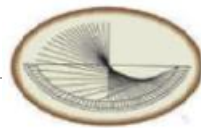# Prosecution Tips

HEIDI BRUN ASSOCIATES

HEIDI BRUN, US PATENT AGENT AND IL PATENT ATTORNEY

FOR CORPORATE PATENT ATTORNEY TRAINING - 2021

Prosecution Pitfalls

Not particular to any one technology.

Observations of how the prosecution process goes

Prosecution usually defined as
- defining the invention
- reviewing the prior art
- amending claims.

We don't talk about the ways that the different people involved in the prosecution read and understand the claims.

Different understanding of:
- Technical issues
- Language issues
  - English / Claims

Over my 30 years in the business, I have seen a lot of misunderstandings that I've had to straighten out.

And I've learned to call the Examiner …

USPTO interviews

Not for arguing with the Examiner

- But to figure out how the examiner is reading (or misreading) the claims
  - now in video!

  - Synchronous – asynchronous
    - Had to put our definition into the claim

  - "Not being specific to any of said cardiac examination procedures" as:
    - it might be specific to another kind of procedure, such as a lung procedure!

  - Misreading of English – particularly when there is a long adjectival phrase
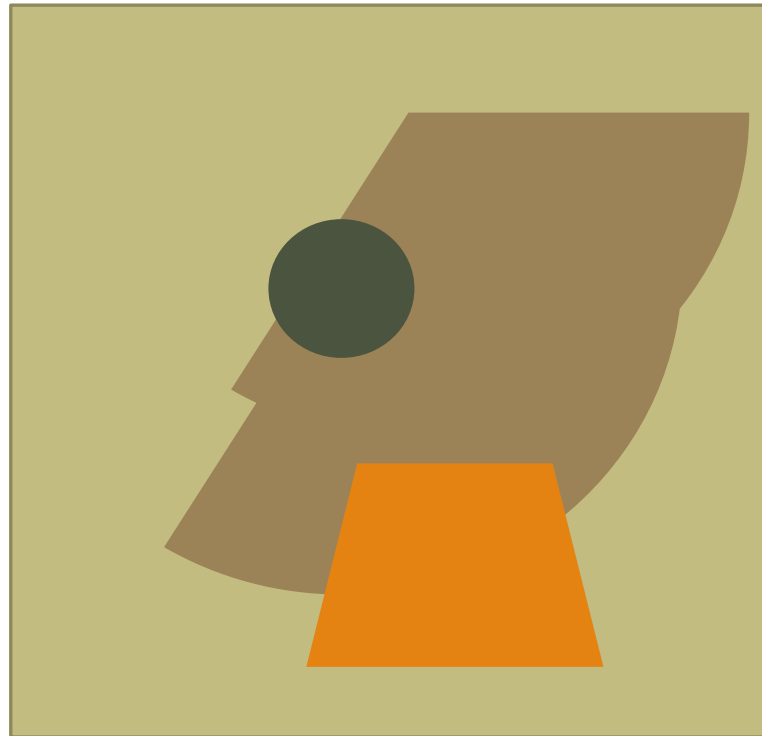
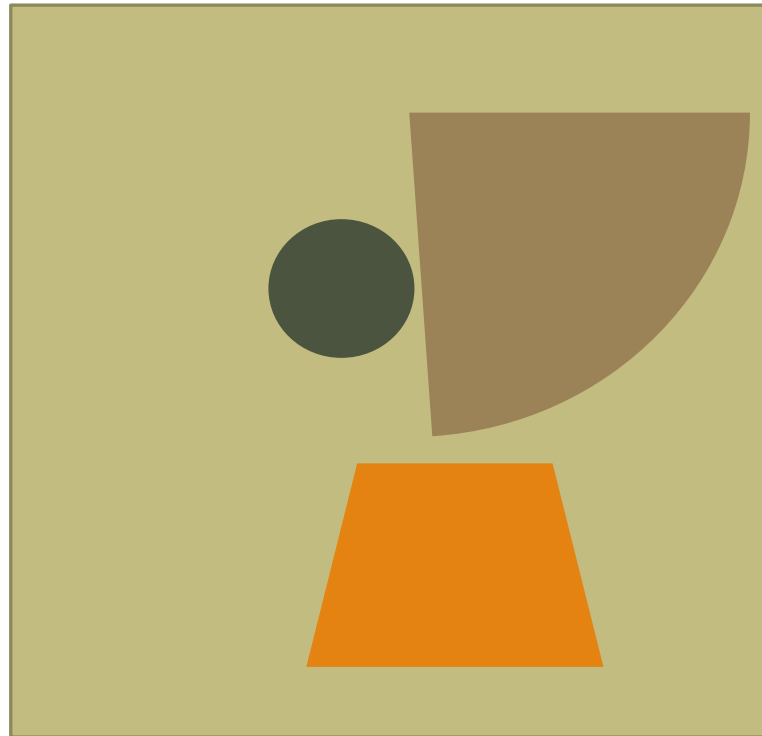 - Ignoring part of the claim

Amendments Narrow Claims
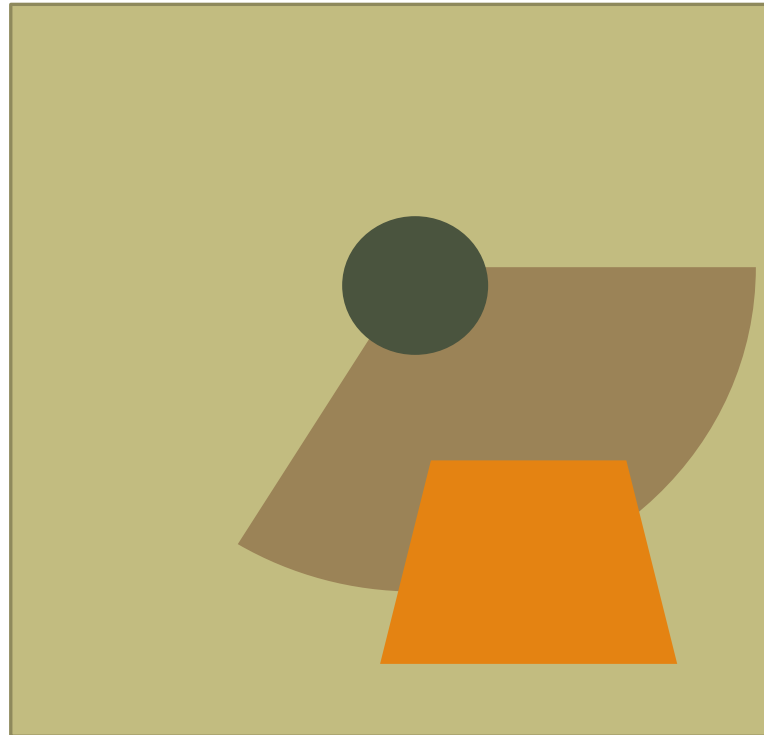
Claims are a Movable Target

Claims are a Movable Target

Associates

Create the translations
- Of Spec
- Of Office Action

May misunderstand the invention
- May give poor suggestions to respond to Examiner

Tips
- In your letters to your associates, make sure to provide the background (or an explanation) to any issue before explaining your solution
  - Much slower explanation
- Write thoughts in full

Use Zoom!
- We did, in preparation for Oral Proceedings at the EPO
- Two different reactions to the Examiner's Office Action

Our view

We concentrated on the non-technical rejection

and to generate a difference tree representing the differences in said components between said at least two versions of the same website page ([0132]-[0135] shows a difference tree representing different versions),

said component based version comparer (650) further comprising a structural version comparer (701) to compare the structural hierarchy of said nodes of said component trees through comparison of their content and at least one of: their geometrical and semantic relationships (see [0014] - different versions are created and compared; see also [0062] for semantically, geometrically associated content elements (figure/caption);

~~wherein said component based version comparer preprocesses said components in a single version of said at least two versions of said website page to determine said geometric relationships and to recognize semantically related component pairs according to at least one of: their type, proximity and relationship, before comparing said components between said at least two versions of said website using said structural version comparer (701);~~ and

a version merger (657) configured to create an integrated version of said two versions of said website based on said difference tree according to the results of said component based version comparer (701) (see [0132]-[0135] sub-trees disclosing alternate versions encoded in XML).

The subject-matter of claim 1 therefore differs from this known apparatus in the above strike-out passages, namely that the version comparer *preprocesses said components [...] to determine said geometric relationships and to recognize semantically related component pairs [...]*.

As a whole, claim 1 is considered to be technical. However, above difference is directed to a non-technical user requirement:

Our Associate's view

Our associate said that the Examiner's concern was that the prior art also showed a difference tree

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~~wherein said component based version comparer preprocesses said components in a single version of said at least two versions of said website page to determine said geometric relationships and to recognize semantically related component pairs according to at least one of: their type, proximity and relationship, before comparing said components between said at least two versions of said website using said structural version comparer (701);~~ and

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The subject-matter of claim 1 therefore differs from this known apparatus in the above strike-out passages, namely that the version comparer *preprocesses said components [...] to determine said geometric relationships and to recognize semantically related component pairs [...]*.

As a whole, claim 1 is considered to be technical. However, above difference is directed to a non-technical user requirement:

Another instance of reading differently

Very long patent against our digital phone exchange
- Examiner said could find any concept in it

Client commented that the cited art was a fully digital exchange, meaning that it went down in a power outage vs his is 'always on'.

Pointed to his splitter-isolator
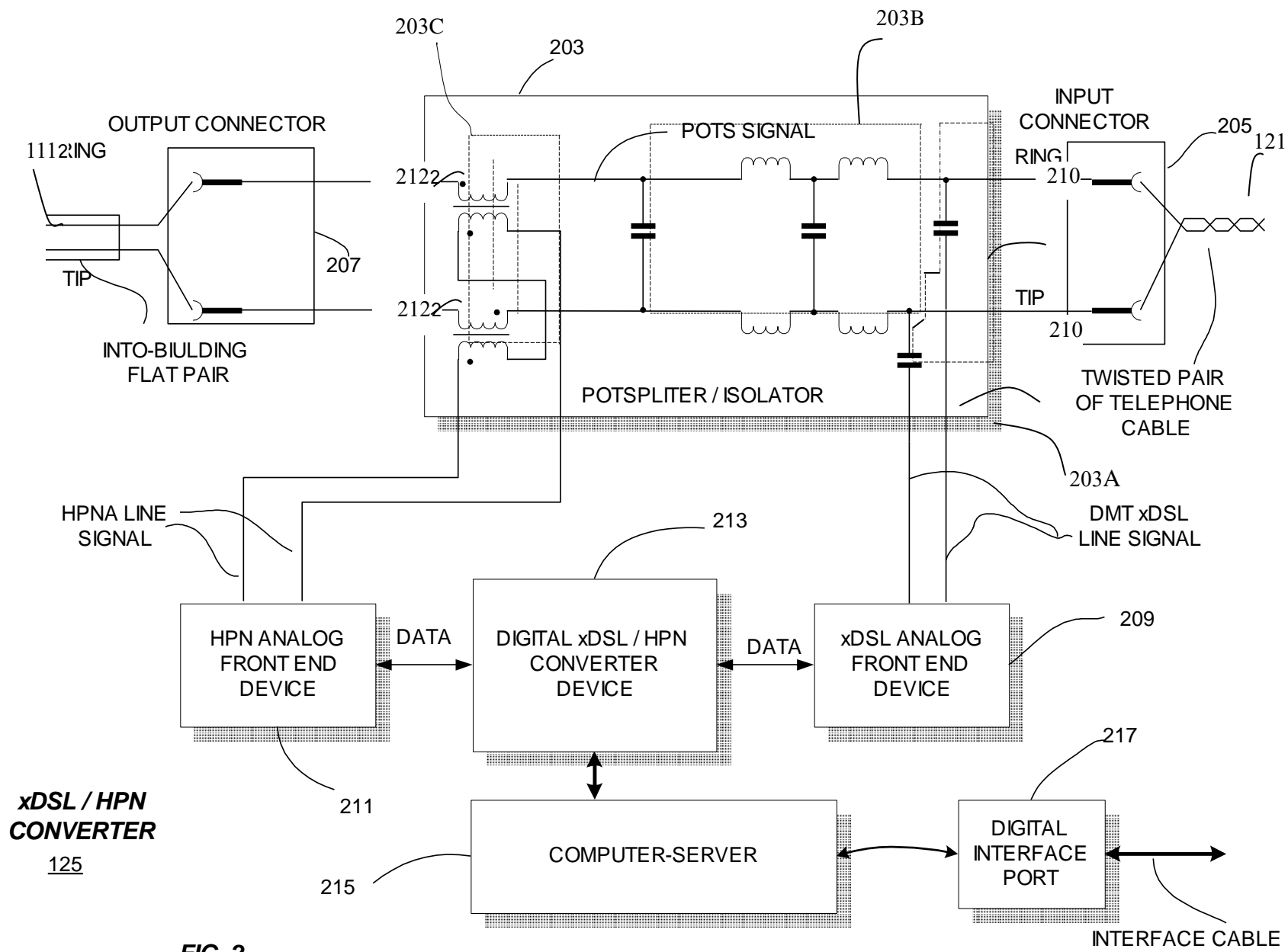- I had used it to argue other differences.

It was analog.

FIG. 2

The amended version

I amended the claim to recite that our splitter-isolator is ANALOG.

4. (Currently Amended) A communication device comprising:

an analog splitter-isolator connectable between to-building wiring and in-building telephone wiring to a subscriber premises which permits passage therethrough only of analog POTS signals and blocks passage of other analog signals between an external xDSL telephone data network and an internal HPNA telephone data network while isolating analog signals of an internal HPNA telephone data network from analog signals of an external xDSL telephone data network;

Three pages into 103 rejection response I wrote:

"None of these 3 elements can be said to in any manner to be equivalent to the herein analog splitter isolator. They do not have the functionality to allow passage of POTS signals and to block passage of other analog signals."

TIP – put your strongest argument FIRST.

OBSERVATION – sometimes, your only difference is ONE word, but it makes ALL the difference in the World.

Prosecution Tips

You see things differently than the inventor, client, associate and examiner

Pay attention to how they are understanding the invention

◦ It may provide you with a new way to define the invention or to amend the claim

Make sure your specification has enough detail in it to handle movable claims

Any Questions?

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