

# THE PATENT CHESS GAME... PROSECUTION

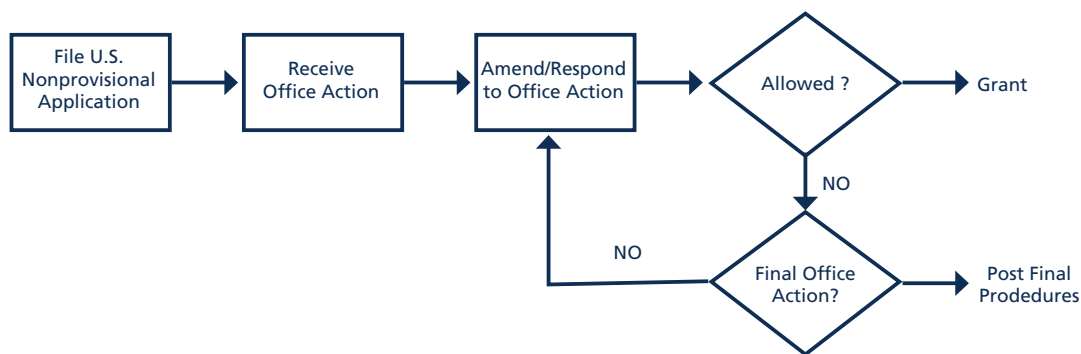
BY DAVE S. CHRISTENSEN



DAVE S. CHRISTENSEN

So, your patent application has been prepared. What comes next? Once some forms are completed, the application is filed at the U.S. Patent and Trademark Office (USPTO), typically via their electronic filing system. Much like a chess match, prosecuting a patent application requires patience, the ability to think ahead, and stamina.

An overview of the initial domestic application (in this case to the USPTO) is shown below. The patience requirement starts at filing. Other than some administrative communications, it is likely that you will not hear anything substantive from the examiner for 18 to 24 months, depending on the technology area (this can be even longer in the software technology groups). During this time, the application goes through an initial review to make sure that the basic requirements have been met. If your invention is related to a national security topic, an additional review may be performed that could further delay processing (and hopefully not result in a secrecy order).



During this initial processing the application is also assigned to a technology group that focuses (more or less) on the technology being claimed. At some point, it is assigned to an examiner. The time until your application is examined will depend on the workload of the examiner. Generally, this is between 14 and 24 months. As of September 2021, the official pendency is 16.8 months to the first action. At this time the applicant receives what is known as an Office Action. The Office Action is a document prepared by the patent examiner that represents their position (and that of the USPTO) regarding the patentability of the claims of the patent application. It is important to remember that the examiner is not judging the

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invention, but rather comparing the claims of the patent application to a set of rules. While there are many requirements for patentability, the most common rejections or objections raised by the examiner are:

- Utility/Abstractness (35 U.S.C. § 101)
- Clarity/Indefiniteness (35 U.S.C. § 112)
- Novelty (35 U.S.C. § 102)
- Obviousness (35 U.S.C. § 103)

Utility/Abstractness test under 35 U.S.C. § 101 is either a nonissue (mechanical technologies) or a huge issue (software technology, and to a degree biotechnology). Other people can comment on the biotechnology issues under 35 U.S.C. § 101, but the electromechanical and software arts were thrown into turmoil when the U.S. Supreme Court issued an opinion in *Alice Corp. v. CLS Bank International* (573 U.S. 208), which is lovingly referred to as *Alice*. Under *Alice* and its progeny, claims that are considered abstract are not patentable, including claims directed to laws of nature. As of the time of this writing, most patent practitioners have developed ways to avoid *Alice* rejections. If your invention involves software, make sure you discuss the technical effects of your invention with your patent attorney and that those advantages are clearly articulated in your application. Examples of technical effects include improving the speed of a processor, reducing the amount of space used on a hard-drive, or increasing the fuel mileage of a vehicle. Generally, the more “real-world” impact (technical effect) that you can articulate, the better your chances of overcoming a 101 or *Alice* rejection.

The clarity/indefiniteness test typically is a result of using relative language. It must be clear from the

words of the claim whether an accused product is infringing. So, if your claim uses a relative term, without defining it, then the examiner may find the claim to be indefinite. Indefiniteness can also be found when the same term is used for multiple elements. Generally speaking, rejections under 35 U.S.C. § 112 can be fixed by rewording the claim.

The two “real” tests for patentability are novelty and obviousness. A novelty test means that the claimed elements of the invention are new. In other words, there are no prior art references that describe all of the elements of the claim in the manner claimed. In practice, the examiner has to find all of the elements in a single prior art reference. The novelty test is a very objective test. Either the elements are in the reference or they are not. A single difference between the claim and the reference is enough to defeat a novelty rejection. Generally, novelty rejections can be worked around unless someone has invented the same exact invention prior to you.

The area we spend the most time on during prosecution is combating obviousness rejections. In an obviousness rejection, an examiner is saying that one of ordinary skill in the art would find the elements of your claim obvious in view of one or more prior art references. In other words, if a skilled person read the references cited by the examiner, they could arrive at the claimed invention. This test is subjective, and examiners commonly take artistic liberties with their rejections. Arguing against these rejections can require careful reading of the prior art references and determining if the references actually teach what the examiner states. Can these references actually be combined in the manner the examiner argues? Or if combined, would the prior art reference fail to operate in the manner claimed?

Of all the rejections, obviousness rejections take the most time.

So, you have received the Office Action. Is that the end? No, receiving your first Office Action with all your claims rejected is like losing your first pawn in chess: the game is just beginning.

After reviewing the rejections, an applicant has a number of options. If the applicant thinks that the examiner is wrong, a response can be filed explaining to the examiner the errors in the rejections. These arguments can be legal (the arguments don't meet the legal obligations required to reject) or technical (combining the references in the manner stated by the examiner wouldn't work). Often, however, the examiner's rejections have some merit or arguably have merit. In this case, the claims may be amended to clarify what the applicant is trying to protect.

Often the issue comes down to how terms of the claim are interpreted, with the examiner construing words in ways not intended by the applicant. This happens because the examiners are trained to construe words using the "broadest reasonable interpretation." As a result, the examiner can find prior art not considered by the applicant. By amending the claims, the applicant can distinguish their claims from the teachings of the prior art.

Regarding amendments, the one requirement to keep in mind is that the amendment must be supported by the specification or drawings. Once the application is filed, no new matter or information may be added. This is one of the reasons that a properly prepared application is very important. In a later article, we will discuss prosecution in non-U.S. jurisdictions, where the preparation and words of the specification are

critical. Fortunately, the U.S. practice is a little more liberal, which allows us some flexibility in the amendments.

It should be appreciated that an amendment or response may include additional changes or arguments not covered above. For example, the examiner may object to the specification or drawings on formality issues. The important thing is that each and every objection or rejection needs to be addressed and argued against/traversed. Otherwise, the amendment will be considered non-responsive and not considered by the examiner.

Once the response or amendment is prepared and filed, it is forwarded to the examiner for consideration. The examiner may perform additional searches (if the claims are amended) and consider the arguments made by the applicant. At the end of this analysis the examiner may issue another Office Action (typically referred to as a "Final Office Action") or a Notice of Allowance. If the Notice of Allowance is issued, all is great. This means the examiner has found all of the claims patentable and the application will be granted once some fees and formalities are addressed.

If the examiner issues a Final Office Action, all is not lost. Depending on the strength of the rejections it may be like losing your queen or a rook. It's not where you want to be, but the game is not over. Despite the name, a "final" office action is not the end. There are procedures for extending prosecution and continuing the negotiations with the examiner.

Before we end this initial look at patent prosecution, there are a couple of things to note. The strategy for responding to office actions depends on the applicant's strategy. Does the

applicant want a patent quickly and is willing to give up claim scope to achieve it? For example, do they want to show investors that they are putting their money to good use and that they should invest more? If so, prosecution can be shortened (and costs reduced) by filing or amending the claims to be narrower. Or, does the applicant want a broad patent? Then amending the claims is avoided or minimized, which means there may be more back and forth with the examiner. This could result in broader claims, but the cost in achieving them can be high.

If broad claims are desired, patience may be required. Broader claims generally require few or no amendments. As we discuss next, there are a number of options available to the applicant once the “final” office action is received. When broad claims are needed, we often have to go through one or more of these processes to achieve our results.

That’s it for now. In the next article we will discuss what happens after the final office action.

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**Dave S. Christensen** is a Partner and Co-Chair of the Mechanical Engineering Department at Cantor Colburn LLP  
e: [dchristensen@cantorcolburn.com](mailto:dchristensen@cantorcolburn.com)



[www.cantorcolburn.com](http://www.cantorcolburn.com)

Hartford, CT | Atlanta, GA | Washington, D.C. | Houston, TX | Detroit, MI  
860.286.2929 | 404.607.9991 | 703.236.4500 | 713.266.1130 | 248.524.2300