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

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
The Law on making Amendments is found at 37 CFR 1.121 (other rules on specific practices)

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.
Appendix to the Specifications

Please replace paragraph [0074] with the following amended paragraph:

[0074] In the construction of the body of this invention, various materials have been selected [and] while a number of diverse properties [1] are allowed to vary as needed in this case. For example, sections of the bucket can be made of a suitable polymer plastic material. Where an aesthetic appeal is desired, the bucket can be made of one of many attractive colors. The following listing of properties serves to define possible uses for the bucket.

Please replace paragraph [0145] with the following amended paragraph:

[0145] Figure 1 displays a bucket of the invention. As can be seen from the drawing, the handle is attached to the upper lip of the structure and connected at points diametrically opposite each other on the circumference.

Please add the following new paragraph after paragraph [0073]:

[0075] An optional feature of the invention is the addition of a detachable, inflatable cover to the bucket to provide protection for any contents which might be exposed. The covering 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 2, which starts with “Under normal circumstances.”
Amendments to the Claims:

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

List of Claims:

Claims 1-5 (cancelled)
Claim 6 (previously presented): A bucket with a handle.
Claim 7 (cancelled): A handle comprising an elongated wire.
Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.
Claim 9 (current): A bucket with a good balance.
Claim 10 (revised): The bucket of claim 9 wherein the handle is made of wood.
Claim 11 (withdrawn)
Claim 12 (cancelled)
Claim 13 (cancelled): A bucket with plastic sides and bottom.
Assumption to the Drawings:

The master sheet of drawings includes changes to Fig. 7. This sheet, which includes Fig. 8, replaces the existing sheet including Figs. 1-2. In Figure 2, previously cited element 1 has been modified.

Attachment: Replace your sheet

Amended Sheet Showing Changes
REMARKS

In the specification, the paragraphs [0021] and [0045] have been amended to correct minor editorial concerns. The new paragraph [0051] added after paragraph [0050] discusses in greater terms the features taken from Example 4.

In amended Figure 7, the previously omitted element numeral 13 has been added.

Claims 6-10 and 12-3 remain as this application. Claims 1-5 and 11 have been cancelled. Claims 7 and 8 have been withdrawn.

The examiner has acknowledged that claims 6 and 9-10 are considered allowable subject matter. Claim 7-8 has been withdrawn as the result of an earlier rejection requirement. Claim 11 adds an additional feature not Example 2 in the specification.

In view of the examiner's action on requirement to prosecute, applicant wishes to request that application No. 7-8 be treated as a divisional application.

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

Respectfully submitted,

SMITH, JONES & BROWN

[Signature]

[Address]

[Date]
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.

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
Markings to Show Changes:

- The following must include markings to show all changes relative to 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.
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”.
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-through strikethrough”
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 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.
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.
Six (6) 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”.

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
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).

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
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

- 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 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.
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).

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
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.
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

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
The Non-compliant Portion of the Amendment has to be redone and resubmitted.
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.

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

- Its an option
- See, Rule .181

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
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

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
Example of a Preliminary Amendment

RETURN TO HOME PAGE FOR THE IP AND BUSINESS LAW OFFICES OF HOWARD L HOFFENBERG
Example of a Preliminary Amendment

No new matter has been added by these amendments. Applicant respectfully requests that the examiner review the application for a patent and allow all claims.

Respectfully submitted,

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Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
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, whichever 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
Arguments Against a 103 Rejection - No incentive to Combine the references because, (d) reference teaches away
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/optimization – (a) examiner bears the burden of proof, (b) unexpected result

**Support for the Amendment**

The four independent claims 1, 12, 23 and 31, have each been amended to:

- **Examiner bears the burden of proof**
- **Unexpected result**

The Examiner is asked to reconsider the position that the claim is

In the range of

would be obvious to one of ordinary.
Rule .130 Affidavit to Disqualify a Commonly Owned Patent

- A 103 rejections 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
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

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
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)
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

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

To Whom It May Concern:

Please amend the above-complified patent application as
and in accordance with 37 C.F.R. 1.121(a) because the amendments
sufficiently addressed by the Examiner remove issues for appeal.
An rejection is required by the Examiner, as

Submitted, all of the claims are new and added to
in compliance with 37 C.F.R. 1.116(a).

An amendment to the Claims is required by the

Remar: The claims are new and added to
in response to the amendments of the Examiner in

the Office Action. Also, the amendment, all of the claims are new and added to

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
Example of an After Final Amendment

Rejection Notice as 35 U.S.C. 133

All of the claims are rejected under 35 U.S.C. 133 as being unpatentable over the references of

view of the references of

It is respectfully submitted, however, that as amended,

all of the claims are now patentable over these references,

duly amending, cancelling, renumbering and redefining all

of the claims as requested.

For the reasons set forth above, applicant

respectfully requests that this application be entered. By this

Amendment, it is submitted that all of the claims are now

patentable.

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
Example of an After Final Amendment

[Document content]

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
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).
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.
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

Return to Home page for The IP and Business Law Offices of Howard L Hoffenberg
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)
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.
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, or
- Contact one of the following Legal Advisors:

  - Elizabeth Dougherty (elizabeth.dougherty@uspto.gov)
  - Eugenia Jones (eugenia.jones@uspto.gov)
  - Joe Narcavage (joseph.narcavage@uspto.gov)