

## COMMENTS ON AND PRACTICAL SUGGESTIONS FOR IMPROVED AFTER FINAL PRACTICE BY MICHAEL E. KONDOUDIS

THIS POST CONCERNS “AFTER FINAL PRACTICE,” THAT IS, PRACTICE AFTER A FINAL OFFICE ACTION HAS BEEN ISSUED IN AN APPLICATION. A BRIEF SURVEY OF SOME BASICS OF AFTER FINAL PRACTICE FOLLOWS, ALONG WITH SOME SUGGESTIONS, SAMPLE PARAGRAPHS, AND PRACTICE TIPS FOR AFTER FINAL PRACTICE.

### PROSECUTION AFTER FINAL REJECTION IS RESTRICTED

THE MOST SIGNIFICANT ASPECT OF AFTER FINAL PRACTICE IS THAT IT IS RESTRICTED. ONCE A FINAL OFFICE ACTION HAS ISSUED, AN APPLICANT IS NO LONGER ENTITLED TO FURTHER UNRESTRICTED PROSECUTION ON THE MERITS, AS A MATTER OF RIGHT. THIS IS THE RESULT OF THE OFFICE’S POLICY OF COMPACT PROSECUTION, WHICH IS DISCUSSED HERE.

THE RESTRICTED NATURE OF AFTER FINAL PRACTICE HAS SOME NOT INSIGNIFICANT RAMIFICATIONS. FOR EXAMPLE, THE AMENDMENTS IN AN AMENDMENT AFTER FINAL ARE ACTUALLY PROPOSED CHANGES TO THAT APPLICATION, EXCEPT IN LIMITED CIRCUMSTANCES. AND, ENTRY OF THOSE PROPOSED CHANGES IS GENERALLY AT THE EXAMINER’S DISCRETION, WITH DIRECTION FROM PATENT OFFICE REGULATIONS AND GUIDANCE FROM THE MANUAL OF PATENT EXAMINING PROCEDURE (MPEP).

### THE REGULATIONS AND THE MPEP

THE REGULATIONS AND THE MPEP ESTABLISH A CONCEPTUAL HIERARCHY FOR THE ENTRY OF AFTER FINAL RESPONSES. SECTION 714.13 OF THE MPEP, ENTITLED “AMENDMENTS AND OTHER REPLIES AFTER FINAL REJECTION OR ACTION,” PROVIDES THAT

[E]XCEPT WHERE AN AMENDMENT MERELY CANCELS CLAIMS, ADOPTS EXAMINER SUGGESTIONS, REMOVES ISSUES FOR APPEAL, OR IN SOME OTHER WAY REQUIRES ONLY A CURSORY REVIEW BY THE EXAMINER, COMPLIANCE WITH THE REQUIREMENT OF A SHOWING UNDER 37 CFR §1.116(B)(3) IS EXPECTED IN ALL AMENDMENTS AFTER FINAL REJECTION.

AND, 37 CFR §1.116(B)(3) REQUIRES A SHOWING OF “GOOD AND SUFFICIENT REASONS” WHY THE AMENDMENT AFTER FINAL REJECTION IS (1) NECESSARY AND (2) WAS NOT EARLIER PRESENTED. IN THIS REGARD, THE MPEP INSTRUCTS THAT A “REFUSAL TO ENTER THE PROPOSED AMENDMENT SHOULD NOT BE ARBITRARY” AND THAT IT SHOULD BE GIVEN “SUFFICIENT

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CONSIDERATION TO DETERMINE WHETHER THE CLAIMS ARE IN CONDITION FOR ALLOWANCE AND/OR WHETHER THE ISSUES ON APPEAL ARE SIMPLIFIED.” MPEP 714.13(II).

PART (B) OF 37 CFR §1.116, ENTITLED “AMENDMENTS AND AFFIDAVITS OR OTHER EVIDENCE AFTER FINAL ACTION AND PRIOR TO APPEAL” PROVIDES THAT

(B) AFTER A FINAL REJECTION OR OTHER FINAL ACTION ... IN AN APPLICATION ... :

(1) AN AMENDMENT MAY BE MADE CANCELING CLAIMS OR COMPLYING WITH ANY REQUIREMENT OF FORM EXPRESSLY SET FORTH IN A PREVIOUS OFFICE ACTION;

(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.

UNFORTUNATELY, NEITHER THE MPEP NOR 37 CFR 1.116 PROVIDE ANY EXAMPLES, STANDARDS, OR OTHER GUIDANCE AS TO WHAT CONSTITUTES “GOOD AND SUFFICIENT REASONS.” AND, THIS IS A SIGNIFICANT STANDARD. INDEED, THE PATENT OFFICE’S OWN ELECTRONIC FILING SYSTEM (EFS-WEB) TUTORIAL WHOLLY IGNORES THE POSSIBILITY OF THE EXISTENCE OF “GOOD AND SUFFICIENT REASONS,” ADVISING THAT AN AMENDMENT AFTER FINAL “WILL NOT BE ENTERED IF IT REQUIRES AN ADDITIONAL SEARCH OR MORE THAN A CURSORY REVIEW.”

ADDITIONALLY, SECTION 714.13 (II) OF THE MPEP INSTRUCTS EXAMINERS TO ADVISE AN APPLICANT WHEN: (1) CERTAIN PORTIONS OF THE AMENDMENT WOULD BE ACCEPTABLE AS PLACING SOME OF THE CLAIMS IN BETTER FORM FOR APPEAL OR COMPLYING WITH OBJECTIONS OR REQUIREMENTS AS TO FORM, IF A SEPARATE PAPER WERE FILED CONTAINING ONLY SUCH AMENDMENTS; AND/OR (2) PROPOSED AMENDMENT(S) TO SOME OF THE CLAIMS WOULD RENDER THEM ALLOWABLE.

## THE AFTER FINAL HIERARCHY

THE FOREGOING REGULATIONS AND MPEP GUIDANCE ESTABLISHES THE FOLLOWING HIERARCHY:

1. RESPONSES AFTER FINAL THAT CANCEL CLAIMS OR AMEND AN APPLICATION TO ADDRESS A FORMAL REQUIREMENT MADE EARLIER (E.G., ADOPTING EXAMINER SUGGESTIONS) ARE ENTERED AS A MATTER OF RIGHT. NO SHOWING OF “GOOD AND SUFFICIENT REASONS” IS REQUIRED.

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2. RESPONSES AFTER FINAL THAT REQUIRE ONLY A CURSORY REVIEW BY THE EXAMINER (E.G., REMOVING ISSUES FOR APPEAL OR PRESENTING REJECTED CLAIMS IN BETTER FORM FOR APPEAL) MAY ENTERED AT THE NON-ARBITRARY DISCRETION OF EXAMINER WITH OR WITHOUT A SHOWING OF “GOOD AND SUFFICIENT REASONS.”

3. RESPONSES AFTER FINAL THAT “TOUCH ON THE MERITS” OR OTHERWISE DO NOT REQUIRE “ONLY A CURSORY REVIEW BY THE EXAMINER” (E.G., NECESSITATING FURTHER SEARCH) MAY BE ENTERED AT DISCRETION OF EXAMINER WITH A SHOWING OF “GOOD AND SUFFICIENT REASONS.”

IN VIEW OF THIS HIERARCHY, IT WOULD APPEAR TO BE A BETTER PRACTICE TO PREPARE AFTER FINAL RESPONSES THAT APPEAL TO THE DISCRETION OF THE EXAMINER, WHEN THEY ARE NOT TO BE ENTERED AS A MATTER OF RIGHT. SUCH RESPONSES WOULD IDEALLY REFLECT THE RESTRICTED NATURE OF AFTER FINAL PRACTICE, SATISFY THE REQUIREMENTS OF THE RELEVANT RULES, AND REFLECT THE MPEP’S GUIDANCE, SO AS TO MAXIMIZE THE LIKELIHOOD OF ENTRY.

## SUGGESTIONS

THE FOLLOWING ARE EXAMPLES OF SUGGESTED MODIFICATIONS TAILORED FOR AFTER FINAL PRACTICE, INCLUDING SOME EXAMPLES OF PARAGRAPHS TO CONSIDER INCLUDING IN AFTER FINAL RESPONSES TO MAXIMIZE THE LIKELIHOOD OF THEIR ENTRY.

1. ACKNOWLEDGE THE RESTRICTED NATURE OF AFTER FINAL PRACTICE AND ASK THE EXAMINER TO EXERCISE HIS/HER DISCRETION TO ENTER YOUR RESPONSE

ONE WAY TO ACCOMPLISH THIS MIGHT BE TO BEGIN AN AFTER FINAL RESPONSE WITH A PARAGRAPH LIKE THE FOLLOWING:

IN RESPONSE TO THE FINAL OFFICE ACTION MAILED APRIL 5, 2007, AND HAVING A PERIOD FOR RESPONSE SET TO EXPIRE ON JULY 5, 2007, APPLICANT RESPECTFULLY REQUESTS THAT THE EXAMINER AMEND THE PRESENT APPLICATION IN THE MANNER SET FORTH IN THIS AMENDMENT.

OR ALTERNATIVELY,

IN RESPONSE TO THE FINAL OFFICE ACTION MAILED APRIL 5, 2007, AND HAVING A PERIOD FOR RESPONSE SET TO EXPIRE ON JULY 5, 2007, APPLICANT RESPECTFULLY REQUESTS THAT THE EXAMINER FAVORABLY CONSIDER THE FOLLOWING REMARKS.

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2. DETERMINE WHERE A REPLY AFTER FINAL REJECTION SHOULD BE CATEGORIZED IN THE HIERARCHY AND EXPRESSLY EXPLAIN WHY THE REPLY SHOULD BE ENTERED

FOR EXAMPLE, AN AMENDMENT AFTER FINAL THAT ADDRESSES FORMAL MATTERS RAISED BY AN EXAMINER SHOULD BE ENTERED AS A MATTER OF RIGHT. SO, AN APPROPRIATE EXPLANATION MIGHT BE:

APPLICANT SUBMITS THAT THIS AMENDMENT AFTER FINAL REJECTION ONLY ADDRESSES FORMAL MATTERS RAISED A PREVIOUS OFFICE ACTION. ACCORDINGLY, APPLICANT IS ENTITLED TO ENTRY OF THIS AMENDMENT AS A MATTER OF RIGHT UNDER 37 C.F.R. §1.116 (B)(1).

WHEN AN AMENDMENT ARGUABLY PLACES THE APPLICATION IN BETTER FORM FOR APPEAL, AN APPROPRIATE EXPLANATION MIGHT BE:

APPLICANT SUBMITS THAT THIS AMENDMENT AFTER FINAL REJECTION AT LEAST PLACES THIS APPLICATION IN BETTER FORM FOR APPEAL. APPLICANT RESPECTFULLY SUBMITS THAT THIS AMENDMENT SHOULD ONLY REQUIRE A CURSORY REVIEW BECAUSE THE CLAIM AMENDMENTS PRESENTED HEREIN DO NOT ADD ANY NEW FEATURES AND/OR DO NOT SIGNIFICANTLY ALTER THE SCOPE OF THE CLAIMS. CONSEQUENTLY, THE CLAIM AMENDMENTS SHOULD NOT REQUIRE ANY FURTHER SEARCH BY THE EXAMINER. THIS AMENDMENT IS NECESSARY AS IT CLARIFIES AND/OR NARROWS THE ISSUES FOR CONSIDERATION BY THE BOARD AND WAS NOT EARLIER PRESENTED BECAUSE APPLICANT BELIEVED THAT THE PRIOR RESPONSE(S) PLACED THIS APPLICATION IN CONDITION FOR ALLOWANCE, FOR AT LEAST THE REASONS SET FORTH IN THOSE RESPONSE(S). ACCORDINGLY, ENTRY OF THE PRESENT AMENDMENT, AS AN EARNEST ATTEMPT TO ADVANCE PROSECUTION AND/OR TO REDUCE THE NUMBER OF ISSUES, IS REQUESTED UNDER 37 C.F.R. §1.116.

WHEN AN AMENDMENT TOUCHES ON THE MERITS, AN APPROPRIATE EXPLANATION MIGHT BE:

APPLICANT SUBMITS THAT THIS AMENDMENT AFTER FINAL REJECTION PLACES THIS APPLICATION IN CONDITION FOR ALLOWANCE BY AMENDING CLAIMS IN MANNERS THAT ARE BELIEVED TO RENDER ALL PENDING CLAIMS ALLOWABLE OVER THE CITED ART AND/OR AT LEAST PLACE THIS APPLICATION IN BETTER FORM FOR APPEAL. THIS AMENDMENT IS NECESSARY BECAUSE ... AND WAS NOT EARLIER PRESENTED BECAUSE APPLICANT BELIEVED THAT THE PRIOR RESPONSE(S) PLACED THIS APPLICATION IN CONDITION FOR ALLOWANCE, FOR AT LEAST THE REASONS DISCUSSED IN THOSE RESPONSES. ACCORDINGLY, ENTRY OF THE PRESENT AMENDMENT, AS AN EARNEST ATTEMPT TO ADVANCE PROSECUTION AND/OR TO REDUCE THE NUMBER OF ISSUES, IS REQUESTED UNDER 37 C.F.R. §1.116.

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OF COURSE, THIS TYPE OF PARAGRAPH SHOULD BE MODIFIED TO ARTICULATE THE PARTICULAR "GOOD AND SUFFICIENT" REASON(S) SPECIFIC TO A PARTICULAR APPLICATION.

3. INCLUDE AN EXPRESS REQUEST FOR THE SPECIFIC NOTICE THAT MPEP §714.13 INSTRUCTS EXAMINERS TO PROVIDE AN APPLICANT

FOR EXAMPLE

IN THE EVENT THAT THE OFFICE DECLINES TO ENTER THE PRESENT AMENDMENT, AND (I) ANY PORTION OF THE PRESENT AMENDMENT WOULD PLACE SOME OF THE CLAIMS IN BETTER FORM FOR APPEAL IF A SEPARATE PAPER WERE FILED CONTAINING ONLY SUCH AMENDMENTS OR (II) ANY PROPOSED AMENDMENT TO ANY CLAIM WOULD RENDER THAT CLAIM ALLOWABLE, APPLICANT RESPECTFULLY REQUESTS THAT THE OFFICE INFORM APPLICANT OF THE SAME PURSUANT TO MPEP §714.13.

4. FILE AFTER FINAL RESPONSES ELECTRONICALLY

FILING ELECTRONICALLY AVOIDS THE DELAY BETWEEN THE TIME DOCUMENTS ARE RECEIVED BY THE PATENT OFFICE AND THE TIME THEY ARE CONVERTED AND PLACED INTO THE IMAGE FILE WRAPPER (IFW). AND, SINCE TIME CAN BE OF THE ESSENCE IN AFTER FINAL PRACTICE, KNOWING A DOCUMENT HAS BEEN RECEIVED AND IS IN THE IFW CAN BE A GREAT BENEFIT. FOR EXAMPLE, IF THE AFTER FINAL REPLY IS FILED WITHIN 2 MONTHS OF THE DATE OF THE FINAL OFFICE ACTION, THE SHORTENED STATUTORY PERIOD FOR RESPONSE WILL EXPIRE EITHER 3 MONTHS FROM THE MAILING DATE OF THE FINAL REJECTION OR ON THE DATE THE ADVISORY ACTION IS MAILED, WHICHEVER IS LATER. STILL FURTHER, THERE ARE ALSO PATENT TERM EXTENSION ADVANTAGES TO FILING ELECTRONICALLY, AS I DISCUSSED HERE.

5. WHEN FILING BY MAIL OR BY HAND, TAKE ADVANTAGE OF THE U.S. PATENT OFFICE'S EXPEDITED PROCEDURE FOR AFTER FINAL RESPONSES

THE PATENT OFFICE HAS AN EXPEDITED PROCESSING PROCEDURE FOR PROCESSING PAPER RESPONSES AFTER FINAL REJECTION UNDER 37 CFR 1.116. TO TAKE ADVANTAGE OF THE EXPEDITED PROCEDURE, AFTER FINAL RESPONSES UNDER 37 CFR 1.116 NEED TO BE MARKED AS A "REPLY UNDER 37 CFR 1.116 - EXPEDITED PROCEDURE - TECHNOLOGY CENTER (XXXX)" ON THE UPPER RIGHT PORTION OF THE PAPER. ALSO, IF THE RESPONSE IS FILED BY MAIL, THE ENVELOPE MUST BE MARKED "MAIL STOP AF" IN THE LOWER LEFT HAND CORNER. THE MARKINGS PREFERABLY SHOULD BE WRITTEN IN A BRIGHT COLOR WITH A FELT POINT MARKER. IF THE REPLY IS HAND-CARRIED TO THE CUSTOMER WINDOW, THE OUTSIDE OF THE ENVELOPE SHOULD BE MARKED "REPLY UNDER 37 CFR 1.116 - EXPEDITED PROCEDURE - TECHNOLOGY CENTER (XXXX)." SEE MPEP 714.13(V).

THREE FINAL COMMENTS

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1. IF YOU ARE NOT FILING ELECTRONICALLY THROUGH THE PATENT OFFICE'S EFS-WEB, I SUGGEST THAT YOU CONSIDER STARTING TO. THE SYSTEM IS SURPRISINGLY SIMPLE AND EASY TO USE.

2. UNDER PATENT OFFICE RULES, EVERY AMENDMENT MUST INCLUDE MARKINGS SHOWING THE CHANGES RELATIVE TO THE LAST ENTERED AMENDMENT. SO, IN AMENDMENTS AFTER FINAL (OR AMENDMENTS FILED WITH A REQUEST FOR CONTINUED EXAMINATION (RCE)), IT IS IMPORTANT TO TAKE CARE NOT TO INCLUDE MARKINGS THAT INDICATE CHANGES RELATIVE TO ANY UNENTERED AMENDMENT. DOING SO SHOULD RESULT IN A NOTICE OF NON-COMPLIANT AMENDMENT. NEVER ASSUME THAT AN AFTER FINAL AMENDMENT HAS ENTERED BECAUSE THEY ARE NOT ENTERED AS A MATTER OF RIGHT.

3. IN VIEW OF THE U.S. PATENT OFFICE'S NEW RULES CHANGING CONTINUATION PRACTICE, IT APPEARS THAT GETTING THE MOST OUT OF EVERY RESPONSE, BEFORE AND AFTER FINAL, IS GOING TO BE MORE IMPORTANT THAN EVER.

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