

# Prosecution Issues: United States

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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



# IDS Management

- **Responses:**
  - Consistent case numbering across jurisdictions
  - Database or matrix to track relationships between cases with “substantially similar” claims; 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



# 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**



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# 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



# Hot Topics

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



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