The “Objective Considerations” in Preparation and Prosecution

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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

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”
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

Opportunities

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

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.
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.

Opportunities

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

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