

# Guide on Responding to an Office Action in a Patent Case

By Howard L. Hoffenberg  
The IP and Business Law Offices of  
Howard L. Hoffenberg, Esq.

First written for use in John Park and Assoc. agent's class

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## Navigating the PTO Website For Amendment Related Material

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**USPTO Job**

**21st Century  
Strategic Plan**

Geographic facilitation for goods  
and services originating in a  
particular geographic area with  
distinctive characteristics.

USPTO has a database of the most  
common geographical terms, data derived and de-

veloped from the USPTO's trademark records, inventories

and a user-centered system that

includes them in the classification of goods and

services and a user-centered tra-

nsformation system.

The featured video this month highlights the initial stages of selecting a geographic indication. It shows the United States government's perspective regarding a special intellectual property right that the origin of goods or services is from a particular geographic area with particular characteristics. Some examples are for you to examine.

Request a copy of the video at [www.uspto.gov/tmdb/strategic/](#).

Geographic indications are a type of trademark because of the unique nature of the name. The Organization for Economic Cooperation and Development (OECD) has developed a definition for the protection of GI at the national level as follows: "A GI is a name or sign identifying goods or services as originating in a particular place, and as such is inherently distinctive of the goods or services." This is a very broad definition of a GI, and it is not limited to geographical origin. The name must be either a geographical identifier, such as a city, state, or region, or a name of generic or traditional commonality, either in the name or the design. In the United States and other WTO member and most member of the European Union

http://www.uspto.gov/

10/16/2005

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# PTO Website Page with Amendment Related Resources

Final Rule 37 CFR 1.121 Revised Amendment Practice More Information Page 1 of 2

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Patents > Office of Patent Legal Administration > Recent Patent-Related Notices > Final Rule 37 CFR 1.121 Revised Amendment Practice More Information

◆ [Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121\(c\) is suspended](#) (30 Jun 2001) (201)

◆ [Frequently Asked Questions - Revised Amendment Practice \(posted 14 Apr 2003, updated 22 Feb 2005, updated 21 Jul 03 or 03 Feb 2004\)](#)

◆ [Amendments Permitted Under the Revised Amendment Practice and Treatment of Non-Compliant Amendments \(signed 14 Jun 2003\)](#)

◆ [Effective Date 30 July 2003 Changes To Implement Electronic Maintenance of Official Patent Application Records, Final Rule \(and related Fed Reg 39811\) \(14 Jun 2003\)](#)

◆ [Sample Format for Revised Amendment Practice \(PDF, \(posted 30 Jun 2003\)\)](#)

◆ [Office Faxes: Amendments May Now be Submitted in Revised Format \(PDF\) \(06 Sep 2003\)](#)

◆ [Slide Sets: Revised Amendment Format 37 CFR 1.121 \[text version\] \(posted 26 Sep 2003\); \[pdf\]\(#\) \(130 KB\) \(2003\)](#)

◆ [Changes To Implement Electronic Maintenance of Official Patent Application Records, 10850 \(as proposed rule making published at 68 Fed Reg 14965 \(14 Mar 2003\); \[pdf\]\(#\) \(123 KB\) \(2003\)\)](#)

Some links are linked to on this page with resources plug in by Adobe Acrobat Reader and Microsoft PowerPoint

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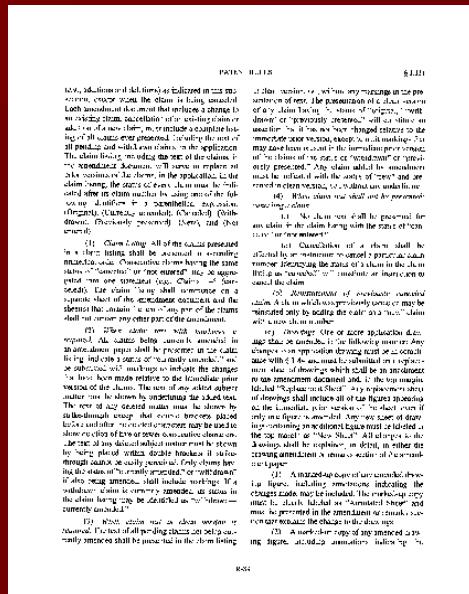
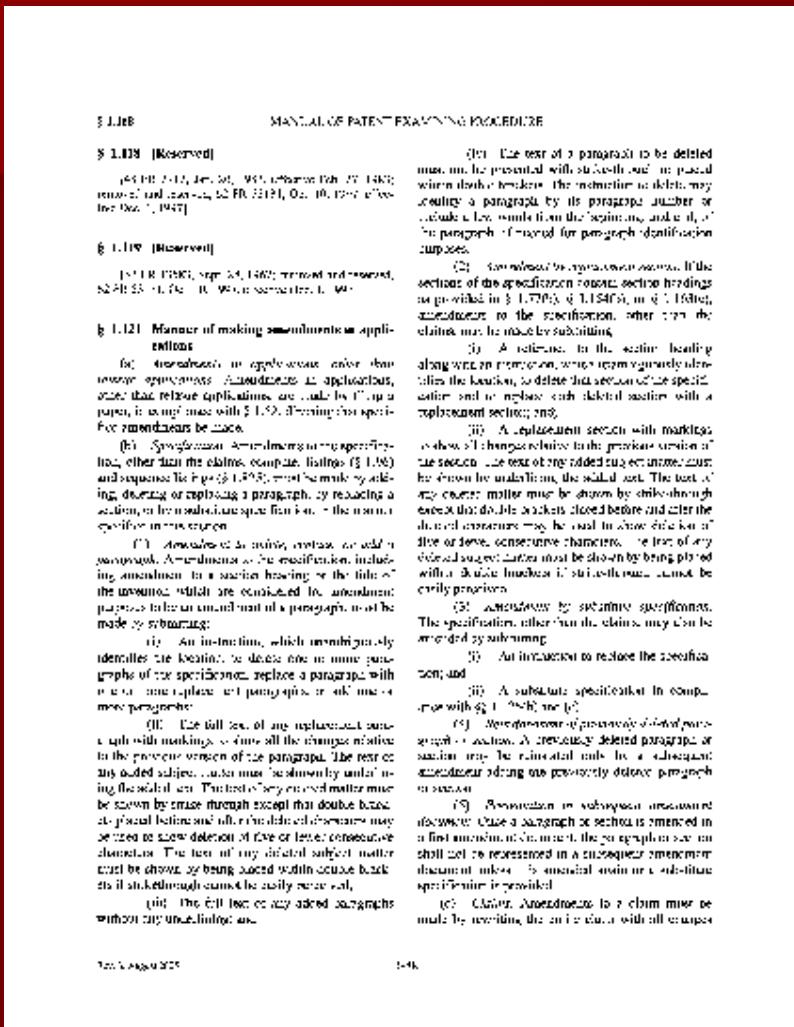
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# The Law on making Amendments is found at 37 CFR 1.121 (other rules on specific practices)



We will go into this in some detail in the upcoming slides

PTO's Sample  
Amendment. For  
now, an  
overview. We will  
go into detail as  
the lecture  
continues

**SAMPLE FORMAT FOR REVISED AMENDMENT PRACTICE** (Rev. 6/13)

Appl. No. : XX:YYYY:ZZZ Continuation/ No. WXYZ  
Applicant : John S. Q. Inventor  
Filed : April 15, 2003  
TCAU. : 744  
Examiner : John D. Doe  
Docket No. : 123456A&123458  
Customer No. : 88888

Commissioner for Patents  
P.O. Box 450  
Alexandria, VA 22313-4500

**AMENDMENT**

51-

In response to the Office action of October 16, 2003, please amend the above-identified Application as follows:

**Amendments to the Specification** begin on page 2 of this paper.

**Amendments to the Claims** are reflected in the listing of claims which begins on page 3 of this paper.

**Amendments to the Drawings** begin on page 4 of this paper and include both an attached replacement sheet and an annotation sheet showing changes.

**Remarks/Arguments** begin on page 5 of this paper.

**An Appendix** including amended drawing figures is attached following page 2 of this paper.

Appl. No. 2005-17,577  
Amendment 14, 279  
Reply to Office action of Dec. 16, 2013

Appendices to the Specifications:

Please replace paragraph [0021] with the following amended paragraph:

[0021] In the construction of the bucket of this invention, various materials have been selected [ and ] which, due to a number of diverse properties, [ ] [ ] are allow for varied functions of the unit [ ]. For economic solutions, the bucket can be made of a durable plastic material. Where an aesthetic appeal is desired, the bucket can be one [off] one of many attractive colors. The following listing list of properties serves to define possible uses for the buckets.

Please replace paragraph [0045] with the following amended paragraph:

[0045] Fig. 1 displays a bucket of the invention. As can be seen from the drawing, the a handle is attached to the upper tip of the structure and connected at points diametrically opposite each other on the circumference.

Please add the following new paragraph after paragraph [0075]:

[0075.1] An optional feature of the article of the invention is the addition of a tetrafluoroethylene coating to the bucket to provide protection from any accidents which might be caused. The coating can be provided to the surface during the manufacturing process or can be added in a later step.

Please delete the paragraph beginning at page 2, line 4, which starts with "Under normal circumstances"

Appl. No. 32075103-3  
Filed: 01/14/2013  
Reply L-Office: 3710/Office - n 2000

**Amendments to the Claims**

This listing of claims will replace all prior versions, and listings, of claims in the application.

**Listing of Claims**

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a green/blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

Appl. No. 32001777777  
Am. Inter. on 15.07.2011  
Ready to file application on 16.07.2011

[Amendments to the Drawings](#)

The marked sheet of drawings includes changes to Fig. 2. This sheet, which includes Fig. 2, replaces the original sheet including Fig. 1-2. In Figure 2, previously omitted element '3' has been added.

Attachment: [Replace your sheet](#)  
[Amended Sheet, Showing Changes](#)

REMARKS AND MENTS

In the specification, the paragraphs [0021] and [0045] have been amended to correct minor editorial problems. The new paragraph [0075] (1) added after paragraph [0075] discusses in general terms the features taken from Example 4.

In *superseded* Figure 7, the previously *erased* element numeral 13 has been added.

Claims 6-10 and 12-13 remain with this application. Claims 1-5 and 11 have been canceled. Claims 7 and 8 have been withdrawn.

The examiner has acknowledged that claims 4 and 9-10 are directed to unallowable subject matter. Claim 7-8 are best withdrawn as the result of an earlier restriction requirement. Claim 1 adds no additional language to claim 1 in the specification.

In view of the claimant's earlier restriction requirements, applicants retain the right to present claims 7-8 in a divisional application.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

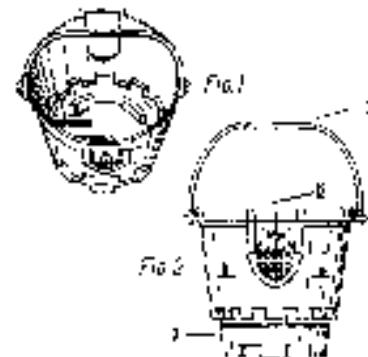
Respectfully submitted,

SMITH, KINGS & BROWN

H-1  
Martin J. Gallagher  
Reg. No. 99,999  
Tel. (0111) 222-1162

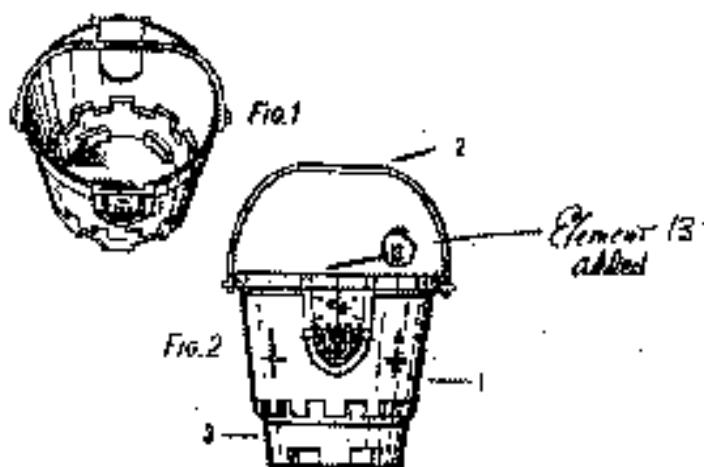
## Attributed

Ap.156, 326333, 517  
Am. 12/15/13, 2013  
Reply to Letter dated 11/16/2013  
Replacement Sheet



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App. No. 10-1111,111  
Art. 111111111111111111  
Serial No. 111111111111111111  
Date of Registration: Oct. 16, 2008  
Ammunition: Small Shrapnel Shelling Charge



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## Amendment Practice (From PTO Slide Show)

Each section of an amendment paper must start on a separate sheet.

- For example: each of the following sections must start on a separate sheet: Introductory comments, Amendments to the Specification, Amendments to the Claims, Amendments to Drawings, and Remarks.

1. Submit only one version of the replacement paragraph or section, or currently amended claims, with markings (*i.e.*, strikethrough, **double brackets [[ ]]**, or underlining), to show the changes relative to immediate prior version.
  - The requirement to provide a separate, clean version has been eliminated, except when applicant submits a substitute specification.

# Amendment Practice

(From PTO Slide Show)

## ■ Markings to Show Changes:

- The following must include markings to show all changes relative the immediate prior version:
  - Replacement paragraphs or sections,
  - Replacement abstracts,
  - Currently amended claims, and
  - Substitute specifications.
- Added text must be shown by **underlining**.
- Deleted text must be shown by **strikethrough** with 2 exceptions.

# Amendment Practice

(From PTO Slide Show)

- Markings to Show Changes (cont')
  - Deleted text must be shown by **strikethrough** (*e.g., strikethrough*), with 2 exceptions:
    1. For deletion of five or fewer consecutive characters, **double brackets** [[ ]] may be used (*e.g., [[eroor]]*); and
    2. If strikethrough cannot be easily perceived, deleted text must be shown by **double brackets** [[ ]] around the deleted text characters.
  - For example: changing “4 corners” to “three corners” should be indicated by “three[[4]] corners”.

# Amendment Practice

(From PTO slide show)

## ■ Markings to Show Changes (cont')

- For changes of punctuation marks or difficult to perceive characters, applicants may delete text before and after with strikethrough, and then insert such text along with the change by underlining. For example:
  - If the hyphen in “strike-through” is to be deleted, it may be shown as “strike-throughstrikethrough”

# Amendments to Claims

from PTO Slide Show

3. When there is any amendment to a claim, a claim listing of all claims ever presented in the case must be supplied in ascending numerical order.
  - An example of a claim listing is as follows:

**Claims 1-5 (canceled)**

**Claim 6 (previously presented) A bucket with a handle.**

**Claim 7 (withdrawn) A handle comprising an elongated wire.**

**Claim 8 (withdrawn) The handle of claim 7[[6]] further comprising a plastic grip.**

**Claim 9 (currently amended) A bucket with a green blue handle.**

**Claim 10 (original) The bucket of claim 9 wherein the handle is made of wood.**

**Claim 11 (canceled)**

**Claim 12 (not entered)**

**Claim 13 (new) A bucket with plastic sides and bottom.**

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# Amendments to Claims

(From the PTO Slide Show)

## ■ What is a claim listing?

- A claim listing must include:
  - The claim number of every claim ever presented in the application, whether entered or not;
  - A status identifier, in parentheses, following each claim number;
  - The text of all pending claims (including **withdrawn** claims); and
  - Markings to show the changes made only in the current amendment relative to immediate prior version.
- The claims in the listing (in the current amendment) will replace all prior versions, and listings, of claims in the application.

# Amendments to Claims (From PTO Slide Show)

- The seven (7) permissible status identifiers and their definitions, are:
  1. **(Original)**: Claim filed with original specification (not added by preliminary amendment and not previously amended).
  2. **(Currently amended)**: Claim being amended in the current amendment. Currently amended claims must include markings (strikethrough, double brackets, or underlining) to indicate changes.
  3. **(Canceled)**: Claim canceled or deleted in current amendment or previously. Do not present the text of a canceled claim. Consecutive canceled claims may be grouped together (*e.g.*, claims 1-5 (canceled)).

# Amendments to Claims (From PTO Slide Show)

## ■ Seven (7) permissible status identifiers (cont.):

### 4. **(Withdrawn)**: Non-elected claim.

- The **text of a withdrawn claim must be presented**.
- Withdrawn claims that are being currently amended must be presented with markings (strikethrough, double brackets, or underlining) to indicate changes.
- Example: Claim 8 (withdrawn) The handle of claim 7[[6]] further comprising a plastic grip.

### 5. **(Previously presented)**: This is a generic identifier to cover any claim that was previously added or amended in an earlier amendment paper.

- The proposed identifiers “previously amended” or “previously added” were not adopted, and must not be used.

# Amendments to Claims (From PTO Slide Show)

- Seven (7) permissible status identifiers (cont.):
  6. **(New)**: Claim being added in the current amendment paper. The text of the claim must be presented in clean form without underlining.
  7. **(Not entered)**: **Claim presented in a previous unentered amendment.**
    - Do not present the text of a not entered claim.
    - Consecutive not entered claims may be grouped together (*e.g.*, Claims 20-25 (not entered)).
    - If in doubt as to whether a prior amendment was entered, the claim should be presumed to be “not entered”.

# Amendments to Claims (From PTO Slide Show)

- Multiple status identifiers must not be used for any single claim.
- Only claims of the status “currently amended” and “**withdrawn**” (**if the withdrawn claims are being currently amended**) **may include markings**.
- All other pending claims (including **withdrawn claims** that are not being currently amended) must be presented in clean text (without markings).

# Amendments to Claims (From PTO Slide Show)

- Any claim presented in clean text (no markings) constitutes an assertion that it has not been changed relative to the immediate prior version, except omitting markings (*i.e.*, underlining, strikethrough, and double brackets) and deleted text.
  - For example,
    - If the immediate prior version of the claim was:  
“Claim 1 (currently amended) A bucket with a blue handle.”
    - The listing of claims in the current amendment must have:  
“Claim 1 (previously presented) A bucket with a handle.”

# Amendments to Claims (From PTO Slide Show)

- Canceled claims and **not entered** claims may only have a “canceled” or “not entered” status identifier after the claim number. The text must not be supplied.
- Grouping of Claims – consecutive canceled claims or **not entered** claims may be aggregated into one line.
  - Examples:      Claims 1-5 (canceled)  
                            Claims 20-25 (not entered)
- New or added claims must have “new” as a status identifier
  - Do not underline the text of the new claims.

# Rule .126 Numbering of Claims

- Original numbering preserved
- Added claims numbered consecutively following highest number
- When ready for allowance, Examiner may renumber or Applicant can request renumbering

# Amendments to Specification

(from PTO slide show)

- The location of the paragraph or section to be deleted or replaced, or where a new paragraph or section is to be added, must be unambiguously identified.
  - The location can be identified by using a few words at the beginning and/or the end of the paragraph or section.
- Do not underline the text of a new paragraph or section.
- Deletion of a paragraph or section must only include an instruction to delete, and the location of the paragraph or section.
- Replacement paragraph or section must be a marked-up version showing the changes.
- A clean version of any replacement paragraph or section must not be submitted in addition to a marked up version, except when applicant submits a substitute specification.

# Substitute Specification

(From the PTO slide show)

## ■ Substitute Specification under 37 CFR 1.125 requires:

- A statement that the substitute specification includes no new matter.
- A specification with markings to show all the changes relative to the immediate prior version.
- A **clean version** (without markings) of the substitute specification.
  - **The requirements of a marked-up version and a clean version have been retained.**

# Amendments to Abstract (from the PTO slide show)

- An amendment to an abstract is treated like an amendment to the specification.
  - If the changes are minor in nature, submit a replacement abstract with markings to show all changes relative to the immediate prior version.
  - If the abstract is being substantially rewritten, submit a new abstract in clean text (no markings) accompanied by an instruction for the cancellation of the previous abstract.
  - Any new, or replacement, abstract must be submitted on a separate sheet (37 CFR 1.72).

# Amendments to Drawings (from the PTO slide show)

- Amendment to drawings must include:
  - **Replacement drawing sheet** showing amended figures which include the desired changes, without markings, on a separate sheet in compliance with §1.84; and
  - **Explanation of the changes** in the remarks, or preferably, in the drawing amendments section, of the amendment paper.
  - **Optional unless required by examiner:**
    - **Annotated drawing sheet** – a marked-up copy of the amended figure(s) with annotations showing the change(s) may be submitted, or required by the examiner.

# Amendments to Drawings (From the PTO slide show)

- Replacement drawing sheet(s) must be identified in top margin as "**Replacement Sheet**".
- Annotated drawing sheet(s) must be identified in top margin as "**Annotated Marked-up Drawings**".
  - This will avoid confusion between a replacement sheet and an annotated sheet.
  - Annotated drawing sheet(s) will not be entered as part of the official drawing(s) for the application.
- The replacement drawing sheet(s) and annotated drawing sheet(s), if any, should follow the last page of the amendment paper, as attachment(s).

# Amendments to Drawings (From the PTO slide show)

- Proposed drawing correction process is eliminated.
- Replacement drawing sheet with changes is accepted by examiner, unless otherwise notified by examiner. No further drawing submission is required.
- If not acceptable, applicants will be notified of any objections or additional requirements.

# Amendments to Drawings (From the PTO slide show)

- Any replacement drawing sheet including amended figures must include all of the figures appearing on the immediate prior version of the sheet.
- The replacement drawing figure must not be labeled as “amended.”
- 37 CFR 1.173 now provides for amending drawings in reissue applications in a similar manner.

# Amendments to Drawings

(From PTO slide show)

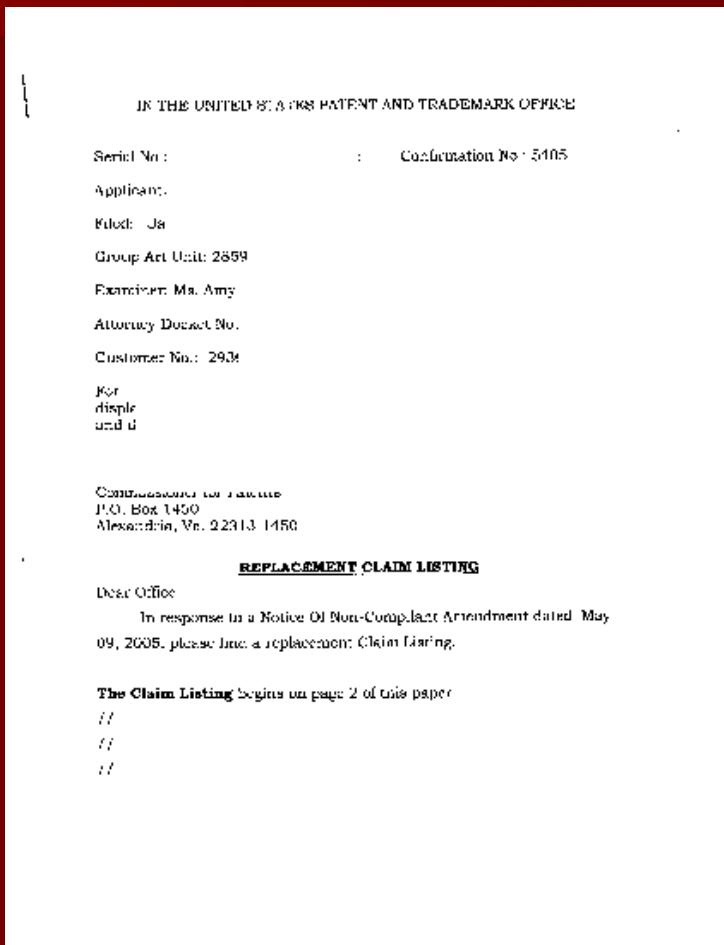
- Deletion of a figure requires the following:
  - An instruction to delete the figure;
  - A replacement sheet which does not include the canceled figure, unless no other figure is on the same sheet as the canceled figure;
  - Amendment to the specification to make corresponding changes to the description of the drawings (*e.g.*, deletion of the description of the canceled figure); and
  - If other figures need to be renumbered, those figures also need to be amended with revised figure numbers via replacement drawing sheets.

# Failure to Adhere to These Standards Will Result in a Notice of Non-Compliant Amendment

More Details to come later in this presentation

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# The Non-compliant Portion of the Amendment has to be redone and resubmitted



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# Treatment of Non-Compliant Amendments (From PTO Slide Show)

- Applicants will be notified of any amendment paper that is not accepted because the changes do not comply with revised §1.121.
  - For **preliminary amendments and replies to non-final Office actions or notices**,
    - A Notice of Non-Compliant Amendment identifying the problem section(s) will be mailed; and
    - A period for reply shall be given; but
    - Patent term adjustment (PTA) reductions may be incurred. See §1.704(c)(7).
  - For **after-final amendments**,
    - Non-compliance will be indicated in an advisory action; and
    - The time period for reply continues to run from the mailing date of the final Office action.
  - See MPEP 714.03 (8<sup>th</sup> Ed. 1<sup>st</sup> Rev., Feb. 2003).

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## Treatment of Non-Compliant Amendments (from PTO slide show)

- The Notice of Non-Compliant Amendment will identify:
  - Each section of the amendment that is not in compliance with 37 CFR 1.121;
  - Items that are required for compliance; and
  - The reasons why the section of the amendment fails to comply with 37 CFR 1.121.
- In reply to the Notice, applicants must submit the **corrected section of the amendment** that was non-compliant.
  - Re-submission of the entire amendment is not required.
  - The entire section, however, with corrections, must be resubmitted.
- The Office will only enter the sections of the amendment that are in compliance with 37 CFR 1.121.

# Example (from PTO slide show)

- Non-compliant claim amendment example:
  - If an amendment includes:
    - (1) amendments to the specification, and
    - (2) amendments to the claims, including adding new claims 21 – 25,
  - But the amendments to the claims were non-compliant,
  - Because the claim listing did not include a status identifier for each claim,
  - A Notice of Non-Compliant Amendment will be mailed.

# Example (Continued) (From PTO Slide Show)

- Non-compliant claim amendment example continued:
  - In reply to the Notice, applicant must submit a **corrected claim listing** that includes a status identifier for each claim.
  - The new claims 21-25 must be presented with the status identifier of “new” and the text of the claims not underlined.
    - Note: the new claims 21-25 must not be presented with the status identifier of “not entered” and must not be renumbered as claims 26-30.
  - A non-compliant amendment is different than an unentered after final amendment situation.
  - In the after final situation, the claim numbers of any unentered new claims may not be re-used.

# Example (Continued) (From PTO Slide Show)

- Non-compliant claim amendment example  
continued:
  - The Office would enter:
    1. The amendments to the specification from the original amendment paper, and
    2. The amendments to the claims that include the corrected claim listing from the paper filed in reply to the Notice.

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# Rule .127 - Petition Refusal To Admit Amendment to the Commissioner

- Its an option
- See, Rule .181

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# Rule .115 Preliminary Amendment

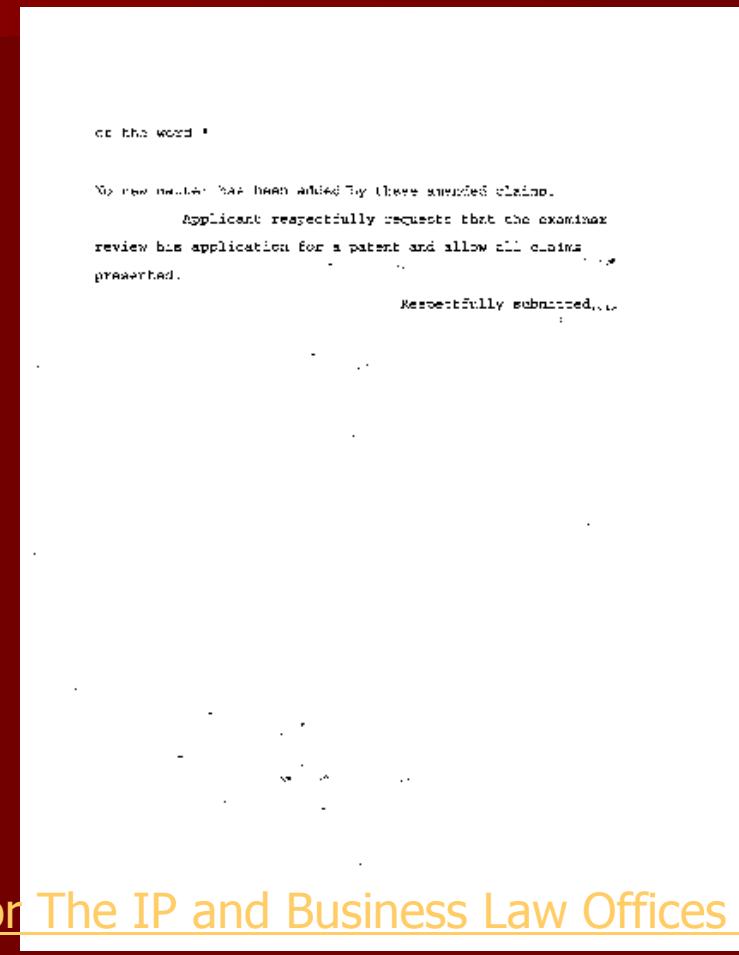
- Subpara (a) Amendment before first Office Action
- Subpara (b)(1) Accepted unless unduly interferes with the preparation of an Office Action
- Subpara (b)(2) 3 month from filing “safe harbor” of mandatory acceptance

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# Example of a Preliminary Amendment

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# Example of a Preliminary Amendment



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# Rule .111 Reply to a Non-Final Office Action

- Subpara (a)(1) Time Period per Rules .134 - .136 (see next slides)
- Subpara (a)(2) Supplemental Reply will be entered unless interferes with the preparation of an Office Action
- Subpara (b) Must be written; point out supposed error; reply every ground of objection and rejection; arguments of distinction over reference specifically pointing out claim language and may request the objections to form be held in abeyance until allowance

## Rules .134 and .136 Time Period and Extensions

- Rule .134 - Up to Six months by statute
- Rule .134 - PTO allowed to shorten the statutory period (typically three months)
- Rule .136(a)(1) Petition and fee extension
- Rule .136(a)(1) up to 6 months or 5 months after due date, which ever is less
- Rule .136(a)(1) Except, notified no extensions, reply brief, interference

# Rule .136 Time Period and Extensions

- .136(a)(2) Date petition filed with fee is date for determining extension
- .136(a)(3) application to treat any current or future reply as incorporating a petition
- .136(a)(3) Authorize to charge fees constitutes a constructive petition
- .136(a)(3) submission of fee constitutes a constructive petition
- .136(b) If Rule .136(a) is not available, then there needs to be a showing of sufficient cause

# Overcoming 102 Rejections (Anticipation)

(See MPEP 706.02(b))

- 102(a) and 102(e)
  - Claim patentably distinguishable
  - Amend to be patentably distinguishable
  - .131 Declaration for priority (see next slides on swearing behind a reference)
  - .132 Not by another
- 102(b)
  - Claim patentably distinguishable
  - Amend to be patentably distinguishable
  - Amend to claim priority

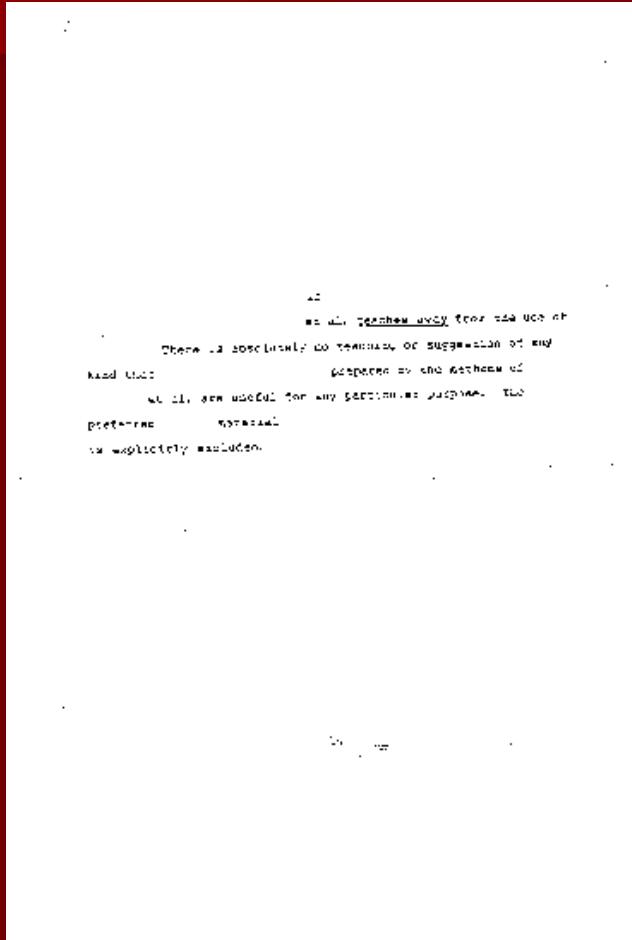
# Arguments Against a 103 Rejection-No incentive to combine the references because (a) impermissible hindsight (b) Applicant discovered a new property of nature, (c) unrelated references

The applicant respectfully traverses these objections. The applicant submits that the cited references do not make obvious either the concrete invention of claim 21 or the concrete materials recited in claims 1-20. The cited references merely disclose various elements found in applicant's invention. There is no teaching or suggestion of any reason or incentive why it would be advantageous to combine these various elements to form applicant's unique invention and concrete. The applicant contends that in the absence of such teaching or suggestion it would not be obvious to one of ordinary skill in the art to exTRACT individual elements from the various references and combine them to form applicant's invention. Only after being educated by applicant's disclosure would one of ordinary skill in the art realize the value of combining the various elements in the manner taught by applicant.

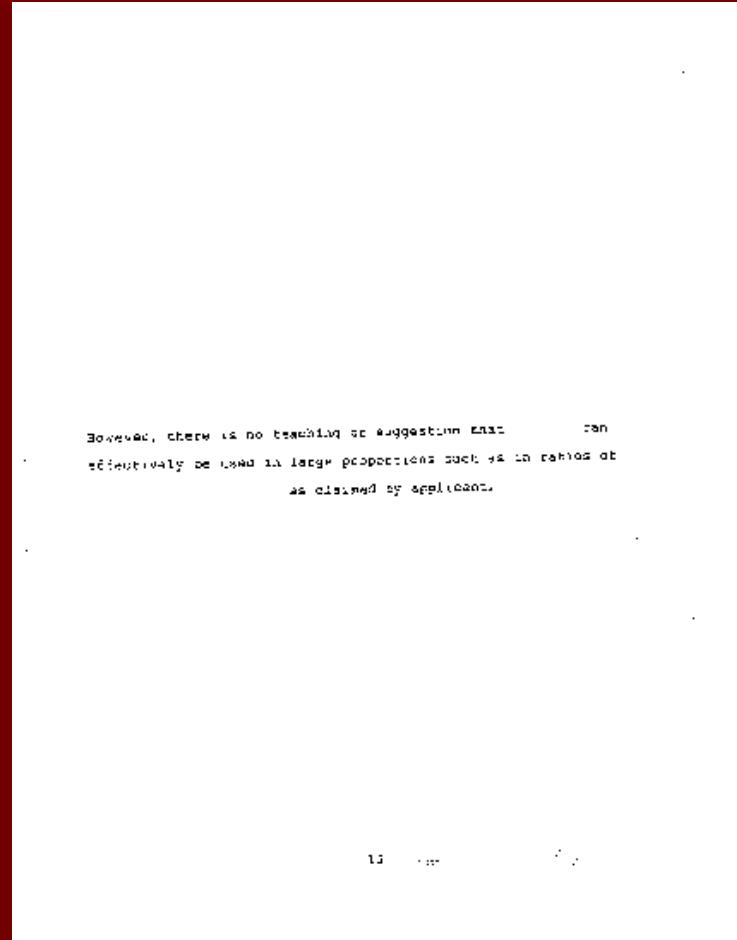
It is the lack of knowledge of these facts which make the invention material recited in claim 21 unobvious to those of ordinary skill in the art. It was the discovery of these facts by the applicant which first provided the incentive to produce the invention.

Applicant strongly contends that one of ordinary skill in the art could not have found the invention obvious by reading the references cited by the Patent Office. Such references are almost totally unrelated to each other and there is no teaching or suggestion in any of them as to what one is trying to produce a combined them in just the right way to produce applicant's unique invention.

# Arguments Against a 103 Rejection-No incentive to Combine the references because, (d) reference teaches away



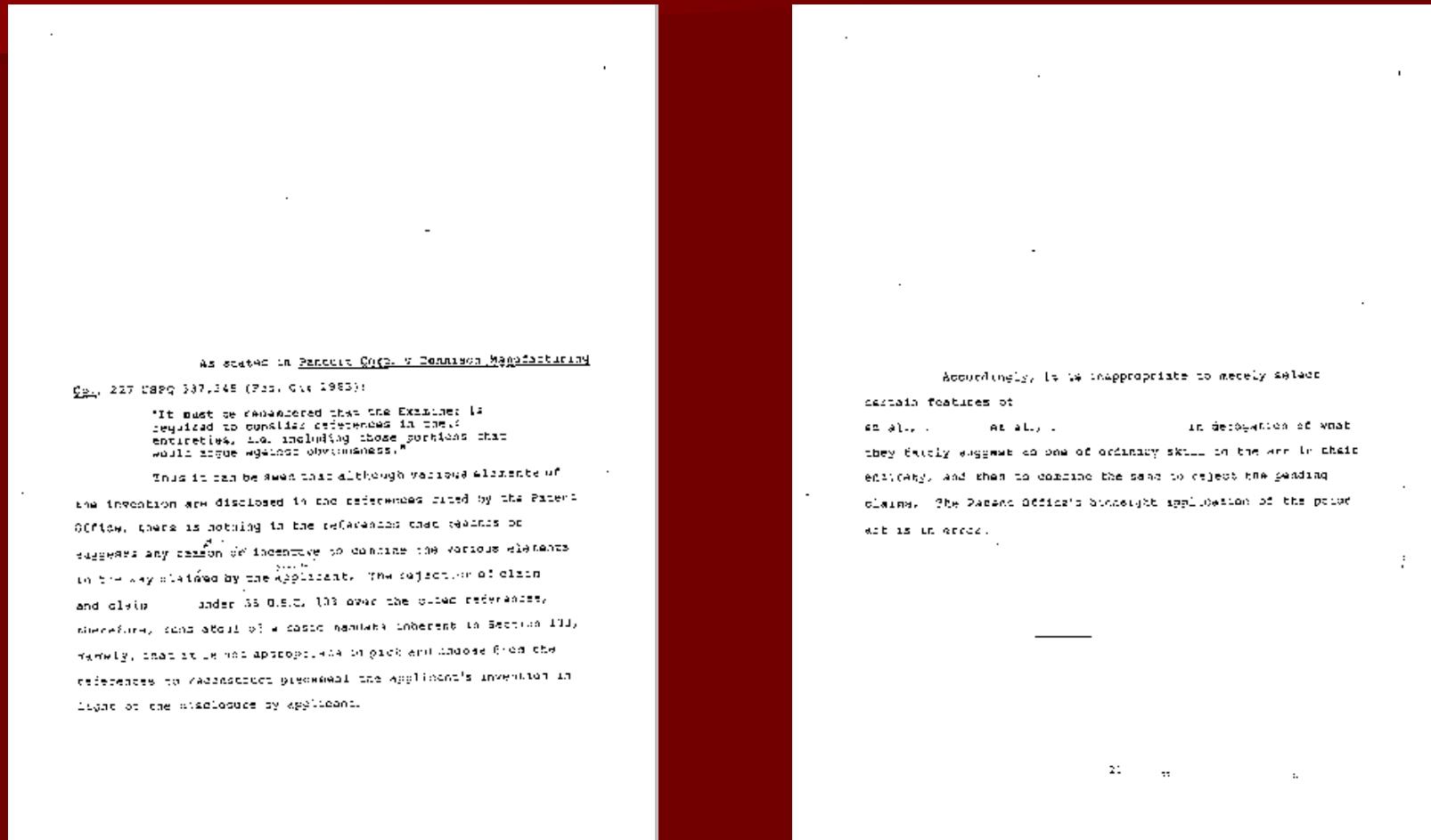
42  
no one teaches away from the use of  
there is absolutely no teaching or suggestion of and  
kind that  
prepared by the methods of  
it is, not useful for any particular purpose. The  
preference  
is explicitly excluded.



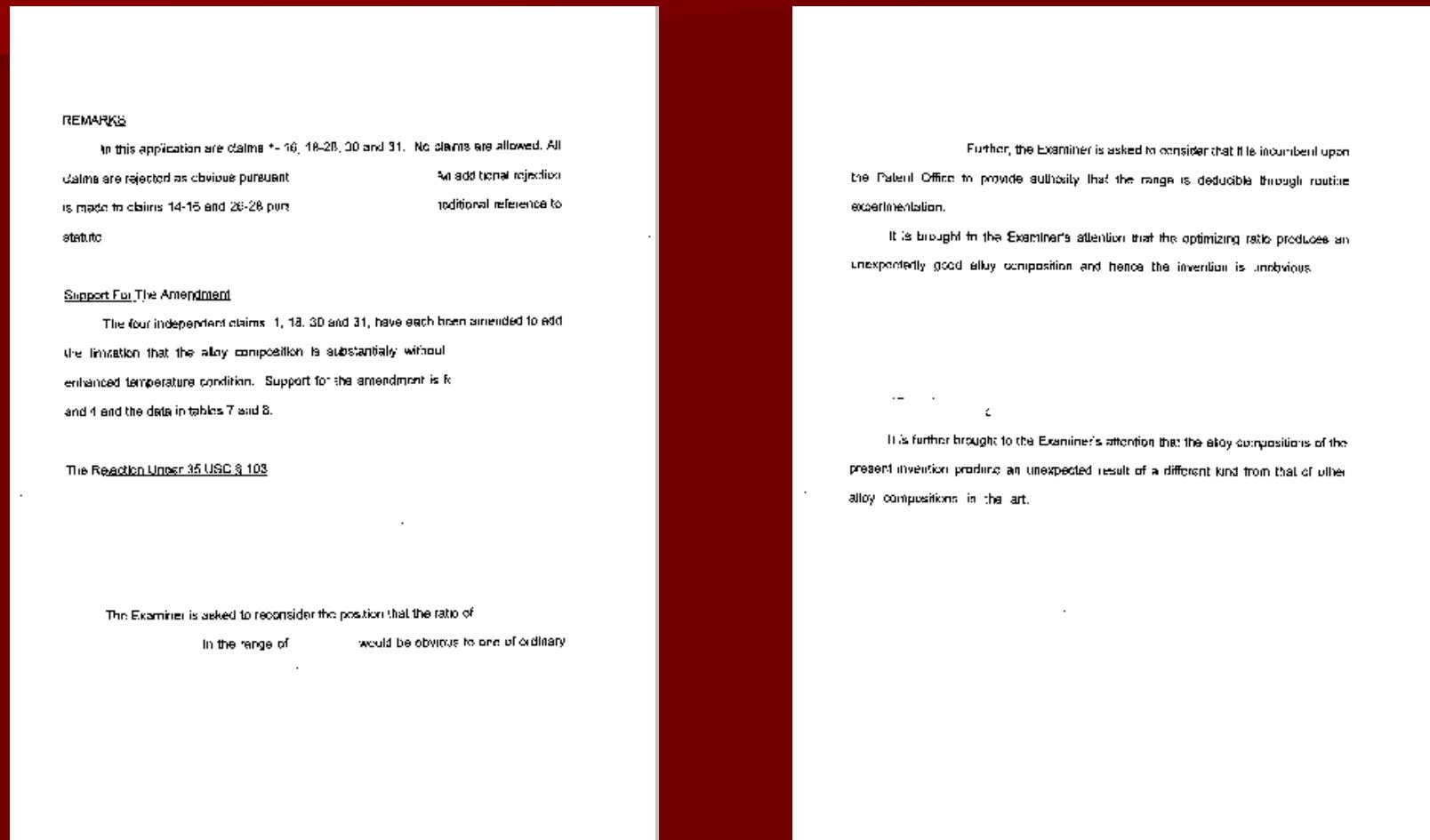
Borrowed, there is no teaching or suggestion that can  
efficiently be used in large proportions such as in ratios of  
as claimed by applicants.

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# Arguments Against a 103 Rejection-No incentive to Combine the references because, (e) picking and choosing elements from the prior art



# Arguments Against a 103 Rejection that the invention is the product of routine experimentation/optimizatin – (a) examiner bears the burden of proof, (b) unexpected result



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# Rule .130 Affidavit to Disqualify a Commonly Owned Patent

- A 103 rejection that is not a 102(b) rejection
- Not identical; but not patentably distinct inventions
- Owned by the same party
- Terminal disclaimer (see, rule .321)
- Declaration commonly owned and the inventor named in the application is the prior inventor under 35 USC 104 (invention made abroad)

# Rule .131 Affidavit of Prior Inventorship

- Claim rejected based on a reference
- A declaration of prior inventorship with documentation (can show prior conception and due diligence in reduction to practice)
- The date of the reference is the publication date or the 102(e) date, whichever is earlier
- Inventorship must occur in the USA, a NAFTA country or a WIPO country
- Not apply if it is the same invention (see, interference) or there is a statutory bar

# Rule .132 Affidavit Traversing Rejections or Objections

- Any Evidence
- Used to supply experimental data of utility, superior result, unexpected result
- Used to supply secondary factors of non-obviousness; e.g., sales

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# Rule .133 Interview with an Examiner

- Informal telephone discussions
- Call Examiner to arrange a time for a formal interview
- Subpara (a)(1) At office during office hours; in person, by telephone or T-1 line video (go, San Jose library)
- Subpara (a)(2) not before first Office Action; Except in a Continued Application
- Identify claims and prior art for discussion
- Subpara (b) a written record required
- Subpara (b) does not relieve responding to an Office Action
- Strategy – fax over proposed amended claims for discussion

## Rule .112 Reconsideration Before Final Action

- Process repeats itself
- The Application again examined by PTO
- Notified by an Office Action
- Reply to such Office Action
- The PTO's Practice is to make the Second Office Action a Final Rejection (see next slides regarding what this is and how to continue prosecution)

# Rule .113 Final Rejection

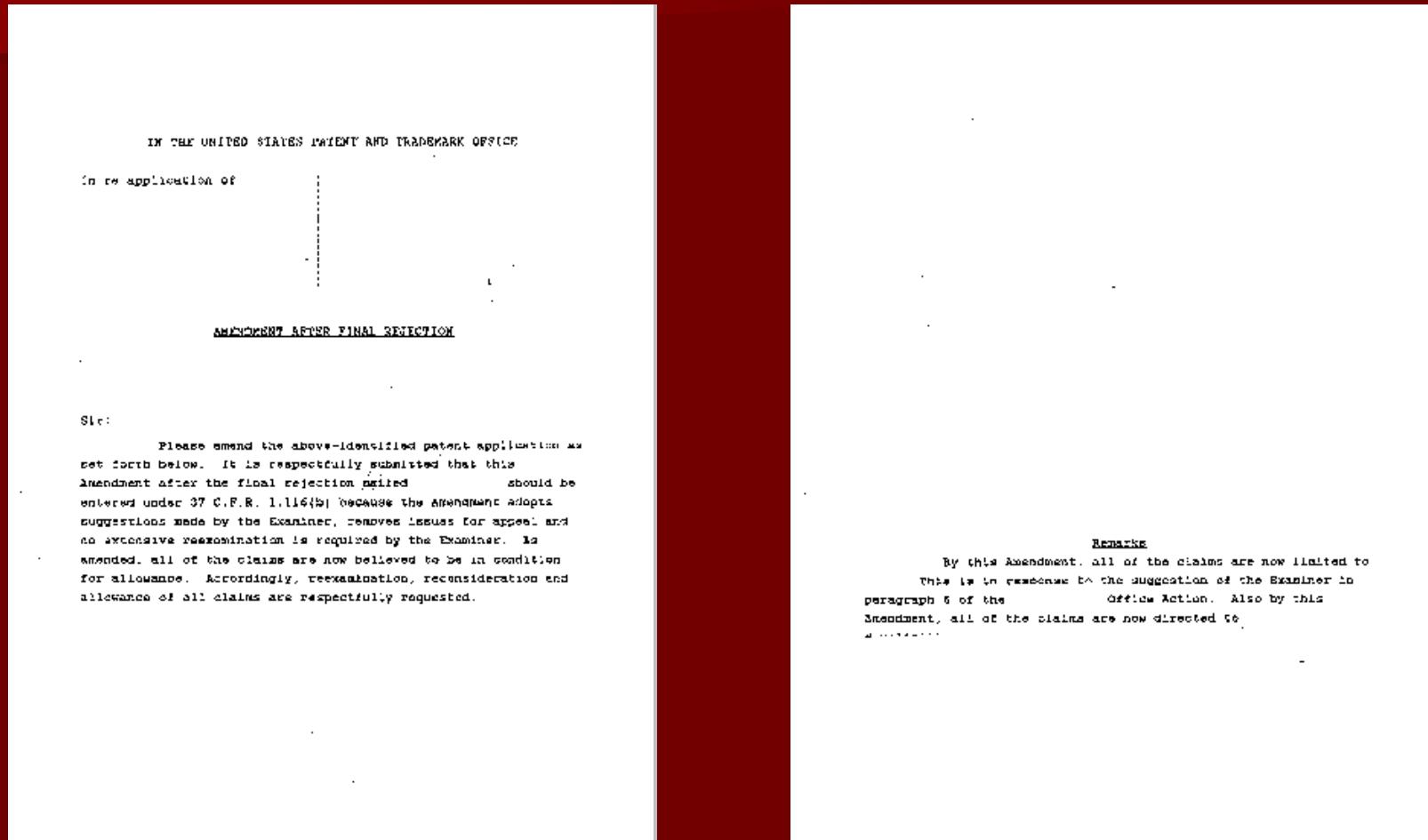
- Subpara (a) On Second or subsequent (policy is second action Final)
- Subpara (a) Options are to:
  - After Final Amendment (see next slides)
  - Appeal to BPIA (Rule .191)
  - Request For Continued Examination (RCE) (Rule .114) (see next slides)
  - Petition to Commissioner (Rule .181) regarding objections or requirements
- Subpara (c) Cancel or Appeal Rejected Claims
- Subpara (c) As for allowed claims, comply requirements and objections as to form (i.e., graduate to Allowance)

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# Rule .116 Amendment After Final or Appeal

- Subpara (b) cancel claims, comply requirements of form
- Subpara (b) amend to present rejected claims in a better form for appeal
- Subpara (b) does not relieve from appealing or save from abandonment
- Subpara (c) Amendment touching on the merits, may be admitted for good cause
- Subpara (d) no amendment as of right in appealed case

# Example of an After Final Amendment



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# Example of an After Final Amendment

Rejection Under 35 U.S.C. 103

All of the claims are rejected under 35 U.S.C. 103 as being unpatentable over the references of view of the references of

1

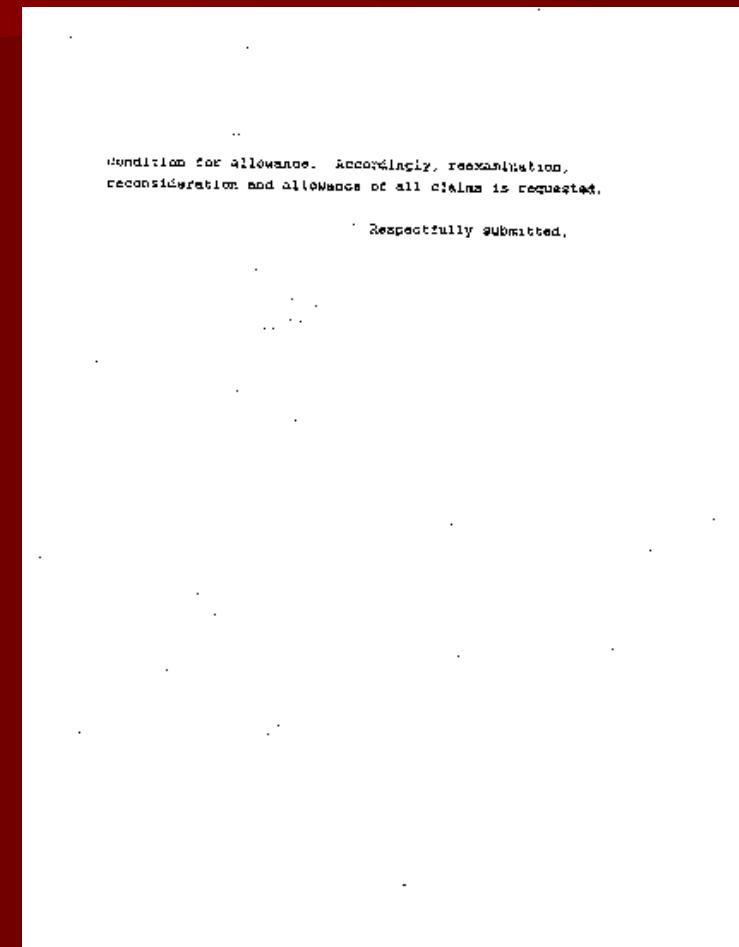
It is respectfully submitted, however, that as amended, all of the claims are now patentable over these references. Accordingly, reexamination, reconsideration and allowance of all of the claims are requested.

Conclusion

For the reasons set forth above, applicant respectfully request that this Amendment be entered. By this Amendment, it is submitted that all of the claims are now in

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# Example of an After Final Amendment



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# After Final Amendments

(From PTO Slide Show)

- Any amendment after final (§1.116), or amendment filed with a request for continued examination (RCE) under §1.114, must include markings showing the changes relative to the last entered amendment.
  - Do not include markings to show changes relative to any unentered amendment.
  - Applicant should not assume that an after final amendment is entered because after final amendments are not entered as a matter of right (§1.116).

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# After Final Amendments (Continued)

- If applicant has not received an advisory action, applicant should check via PAIR, or call the examiner, to determine whether the after final amendment has been entered before filing another after final amendment or an amendment with an RCE.
- If the advisory action has indicated that an after final amendment will be entered upon the filing of an appeal, applicant should assume that the after final amendment is not entered.
  - Any subsequent amendment must include markings showing the changes relative to the last entered amendment, and not the amendment which the advisory action indicated will be entered upon the filing of an appeal.

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# After Final Amendments (Continued)

- If applicant wishes to file an RCE after filing more than one after final amendment that has not been entered, applicant is encouraged to file an amendment with the RCE that includes:
  - Instructions not to enter the unentered after final amendments; and
  - All of the desired changes, including changes presented in the unentered after final amendments.
    - The markings must show changes relative to the last entered amendment.
    - A claim listing which includes any unentered claims presented using the status identifier “not entered” (e.g., claims 20-25 (not entered)).
    - Any new claims must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not).

# Rule .127 - Petition Refusal To Admit Amendment to the Commissioner

- Its an option
- See, Rule .181

## Rule .114 Request For Continuing Examination

- Subpara (a) Prosecution is closed
- Subpara (b) Prosecution is closed when Appeal, Final Action (.113) or Notice of Allowance (.311)
- Subpara (a) Pay a fee before issue (unless petition to withdraw issue .313); abandonment; Appeal to CAFC or suit under 35 USC 145, 146
- See subparas (c), (d) and (e)

# RCE Form

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# International Applications (From PTO Slide Show)

- The revised amendment practice under 37 CFR 1.121 does not apply to amendments filed in the international stage of an international application.
  - Such amendments must be in compliance with the Patent Cooperation Treaty (PCT) amendment procedure (*i.e.*, PCT Articles 19 and 34(2)(b)).
  - Thus, status identifiers are not to be used during the international stage.
- Amendments filed in the national stage (pursuant to 35 U.S.C. 371) of an international application must comply with the revised amendment practice under 37 CFR 1.121.
  - The status identifier “original” must only be used for claims that were presented on or before the international filing date and have not been modified or canceled.

# *Information Contacts* (From PTO Slide Show)

- Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA):

Call (703) 305-1616,

e-mail to [PatentPractice@USPTO.gov](mailto:PatentPractice@USPTO.gov), or

Contact one of the following Legal Advisors:

Elizabeth Dougherty ([elizabeth.dougherty@uspto.gov](mailto:elizabeth.dougherty@uspto.gov))

Eugenia Jones ([eugenia.jones@uspto.gov](mailto:eugenia.jones@uspto.gov))

Joe Narcavage ([joseph.narcavage@uspto.gov](mailto:joseph.narcavage@uspto.gov))

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