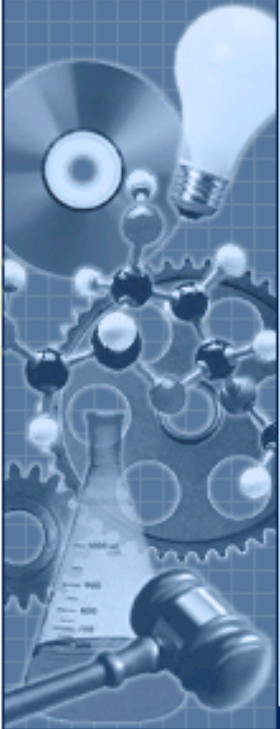




(P) 770.984.2300
(F) 770.984.0098



Patent Prosecution: A Primer for New Attorneys

Arthur A. Gardner

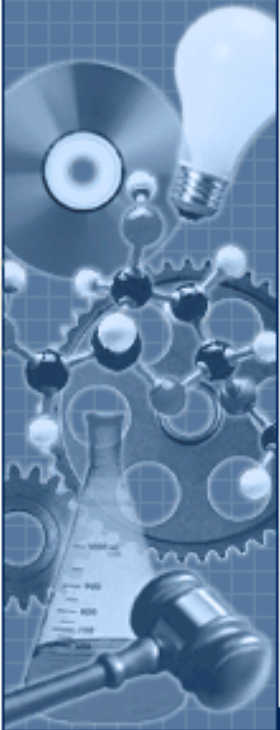
GARDNER GROFF SANTOS & GREENWALD, P.C.
Patent, Trademark and Copyright Law and Related Matters Exclusively

9.29.06

GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098



Agenda

- Corresponding with Clients
- Your Relationship with the USPTO
- How to Respond to Office Actions
 - Ways to Overcome
 - Amendments
 - Handling “Problem” Cases
- When Infringement and/or Litigation is Expected
- The “Dirty Dozen”: 12 Strategic Mistakes Commonly Made by IP Attorneys

GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098

Correspondence with Clients

- Try to avoid characterizing what is going on in patent office
- Inherent tension between informing client adequately and protecting lawyer's interest



GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098

Your Relationship with the USPTO

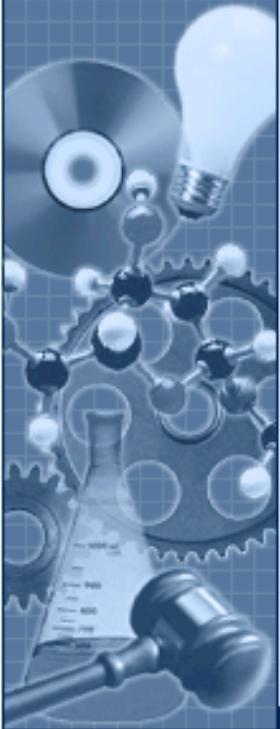
- Not an Adversarial Situation
- Not your Partner
- Somewhere in between



GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098



How to Respond to Office Actions

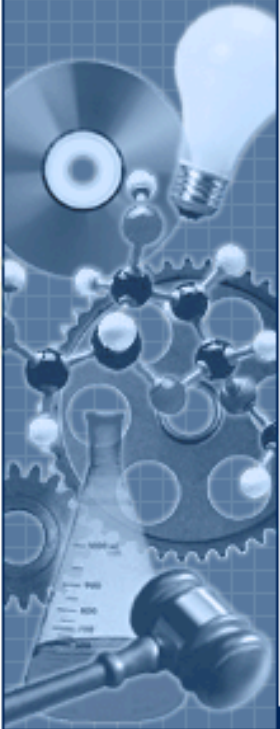
- Old saying:
 - “My dog didn’t bite you...”



GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098



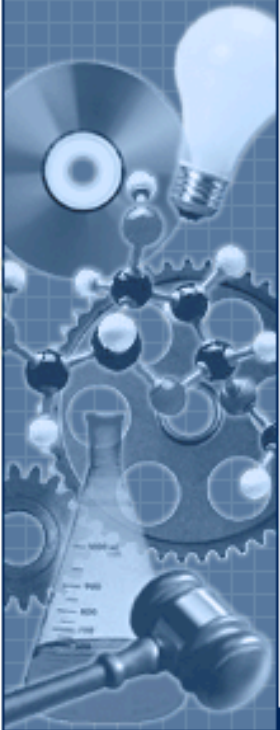
How to Respond to Office Actions

- Ways to Overcome Office Actions
 - Is the art analogous and prior art?
 - If the art is proper,
 - §102
 - Does the art anticipate?
 - §103
 - Is it logical to make the combination or is the combination suggested in the art?
 - Is the combination the result of improper hindsight reconstruction?

GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098



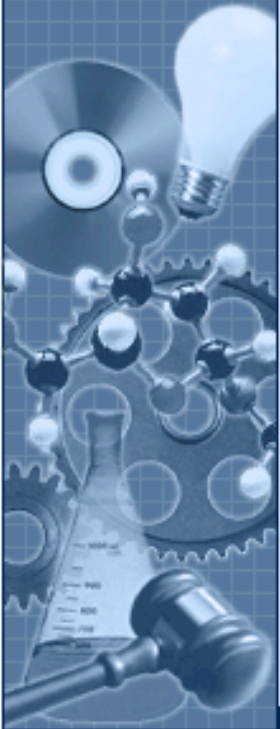
How to Respond to Office Actions

- Amendments
 - Etiquette
 - Acknowledge Office Action *and*
 - Request USPTO to Amend Application.
 - What is the Invention? The Environment?
 - Would Claimed Device on Shelf Infringe?
 - Orientation?
 - Direct vs. Contributory Infringement
 - “Said” vs. “The”

GARDNER GROFF

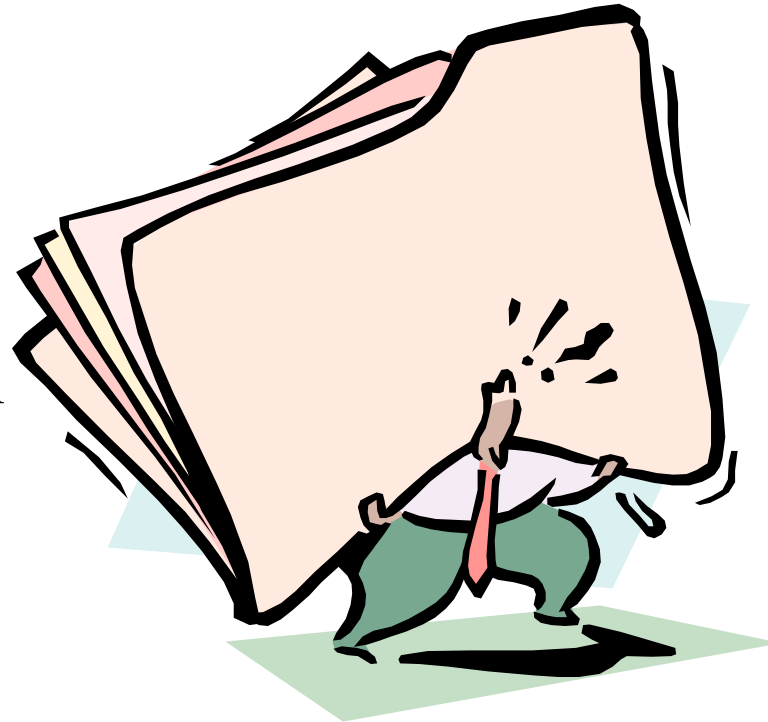


(P) 770.984.2300
(F) 770.984.0098



How to Respond to Office Actions

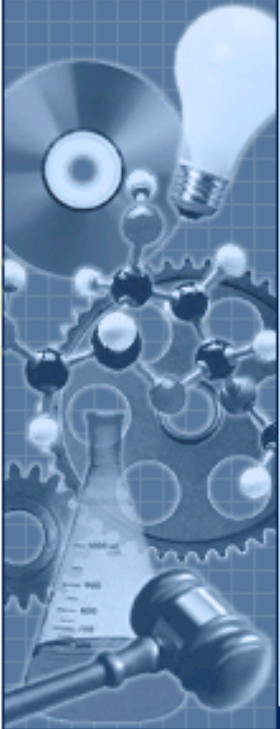
- Amendments
 - File Wrapper Estoppel
 - Remarks = Limits on Claims
 - Nexus between Claims & Argument



GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098



How to Respond to Office Actions

- Amendments
 - General Good Practice
 - Summarize Office Action and Amendment
 - Address *each* Rejection or Objection in Order (when possible)
 - Discuss General Structure of Prior Art Cited, Using Nomenclature of Claims



GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098

How to Respond to Office Actions

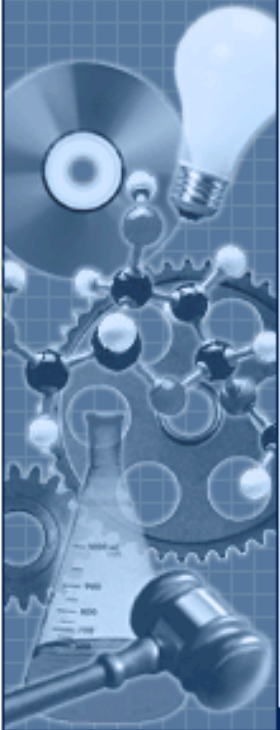
- Interviews
 - Telephone
 - Personal



GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098



How to Respond to Office Actions

- Handling “Problem Cases”
 - Appeal
 - Give to Another Attorney in Your Firm



GARDNER GROFF

When Infringement and/or Litigation is Expected

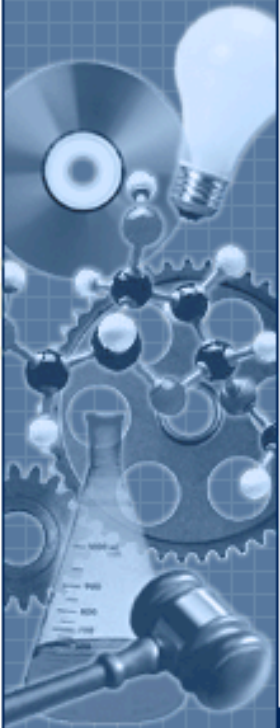
- “Life Preserver” Application



- Amend the Summary to Match the Claims



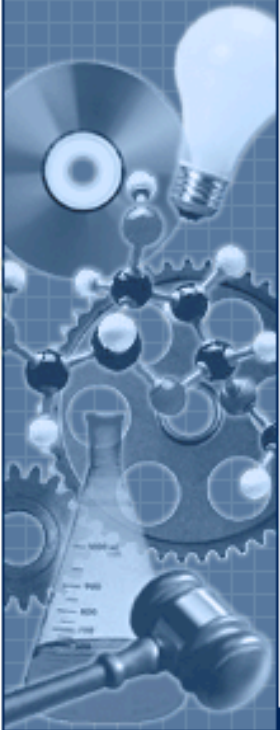
(P) 770.984.2300
(F) 770.984.0098



GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098



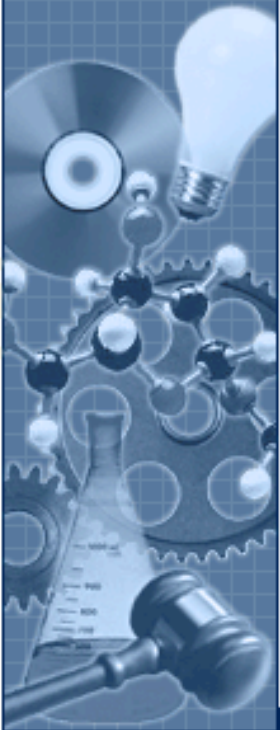
The “Dirty Dozen”

1. “Cloned Claims” and Underclaiming
2. Needless Priority Claims
 - shorten term *or*
 - invoke prosecution history estoppel
3. Inadequate Use of Dependent Claims
 - Strengthen Validity *and*
 - Broaden Independent Claims
4. Excessive or Ineffective Arguments Directed to Unclaimed Features
5. Over-Enablement
 - Applications are directed to someone skilled in the art, not a neophyte patent attorney
6. Not Making Use of Interviews

GARDNER GROFF



(P) 770.984.2300
(F) 770.984.0098



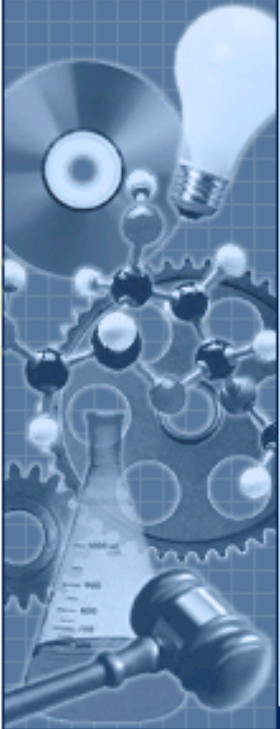
The “Dirty Dozen”

7. Poorly Designed Patents
8. Failure to Use “Life Preserver” Patents
 - To ensnare infringers who design around
9. Unthinking, Unquestioning Assent to USPTO Determinations or Suggestions
 - Examiner’s Statement of Reasons for Allowance
 - Double Patenting Rejections and Terminal Disclaimers
 - Claim Language Suggested by the Examiner
10. Infringement Charge Letters that Create Declaratory Judgment Jurisdiction
11. “Patent Profanity”
12. Trying to Make a Good Deal *Perfect*

GARDNER GROFF

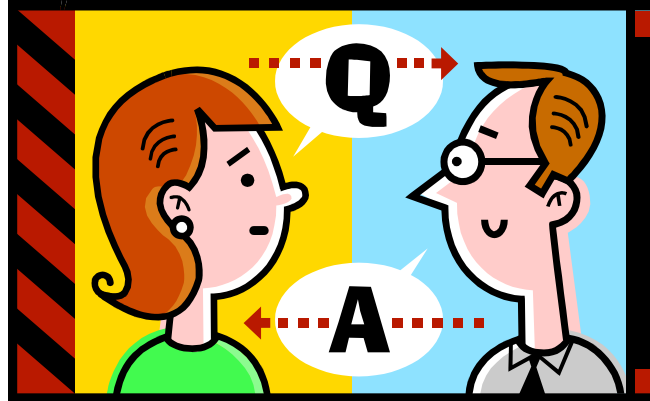


(P) 770.984.2300
(F) 770.984.0098



Questions

???



GARDNER GROFF