hezron.williams@uspto.gov

Jennifer Doak  
Primary Patent Examiner  
(571)272-9791  
jennifer.doak@uspto.gov

Thank you!