

# INVENTION ANALYSIS AND CLAIMING: Amend or Argue — PART I'



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**W**hat’s to be done when a claim is rejected under §102 or §103?

One option, of course, is to cancel the claim, irrespective of the merits of the rejection. A rejected claim may be expendable because other, allowed claims may be deemed to adequately cover the invention. Or the client may not wish to incur the cost of fighting the rejection. Yet another option is to “take” any allowed claims and re-present the cancelled claim(s) in a continuation.

On the other hand, when addressing a §§102-103 rejection on the merits, six main options are available, as shown in the accompanying flow diagram. The option to simply cancel the claim is shown as stand-alone box 10. The other five options are shown in boxes 12, 14, 16, 18 and 20, as well as four questions—shown in boxes 11, 13, 15 and 17— whose answers determine which of those five option(s) is(are) the most appropriate.<sup>2</sup>

This month’s column looks at the options associated with first and second questions (boxes 11 and 13). Next month’s column looks at the options associated with the third and fourth questions (boxes 15 and 17).

## QUESTION 1: IS THE EXAMINER’S POSITION ON OBVIOUSNESS WELL-FOUNDED? (BOXES 11, 12)

The threshold consideration when faced with a §103 rejection is whether the exam-

iner’s position on obviousness is well-founded. It may not be. For example, the prior art may “teach away” from making the asserted modification or combination of references. Or the examiner’s position may arguably be the product of hindsight, given the benefits of the inventor’s teachings.

If there is a basis for arguing the non-obviousness of the cited modification and/or combination of references,<sup>3</sup> that is an option to strongly consider. There is usually no reason to narrow a claim to avoid reading on subject matter that we can argue is non-obvious—not, at least, until after we have attempted to convince the examiner that the examiner’s position on obviousness is not well-founded.

## QUESTION 2: DOES THE CLAIM READ ON THE CITED PRIOR ART? (BOXES 13, 14)

The examiner’s position that the claim reads on the cited prior art needs to be evaluated. Claims are often rejected even though the cited prior art does not meet every claim limitation.

If the claim does not read on the cited prior art reference or combination/modification of references, we should argue against the rejection on that basis. That argument should be made even if we have argued against the obviousness of a modification/combination of references advanced by the examiner in a §103 rejection. That is, we can argue that even if the cited modification/combination were obvious, the claim still doesn’t read on it.

### *Try to See It the Examiner’s Way*

In assessing whether a claim reads on cited prior art, it is important to read the claim and the prior art from the examiner’s perspective. The examiner is not required to interpret a claim term narrowly based on what is disclosed in the specification. Indeed, the examiner is duty-bound to give claim language its broadest reasonable meaning.<sup>4</sup>

For example, computer scientists use the term “active database” to mean a database that takes an action when a particular event happens. An active database operated by a stock brokerage firm, for example, may be programmed to send an email message to client A when stock B reaches a certain price level. However, the examiner may choose to

read “active database” on any database that is “up and running.” It is not unreasonable to say that such a database is “active,” as opposed to dormant or unresponsive.

There is an exception. If the specification explicitly defines a term, then the examiner is supposed to accord it the narrow meaning provided in the definition, e.g.:

**The term “active database” as used in this specification and claims means a database that takes an action when a particular event happens.**

Specifications rarely include such statements, however, and for good reason. A definition may turn out to be more restrictive than had been realized when the definition was formulated.

It is usually futile, therefore, to argue for a narrower reading of a claim if the examiner’s way of reading it is not totally without merit. More importantly, the fact that the examiner was able to make all of the words of the claim congruent with something irrelevant to the invention is often an indication that something fundamental to the inventive concept is missing from the claim. As such, the claim is susceptible to reading on a whole raft of invention-irrelevant prior art that might not turn up until after the patent has issued. This is an opportunity for the attorney to ask, “How did I manage to write a claim that covers something not embodying the inventor’s contribution?” and to fix the claim so that it no longer does.

Of course, we should fight for a claim in its un-amended form if a rejection is not well-founded. But it is just as important to recognize when it’s time to stop, regroup, and amend rather than argue.

### **Don’t Read Too Much into the Reference(s)**

Be wary of reading too much into a reference by bringing your knowledge of the invention to the reading. A reference may seem to be describing the inventive subject matter, but a careful reading may reveal otherwise.

The author once supervised a prosecution where the invention related to a facsimile machine that would detect that it was almost out of paper and would thereupon automatically generate a paper order form containing the facsimile telephone number of the company’s paper supplier. A user could then simply fill out the order form while still at the fax machine and fax it to the supplier, without having to look for the supplier’s facsimile number or for a blank order form.

The cited prior art was the following translated abstract of a Japanese patent:

A facsimile machine detects an out-of-paper condition and, in response, outputs, either on a screen or on paper, ordering information including the telephone number of the paper vendor.

The attorney handling the prosecution recommended that the application be abandoned based on this abstract. But his knowledge of the invention caused him to read too much into the prior art disclosure. The full translation revealed that the prior art fax machine did not output an order form but only the paper supplier's telephone number—an arguably non-obvious distinction.

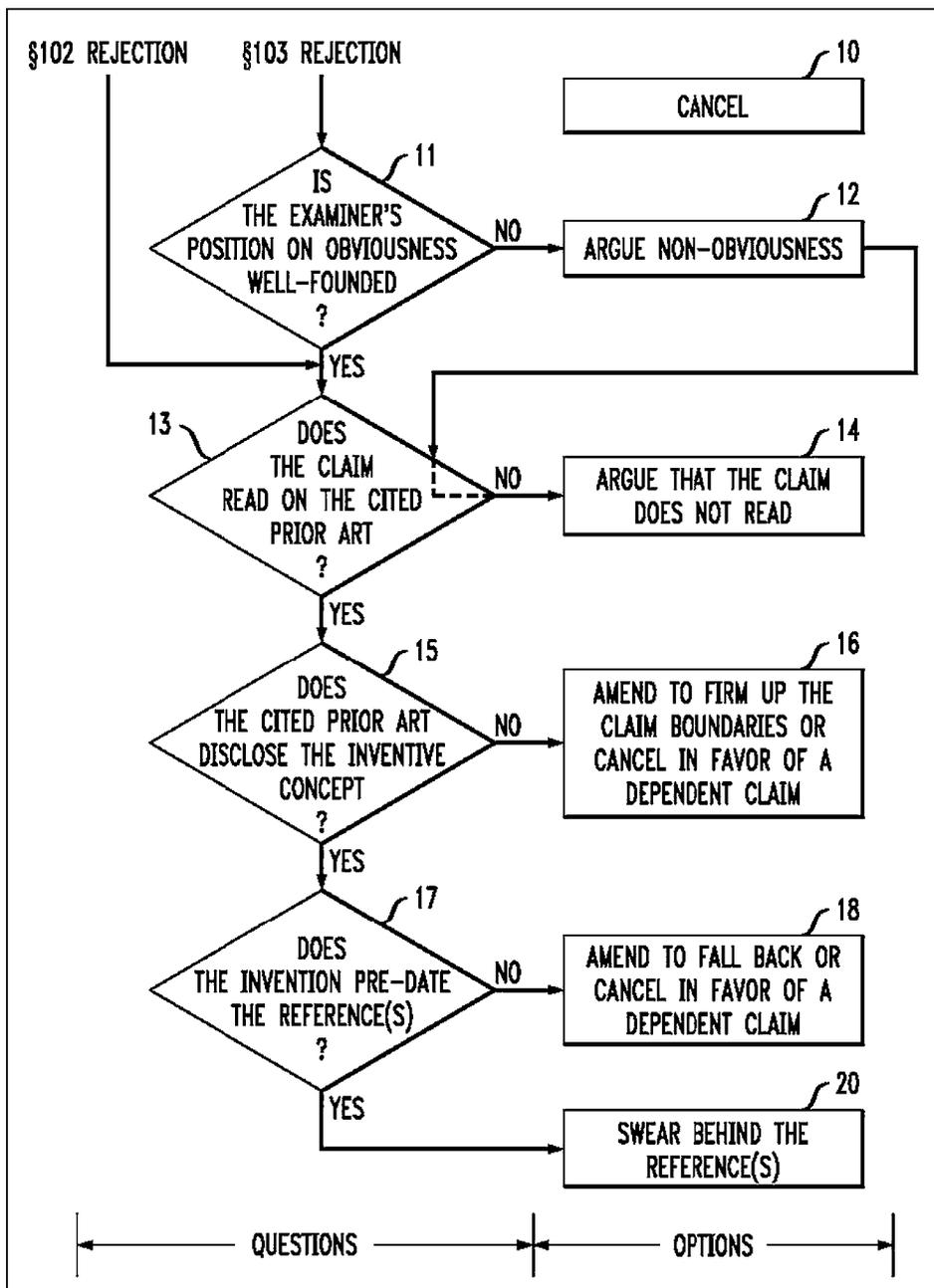
**Don't Rely Exclusively on the Inventor's Reading of the References**

The inventor's opinion as to what the cited prior art reference(s) teach can be invaluable. But we should not rely on the inventor's reading exclusively. Inventors tend to focus on the broad outlines of a prior art disclosure. They sometimes don't find, or appreciate the significance of, out-of-the-way statements buried in a patent specification that may be highly relevant to or, perhaps even anticipate, the claimed subject matter. Sometimes an inventor will assert that "it's not the same thing" because the prior art is directed to a different problem, even though the prior art's solution inherently solves the problem that the inventor sought to solve. It is therefore important for the attorney to also review the reference.

*Next month:* Amend or Argue—Part II

**ENDNOTES**

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2. The diagram assumes that the effective date of a reference is early enough to render it properly citable against the rejected claim(s). This is something to be checked, although examiners rarely make a mistake in this regard.
3. This may include submitting a declaration in support of the non-obviousness argument, per 37 C.F.R. 1.132.
4. See, e.g., *In re Morris*, supra, and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). But see *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (en banc), (specification sets a limit on how broadly the Patent and Trademark Office may construe means-plus-function language under the rubric of reasonable interpretation).



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