

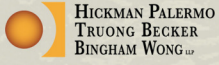
**HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP**
INTELLECTUAL PROPERTY LAW

The “Objective Considerations” in
Preparation and Prosecution

Christopher J. Palermo

Background

- The objective considerations are under-used.
Why?
 - Not a “habit of mind”
 - Usually unconvincing for examiners
 - Insufficient time to gather evidence
 - Insufficient budget



Opportunities

- Inventor interview and/or disclosure form
- Drafting the description
- Examiner interviews and replies to actions
- Appeal brief



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP

Opportunities

- Inventor interview and/or disclosure form
 - Update your inventor interview checklist to include the factors
 - Update your disclosure form(s) to include the factors
 - Phrase the items to develop the “nexus”

6. Advantages and Benefits: Describe the advantages and benefits of the invention compared to prior solutions. Provide any available information to support any of the following objective indicia of nonobviousness:
- commercial success – customers willing to pay a premium or even requiring the features to be claimed
 - industry praise
 - unexpected results, such as unforeseen increases in efficiency
 - copying by others
 - industry skepticism
 - licensing
 - long-felt but unsolved need – customer surveys, customer demand for claimed features, competitor position paper, trade journal article



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP

Opportunities

- Drafting the description
 - When drafting a nonprovisional based upon a provisional or foreign case, re-investigate the factors; evidence may have been created over time



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG ^{LLP}

Opportunities

- Drafting the description
 - Update your application template to include the factors, with reminders about the nexus

BENEFITS OF CERTAIN EMBODIMENTS

[0028] [[Here describe benefits of embodiment(s) compared to prior solutions; provide any available information to support any of the following objective indicia of nonobviousness, using description that ties the indicia to at least one claim as a whole: commercial success – customers willing to pay a premium or even requiring the features to be claimed; industry praise; unexpected results, such as unforeseen increases in efficiency; copying by others; industry skepticism; licensing; long-felt but unsolved need – customer surveys, customer demand for claimed features, competitor position paper, trade journal article]]

[0029] [[Example]] In an embodiment, a solution as described herein improves computer efficiency in sorting data by eliminating the classification step that other approaches have used.
...



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG ^{LLP}

Opportunities

- Drafting the description
 - The heading is just a reminder. Weave the indicia into the description. Don't create the argument that this heading states all benefits.

BENEFITS OF CERTAIN EMBODIMENTS

[0028] [[Here describe benefits of embodiment(s) compared to prior solutions; provide any available information to support any of the following objective indicia of nonobviousness, using description that ties the indicia to at least one claim as a whole: commercial success – customers willing to pay a premium or even requiring the features to be claimed; industry praise; unexpected results, such as unforeseen increases in efficiency; copying by others; industry skepticism; licensing; long-felt but unsolved need – customer surveys, customer demand for claimed features, competitor position paper, trade journal article]]

[0029] [[Example]] In an embodiment, a solution as described herein improves computer efficiency in sorting data by eliminating the classification step that other approaches have used.
...



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP

Opportunities

- Examiner interviews and replies to actions
 - Re-investigate the factors and the available evidence. Perhaps years have passed and new evidence is available.
 - Introduce evidence informally in the interview, OR consider carefully drafted Rule 132 declaration.
 - Argue the case law; USPTO always invokes first 3 *Graham* inquiries but rarely addresses the “important component”—secondary considerations—which *must* be considered, Transocean v. Maersk II, MPEP 2145
 - Use interview to gently educate the (non-lawyer) examiner
 - Show the nexus (connection); don't give PTAB easy counter-attack that no nexus was shown.



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP

Opportunities

- Examiner interviews and replies to actions
 - Evidence may be most useful in attacking “non-linked 103 rejection” like the one in Plantronics v. Aliph
Claim recites A, B and C. Reference 1 suggests A. Reference 2 suggests B, C. The only connection is the examiner’s unsupported assertion of obviousness to combine.
 - Convincing the examiner with this evidence alone isn’t essential; it builds a record for appellate review to show error in ignoring the evidence.



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP

Opportunities

- Appeal Brief
 - Update your appeal brief template with a reminder to consider the factors.
 - Re-investigate the record: specification, declarations, prior argument.



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP

Opportunities

- Appeal Brief
 - Is the record really frozen?

37 CFR 41.33(d)(1) - An affidavit or other Evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other Evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other Evidence is necessary and was not earlier presented has been made.



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP

Christopher J. Palermo
cpalermo@h35g.com



HICKMAN PALERMO
TRUONG BECKER
BINGHAM WONG LLP

INTELLECTUAL PROPERTY LAW

Comprehensive IP Strategies / hickmanpalermo.com