

Avoiding Implications By Silence In A Prosecution History

By Michael E. Kondoudis

This is a discussion of various techniques that take advantage of opportunities in a prosecution history to rebut/preclude disadvantageous implications that often tend to arise in patent litigation. These techniques tend to yield prosecution histories that are more difficult to assail while also providing future litigators asserting the patent with enhanced tactical flexibility.

The Implication That Only The Arguments Presented Were Believed to Be Meritorious

One of the important strategic decisions in responding to a claim rejection is to identify which argument(s) should be presented. This is especially true when it appears that any of several arguments would be successful. Sometimes, it may be advantageous to present every argument believed to have merit. This approach, however, increases possible argument estoppel and can be expensive. For these reasons, it is often advantageous to present fewer than all possible meritorious arguments. This argument selection process can be based on myriad factors. For example, will it be more effective to present the shortest, most efficient argument or a legal argument against, for example, motivation to make a combination? How about discussing the easiest claim feature not taught or suggested by the cited art? How about the first claim feature? For some prosecutors, this is where their analysis often ends. I submit, however, that when fewer than all possible arguments are presented, it can be a better practice to make it clear in the prosecution history that other possible arguments were believed to have merit. In this regard, consider the following:

1. There is nothing to be gained by exposing an Applicant in future litigation to the argument that the Applicant only believed that claims were patentable only for the reason(s) presented while there is much that might be gained by avoiding the argument entirely.

2. This approach is prudent, unless a prosecutor is confident that the argument presented is by far the best one, and liberates a prosecutor to more safely selectively discuss the feature most likely to win the day (e.g., the easiest to explain to an Examiner, the first feature, or the feature requiring the shortest argument).

3. This approach makes it easier for litigators to make alternative/additional patentability arguments in the future, if later evaluation of the cited art in litigation reveals such arguments have merit.

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Examples of Specific Techniques

Having established that avoiding an implication that only those arguments presented in prosecution were believed to have merit is important, I have found the following techniques to be subtle, efficient, and effective for avoiding this implication.

1. When Allowed/Allowable Subject Matter is Indicated

Perhaps the most elegant and efficient technique is to add a phrase/statement in the following exemplary paragraph I use when allowable/allowed subject matter is indicated.

Applicant acknowledges with appreciation the indication that claims 1-10 are allowed and that claims 11-20 recite patentable subject matter and would be allowable if rewritten in independent form to include all of the features of their respective base claims and any intervening claims. By the present Amendment, Applicant has not amended any of allowed claims 1-10. Accordingly, Applicant respectfully submits that claims 1-10 should remain allowed. Also, Applicant has respectfully maintained claims 11-20 in dependent form because it is believed that their respective base claims patentably define over the cited art, for at least the reasons discussed herein.

It is to be appreciated that this exemplary paragraph serves three functions. First, it expressly implies that other meritorious reasons for patentability are possible. Second, it is hyper-accurate; representing only that the allowed claims, which may have been previously amended, are not amended by the present Amendment. Thirdly, it is an attempt to subtly and politely disagree with an Examiner who has identified allowable subject matter in some claims.

2. In a Traversal

Another technique is to insert specific phrases in the traversal of the rejection that rebut the presumption. Consider an oversimplified example in which a claim 1 is rejected under 35 U.S.C. § 103 over the combination of patent A and patent B that, after review, is determined to be deficient, failing to disclose a feature of the claim. An adequate response might include the following paragraphs:

Claim 1 recites, among other features, a widget on a vertical surface.

Applicant respectfully submits, however, that the asserted combination does not disclose the aforementioned feature of claim 1.

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Patent A teaches a widget 20. (Patent A, Col. 5, lines 1-10; FIG. 1). The Office Action contends that Patent A discloses a widget on a vertical surface. (Office Action, page 4). This contention is respectfully traversed.

Patent A expressly teaches that widget 20 is on a horizontal surface. (Id.).

Patent B is cited for its alleged disclosure of various features of claim 1 other than the aforementioned feature. Applicant respectfully submits that Patent B does not add anything to the disclosure of Patent A that would remedy the aforementioned deficiency.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 103 are respectfully requested.

Such a response adequately presents the argument that the asserted combination is deficient. The response, however, arguably implies that the Applicant believed that the asserted combination was proper. Also absent is any indication that the Applicant might have believed, for example, that claim 1 patentably defined over the cited art for any other reason. Consequently, the resulting prosecution history does not provide a strong defense against these implications. Thus, a better approach might be the following:

Claim 1 recites, among other features, a widget on a vertical surface.

Applicant respectfully submits that the asserted combination does not disclose at least the aforementioned feature of claim 1, for at least the reasons discussed below.

Patent A teaches a widget 20. (Patent A, Col. 5, lines 1-10; FIG. 1). The Office Action contends that Patent A discloses a widget on a vertical surface. (Office Action, page 4). This contention is respectfully traversed.

Patent A expressly teaches that widget 20 is on a horizontal surface. (Id.).

Patent B is cited for its alleged disclosure of various features of claim 1 other than the aforementioned feature. Applicant respectfully submits that Patent B does not add anything to the disclosure of Patent A that would remedy the aforementioned deficiency.

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Accordingly, for at least the aforementioned reasons, reconsideration and withdrawal of the rejections of claim 1 under 35 U.S.C. § 103 are respectfully requested.

I submit that the latter response yields potentially significant advantages over the former, without increased cost or effort. The latter response, if it results in an allowance will, in the absence of any statement of reasons for allowance, provide future litigators with several options on which to argue the patentability of claims or several arguable bases on which the claims were allowed. This can be advantageous if any one patentability argument is later proven to be incorrect, which can happen during litigation when prosecution histories are often studied in great detail. In this regard, the latter approach also provides a “safety net” for the prosecutor, since it can be argued that at least one of the arguments presented was properly persuasive.

3. An Omnibus Paragraph

Still another technique is to add a paragraph after all of the traversals in an Amendment that expressly explains that the absence of additional patentability arguments should not be construed as either a disclaimer of such arguments or that such arguments are not believed to be meritorious.

I submit that the techniques presented thus far provide the prosecutor the flexibility to selectively present the most appropriate argument (e.g., the easiest to explain to an Examiner, the first feature not present, or the feature requiring the shortest argument). Second, I submit that this approach makes it easier for litigators to make other patentability arguments in the future. Thirdly, this technique provides an extra layer of safety to the prosecutor in the unlikely event that the prosecutor did not present the strongest argument.

Implications by silence, however, may also arguably arise from failures to rebut in the prosecution history implied agreement with an examiner. For example, if an Applicant argues only that an asserted combination of art does not disclose a claim feature, does that mean that the Applicant agreed with the Examiner that the asserted combination was proper (e.g., that there was the requisite motivation to make the combination)? Maybe not. But why not avoid the risks of such an implication entirely, especially because it is so easy to do?

The following are a few additional opportunities in a prosecution history where convenient and cost-effective techniques to accomplish this objective can be applied.

Responses to Rejections Under § 112

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Consider the following example concerning a rejection of a claim under the second paragraph of 35 U.S.C. § 112. Assume that the Examiner has rejected the claim as indefinite. After a thorough review, you conclude that it is a close call but one that may very well be traversed by argument. For strategic/business reasons, however, the applicant opts not to fight the rejection but instead to amend the claim.

An adequate explanation in the remarks about applicant's claim amendment might be:

Claim 5 stands rejected under the second paragraph of 35 U.S.C. § 112, as indefinite. In response, claim 5 has been amended in view of the Examiner's comments. Applicant respectfully submits that the amendments to claim 5 traverse this rejection. Accordingly, favorable reconsideration and withdrawal of this rejection are respectfully requested.

A better response, however, might be the following paragraph:

Claim 5 stands rejected under the second paragraph of 35 U.S.C. § 112, as indefinite. By the present Amendment, Applicant has amended claim 5 in view of the Examiner's comments. Applicant respectfully submits that claim 5 now even more fully satisfies the requirements of the second paragraph of 35 U.S.C. § 112. Accordingly, favorable reconsideration and withdrawal of this rejection are respectfully requested.

I submit that the latter response is superior to the former in several ways. First, the latter example reserves the possible future argument that the Applicant did not agree that rejected claim 5 was definite as it was originally presented. This could be of value, for example, if similar claim constructions are presented in parallel applications. In contrast, I think that in the former response needless makes this future argument more difficult to make. Secondly, it may also be of value if the Applicant presents a similarly constructed claim later in prosecution. If that later added claim is similarly rejected, and the Applicant has a change of heart deciding to traverse the rejection by argument, it is far easier to craft a persuasive patentability argument. Thirdly, it is a polite way to "save the argument" that avoids offending or directly challenging the Examiner, which is almost always in an Applicant's best interests.

This approach can be applied to other non-art rejections as well as objections, such as objection to the title (e.g., Applicant has amended the title to even more accurately describe the claimed subject matter).

Avoiding an Implication that Applicant Agrees that an Asserted Combination is Proper

One of what I believe to be the very most important arguments to expressly reserve in the prosecution history is a challenge to the propriety of any asserted combination. Litigators have far more time to study art and may find support for a challenge to the propriety of a combination or modification. Staying silent on this point during prosecution can arguably

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blunt the effectiveness of this later argument. For this reason, when I choose to challenge only the sufficiency of a combination in response to a rejection, it is my usual practice to expressly reserve any argument about whether the combination is proper. One technique I employ is illustrated by the following example:

Claim 1 recites, among other features, a widget on a vertical surface.

Without conceding the propriety of the asserted combination, however, Applicant respectfully submits that the asserted combination does not disclose at least the aforementioned feature of claim 1, for at least the following reason.

Patent A discusses an arrangement that includes a smidget 20. (Patent A, Col. 5, lines 1-10; FIG. 1).

The Office Action contends that this smidget meets that aforementioned feature of claim 1. (Office Action, page 4).

A review of Fig. 1 of patent A reveals, however, that the smidget 20 is on a horizontal surface. (Id.). Further, patent A expressly teaches that the smidget 20 must be on a horizontal surface. (Patent A, Col. 5, lines 10-12).

Patent B is cited for its alleged disclosure of various features of claim 1 other than the aforementioned feature. Applicant respectfully submits that Patent B does not add anything to the disclosure of Patent A that would remedy the aforementioned deficiency.

Also, Applicant respectfully submits that one of ordinary skill would not have been motivated to combine patent A with patent B.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 103 are respectfully requested.

The value added by the techniques may be difficult to measure. After all, it is impossible to see the future. I look at it, however, from a cost/benefit perspective. The cost is at most the time required to type these few extra words. Thus, I submit that almost any potential benefit of these techniques, regardless of how remote, outweigh the cost. Additionally, as a former litigator, I submit that it is always a better practice to try to arm future litigators with as many arguments and/or counterarguments as possible. For this reason, when I have the opportunity to at least imply that the Applicant does not agree with an Examiner, I take it.

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