Prosecution Issues: United States

Christopher J. Palermo



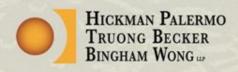
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Overview

- Information Disclosure Statement (IDS) management
- Breaking infinite loops of Office actions and citations
- Avoiding Request for Continued Examination (RCE) time lags
- Acceleration
- Hot topics –IT process claims after Alice v. CLS Bank and its progeny



IDS Management

Challenges:

- Large families of cases in related technology;
- Multiple agents in different jurisdictions;
- 3-month time limit (from knowledge to filing) under US rules;
- Soft standards expressed in US rules about whether a reference actually needs to be cited in a particular case;
- Study has shown that applicant citations have little effect on Examiner behavior; so the goal is to avoid accusation of "reckless disregard" of materiality



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IDS Management

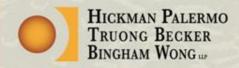
Responses:

- Consistent case numbering across jurisdictions
- Database or matrix to track relationships between cases with "substantially similar" <u>claims</u>; establish relationships at case inception
- Central database, or at least spreadsheet, of all references
- Early and consistent instructions to all agents to report receiving references
- Negotiate a fixed fee with US agents/attorneys

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Examination – Infinite Loops

- Why does this happen?
 - Predominant focus on protection of the public interest
 - USPTO "image issues"
 - Scheme for evaluating productivity of examiners provides an easy incentive to reject
 - USPTO rules justify a new rejection and/or new citation whenever the applicant amends a claim



Examination – Infinite Loops

- Tactics
 - Original drafting include multiple independent claims of varying scope, and place the narrowest of those as Claim 1.
 - Do not take time extensions; reply within two months of action date.
 - At some point, cease materially amending any claim.



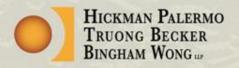
Examination – Infinite Loops

- Tactics
 - Early and regular examiner conferences (interviews):

Pre First Office Action Interview Pilot Program

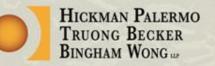
Ordinary interview – after non-final Office action

After Final Examination Pilot Program 2.0



Avoiding RCE Time Lags

- Virtually never attempt a reply, after "final" action, that does not amend the claims
- Interview
- Use "After Final Examination Pilot Program 2.0". Requires identifying a claim amendment that actually narrows at least one claim, but not so much as to justify a new prior art search by the examiner.



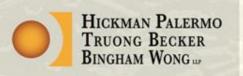
Acceleration

- Track 1 Prioritized Examination
- No time extensions
- Pre First Office Action Interview Program
- After Final Examination Pilot Program 2.0
- PPH
- Petition to Make Special, with Examination Support Document(s)
- Spectrum of claims, realistic claims

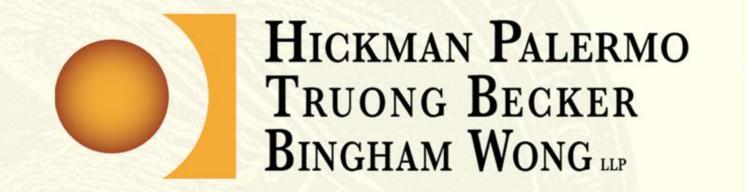




- Is any IT-related process claim eligible after Alice v. CLS Bank and its progeny?
- Examination issues
- Drafting tips



Christopher J. Palermo cpalermo@h35g.com Tel. 001.408.414.1202



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