

THE BENEFITS OF EFFICIENT RESPONSES AND APPROACHES FOR EFFICIENTLY RESPONDING TO REJECTIONS UNDER 35 U.S.C. §103

BY MICHAEL E. KONDOUDIS

THERE IS AN OLD SAYING THAT “SOMETIMES, LESS IS MORE.” THIS ADVICE HAS PARTICULAR APPLICABILITY TO PATENT PROSECUTION WHERE, WITH EACH WORD WRITTEN, AN APPLICANT RISKS GENERATING ARGUMENT ESTOPPEL. ADDITIONALLY, EACH WRITTEN WORD PRESENTS WITH IT AN INHERENT RISK OF INTRODUCING ERROR. FURTHER, EXTENDED ARGUMENTS ARE GENERALLY MORE EXPENSIVE SINCE THEY REQUIRE ADDITIONAL TIME TO DRAFT AND EDIT. MOREOVER, EXTENDED ARGUMENTS TEND TO BE LESS PERSUASIVE THAN SHORTER ARGUMENTS, PERHAPS BECAUSE THE ARGUMENT GETS “WATERED DOWN” OR PERHAPS BECAUSE IT IS HARDER TO KEEP A READER’S ATTENTION. IN THE END, IN A RISK/BENEFIT ANALYSIS, THE RISKS ASSOCIATED WITH UNNECESSARILY EXTENDING A PATENTABILITY ARGUMENT GENERALLY OUTWEIGH ANY POTENTIAL BENEFITS. FOR THIS REASON, I SUBMIT THAT NOT ONLY IS IT A GENERALLY BETTER PRACTICE TO PRESENT THE SHORTEST, MOST EFFICIENT PATENTABILITY ARGUMENTS POSSIBLE, BUT THAT IT IS ALSO WORTH THE TIME TO DEVELOP AND CONTINUALLY REFINE APPROACHES THAT PROMOTE THIS OBJECTIVE.

FOR INSTANCE, A REJECTION UNDER 35 U.S.C. §103 ON THE BASIS THAT THE ASSERTED COMBINATION IS DEFICIENT MAY BE EFFICIENTLY TRAVERSED USING THE FOLLOWING APPROACH:

1. EXPRESSLY IDENTIFYING THE CLAIM LANGUAGE ON WHICH THE PATENTABILITY ARGUMENT IS BASED;
2. EXPRESSLY SUMMARIZING THE PATENTABILITY ARGUMENT BEING PRESENTED;
3. IDENTIFYING THE OFFICE’S CONCESSION/ADMISSION THAT ONE OF THE CITED DOCUMENTS DOES NOT DISCLOSE ALL OF THE CLAIM FEATURES (HENCE THE NEED FOR THE COMBINATION);
4. IDENTIFYING THE OFFICE’S CONTENTION THAT THE MISSING CLAIM FEATURE(S) IS/ARE IN ANOTHER CITED DOCUMENT AND EXPRESSLY STATING THAT IT IS THIS SPECIFIC CONTENTION THAT IS BEING TRAVERSED; AND
5. EXPLAINING WHY THE OFFICE’S CONTENTION IS INCORRECT.

THIS APPROACH FOCUSES ON THE CLAIM FEATURE(S) AT ISSUE, ARTICULATES THE SPECIFIC POINT OF CONTENTION, AND EXPLAINS THE SPECIFIC DEFICIENCY IN THE ASSERTED COMBINATION. THIS APPROACH, ADVANTAGEOUSLY, AVOIDS

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UNNECESSARY CHARACTERIZATIONS OF THE CLAIMS AND THE CITED ART ALONG WITH THE DANGERS OF POTENTIAL ARGUMENT ESTOPPEL RESULTING FROM SUCH UNNECESSARY CHARACTERIZATIONS.

EXAMPLES

CONSIDER THE FOLLOWING HYPOTHETICAL RESPONSE TO A REJECTION UNDER 35 U.S.C. §103 BASED ON A COMBINATION OF A PRIMARY CITATION TO A PATENT TO SMITH AND A SECONDARY CITATION TO A PATENT TO JONES.

INDEPENDENT CLAIM 1 RECITES, INTER ALIA, A WIDGET ON A FRAME.

APPLICANT SUBMITS THAT NEITHER SMITH NOR JONES DISCLOSES AT LEAST THE AFOREMENTIONED FEATURE OF INDEPENDENT CLAIM 1. IN PARTICULAR, IT IS SUBMITTED THAT SECONDARY CITATION TO JONES DOES NOT REMEDY THE CONCEDED DEFICIENCY IN THE PRIMARY CITATION TO SMITH. ACCORDINGLY, WITHOUT CONCEDED THE PROPRIETY OF THE ASSERTED COMBINATION, THE ASSERTED COMBINATION OF SMITH AND JONES IS LIKewise DEFICIENT, EVEN IN VIEW OF THE KNOWLEDGE OF ONE OF ORDINARY SKILL IN THE ART.

THE OFFICE ACTION CONCEDES THAT THE PRIMARY CITATION TO SMITH DOES NOT DISCLOSE A WIDGET ON A FRAME. (OFFICE ACTION, PAGE 2). NONETHELESS, THE OFFICE ACTION REJECTS INDEPENDENT CLAIM 1, CONTENDING THAT THE SECONDARY CITATION TO JONES PROVIDES THIS NECESSARY DISCLOSURE. (OFFICE ACTION, PAGE 3). THIS CONTENTION IS RESPECTFULLY TRAVERSED.

JONES RELATES TO A PERPETUAL MOTION MACHINE AND DISCUSSES AN ARRANGEMENT INCLUDING A MAIN BOARD 10, A FRAME HOLDING THE MAIN BOARD 20, AND A WIDGET 30. (JONES, COL. 3, LINES 3-13; FIG. 2). JONES, HOWEVER, EXPRESSLY TEACHES THAT WIDGET 30 CANNOT BE LOCATED ON FRAME 20. (JONES, COL. 3, LINES 25-35). THUS, JONES DOES NOT PROVIDE A DISCLOSURE THAT REMEDIES THE AFOREMENTIONED, CONCEDED DEFICIENCY IN THE PRIMARY CITATION TO SMITH.

OF COURSE, THIS TECHNIQUE WORKS EQUALLY AS WELL WHEN THERE IS A DEFICIENCY IN THE PRIMARY DOCUMENT. IN THIS CASE, AN EFFICIENT RESPONSE MIGHT BE:

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APPLICANT SUBMITS THAT NEITHER SMITH NOR JONES DISCLOSES AT LEAST THE AFOREMENTIONED FEATURE OF INDEPENDENT CLAIM 1. IN PARTICULAR, IT IS SUBMITTED THAT THE PRIMARY CITATION TO SMITH DOES NOT DISCLOSE THE CLAIMED WIDGET. ACCORDINGLY, WITHOUT CONCEDED THE PROPRIETY OF THE ASSERTED COMBINATION, THE

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ASSERTED COMBINATION OF SMITH AND JONES IS LIKewise DEFICIENT, EVEN IN VIEW OF THE KNOWLEDGE OF ONE OF ORDINARY SKILL IN THE ART.

THE PRIMARY CITATION TO SMITH RELATES TO A METHOD OF PERPETUAL MOTION AND DISCUSSES A PROCESS INCLUDING ENERGIZING A MOVING UNIT AND EMPLOYING A WIDGET ON A SUBSTRATE TO CONSERVE ENERGY. (SMITH, FIG. 3).

THE OFFICE ACTION CONTENDS THAT THE WIDGET DESCRIBED AS BEING USED TO CONSERVE ENERGY MEETS THE AFOREMENTIONED FEATURE OF INDEPENDENT CLAIM 1. (OFFICE ACTION, PAGE 3). THIS CONTENTION IS RESPECTFULLY TRAVERSED.

SMITH, AT COLUMN 4, LINES 1-18, EXPRESSLY TEACHES THAT THE WIDGET MUST BE DISPOSED AT A CENTRAL LOCATION ON A PRINTED CIRCUIT BOARD. THUS, SMITH CANNOT REASONABLY BE INTERPRETED TO DISCLOSE THE AFOREMENTIONED FEATURE OF INDEPENDENT CLAIM 1.

THE SECONDARY CITATION TO JONES RELATES TO A PERPETUAL MOTION MACHINE AND IS CITED FOR ITS ALLEGED DISCLOSURE OF A FRAME HOLDING A MAIN BOARD. (OFFICE ACTION, PAGE 3). APPLICANT SUBMITS THAT JONES DOES NOT ADD ANYTHING THAT WOULD REMEDY THE AFOREMENTIONED DEFICIENCY IN SMITH. ACCORDINGLY, FAVORABLE RECONSIDERATION AND WITHDRAWAL OF THE REJECTION OF INDEPENDENT CLAIM 1 UNDER 35 U.S.C. §103 ARE RESPECTFULLY REQUESTED.

APPROACHES LIKE THESE CAN PROMOTE THE PARALLEL GOALS OF EFFICIENCY AND ACCURACY, WHICH ALSO TENDS TO ENHANCE PERSUASIVENESS. FIRSTLY, THEY MINIMIZE ARGUMENT ESTOPPEL BY EXPRESSLY IDENTIFYING: THE CLAIM LANGUAGE RELIED UPON; THE SPECIFIC ARGUMENT BEING TRAVERSED; AND THE PATENTABILITY ARGUMENT BEING PRESENTED. THUS, AMBIGUITY LATER USABLE AS ALLEGED ARGUMENT ESTOPPEL IS MINIMIZED. SECONDLY, THESE APPROACHES AVOID THE TEMPTATION TO SUMMARIZE OR CHARACTERIZE THE CLAIM FEATURES AT ISSUE BY IDENTIFYING THE EXPRESS CLAIM LANGUAGE ONCE, AND THEREAFTER REFERRING TO THE FEATURE AS “THE AFOREMENTIONED FEATURE OF CLAIM X.” LASTLY, THESE APPROACHES MINIMIZE THE LENGTH OF THE ARGUMENT SO AS TO YIELD EFFICIENCIES AND PROMOTE A GENERALLY MORE FOCUSED AND PERSUASIVE ARGUMENT.

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