

# U.S. Prosecution

*For Maximum Value*

*Presented to our CIPS and HKIPS Colleagues by:*

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# The Purpose of Patenting:

*What will Your Client Need in 5, 10, 20 Years?*

● What is Most Likely (now) to Have Been (in hindsight) Efficient?

● Good patents should:

**3) Deter competitors; and therefore must**

**2) Command respect in licensing; and so must**

**1) Be solid enough to withstand litigation.**

- **Claims should prevent design-around.**
- **Specification should suggest modifications.**
- **Cite a good collection of Prior Art!**
- **“Clean” Prosecution History!**

# Professional Cooperation:

- Get the Most Benefit from your U.S. Attorneys' Skills
  - Often at No Extra Cost or Delay
- Baseline Procedures and Deadlines  
(with some cushion)
- Invite Suggestions

# The First Decisions

The most difficult decisions occur before prosecution:

- Whether to file at all?
- Whether to file PCT/Foreign applications?
- Which Foreign Countries?

The remaining decisions are much easier!

# Completing U.S. Filing

- Improvement of Claims: the most valuable service of U.S. Attorneys.
- Identify the best prior art you know of, for submission to the U.S. Patent Office.
- Ask your U.S. Attorney to review disclosure for adequate support.
  - Add updated results if available.
- \$\$ Consider whether to Accelerate.
  - US and EU permit this.

# First Office Action

*(After 1-3 years)*

- A fast assessment by your U.S. attorney can be very useful.
- Most U.S. applications are rejected in the first Office Action, but
  - not all rejections are equally serious.
- First chance to assess U.S. Examiner.

# Responding

- Your U.S. Attorney may be able to respond without detailed instructions.
  - IF claims will not be narrowed!
- Do not comment on art not applied.
- Consider asking your U.S. attorney to send a draft 10 days before due date.
- Best to Avoid Extensions of Time.
- \$ Ask U.S. Attorney whether more claims should be added.
- \$ Consider evidentiary submissions.

# Final Office Action

- Quick call to Examiner helps assess.
- Three basic options:
  - 1) File a Response
    - *(after telephone interview);*
  - 2) File a Notice of Appeal, and then:
    - **\$ Pre-Appeal Submission?**
    - *Appeal Brief (usually)*
    - *Reply Brief (usually)*
    - **\$\$ Oral Argument?**
  - 3) **\$** File an RCE
    - **\$ (possibly with additional evidence).**

# Final Office Action (more)

- 1) Response after Final will usually not succeed unless the Examiner has given clear suggestions, or agreement was reached by telephone.
- 2) \$ Appeal usually wins, but is slow.
- 3) \$ RCE with response increases chances but does not guarantee success.

# Continuation Applications

- Consider filing Continuation in addition to, OR instead of, paying Issue Fee.
  - *Many clients underestimate the importance of this decision.*
  - *Ask your U.S. attorney whether significant claim scope might be gained.*
- \$ Continuation-in-Part has similar considerations.

# Turning Points:

1. US Filing
2. First Office Action
3. Response
4. Final Office Action
5. Issue and Continuation

# Options for Star Cases:

- \$ Interviews with Examiner
- \$ RCE Fees
- \$ Continuations
- \$\$ Continuations-in-Part
- \$\$ Appeal
- \$\$\$ Interference
  - *Can Be Offensive Weapon*
- \$\$ Patent Repair

# Patent Repair:

- **Certificate of Correction**
- **Continuation**
- **Continuation-in-Part**
- **Reexam**
- **Reissue**
- **Merged Proceeding**

# Recent Developments:

- Increase in Quality of Examiners
- Pre-Appeal Submissions
- Much Higher Fees for Extra Claims
  - Many companies double-filing or reducing claims
- Much Higher Fees for Appeal Hearing
  - Still adds >5% to Chance of Success
- ***Proposed Limits on Continuations***
  - ***Very Controversial***

# **Business Strategy:**

***Patents can be seen as Options:***

- High-Risk***
- Long-Duration (Acquisition AND Life Cycle)***
- Significant Maintenance Cost.***

***Goal is to Have Leverage when and where the company needs it.***

***For Best Cost-Effectiveness:***

- a) Avoid accidental loss of coverage;***
- b) Defer Expense, subject to (a);***
- c) Diversify Coverage;***
- d) Maintain Good Knowledge Base.***

**Wishing You and Your  
Clients Success!**

**祝您好運!**

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