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- September 9 Enforcement Issues
- September 15 Balancing Data Privacy Obligations and Regulatory reporting/disclosure requirements in international [export and sanctions] investigations
- September 17 GDPR Specialties Cookies/International Data Transfers and EU ePrivacy Regulations
- September 24 Antitrust Issues to Watch Out for with Big Data Sets
- September 29 Cybersecurity Incidence Response: Managing Near Term and Long Term Issues

Before we begin

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**PATENT PROSECUTION FROM AN
EXAMINER'S PERSPECTIVE**

**INTERVIEWING THE EXAMINER
AND RESPONDING TO THE OFFICE ACTION**

July 1, 2020

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Presenters



Andrew J. Gray IV

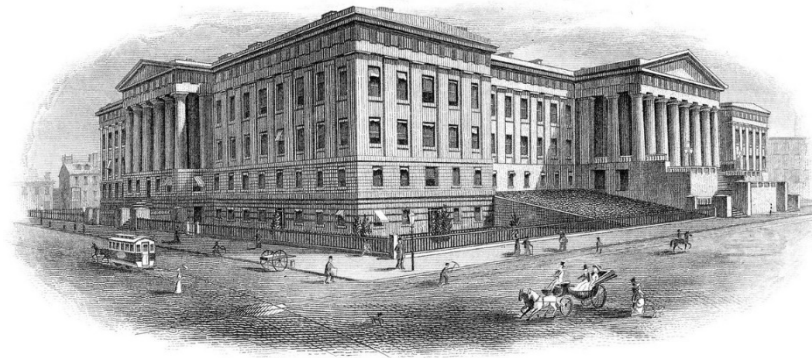


Benjamin H. Pezzner

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Presentation Goal

- Examination Quality!
 - How to get patent examiners to follow PTO rules, their training, and be more accountable
 - More accountability > higher quality examination > allowances



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Agenda

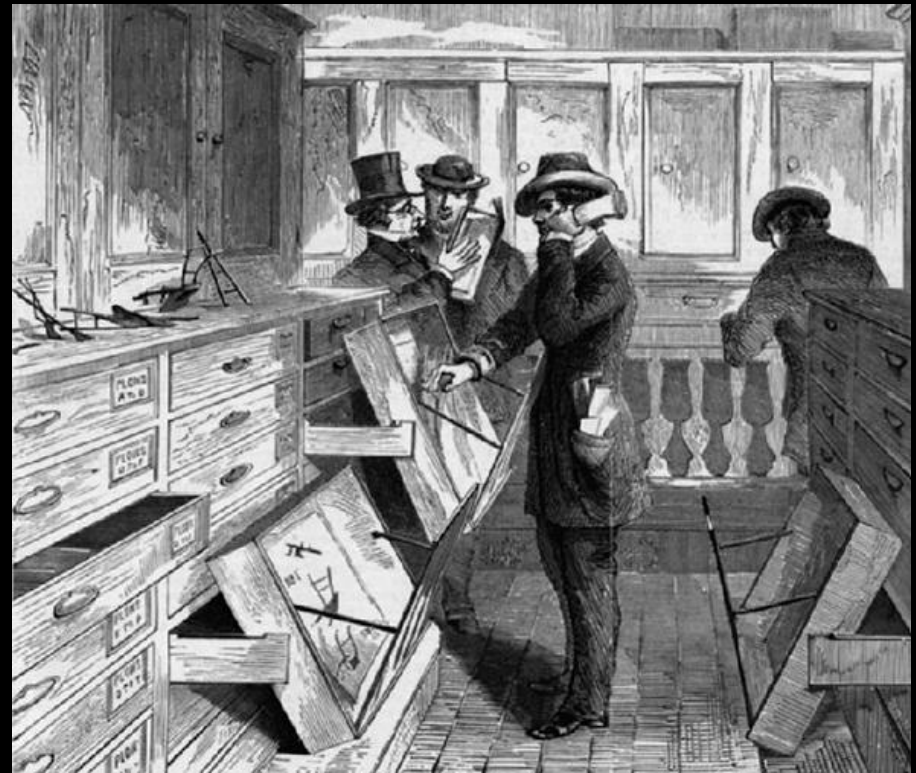
1. Examiner's Perspective
 - Motivations and training
2. Before the Interview
 - Evaluate the office action, draft an agenda
3. During the Interview
 - Clarify the record, pursue admissions
4. After the Interview
 - Draft arguments based on clarifications and admissions
5. Examples

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Examiner's Perspective

Motivations > Training > Toolkit

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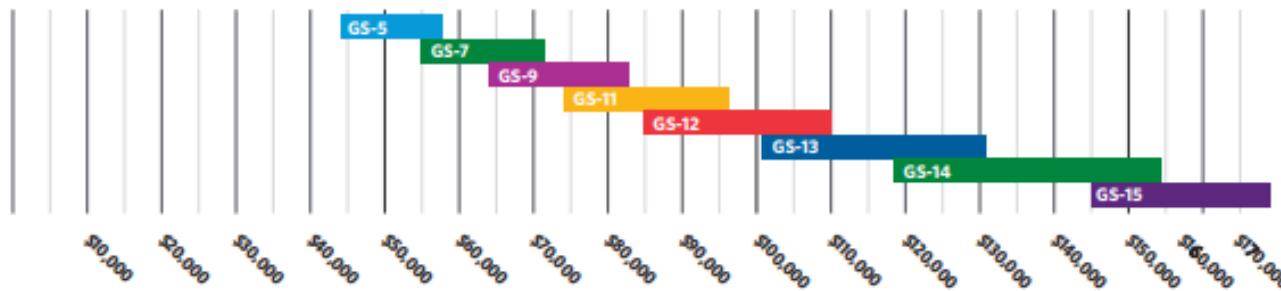


Examiner's Perspective

[Motivations](#) > Training > Toolkit

- Evaluated based on quantity (production) and quality (master review form)
- Grades come out every biweek, every quarter, every year
- Base salary: roughly \$70-\$90k (junior), \$105k - \$125k (primary)
- Salary + bonus: \$170k (up to 60% of base salary)

Patent Examiner Pay Scale, Fiscal Year 2020



Examiner Motivations

Motivations > Training > Toolkit

2.0 counts per round of prosecution

non-final action > final action > disposal (RCE|appeal|allow|abandon)

1.25

0.25

0.5

$$\text{Production} = \frac{\text{Counts}}{\text{Examining Time}}$$

non-exam "other time" for: training, interview prep (30 min),
AFCP consideration (2 hr.)

nothing for: regular after-final, non-interview phone calls,
communications between OA and response

Examiner Training

Motivations > Training > Toolkit

Prior Art Search

Training	Practice*
Compact prosecution (read spec, search the inventive concepts)	Piecemeal prosecution (skip spec, search for buzzwords in claims)
Look at keywords in context	Buzzword bingo (ignoring context)

*Observed in practice. Not official examination policy

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present assistance **icons** on the touch screen, which serves as touch-button for the user to select different assistances. Or it can be so it can utilize the buttons on the hardware (e.g. mobile phones) such as having the fast dial or side button programmed to request different assistances.

Brief Summary Text - BSTX (21):

[0019] The user can download the software after subscribing to the personal security service plan. The software provides multiple options of assistance through selectable **icons** on the touch screen of the mobile phone or buttons on the mobile phone; the options include but are not limited to police stations, medical facilities, roadside assistance, etc. The software can utilize the GPS receiver in the mobile phone that sends tracking signals. When an individual is in need of assistance, the individual presses the button to send out an alert to the assistance providers via SMS or e-mail alert or other technologies currently known or available in the future. The information regarding the mobile phone owner such as name, age, social security number, driver license number, **medical history** etc may be provided to the assistance provider depending on the nature of the assistance. For example, if a police station is contacted, more detail information will be provided to the police station. If a medical assistance is needed, the owner's **medical history** may be provided. If the road service is needed, there's no need to provide social security number. The alert will also contain the time and date.

Brief Summary Text - BSTX (24):

[0022] The GPS receiver in the mobile phone tracks mobile phone's position information from GPS satellites. The detected information is then provided to the phone module. When the assistance button is pushed or **icon** is touched, the phone module collects the location information from the GPS receiver and sends it through cellular networks to assistance providers that can plug the coordinates into map files in their computer system.

Description of Disclosure - DETX (3):

[0031] FIG. 1 is a perspective view of a mobile phone showing the

[0031] FIG. 1 is a perspective view of a mobile phone showing the

[FLT]	U	1	2	3	4	5	6	7	Pa	Inventor	Document ID	Filing Date	Title	Current OR
1									50	McCoy, Kate	US 20130189944 A1	20130116	TRACKING AND REPORTING INFORMATION CHARAC	455/404.1
2									10	Jadaan; Majd	US 2012020849 A1	20110210	Personal Security With Location Tracking Service	455/404.2
3									25	Conroy, Thomas M.	US 20120088466 A1	20110113	Critical health information profile and emergency co	455/404.1
4									40	Barash; David et al.	US 20110117878 A1	20101115	Community-Based Response System	455/404.2
5									31	Pfeffer; Anshel	US 8314683 B2	20090427	Incident response system	340/7.3
6									18	Scott; Sherry Lee Lo	US 20100190468 A1	20090128	METHOD OF PROVIDING LOCATION INFORMATION I	455/404.2
7									15	Scott; Sherry Lee Lo	US 20100190467 A1	20090128	METHOD OF INTEGRATING EMERGENCY INFORMATI	455/404.2

Rejection

Training	Practice*
Map each claim element to a specific teaching in the reference	Condense multiple claim elements, provide one citation
Specific citations (e.g., paragraph [0054] lines 4-7)	Bulk citations (e.g., paragraphs [0054]-[0062])
Add brief explanations re: grounds of rejection	Add findings that are not necessarily supported by the reference

*Not official examination policy

Response to Arguments

Training	Practice*
Respond to the <u>substance</u> of each argument	Response may repeat the rejection without substantively responding
Respond to the substance of <u>each</u> argument	Response may lump arguments together and skip certain points
Respond to arguments that are still relevant even if new grounds of rejection	Response may improperly label <u>all</u> arguments moot in light of new references

*Not official examination policy

Errors

Training	Practice*
Find arguments persuasive + Issue a second non-final OA or withdraw finality	Maintain rejection until next RCE
	Propose amendments (allowing the next OA to go final)
	Reject using new citations to the same references, go final

Rework due to an error (second non-final, withdrawing finality, reopening prosecution after final) invites scrutiny because this hurts the SPE/art unit's ratings.

*Not official examination policy



Broadest Reasonable Interpretation (BRI)

- The broader the BRI, the easier it is to find prior art
- The standard varies from art unit to art unit, difficult to argue



Combination Rejections (103)

- The greater the number of references, the easier it is to find prior art
- TSM and KSR findings are often tenuous, yet still difficult to argue



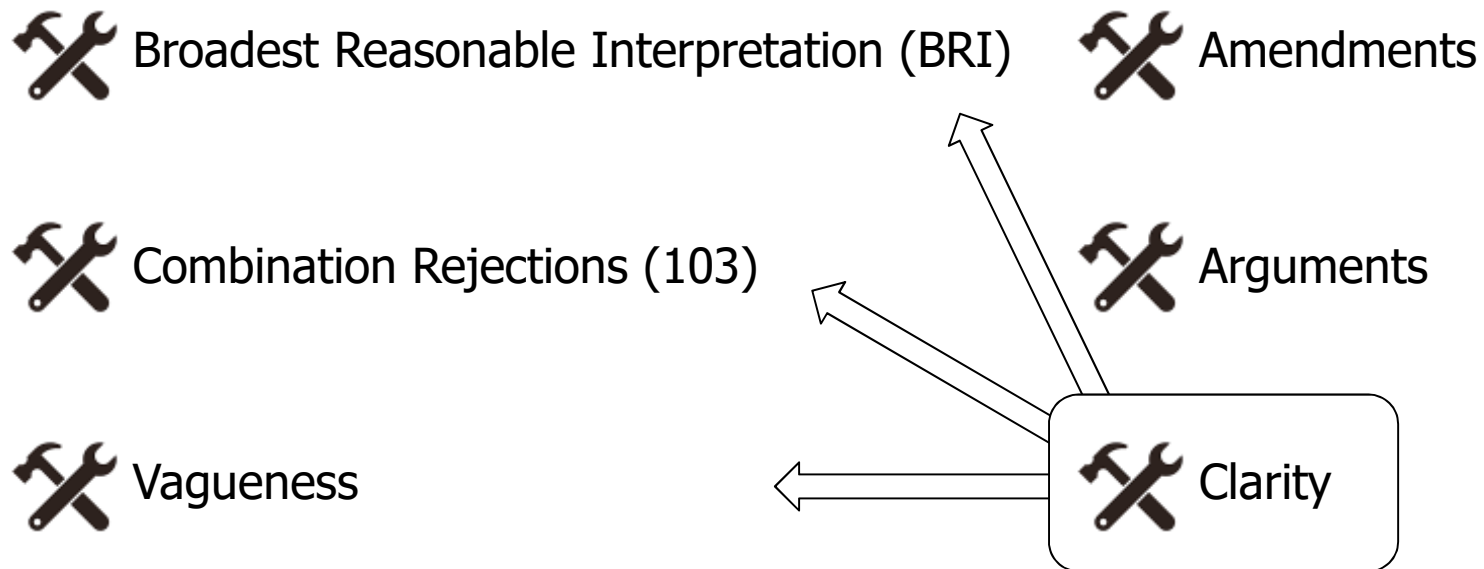
Vagueness

- The more ambiguous the rejection, the easier it is to maintain
- Lack of clarity (grouping multiple claim elements together, bulk citations)

*Not official examination policy

Examiner's Toolkit*

Applicant's Toolkit



*Not official examination policy

Before the Interview

Evaluation > Clarification > Agenda Prep

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Before the Interview

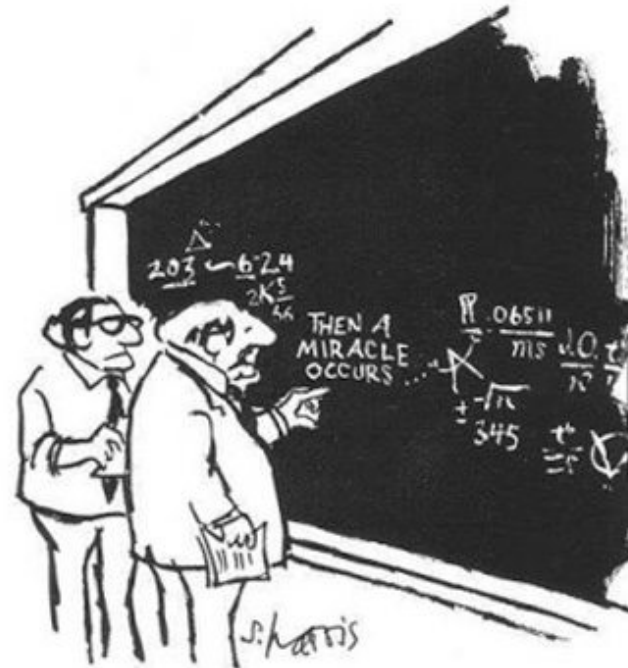
Evaluation > Clarification > Agenda Prep

- Evaluate the Office Action
 - Breaking these two rules = new ground of rejection (do-over)
 1. Address every element in the claims by mapping to a reference or by explaining obviousness or inherency
 2. Address every argument in the applicant's response

"Clarity of the Record"

(Examiners must show their work!)

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"I THINK YOU SHOULD BE MORE EXPLICIT HERE IN STEP TWO."

- If a claim element is mapped:
 - Evaluate the citations (paragraph/line numbers vs. bulk citations)
 - Evaluate the examiner's notes (explaining BRI vs. unsupported findings of fact)
 - Evaluate the rejection's handling of the claim's "connective tissue"
 - Timing elements: "prior to...," "subsequent to..."
 - Conditional elements: "in accordance with...," "in response to..."
 - Relationships between elements: "X determines Y," "Y includes Z"

- If a claim element is not mapped:
 - Does the OA articulate a reason for not mapping the element?
 - If official notice, some kind of reasoning is required
 - MPEP 2144.03(B): “The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support the conclusion of common knowledge”
 - If inherency, easy to challenge in the response
 - MPEP 2112(IV): “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient.” The characteristic must “necessarily flow” from the prior art.
 - If 112 issue (e.g., examiner says “the claim didn’t describe *how* A performs B”)
 - MPEP 2173.06(II): “Avoid piecemeal examination” – include prior art rejections unless “there is a great deal of confusion and uncertainty.” [this is a high bar]

Before the Interview

Evaluation > Clarification > Agenda Prep

- Step 1: Find all of the holes in the OA
 - Claim elements that were not mapped, or mapped so vaguely that it's impossible to figure out what the examiner was thinking
 - Arguments that were not substantively answered
- Step 2: Prioritize the holes
 - Give high priority to important claim elements (the inventive concept) that are missing
 - Give high priority to ignored arguments that would easily win on appeal (disqualify a reference, disqualify an interpretation)
- Step 3: Call the examiner (optional)
 - Pre-interview clarity calls can be extremely important; don't wait for the actual interview
 - The PTO encourages applicants to call and ask questions about the OA

- Pre-interview clarity call (cont'd)
 - Frame the call as preparation for the interview
 - “I was preparing the interview agenda and I had a couple questions about something I saw in the office action. I was hoping we could clear this up before the interview so I can draft a better agenda.”
 - Pick the one or two most important items on your list, and keep the questions short
 - “I couldn’t find where the timing condition in claim 1 is addressed in the OA. Can you show me where this is?”
 - “The OA maps the ‘second sub-stream’ in claim 1 to twelve paragraphs in the primary reference. I was wondering which part of that selection you’re mapping to?”
 - “I couldn’t find a response to my second argument. Can you point me in the right direction?”
 - “I wasn’t sure what you meant by ‘A means B’ on page 3 of the OA. Can I get some more details?”

Before the Interview

Evaluation > Clarification > Agenda Prep

- Pre-interview clarity call (cont'd)
 - If the examiner puts in a good faith effort but can't answer a question, ask for a follow-up call
 - Politely reiterate that the reason for the call is to ask a question about the office action in preparation for the interview (not to propose arguments or amendments)
 - Politely note that the official interview may not be productive unless you have an answer to your question beforehand

Before the Interview

Evaluation > Clarification > Agenda Prep

- Step 1: Find all of the holes in the OA
- Step 2: Prioritize the holes
- Step 3: Call the examiner
- Step 4: Draft the agenda
 - The examiner gets 30 minutes of non-examining time to prepare (but often does not use this time)
 - The more streamlined the agenda, the more likely you'll get substantive answers and cover each topic
 - Consider discussion topics (vs. draft arguments)

- Sample discussion topics for the agenda:
 - “Discuss BRI of the term ‘second sub-stream’ as recited in claim 1.”
 - “Review mapping of lines 3-4 of claim 1 to the primary reference.”
 - “Discuss Figure 3 of the reference in relation to the ‘inner shell’ recited in claim 1.”
- Capture the examiner’s pre-interview clarifications in the agenda
- Consider adding figures and reference snippets directly to the agenda (cut down on time spent shuffling papers/windows)

During the Interview

Clarification > Deflections > Admissions

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- Consider adding oversight
 - If OA is signed with initials => junior examiner, may ask for primary/SPE to join
- Focus on clarifying the record
 - Rather than explaining and advancing arguments, let the examiner do all of the talking
 - Ask questions first, save arguments for later: “How are you mapping limitation X?”
- Goals:
 1. Get the examiner to take a position re: missing claim elements and arguments
 2. Get the examiner's positions on the record (interview summary)
 3. Use the examiner's clarified positions in your next response

- Consider diving right in without offering to explain anything
 - A: “Thank you for the interview. Did you have an opportunity to review our agenda?”
 - E: “Yes”
 - A: “Great. Do you have any thoughts on the first discussion topic?”
- If the examiner asks for some background first:
 - Ask the examiner if he/she needs additional time to review the agenda
 - Don't go on too long about the invention while the examiner's sitting on the phone; do a quick 15-30 second introduction and transition back to the discussion points
 - Keep track of how much time is spent answering examiner's questions vs. examiner answering your questions/discussion points (keep refocusing until you get an answer)
- Keep the focus on the words in the claims and the words in the reference

- Examiner deflections
 - Stay focused on the agenda points
 - Examiners sometimes conflate prior art issues with:
 - scope (e.g., how are you mapping this? “well it's so broad it can mean anything”)
 - support (e.g., how are you mapping this? “well what's your support?”)
 - indefiniteness (e.g., how are you mapping this? “well I'm not sure what it means”)
 - procedural deflections (e.g., “include this argument in a formal response”)
the argument has already been “formally included” in this interview agenda!

- Examiner deflections: 112 conflation (cont'd)
 1. Confirm there are no 112 issues (if there are no 112 rejections)
 2. Confirm claim is allowable over prior art (if there are no 102/103 rejections)
 3. If Examiner doesn't give confirmation, ask for an explanation
 4. Document explanation in interview summary and arguments; for a 112 or 102/103 explanation on the record "in the event the next OA maintains the rejection"
 5. If next OA includes a new 112 rejection, or a new 102/103 rejection, ensure OA is a second nonfinal, or finality is withdrawn

- Examiner deflections: further search/consideration
 - Fine if in response to proposed amendments or complicated arguments
 - Not ok if in response to an agenda item asking a clarity question regarding the OA
 - Schedule a follow-up call (applicant is entitled to an answer before responding)
 - Examiner should have used the 30 minutes to review the agenda topics and prepare quick responses
 - Reminder: this only works if the agenda is streamlined (2-3 topics, straightforward clarity questions)

- Examiner admissions
 - Clarity questions may be worded in such a way as to make the examiner admit to an incorrect or inconvenient interpretation of a claim element or prior art reference
 - Example admissions (in order from easiest to hardest to obtain)
 - Agreement that the examiner is interpreting claim element Z to mean Y so that the reference still applies (the more far-fetched Y is, the better)
 - Agreement that disclosure X in reference A does not teach Y (where Y isn't necessarily a claim element, but can be used in a later argument)
 - Agreement that disclosure X in reference A does not teach Z (where Z is a claim element)
 - Agreement that claim element Z is not taught by the cited references
 - Agreement that claim 1 is distinguished over the cited references
 - Agreement that the claims are allowable

After the Interview

[Summary](#) > [Arguments](#) > [Amendments](#)

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Interview Summary

- Get the examiner's clarifications on the record (the most important part!)
 - "Examiner noted during the interview that the office action relies on feature A of reference X to teach limitation B in the pending claims."
 - "Examiner noted during the interview that the office action interprets limitation B as ____."
 - "Examiner clarified the record by offering the following additional explanation regarding interpretation of limitation X."

Arguments: Form

- Consider including a form paragraph at the beginning of the argument section:
 - “For purposes of compact prosecution, if the next office action maintains the current grounds of rejection, the Applicant requests a separate response to each of the following arguments.”
- Label arguments with big bold headings:
 - “Argument 1: ____”
 - “Argument 2: ____”

Arguments: Substance

- Argue based on the examiner's clarifications
 - Once the examiner takes a position (e.g., narrows or clarifies an interpretation), use this clarified position moving forward
 - The more specific you can get during the interview, the easier it will be to distinguish the claims in the response AND the better the applicant's position will be on appeal

Arguments: Substance

- The key is to focus on narrowing a vague point in the OA to a specific position during the interview, so you can argue that more specific position in the response
 - This makes it harder for the examiner to move the goalposts in the next office action
 - The examiner can narrow an interpretation after a response and go final; but if the applicant can narrow the interpretation before the response (during the interview), the examiner must (i) find new references, or (ii) keep the references and rely on a tenuous argument for maintaining the rejection
- If the arguments are persuasive + no amendments, the examiner is motivated to find allowable subject matter

Amendments

- PROs
 - Move prosecution forward, make the examiner happy
 - Clear up claim ambiguities and BRI nuances
- CONs
 - Narrow the scope of protection
 - Cause potential issues during litigation (doctrine of equivalents is presumed surrendered)
 - Let the examiner off the hook (can use new references, label your arguments moot, and go final)
- Conclusion
 - If you have a winning argument + references are nowhere close, consider arguments only
 - If references are close + examiner has agreed that amendment would distinguish, may consider amending to advance prosecution (even if arguments are good)

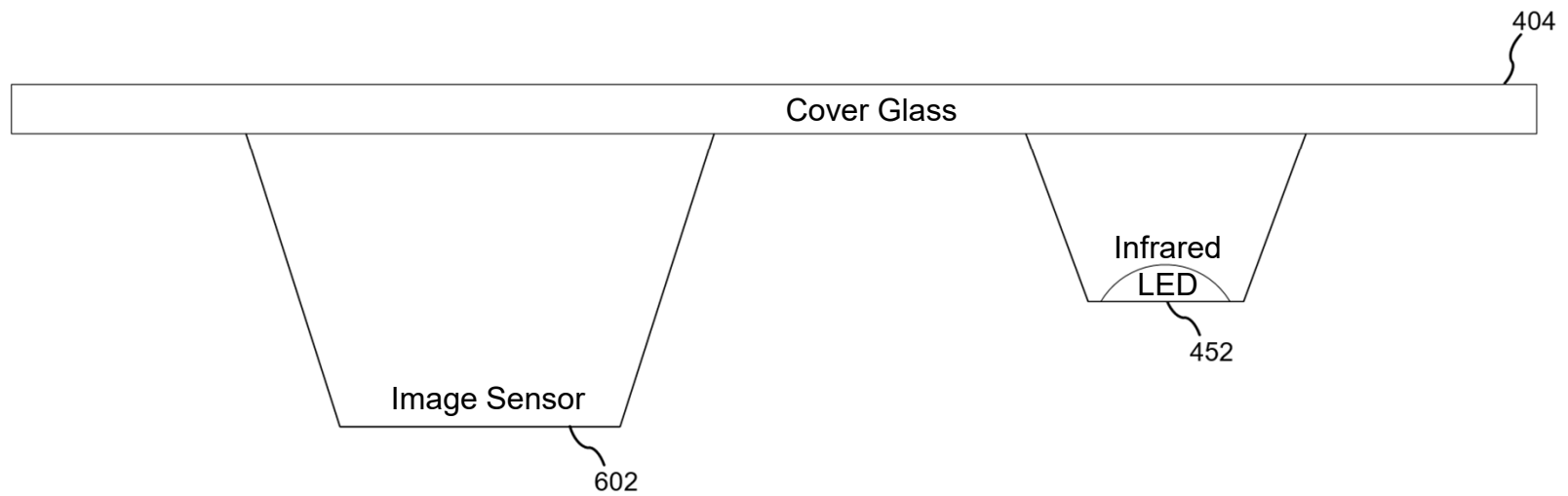
Takeaways

- Before the interview: clarify broad interpretations, narrow the examiner's positions, fill in missing pieces of the office action
- During the interview: keep the focus on clarifying the record, keep the examiner on track, don't get bogged down in deflections from the agenda topics, pursue examiner admissions
- After the interview: include a detailed accounting of the examiner's clarified positions in the interview summary; proceed with the response based on these clarified positions

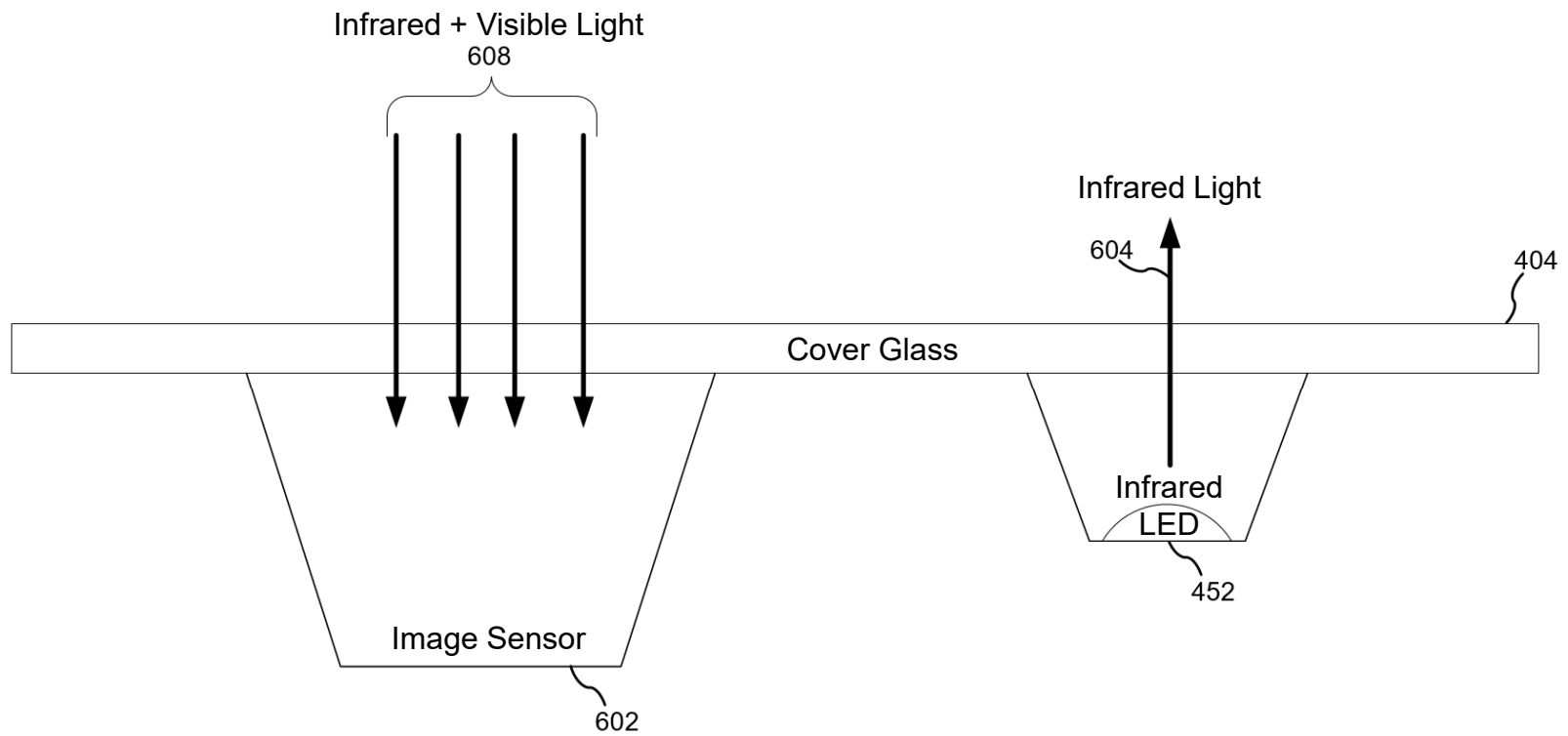
Examples

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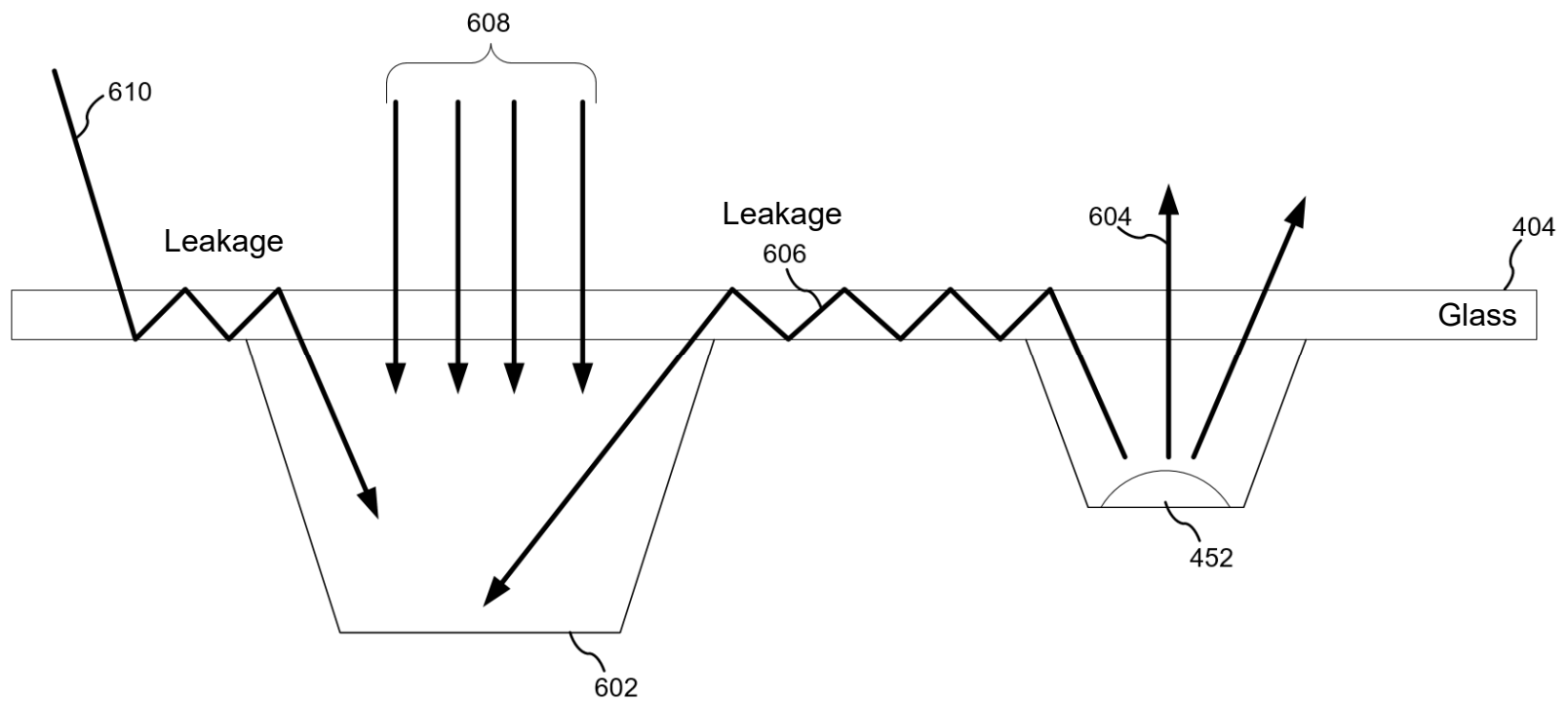
Example 1: Cover Glass



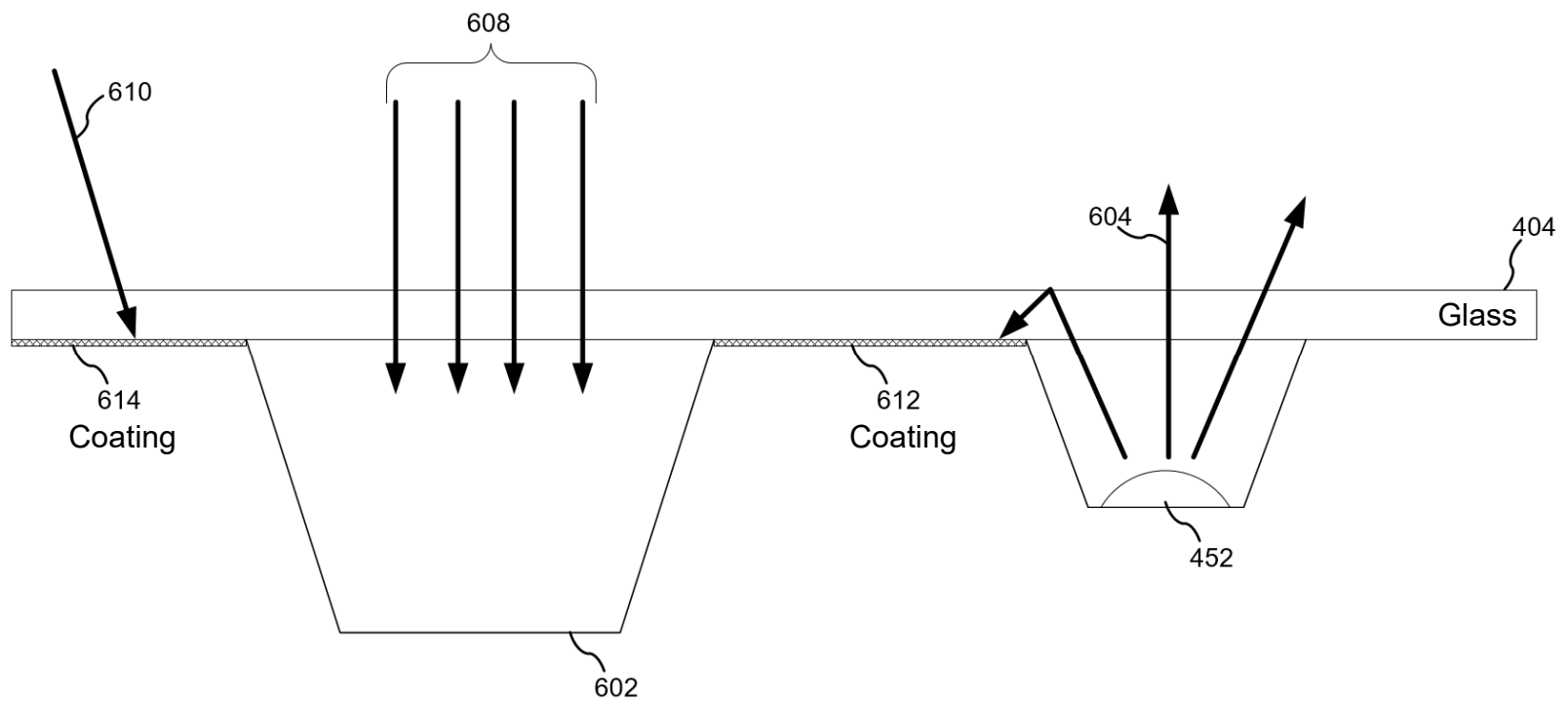
Example 1: Cover Glass



Example 1: Cover Glass

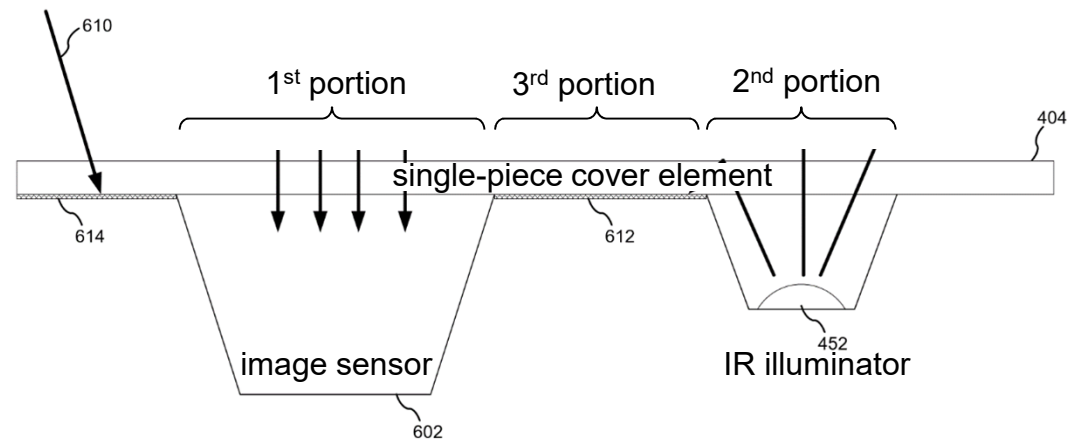


Example 1: Cover Glass



Example 1: Cover Glass

1. A camera assembly, comprising:
 - an image sensor having a field of view corresponding to a scene;
 - an infrared (IR) illuminator configured to selectively illuminate the scene; and
 - a single-piece cover element positioned in front of the image sensor and the IR illuminator, the cover element including:
 - a first portion corresponding to the image sensor, the first portion being substantially transparent to visible light and IR light;
 - a second portion corresponding to the IR illuminator, the second portion being substantially transparent to IR light; and
 - a third portion between the first portion and the second portion, the third portion being substantially opaque to IR and/or visible light.



Example 1: Cover Glass

First Office Action (non-final)

Interview Agenda

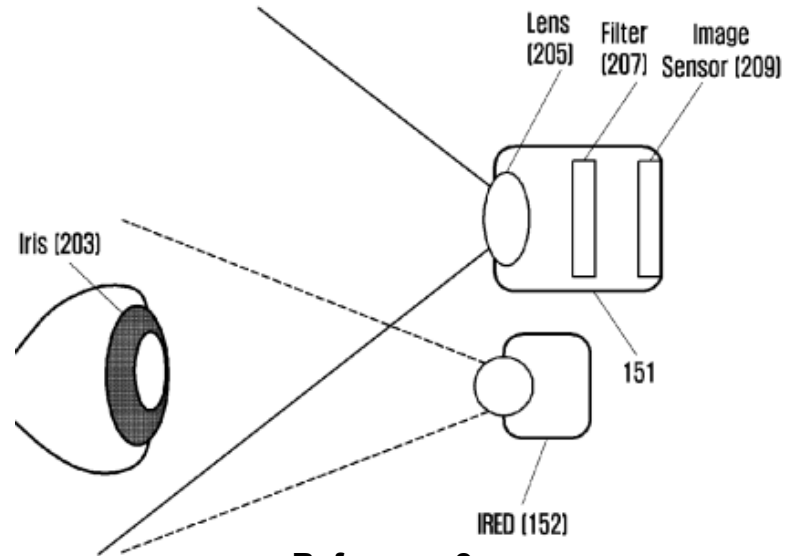
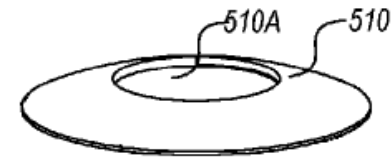
Clarify the following mappings from the office action:

- “cover element” mapped to cover 510 (Ref1), lens 205 (Ref2)
- “in front of” (mapping unclear)
- “second portion” (mapping unclear)
- “third portion” (mapping unclear)

Interview Goals

1. Get the examiner to admit that cover 510 and lens 205 are two different pieces of hardware.
2. Get the examiner to admit that IR LED 152 is not “in front of” image sensor 209.
3. Get the examiner to point to the exact part in the figures or the exact paragraph/line numbers that he is mapping each of the three portions to, then bring up their properties.

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Example 1: Cover Glass

Second Office Action (non-final)

Interview Agenda

Clarify the following mappings from the office action:

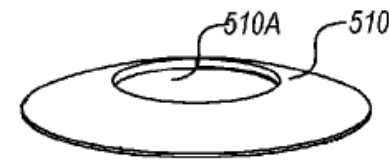
- “cover element” mapped to 510A (Ref1), lens 50 (Ref2)
- “third portion” mapped to ink 34 (Ref2)

Clarify how “third portion **between** the first portion and the second portion” is being mapped to the references.

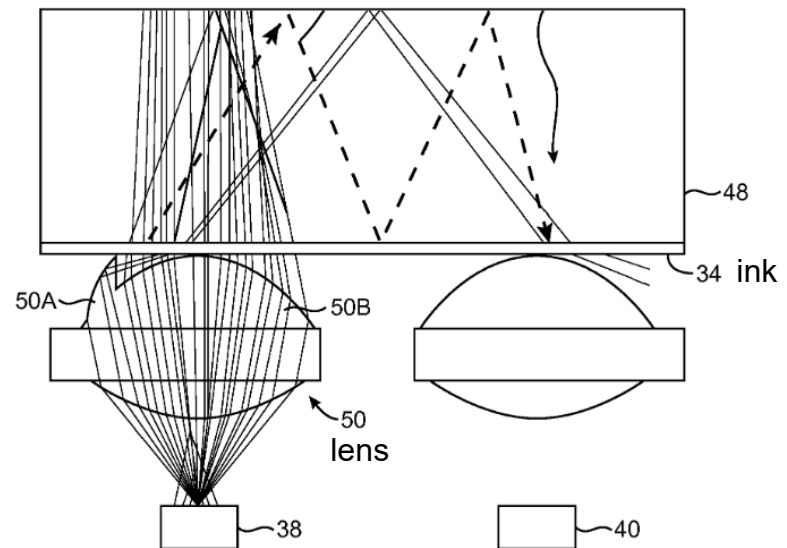
Interview Goals

1. Get the examiner to admit that ink 34 is not a “portion” of lens 50 (otherwise, would be inconsistent with Ref2).
2. Alternatively, get the examiner to extend the mapping of the “cover element” to include layer 48 (Ref2), which would be inconsistent with the rest of the rejection.
3. Get any kind of answer to the “between” clarification request.

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Reference 1



Reference 2

Example 1: Cover Glass

Third Office Action (non-final)

Interview Agenda

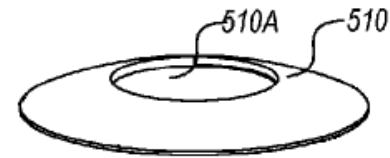
Discuss how the following five parts are mapped to the “single-piece cover element” and its three portions:

- transparent portion 510A (Ref1)
- front cover 510 (Ref1)
- objective lens 32 (Ref2)
- diffractive lens 44 (Ref2)
- aperture stop 46 (Ref2)

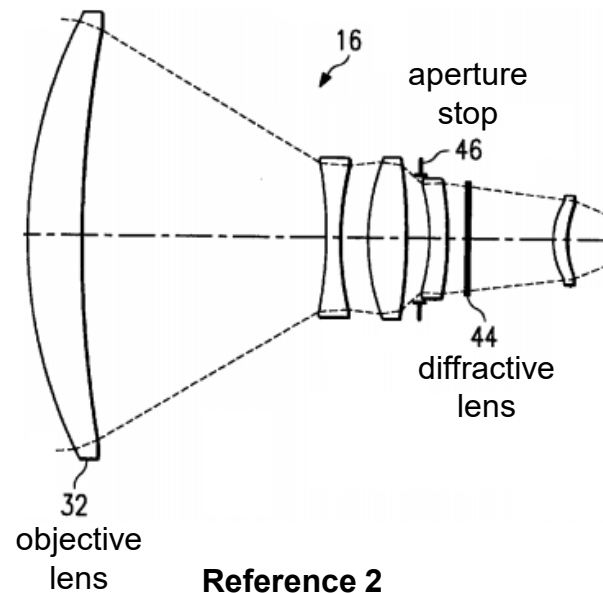
Interview Goals

1. Get the examiner to admit that the lens assembly in Ref2 is not a single piece of glass as alleged in the office action.
2. Narrow the mappings of each portion of the cover element.

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Reference 1

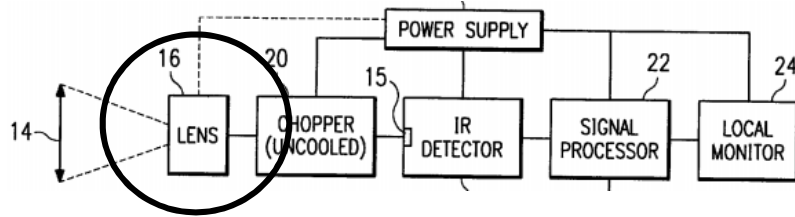


Reference 2

Example 1: Cover Glass

Interview Results

The examiner admitted that his interpretation of Ref2's lens assembly as being a single piece of glass depended on the following functional diagram:



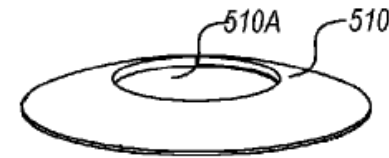
Interview Summary

The applicant's attorneys thank the examiner for the opportunity to discuss the application during a telephone interview. In the interview, the examiner clarified the rejection of the "single-piece cover element" as recited in the independent claims.

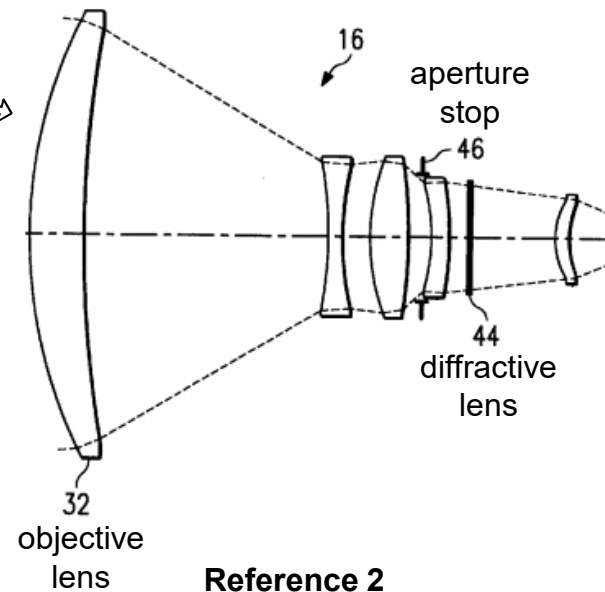
Specifically, the office action relied on an interpretation of the lens assembly 16 in Ref2 as only including a single piece of glass.

Although no agreement regarding allowability was reached, the applicant thanks the examiner for his candor.

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Reference 1



Reference 2

Example 1: Cover Glass

Argument: The Examiner's interpretation of elements in Ref2 are inconsistent with the actual disclosure in Ref2.

During the interview, the Examiner explicitly noted that the Office Action relies on an interpretation of elements 32, 44, and 46 in Ref2 as being *one piece of glass* (in order to address the “single-piece” feature recited in claim 1). The Examiner pointed to “lens 16” in Figure 1 to back up this interpretation.

First, Figure 1 of Ref2 is a block diagram depicting functional blocks of an imaging system. Just as the “power supply 29” is not a single part that provides power to the imaging system, “lens 16” is not a single lens, but rather an assembly of lenses. See lines 20-33 of column 5 (disclosing “the various components of lens assembly 16”), as well as Figures 2A and 2B (depicting separate components constituting the lens assembly 16 – not a single piece of glass as asserted by the Examiner).

Second, even if the “lens 16” in Figure 1 did disclose a single piece of glass, the Office Action relies on the elements disclosed in Figures 2A and 2B to address the three portions of the single-piece cover element recited in claim 1. The cited elements in Figures 2A and 2B are described in the reference as being an “objective lens 32,” a “diffractive lens 44,” and an “aperture stop 46” of a “lens *assembly*” (lines 20-33 of Column 5), and depicted in Figures 2A and 2B as being separate elements (not one piece of glass). In fact, the diffractive lens is “positioned in front of the object lens” and has a surface “facing the objective lens.” This would be impossible if the objective and diffractive lenses were the same piece of glass. Further, the aperture stop 46 is mounted to a completely different lens (a collecting lens 38), and is likewise not the same piece of glass as lens 32 or lens 46.

Thus, the elements relied on in Ref2 (32, 44, and 46) to address the recited “single-piece” feature and the three portions of the claimed single-piece cover element do not teach or suggest a “single-piece cover element” as recited in claim 1.

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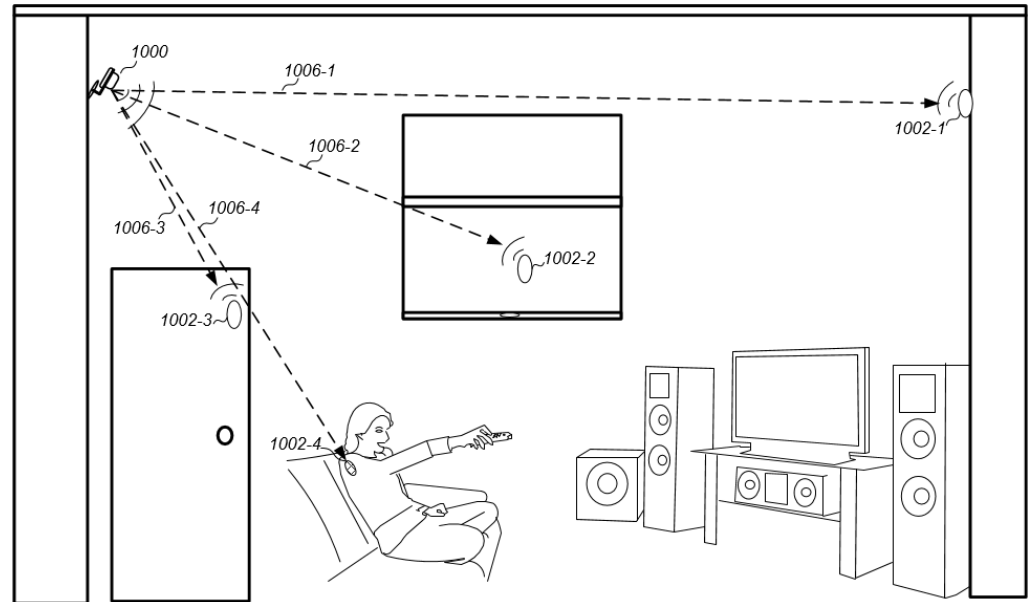
Example 1: Cover Glass

Allowed!

Example 2: Radar

Claim (Summary)

1. A method for determining locations of a plurality of electronic devices, comprising:
 - obtaining device IDs for the plurality of devices;
 - broadcasting, via a standard wireless communication protocol, a request based on the device IDs that a particular device reflect its position using radar;
 - receiving a radar signal from the particular device; and
 - determining positioning/velocity of the particular device based on the radar signal.



Example 2: Radar

Reference

Referring to Figure 1, on launching the App, the user is first presented with a “Radar Screen” which emulates the rotational sweep pattern expected of a traditional avionics radar system, while the mobile/app searches for smart bulbs (or other devices) via the Bluetooth wireless communication embedded in the smart phone.



Figure 1

Example 2: Radar

Reference

Referring to Figure 1, on launching the App, the user is first presented with a “Radar Screen” which emulates the rotational sweep pattern expected of a traditional avionics radar system, while the mobile/app searches for smart bulbs (or other devices) via the Bluetooth wireless communication embedded in the smart phone.

Examiner’s Search Strategy

L2	358	radar with smart with devices	US- PGPUB; USPAT; EPO; JPO; DERWENT	ADJ	ON	2019/07/17 20:58
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search operators

adj = adjacent
nearX = within X words
with = same sentence
same = same paragraph

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Example 2: Radar

Interview Agenda

- The examiner's search strategy
- The examiner's search result (with keywords highlighted)
- The examiner's rejection
- The applicant's brief remarks

Interview Goals

- Get the examiner to agree that the figure is merely a decoration.
- Confirm there is nothing else in the reference that the examiner is relying on.

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Allowed!

Search Strategy						
L2	358	radar with smart with devices	US- PGPUB; USPAT; EPO; JPO; DERWENT	ADJ	ON	2019/07/17 20:58

Search Result

[0106] Referring to FIG. 1, on launching the App, the user is first presented with a "Radar Screen" which emulates the rotational sweep pattern expected of a traditional avionics radar system, while the mobile/app searches for smart bulbs (or other devices) via the Bluetooth wireless communication embedded in the smart phone.

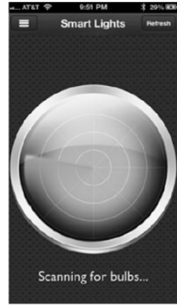


Figure 1

Rejection

"See para 0106 for smart devices communicating via a radar system; see also para 0313-0314 about using a radio signal." (Office Action, page 2, relevant portion of first row)

Applicant's Remarks

The office action relies on the primary reference to reject all 20 claims. However, the primary reference appears to have been interpreted out of context. The emulated "radar screen" of Figure 1 is merely a decorative element, displayed while searching for devices "via the Bluetooth wireless communication." Therefore, the primary reference does not teach or suggest any of the radar-related elements in claims 1-20.

Example 3: Lazy Examination

Office Action

- Rejected all 20 claims using two unrelated paragraphs in a single reference.
- Copy/pasted the paragraphs themselves into the rejection, rather than explaining how anything in the paragraphs was being mapped to the claim elements.

Interview Agenda

1. The independent claims recite (i) “identifying a plurality of device characteristics” and (ii) “illuminating ... according to a modulation signal.” The claims further recite “obtaining a lookup table” corresponding to (i) and (ii).

The Office Action relies on paragraphs [0083] and [0626] of the primary reference to address each of these features. However, these portions of the reference appear to be silent regarding a “device characteristic” determination or “modulation signal.”

Example 3: Lazy Examination

Interview Agenda (cont'd)

2. The Office Action rejects all 20 claims by citing to the same two paragraphs in the primary reference. However, many details in the dependent claims appear to be missing not only from the cited portions, but also from the reference as a whole. For example:
 - “tracking movement of an object” (claim 5),
 - “user gesture” (claim 6),
 - “generating an alert command” (claim 7),
 - “hand wave,” and “alarm signal from [a] smoke detector” (claim 8),
 - “a subset ... for each column of the lookup table” (claim 16),
 - “determining a voxel vector X that minimizes $\|Y - AX\|_2$ ” (claim 17),
 - “the plurality of device characteristics” (claim 18),
 - “calibrating a baseline” (claim 19), and
 - “obtaining a fine lookup table” (claim 20)

Example 3: Lazy Examination

Interview Agenda (cont'd)

3. The Applicant wishes to clarify if the primary reference is being used to reject each pending dependent claim. If so, the Applicant requests, **during the interview**, either:
 - **a detailed mapping** of each claim element per established examination guidelines for clarity of the record, or
 - **agreement** that the claims are distinguished over the reference.

Allowed!

Thank you!

Questions?

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Coronavirus COVID-19 Resources

We have formed a multidisciplinary **Coronavirus/COVID-19 Task Force** to help guide clients through the broad scope of legal issues brought on by this public health challenge.

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To help keep you on top of developments as they unfold, we also have launched a resource page on our website at www.morganlewis.com/topics/coronavirus-covid-19

If you would like to receive a daily digest of all new updates to the page, please visit the resource page to [subscribe](#) using the purple "Stay Up to Date" button.



Biography



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Serving as the leader of Morgan Lewis’s semiconductor practice and as a member of the firm’s fintech and technology practices, Andrew J. Gray IV concentrates his practice on intellectual property (IP) litigation and prosecution and on strategic IP counseling. Andrew advises both established companies and startups on Blockchain, cryptocurrency, computer, and Internet law issues, financing and transactional matters that involve technology firms, and the sale and licensing of technology. He represents clients in patent, trademark, copyright, and trade secret cases before state and federal trial and appellate courts throughout the United States, before the US Patent and Trademark Office’s Patent Trial and Appeal Board, and before the US International Trade Commission.

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Biography



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Benjamin H. Pezzner brings a diverse background in patents to his intellectual property (IP) practice, including experience as a patent examiner, an electrical engineer, and an inventor. This background enables Benjamin to bring a unique combination of perspectives to a practice that includes counseling clients on patent strategy and prosecution in a variety of computer hardware and software fields, including smart home systems, integrated circuits, memory, video compression, communication networks, blockchain technology, medical devices, and user interfaces.

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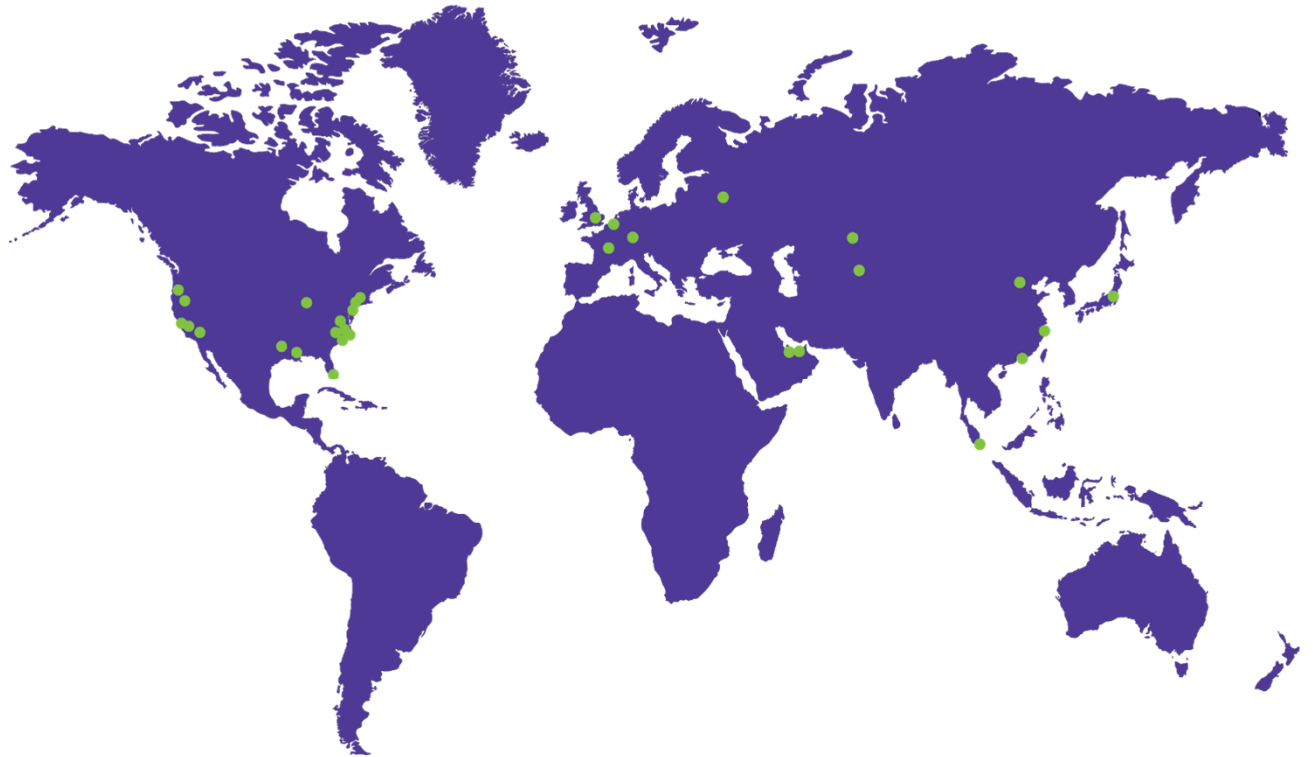
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