

# Guide on Responding to an Office Action in a Patent Case

By Howard L. Hoffenberg  
The IP and Business Law Offices of  
Howard L. Hoffenberg, Esq.

First written for use in John Park and Assoc. agent's class


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# PTO Website Page with Amendment Related Resources

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



















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- ◆ [Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121\(c\) is now 35 USC 2001 \(1/1/12\)](#)
- ◆ [Frequently Asked Questions - Revised Amendment Practice \(posted 11A 2008, updated 2/16/2008, updated 4/11/08 03P52074\)](#)
- ◆ [Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments is now 7/10/2008](#)
- ◆ [Effective Date 30 July 08 Changes To Implement Electronic Maintenance of Official Patent Application Records, Final Rule \(published in 68 Fed Reg 58811 \(11/10/2003\)\)](#)
- ◆ [Sample Format for Revised Amendment Practice \(PDF, \(posted 30 Jun 2008\)\)](#)
- ◆ [Office Files: Amendments May Now be Submitted in Revised Format \(PDF\) \(06/08 30 Jun 2008\)](#)
- ◆ [Slide Set: Revised Amendment Format 37 CFR 1.121 \(text version\) \(last revised 26 Sep 2008; published 30 Jun 2008\)](#)
- ◆ [Changes To Implement Electronic Maintenance of Official Patent Application Records, notice of proposed rule making published in 68 Fed Reg 14375 \(11/10/2003\)](#)

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# The Law on making Amendments is found at 37 CFR 1.121 (other rules on specific practices)

§ 1.118

MANUAL OF PATENT EXAMINING PRACTICE

## § 1.118 [Reserved]

(43 FR 1411, Apr. 24, 1978; 48 FR 1467, Apr. 27, 1983; amended and reorganized, 52 FR 3131, Oct. 10, 1987; 53 FR 1065, Apr. 1, 1988)

## § 1.119 [Reserved]

(43 FR 1462, Apr. 24, 1978; amended and reorganized, 52 FR 3131, Oct. 10, 1987; 53 FR 1065, Apr. 1, 1988)

## § 1.121 Manner of making amendments in applications

(b) Amendments in applications under class review procedures. Amendments in applications under review procedures are made by filing a paper, in compliance with § 1.52, showing the specific amendments to be made.

(c) Specification. Amendments in the specification, other than the claims, complete drawings (§ 1.103) and sequence listings (§ 1.105), may be made by adding, deleting or replacing a paragraph, by renumbering a section, or by substituting specific text for the material specified in the section.

(1) Addition of a sentence, phrase, or word to a paragraph. Amendments to the specification, including amendments to a section heading or the title of the invention, which are contained in amendment papers filed in accordance with a paragraph, may be made by substituting:

- (i) An insertion, which unambiguously identifies the location to be added in the paragraph of the specification, replace a paragraph with a new sentence, phrase, or word, or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike through except that double based, alphabetical letters and other alphabetical characters may be shown by square deletion. If five or fewer consecutive characters in the text of any deleted subject matter must be shown, by being underlined because markings in alphabetical characters are easily reversed, and the full text of any added paragraphs without any underlining, and

7-11-88 (2025)

(iii) The text of a paragraph to be deleted must, unless provided with a check-out, be placed within double brackets. The notation to delete may include a paragraph by its paragraph number or, outside a line, words from the beginning and end of the paragraph if marked for paragraph identification purposes.

(2) Deletion by square deletion. If the section of the specification, complete drawings or sequence listings, to be deleted is not a paragraph, the deletion may be made by substituting:

- (i) A reference to the section heading along with an insertion, which unambiguously identifies the location, to delete that section of the specification and to replace each deleted section with a replacement section; and

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(3) Amendment by sentence, phrase, or word. The specification, other than the claims, may also be amended by substituting:

- (i) An insertion to replace a paragraph with a new sentence, phrase, or word, or more paragraphs;
- (ii) A substitute specification in compliance with § 1.102, and (3)

(4) Amendment of previously deleted paragraphs or sections. A previously deleted paragraph or section may be reinstated only in a subsequent amendment during the prosecution of the application.

(5) Amendment in subsequent amendments. Once a paragraph or section is amended in a first amendment, thereafter, the paragraph or section shall not be reamended in a subsequent amendment unless a substantial reason for the additional amendment is provided.

(6) Claims. Amendments to a claim may be made by rewriting the entire claim with all changes

60000 01.121

§ 1.121

(a) Addition of a sentence, phrase, or word to a paragraph. Amendments to the specification, including amendments to a section heading or the title of the invention, which are contained in amendment papers filed in accordance with a paragraph, may be made by substituting:

- (i) An insertion, which unambiguously identifies the location to be added in the paragraph of the specification, replace a paragraph with a new sentence, phrase, or word, or more paragraphs;

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- (ii) A substitute specification in compliance with § 1.102, and (3)

(4) Amendment of previously deleted paragraphs or sections. A previously deleted paragraph or section may be reinstated only in a subsequent amendment during the prosecution of the application.

(5) Amendment in subsequent amendments. Once a paragraph or section is amended in a first amendment, thereafter, the paragraph or section shall not be reamended in a subsequent amendment unless a substantial reason for the additional amendment is provided.

(6) Claims. Amendments to a claim may be made by rewriting the entire claim with all changes

§ 1.122

MANUAL OF PATENT EXAMINING PRACTICE

Amendments to a claim may be made by rewriting the entire claim with all changes

(a) Addition of a sentence, phrase, or word to a paragraph. Amendments to the specification, including amendments to a section heading or the title of the invention, which are contained in amendment papers filed in accordance with a paragraph, may be made by substituting:

- (i) An insertion, which unambiguously identifies the location to be added in the paragraph of the specification, replace a paragraph with a new sentence, phrase, or word, or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike through except that double based, alphabetical letters and other alphabetical characters may be shown by square deletion. If five or fewer consecutive characters in the text of any deleted subject matter must be shown by being underlined because markings in alphabetical characters are easily reversed, and the full text of any added paragraphs without any underlining, and

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(3) Amendment by sentence, phrase, or word. The specification, other than the claims, may also be amended by substituting:

We will go into this in some detail in the upcoming slides

PTO's Sample  
Amendment. For  
now, an  
overview. We will  
go into detail as  
the lecture  
continues

**SAMPLE FORMAT FOR REVISED AMENDMENT PRACTICE (Rev. 6/03)**

Appl. No. : XX,YYY,YYY      Continuation No. WXYZ  
Applicant : Jack Q. Inventor  
Filed : April 19, 2003  
TC/A.U. : 744  
Examiner : John Doe  
Docket No. : 112450A&S&C&B  
Customer No. : 88888

Commissioner for Patents  
P.O. Box 1470  
Alexandria, VA 22315-4420

**AMENDMENT**

51-

In response to the Office action of October 16, 2003, please amend the above-identified application as follows:

**Amendments to the Specification** begin on page 2 of this paper.

**Amendments to the Claims** are reflected in the listing of claims which begins on page 3 of this paper.

**Amendments to the Drawings** begin on page 4 of this paper and include both an attached replacement sheet and/or annotational sheet showing changes.

**Remarks/Arguments** begin on page 5 of this paper.

An Appendix including amended drawing figures is attached following page 2 of this paper.

**Amendments to the Specification:**

Please replace paragraph [0071] with the following amended paragraph:

[0021] In the construction of the bucket of this invention, various materials have been selected and which confer a number of diverse properties, and allow for varied functions of the article. For example, in one embodiment, the bucket can be made of a durable polymer plastic material. Where an aesthetic appeal is desired, the bucket can be any one of many attractive colors. The following listing of properties serves to define possible uses for the bucket:

Please replace paragraph [0045] with the following amended paragraph:

[0045] Figure 1 displays a bucket of the invention. As can be seen from the drawing, the handle is attached to the upper lip of the structure and connected at points diametrically opposite each other on the circumference.

Please add the following new paragraph after paragraph [0073]:

[0075.1] An optional feature of the articles of the invention is the addition of a retroreflective or coating to the bucket to provide protection from any contents which might be stored. The coating can be provided to the surface during the manufacturing process or can be added in a later step.

Please delete the paragraph beginning at page 2, line 4, which starts with "Under normal circumstances"

Appl. No. 2007017777  
Filed October 14, 2007  
Priority Office action of October 10, 2007

**Amendments to the Claims:**

This listing of claims will replace all prior versions, and listings, of claims in the application.

**Listing of Claims:**

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (previously presented): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~plastic~~ plastic handle.

Claim 10 (previously presented): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (previously presented)

Claim 13 (new): A bucket with plastic sides and bottom.

Appl. No. 2009/023337  
Amendment on 15/06/11  
Reply to Office Action of Oct. 18, 2010

**Amendments to the Drawings:**

The machine sheet of drawings includes drawings to Fig. 2. This sheet, which includes Fig. 1-2, replaces the original sheet including Fig. 1-2. In Figure 2, previously omitted element 13 has been added.

Attachment    Replace your Sheet  
                    Annotated Sheet Showing Changes



REMARKS/REPLY COMMENTS

In the specification, the paragraphs [0041] and [0046] have been amended to correct minor editorial problems. The new paragraph [0075.1] added after paragraph [0075] discusses in general terms the features taken from Example 4.

In amended Figure 2, the previously omitted element numeral 13 has been added.

Claims 6-10 and 12-13 remain in this application. Claims 1-5 and 11 have been cancelled. Claims 7 and 8 have been withdrawn.

The examiner has acknowledged that claims 6 and 9-10 are directed to allowable subject matter. Claim 7-8 have been withdrawn as the result of an earlier restriction requirement. Claim 12 adds an additional feature from Example 2 of the specification.

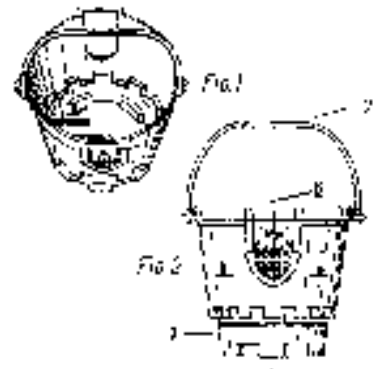
In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 7-8 in a divisional application. . . . .  
. . . . .  
. . . . .

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

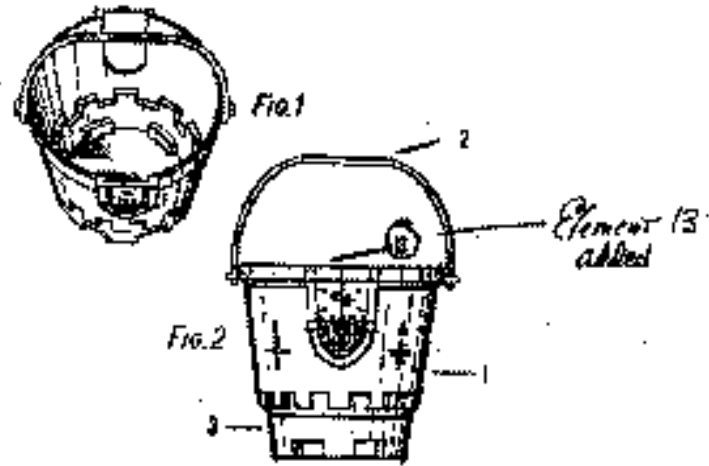
Respectfully submitted,  
  
SMITH, JONES & BROWN  
  
By: \_\_\_\_\_  
Martin J. Gallagher  
Reg. No. 99,999  
Tel. (111) 555-2345

Attachments

Ap. No. 2007/011  
Filed: 03/11/07  
Reply to Office Action of 01/16/07  
Replacement Sheet



App. No. 808,177,177  
4mch 11 1941  
Sealy & Co. Inc. v. Peck, 182,000  
Amended Sheet Showing Changes



## Amendment Practice (From PTO Slide Show)

Each section of an amendment paper must start on a separate sheet.

- For example: each of the following sections must start on a separate sheet: Introductory comments, Amendments to the Specification, Amendments to the Claims, Amendments to Drawings, and Remarks.

1. Submit only one version of the replacement paragraph or section, or currently amended claims, with markings (*i.e.*, strikethrough, **double brackets** [[ ]], or underlining), to show the changes relative to immediate prior version.

- The requirement to provide a separate, clean version has been eliminated, except when applicant submits a substitute specification.

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# Amendment Practice (From PTO Slide Show)

- **Markings to Show Changes:**
  - The following must include markings to show all changes relative the immediate prior version:
    - Replacement paragraphs or sections,
    - Replacement abstracts,
    - Currently amended claims, and
    - Substitute specifications.
  - Added text must be shown by **underlining**.
  - Deleted text must be shown by **strikethrough** with 2 exceptions.

# Amendment Practice (From PTO Slide Show)

## ■ Markings to Show Changes (cont')

- Deleted text must be shown by **strikethrough** (*e.g., ~~strikethrough~~*), with 2 exceptions:
  1. For deletion of five or fewer consecutive characters, **double brackets** **[ [ ] ]** may be used (*e.g., ~~error~~*); and
  2. If strikethrough cannot be easily perceived, deleted text must be shown by **double brackets** **[ [ ] ]** around the deleted text characters.
    - For example: changing "4 corners" to "three corners" should be indicated by "three~~[4]~~ corners".

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# Amendment Practice (From PTO slide show)

- **Markings to Show Changes (cont')**
  - For changes of punctuation marks or difficult to perceive characters, applicants may delete text before and after with strikethrough, and then insert such text along with the change by underlining. For example:
    - If the hyphen in "strike-through" is to be deleted, it may be shown as "strike-throughstrikethrough"

# Amendments to Claims from PTO Slide Show

3. When there is any amendment to a claim, a claim listing of all claims ever presented in the case must be supplied in ascending numerical order.

■ An example of a claim listing is as follows:

**Claims 1-5 (canceled)**

**Claim 6 (previously presented) A bucket with a handle.**

**Claim 7 (withdrawn) A handle comprising an elongated wire.**

**Claim 8 (withdrawn) The handle of claim 7 further comprising a plastic grip.**

**Claim 9 (currently amended) A bucket with a green blue handle.**

**Claim 10 (original) The bucket of claim 9 wherein the handle is made of wood.**

**Claim 11 (canceled)**

**Claim 12 (not entered)**

**Claim 13 (new) A bucket with plastic sides and bottom.**

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# Amendments to Claims (From the PTO Slide Show)

- What is a claim listing?
  - A claim listing must include:
    - The claim number of every claim ever presented in the application, whether entered or not;
    - A status identifier, in parentheses, following each claim number;
    - The text of all pending claims (including **withdrawn** claims); and
    - Markings to show the changes made only in the current amendment relative to immediate prior version.
  - The claims in the listing (in the current amendment) will replace all prior versions, and listings, of claims in the application.

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# Amendments to Claims (From PTO Slide Show)

- The seven (7) permissible status identifiers and their definitions, are:
  1. **(Original)**: Claim filed with original specification (not added by preliminary amendment and not previously amended).
  2. **(Currently amended)**: Claim being amended in the current amendment. Currently amended claims must include markings (strikethrough, double brackets, or underlining) to indicate changes.
  3. **(Canceled)**: Claim canceled or deleted in current amendment or previously. Do not present the text of a canceled claim. Consecutive canceled claims may be grouped together (*e.g.*, claims 1-5 (canceled)).

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# Amendments to Claims (From PTO Slide Show)

- Seven (7) permissible status identifiers (cont.):
  4. **(Withdrawn)**: Non-elected claim.
    - The **text of a withdrawn claim must be presented**.
    - Withdrawn claims that are being currently amended must be presented with markings (strikethrough, double brackets, or underlining) to indicate changes.
    - Example: Claim 8 (withdrawn) The handle of claim Z[[6]] further comprising a plastic grip.
  5. **(Previously presented)**: This is a generic identifier to cover any claim that was previously added or amended in an earlier amendment paper.
    - The proposed identifiers “previously amended” or “previously added” were not adopted, and must not be used.

# Amendments to Claims (From PTO Slide Show)

- Seven (7) permissible status identifiers (cont.):
  6. **(New)**: Claim being added in the current amendment paper. The text of the claim must be presented in clean form without underlining.
  7. **(Not entered): Claim presented in a previous unentered amendment.**
    - Do not present the text of a not entered claim.
    - Consecutive not entered claims may be grouped together (*e.g.*, Claims 20-25 (not entered)).
    - If in doubt as to whether a prior amendment was entered, the claim should be presumed to be “not entered”.

# Amendments to Claims (From PTO Slide Show)

- Multiple status identifiers must not be used for any single claim.
- Only claims of the status “currently amended” and “**withdrawn**” (if the **withdrawn claims are being currently amended**) may include **markings**.
- All other pending claims (including **withdrawn claims** that are not being currently amended) must be presented in clean text (without markings).

# Amendments to Claims (From PTO Slide Show)

- Any claim presented in clean text (no markings) constitutes an assertion that it has not been changed relative to the immediate prior version, except omitting markings (*i.e.*, underlining, strikethrough, and double brackets) and deleted text.
  - For example,
    - If the immediate prior version of the claim was:  
“Claim 1 (currently amended) A bucket with a blue handle.”
    - The listing of claims in the current amendment must have:  
“Claim 1 (previously presented) A bucket with a handle.”

# Amendments to Claims (From PTO Slide Show)

- Canceled claims and **not entered** claims may only have a “canceled” or “not entered” status identifier after the claim number. The text must not be supplied.
- Grouping of Claims – consecutive canceled claims or **not entered** claims may be aggregated into one line.
  - Examples:        Claims 1-5 (canceled)  
                             Claims 20-25 (not entered)
- New or added claims must have “new” as a status identifier
  - Do not underline the text of the new claims.

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# Rule .126 Numbering of Claims

- Original numbering preserved
- Added claims numbered consecutively following highest number
- When ready for allowance, Examiner may renumber or Applicant can request renumbering



# Amendments to Specification (from PTO slide show)

- The location of the paragraph or section to be deleted or replaced, or where a new paragraph or section is to be added, must be unambiguously identified.
    - The location can be identified by using a few words at the beginning and/or the end of the paragraph or section.
  - Do not underline the text of a new paragraph or section.
  - Deletion of a paragraph or section must only include an instruction to delete, and the location of the paragraph or section.
  - Replacement paragraph or section must be a marked-up version showing the changes.
  - A clean version of any replacement paragraph or section must not be submitted in addition to a marked up version, except when applicant submits a substitute specification.
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# Substitute Specification (From the PTO slide show)

- Substitute Specification under 37 CFR 1.125 requires:
  - A statement that the substitute specification includes no new matter.
  - A specification with markings to show all the changes relative to the immediate prior version.
  - A **clean version** (without markings) of the substitute specification.
    - **The requirements of a marked-up version and a clean version have been retained.**

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# Amendments to Abstract (from the PTO slide show)

- An amendment to an abstract is treated like an amendment to the specification.
  - If the changes are minor in nature, submit a replacement abstract with markings to show all changes relative to the immediate prior version.
  - If the abstract is being substantially rewritten, submit a new abstract in clean text (no markings) accompanied by an instruction for the cancellation of the previous abstract.
  - Any new, or replacement, abstract must be submitted on a separate sheet (37 CFR 1.72).

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# Amendments to Drawings (from the PTO slide show)

- Amendment to drawings must include:
  - **Replacement drawing sheet** showing amended figures which include the desired changes, without markings, on a separate sheet in compliance with §1.84; and
  - **Explanation of the changes** in the remarks, or preferably, in the drawing amendments section, of the amendment paper.
  - **Optional unless required by examiner:**
    - **Annotated drawing sheet** – a marked-up copy of the amended figure(s) with annotations showing the change(s) may be submitted, or required by the examiner.

# Amendments to Drawings (From the PTO slide show)

- Replacement drawing sheet(s) must be identified in top margin as “**Replacement Sheet**”.
- Annotated drawing sheet(s) must be identified in top margin as “**Annotated Marked-up Drawings**”.
  - This will avoid confusion between a replacement sheet and an annotated sheet.
  - Annotated drawing sheet(s) will not be entered as part of the official drawing(s) for the application.
- The replacement drawing sheet(s) and annotated drawing sheet(s), if any, should follow the last page of the amendment paper, as attachment(s).

# Amendments to Drawings (From the PTO slide show)

- Proposed drawing correction process is eliminated.
- Replacement drawing sheet with changes is accepted by examiner, unless otherwise notified by examiner. No further drawing submission is required.
- If not acceptable, applicants will be notified of any objections or additional requirements.

# Amendments to Drawings (From the PTO slide show)

- Any replacement drawing sheet including amended figures must include all of the figures appearing on the immediate prior version of the sheet.
- The replacement drawing figure must not be labeled as “amended.”
- 37 CFR 1.173 now provides for amending drawings in reissue applications in a similar manner.

# Amendments to Drawings (From PTO slide show)


- Deletion of a figure requires the following:
  - An instruction to delete the figure;
  - A replacement sheet which does not include the canceled figure, unless no other figure is on the same sheet as the canceled figure;
  - Amendment to the specification to make corresponding changes to the description of the drawings (*e.g.*, deletion of the description of the canceled figure); and
  - If other figures need to be renumbered, those figures also need to be amended with revised figure numbers via replacement drawing sheets.

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# Failure to Adhere to These Standards Will Result in a Notice of Non-Compliant Amendment

More Details to come later in this presentation

 UNITED STATES PATENT AND TRADEMARK OFFICE

Office of the Commissioner  
Washington, DC 20590  
P.O. Box 1450  
Telephone: (301) 491-2000  
Fax: (301) 491-4000

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment to the application is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment to be a compliant amendment, the following requirements must be met. Only the corrected sections of the non-compliant amendment should be submitted to this office. If the entire amendment is submitted, the Office will consider the entire amendment to be non-compliant. 37 CFR 1.121(b).

THE FOLLOWING CHECKLIST IDENTIFIES CAUSES FOR NON-COMPLIANCE. CHECK THE APPROPRIATE BOXES.

1. Amendment to the specification:  
A. Amendment paragraph(s) does not refer to markings  
B. New paragraph(s) does not refer to markings  
C. Other: \_\_\_\_\_

2. Abstract:  
A. Not presented in a separate sheet, 37 CFR 1.177  
B. Other: \_\_\_\_\_

3. Amendment to the drawings:  
A. \_\_\_\_\_  
B. Other: \_\_\_\_\_

4. Amendment to the claims:  
A. A complete listing of all the claims is not present.  
B. The filing of claims creates a file history that purports to be a continuation-in-part application and does not contain the full text of the parent application.  
C. The claims have been prepared with the wrong set of identifiers, and comply the individual nature of each claim is not identified. Note: the use of "each claim" in 37 CFR 1.121(b) is not intended to be interpreted by using the terms "each" or "each claim" (unless it is clearly apparent from the context, e.g., "each claim" or "each claim" or "each claim") in the claims.  
D. The claims of the amendment paper have not been presented in ascending numerical order.  
E. Other: CLAIMS ARE NOT IN ASCENDING ORDER

No. 5. Other requirements of the Guidelines, as amended by 37 CFR 1.101, 1.102, 1.103, 1.104 and the USPTO published in the Official Gazette, have been observed in the amendment.

If the non-compliant amendment is a **PROVISIONAL AMENDMENT**, applicant is granted a **ONE MONTH** time limit to amend the application to comply with the applicable provisions of 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in the application being abandoned. A non-compliant amendment to the application will be considered without amendment to the extent that the amendment is non-compliant. This notice is an administrative action under 35 U.S.C. 115, and only ONE MONTH time limit is applicable.

If the non-compliant amendment is a **FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment system is a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment system is a **NON-FINAL OFFICE ACTION**, the applicant is granted a **ONE MONTH** time limit to amend the application to comply with the applicable provisions of 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in the application being abandoned. A non-compliant amendment to the application will be considered without amendment to the extent that the amendment is non-compliant. This notice is an administrative action under 35 U.S.C. 115, and only ONE MONTH time limit is applicable.

If the non-compliant amendment is a **FINAL REJECTION**, the finality of the rejection is not affected. The finality of the rejection is not affected by the non-compliant amendment.

\_\_\_\_\_  
Patent Trial and Appeal Board  
37 CFR 1.121(b)

971 276-1162  
Telephone No.

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# The Non-compliant Portion of the Amendment has to be redone and resubmitted

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : Confirmation No. 5405

Applicant:

Filed: Ja

Group Art Unit: 2859

Examiner: Ms. Amy

Attorney Contact No.

Customer No.: 2936

For  
displ  
and d

Communications to the Office  
P.O. Box 1450  
Alexandria, Va. 22313-1450

**REPLACEMENT CLAIM LISTING**

Dear Office

In response to a Notice Of Non-Compliant Amendment dated May 09, 2005, please find a replacement Claim Listing.

**The Claim Listing begins on page 2 of this paper**

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# Treatment of Non-Compliant Amendments (From PTO Slide Show)

- Applicants will be notified of any amendment paper that is not accepted because the changes do not comply with revised §1.121.
  - For **preliminary amendments and replies to non-final Office actions or notices**,
    - A Notice of Non-Compliant Amendment identifying the problem section(s) will be mailed; and
    - A period for reply shall be given; but
    - Patent term adjustment (PTA) reductions may be incurred. See §1.704(c)(7).
  - For **after-final amendments**,
    - Non-compliance will be indicated in an advisory action; and
    - The time period for reply continues to run from the mailing date of the final Office action.
  - See MPEP 714.03 (8<sup>th</sup> Ed. 1<sup>st</sup> Rev., Feb. 2003).

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## Treatment of Non-Compliant Amendments (from PTO slide show)

- The Notice of Non-Compliant Amendment will identify:
  - Each section of the amendment that is not in compliance with 37 CFR 1.121;
  - Items that are required for compliance; and
  - The reasons why the section of the amendment fails to comply with 37 CFR 1.121.
- In reply to the Notice, applicants must submit the **corrected section of the amendment** that was non-compliant.
  - Re-submission of the entire amendment is not required.
  - The entire section, however, with corrections, must be resubmitted.
- The Office will only enter the sections of the amendment that are in compliance with 37 CFR 1.121.

## Example (from PTO slide show)

- Non-compliant claim amendment example:
  - If an amendment includes:
    - (1) amendments to the specification, and
    - (2) amendments to the claims, including adding new claims 21 – 25,
      - But the amendments to the claims were non-compliant,
      - Because the claim listing did not include a status identifier for each claim,
  - A Notice of Non-Compliant Amendment will be mailed.

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## Example (Continued) (From PTO Slide Show)

- Non-compliant claim amendment example continued:
  - In reply to the Notice, applicant must submit a **corrected claim listing** that includes a status identifier for each claim.
  - The new claims 21-25 must be presented with the status identifier of “new” and the text of the claims not underlined.
    - Note: the new claims 21-25 must not be presented with the status identifier of “not entered” and must not be renumbered as claims 26-30.
  - A non-compliant amendment is different than an unentered after final amendment situation.
  - In the after final situation, the claim numbers of any unentered new claims may not be re-used.

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## Example (Continued) (From PTO Slide Show)

- Non-compliant claim amendment example  
continued:
  - The Office would enter:
    1. The amendments to the specification from the original amendment paper, and
    2. The amendments to the claims that include the corrected claim listing from the paper filed in reply to the Notice.

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# Rule .127 - Petition Refusal To Admit Amendment to the Commissioner

- Its an option
- See, Rule .181

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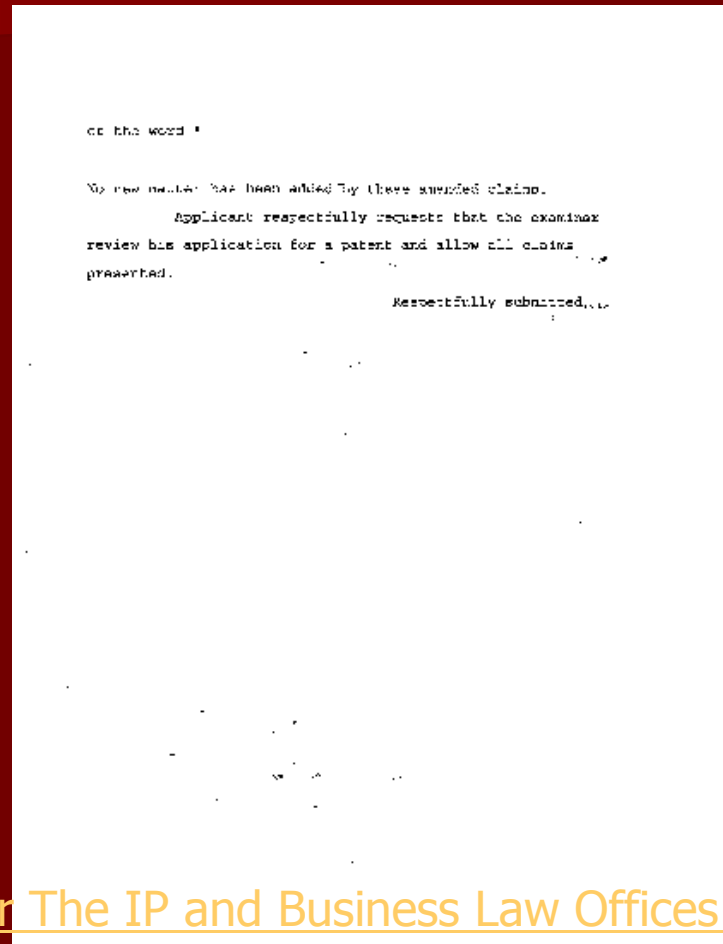
# Rule .115 Preliminary Amendment

- Subpara (a) Amendment before first Office Action
- Subpara (b)(1) Accepted unless unduly interferes with the preparation of an Office Action
- Subpara (b)(2) 3 month from filing “safe harbor” of mandatory acceptance

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# Example of a Preliminary Amendment



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# Rule .111 Reply to a Non-Final Office Action

- Subpara (a)(1) Time Period per Rules .134 - .136 (see next slides)
- Subpara (a)(2) Supplemental Reply will be entered unless interferes with the preparation of an Office Action
- Subpara (b) Must be written; point out supposed error; reply every ground of objection and rejection; arguments of distinction over reference specifically pointing out claim language and may request the objections to form be held in abeyance until allowance

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## Rules .134 and .136 Time Period and Extensions

- Rule .134 - Up to Six months by statute
- Rule .134 - PTO allowed to shorten the statutory period (typically three months)
- Rule .136(a)(1) Petition and fee extension
- Rule .136(a)(1) up to 6 months or 5 months after due date, whichever is less
- Rule .136(a)(1) Except, notified no extensions, reply brief, interference

## Rule .136 Time Period and Extensions

- .136(a)(2) Date petition filed with fee is date for determining extension
- .136(a)(3) application to treat any current or future reply as incorporating a petition
- .136(a)(3) Authorize to charge fees constitutes a constructive petition
- .136(a)(3) submission of fee constitutes a constructive petition
- .136(b) If Rule .136(a) is not available, then there needs to be a showing of sufficient cause

# Overcoming 102 Rejections (Anticipation) (See MPEP 706.02(b))

- 102(a) and 102(e)
  - Claim patentably distinguishable
  - Amend to be patentably distinguishable
  - .131 Declaration for priority (see next slides on swearing behind a reference)
  - .132 Not by another
- 102(b)
  - Claim patentably distinguishable
  - Amend to be patentably distinguishable
  - Amend to claim priority

# Arguments Against a 103 Rejection-No incentive to combine the references because (a) impermissible hindsight (b) Applicant discovered a new property of nature, (c) unrelated references

The applicant respectfully traverses these objections. The applicant submits that the cited references do not make obvious either the quantitative material of claim 21 or the concrete materials recited in claims 1-20. The cited references merely disclose various elements found in applicant's invention. There is no teaching or suggestion of any reason or incentive why it would be advantageous to combine these various elements to form applicant's unique cement and concrete. The applicant contends that in the absence of such teaching or suggestion it would not be obvious to one of ordinary skill in the art to extract individual elements from the various references and combine them to form applicant's invention. Only after being educated by applicant's disclosure would one of ordinary skill in the art realize the value of combining the various elements in the manner taught by applicant.

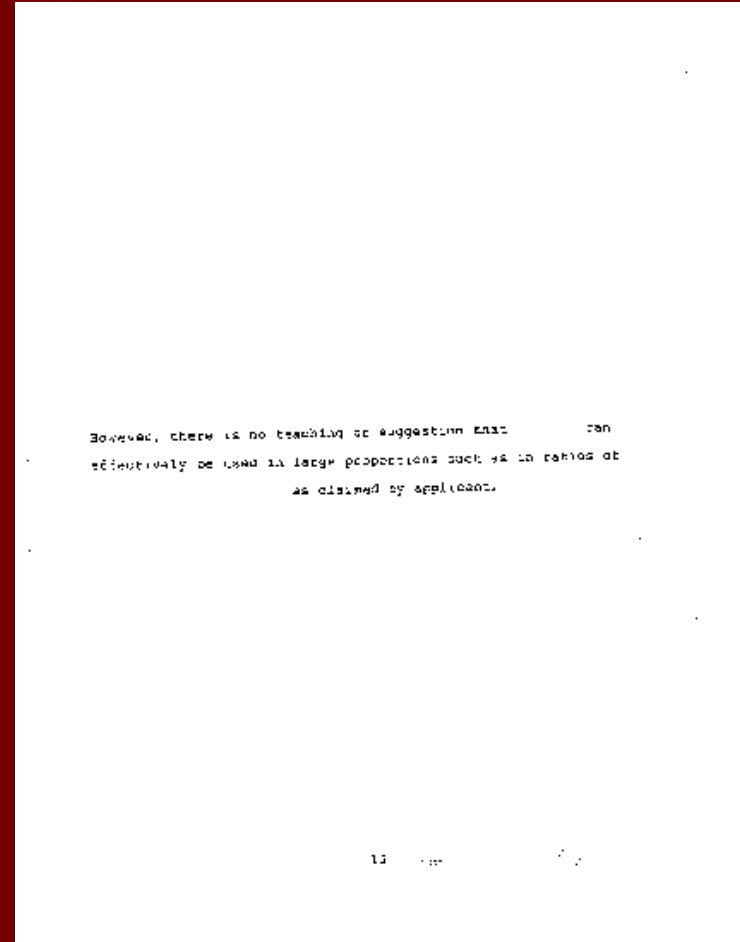
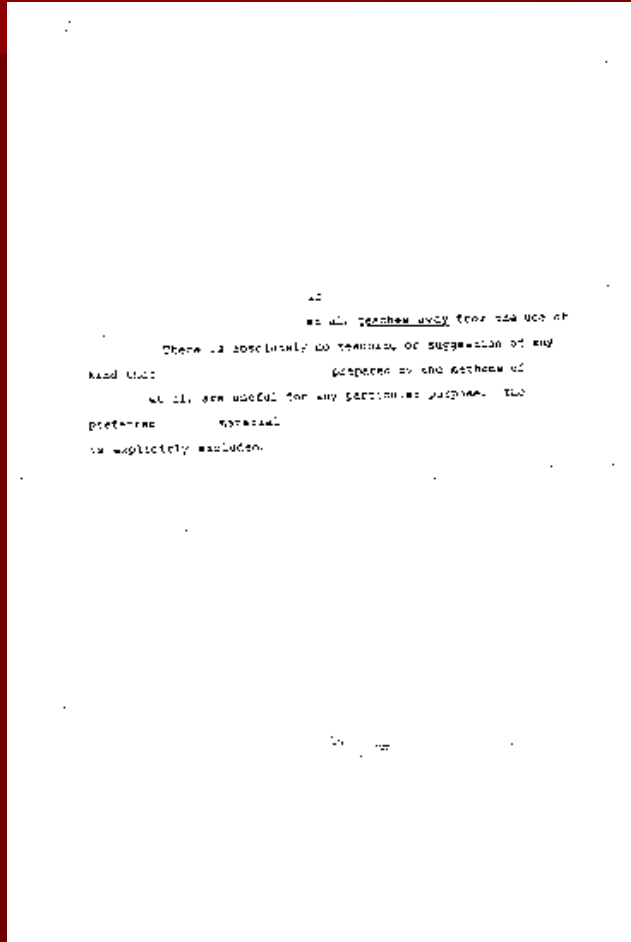
It is the lack of knowledge of these facts which made the material recited in claim 21 unobvious to those of ordinary skill in the art. It was the discovery of these facts by the applicant which first provided the incentive to produce the invention.

Applicant strongly contends that one of ordinary skill in the art could not have found the invention obvious by reading the references cited by the Patent Office. Such references are almost totally unrelated to each other and there is no teaching or suggestion in any of them as to how one might produce a concrete which is just the right way to produce applicant's unique invention.

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# Arguments Against a 103 Rejection-No incentive to Combine the references because, (d) reference teaches away



# Arguments Against a 103 Rejection-No incentive to Combine the references because, (e) picking and choosing elements from the prior art

As stated in Pearce Corp. v. Dennison Mfg. Co., 227 USPQ 337, 145 (Pis. Cir. 1985):

"It must be remembered that the Examiner is required to consider references in their entirety, i.e. including those portions that would argue against obviousness."

Thus it can be seen that although various elements of the invention are disclosed in the references cited by the Patent Office, there is nothing in the references that suggests or suggests any reason or incentive to combine the various elements in the way claimed by the applicant. The rejection of claim and claim under 35 U.S.C. 103 over the cited references, therefore, does not offend a basic principle inherent in Section 103, namely, that it is not appropriate to pick and choose from the references to reconstruct precisely the applicant's invention in light of the disclosure by applicant.

Accordingly, it is inappropriate to merely select certain features of an art. At all, in derogation of what they fairly suggest to one of ordinary skill in the art in their entirety, and then to combine the same to reject the pending claims. The Patent Office's hindsight application of the prior art is in error.

# Arguments Against a 103 Rejection that the invention is the product of routine experimentation/optimization – (a) examiner bears the burden of proof, (b) unexpected result

## REMARKS

In this application are claims 1-16, 18-20, 20 and 31. No claims are allowed. All claims are rejected as obvious pursuant to 35 USC § 103. An additional rejection is made to claims 14-16 and 26-28 pursuant to 35 USC § 103. Additional reference to statute.

### Support For The Amendment

The four independent claims 1, 12, 30 and 31, have each been amended to add the limitation that the alloy composition is substantially without enhanced temperature condition. Support for the amendment is found in the specification and the data in tables 7 and 8.

### The Reaction Under 35 USC § 103

The Examiner is asked to reconsider the position that the ratio of [redacted] in the range of [redacted] would be obvious to one of ordinary skill in the art.

Further, the Examiner is asked to consider that it is incumbent upon the Patent Office to provide authority that the range is deducible through routine experimentation.

It is brought to the Examiner's attention that the optimizing ratio produces an unexpectedly good alloy composition and hence the invention is unobvious.

It is further brought to the Examiner's attention that the alloy compositions of the present invention produce an unexpected result of a different kind from that of other alloy compositions in the art.

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# Rule .130 Affidavit to Disqualify a Commonly Owned Patent

- A 103 rejection that is not a 102(b) rejection
- Not identical; but not patentably distinct inventions
- Owned by the same party
- Terminal disclaimer (see, rule .321)
- Declaration commonly owned and the inventor named in the application is the prior inventor under 35 USC 104 (invention made abroad)

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# Rule .131 Affidavit of Prior Inventorship

- Claim rejected based on a reference
- A declaration of prior inventorship with documentation (can show prior conception and due diligence in reduction to practice)
- The date of the reference is the publication date or the 102(e) date, whichever is earlier
- Inventorship must occur in the USA, a NAFTA country or a WIPO country
- Not apply if it is the same invention (see, interference) or there is a statutory bar

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# Rule .132 Affidavit Traversing Rejections or Objections

- Any Evidence
- Used to supply experimental data of utility, superior result, unexpected result
- Used to supply secondary factors of non-obviousness; e.g., sales

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# Rule .133 Interview with an Examiner

- Informal telephone discussions
- Call Examiner to arrange a time for a formal interview
- Subpara (a)(1) At office during office hours; in person, by telephone or T-1 line video (go, San Jose library)
- Subpara (a)(2) not before first Office Action; Except in a Continued Application
- Identify claims and prior art for discussion
- Subpara (b) a written record required
- Subpara (b) does not relieve responding to an Office Action
- Strategy – fax over proposed amended claims for discussion

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## Rule .112 Reconsideration Before Final Action

- Process repeats itself
- The Application again examined by PTO
- Notified by an Office Action
- Reply to such Office Action
- The PTO's Practice is to make the Second Office Action a Final Rejection (see next slides regarding what this is and how to continue prosecution)



# Rule .113 Final Rejection

- Subpara (a) On Second or subsequent (policy is second action Final)
- Subpara (a) Options are to:
  - After Final Amendment (see next slides)
  - Appeal to BPIA (Rule .191)
  - Request For Continued Examination (RCE) (Rule .114) (see next slides)
  - Petition to Commissioner (Rule .181) regarding objections or requirements
- Subpara (c) Cancel or Appeal Rejected Claims
- Subpara (c) As for allowed claims, comply requirements and objections as to form (i.e., graduate to Allowance)

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# Rule .116 Amendment After Final or Appeal

- Subpara (b) cancel claims, comply requirements of form
- Subpara (b) amend to present rejected claims in a better form for appeal
- Subpara (b) does not relieve from appealing or save from abandonment
- Subpara (c) Amendment touching on the merits, may be admitted for good cause
- Subpara (d) no amendment as of right in appealed case



# Example of an After Final Amendment

Rejection Under 35 U.S.C. 103

All of the claims are rejected under 35 U.S.C. 103 as being unpatentable over the reference of view of the references of

1

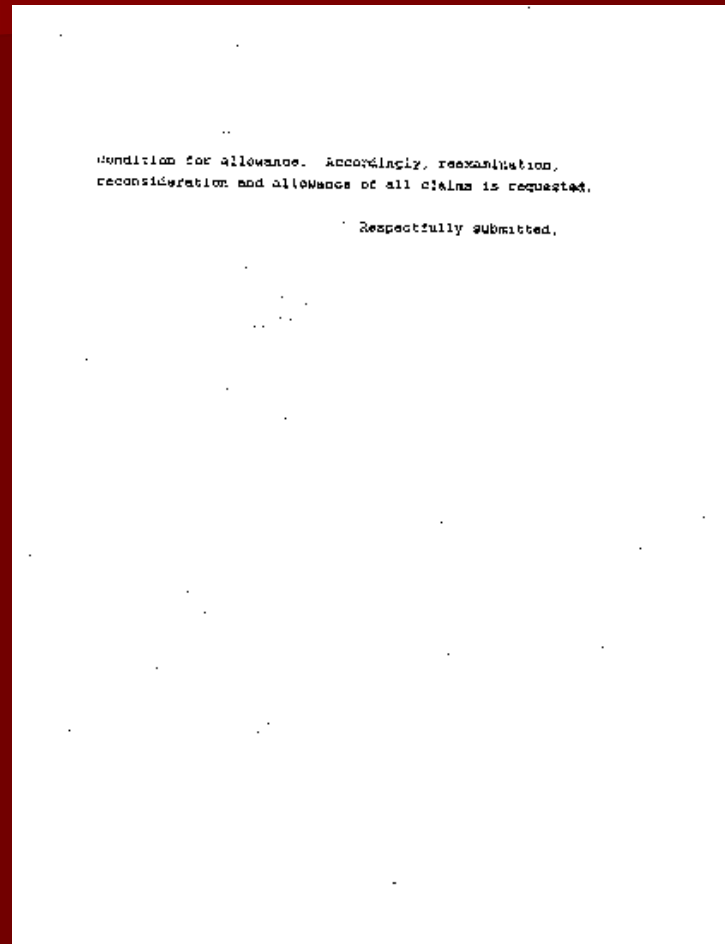
it is respectfully submitted, however, that as amended, all of the claims are now patentable over these references. Accordingly, reexamination, reconsideration and allowance of all of the claims are requested.

Conclusion

For the reasons set forth above, applicant respectfully request that this Amendment be entered. By this Amendment, it is submitted that all of the claims are now in

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# Example of an After Final Amendment



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# After Final Amendments (From PTO Slide Show)

- Any amendment after final (§1.116), or amendment filed with a request for continued examination (RCE) under §1.114, must include markings showing the changes relative to the last entered amendment.
  - Do not include markings to show changes relative to any unentered amendment.
  - Applicant should not assume that an after final amendment is entered because after final amendments are not entered as a matter of right (§1.116).

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# After Final Amendments (Continued)

- If applicant has not received an advisory action, applicant should check via PAIR, or call the examiner, to determine whether the after final amendment has been entered before filing another after final amendment or an amendment with an RCE.
- If the advisory action has indicated that an after final amendment will be entered upon the filing of an appeal, applicant should assume that the after final amendment is not entered.
  - Any subsequent amendment must include markings showing the changes relative to the last entered amendment, and not the amendment which the advisory action indicated will be entered upon the filing of an appeal.

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# After Final Amendments (Continued)

- If applicant wishes to file an RCE after filing more than one after final amendment that has not been entered, applicant is encouraged to file an amendment with the RCE that includes:
  - Instructions not to enter the unentered after final amendments; and
  - All of the desired changes, including changes presented in the unentered after final amendments.
    - The markings must show changes relative to the last entered amendment.
    - A claim listing which includes any unentered claims presented using the status identifier “not entered” (*e.g.*, claims 20-25 (not entered)).
    - Any new claims must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not).



# Rule .127 - Petition Refusal To Admit Amendment to the Commissioner

- Its an option
- See, Rule .181

## Rule .114 Request For Continuing Examination

- Subpara (a) Prosecution is closed
- Subpara (b) Prosecution is closed when Appeal, Final Action (.113) or Notice of Allowance (.311)
- Subpara (a) Pay a fee before issue (unless petition to withdraw issue .313); abandonment; Appeal to CAFC or suit under 35 USC 145, 146
- See subparagraphs (c), (d) and (e)



# International Applications (From PTO Slide Show)

- The revised amendment practice under 37 CFR 1.121 does not apply to amendments filed in the international stage of an international application.
  - Such amendments must be in compliance with the Patent Cooperation Treaty (PCT) amendment procedure (*i.e.*, PCT Articles 19 and 34(2)(b)).
  - Thus, status identifiers are not to be used during the international stage.
- Amendments filed in the national stage (pursuant to 35 U.S.C. 371) of an international application must comply with the revised amendment practice under 37 CFR 1.121.
  - The status identifier “original” must only be used for claims that were presented on or before the international filing date and have not been modified or canceled.

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## *Information Contacts* (From PTO Slide Show)

- Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA):  
Call (703) 305-1616,  
e-mail to [PatentPractice@USPTO.gov](mailto:PatentPractice@USPTO.gov), or  
Contact one of the following Legal Advisors:

Elizabeth Dougherty ([elizabeth.dougherty@uspto.gov](mailto:elizabeth.dougherty@uspto.gov))

Eugenia Jones ([eugenia.jones@uspto.gov](mailto:eugenia.jones@uspto.gov))

Joe Narcavage ([joseph.narcavage@uspto.gov](mailto:joseph.narcavage@uspto.gov))

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