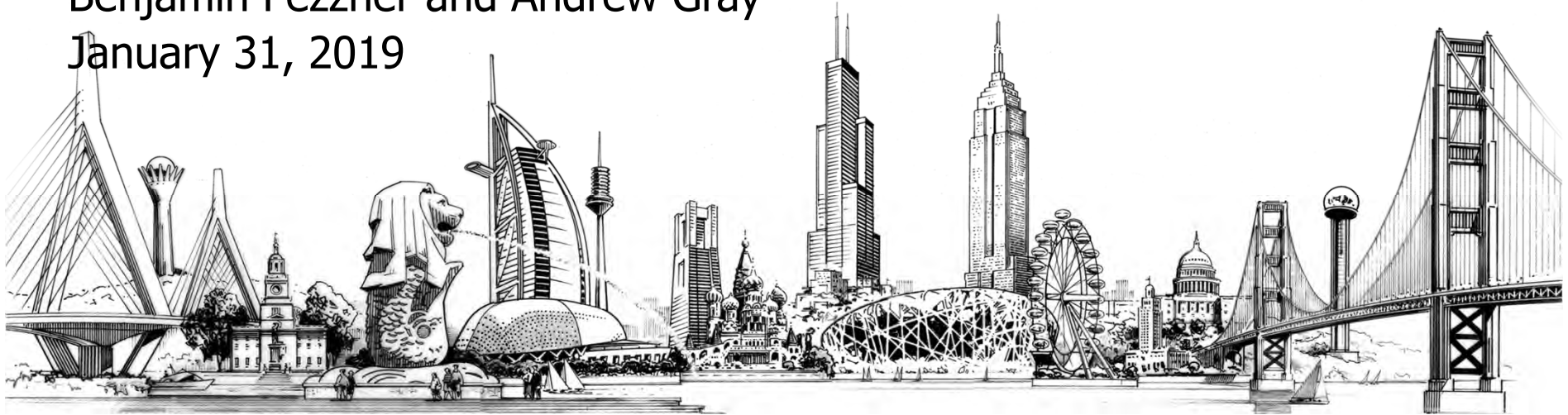


Morgan Lewis

**PATENT PROSECUTION
FROM AN EXAMINER'S PERSPECTIVE:
ANTICIPATING THE OFFICE ACTION
AND ATTAINING THE ALLOWANCE**

Benjamin Pezzner and Andrew Gray
January 31, 2019

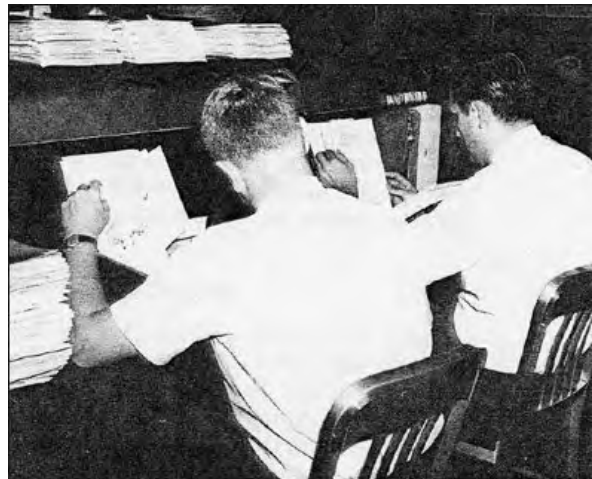


Presenter Background

- Patent Examiner: 3 years
 - 3 different art units; my last art unit was run very well, we followed all of the rules, primaries were very good, SPE was fair, I didn't understand the criticism from the blogs
 - goal was to document the thinking of an examiner so I could use it on the outside
- Patent Attorney: 2 years
 - expected the goal to be outwitting examiners and getting allowances
 - goal turned out to be attaining higher quality examination (with allowances being a byproduct)

Presentation Goal

- Make Examination Great Again!
 - show you how to get patent examiners to follow their own rules, to follow their training, to be more accountable
 - more accountability = higher quality examination = more allowances



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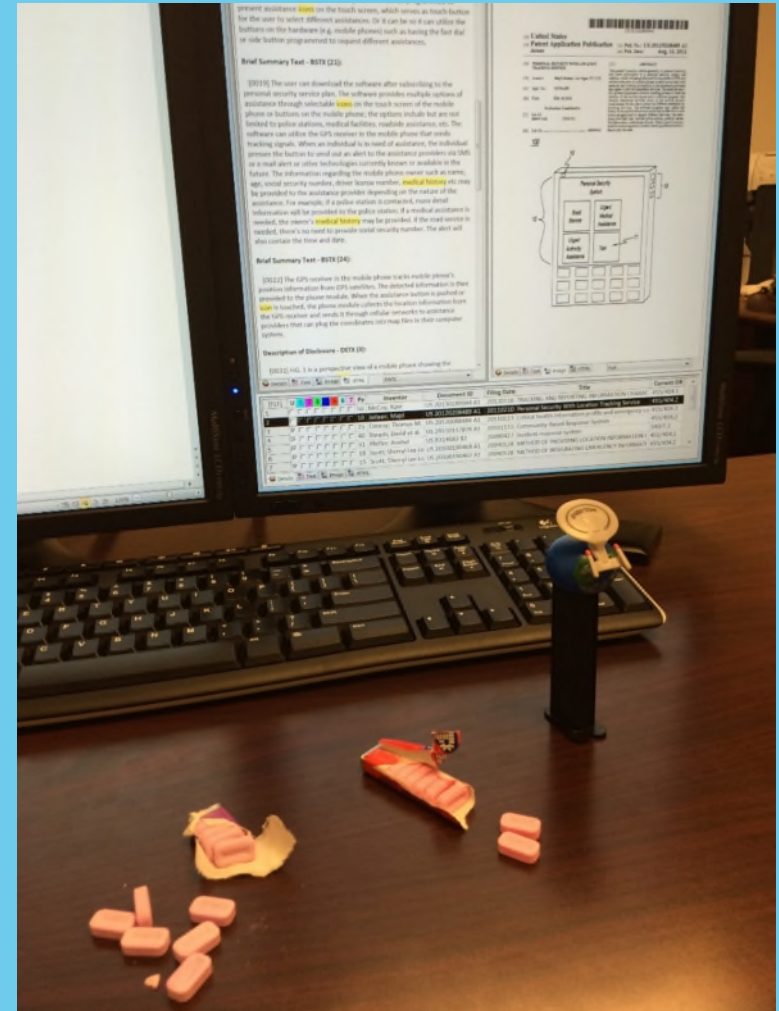
Agenda

1. Day in the life of an examiner
 - motivations, training, oversight
2. Using rules to get leverage
 - the rules that, if broken, result in a do-over
3. Using leverage to move prosecution forward
 - without losing examiner goodwill (diplomatic vs. adversarial); interviews
4. When diplomacy fails
 - steps to take before appeal
5. 101 developments
 - examiner training, thoughts on implementation

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PART 1

DAY IN THE LIFE OF AN EXAMINER



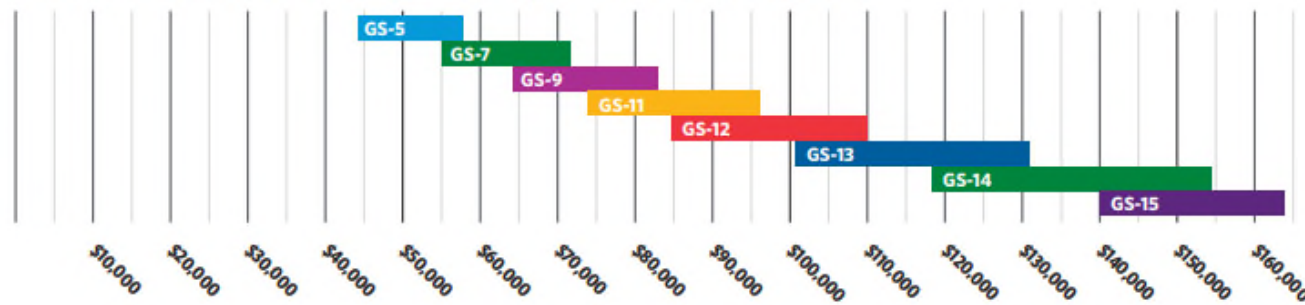
Day in the Life: Motivation

- Evaluated based on quantity (production) and quality (master review form)
- Main motivation: work as quickly and efficiently as possible (quantity) + make quality just high enough to not get dinged on review (quality)
 - part of the academy training to not go overboard
 - not concerned about winning or losing on appeal
 - not concerned with trying to find the best way to get your case allowed or abandoned
- Only concerned with the next office action, and how to maximize bang (production credit available) for the buck (time spent working for that credit)

Day in the Life: Production, Bonuses, and Overtime

- Grades come out every biweek, every quarter, every year
- Bonuses for annual production and rolling windows of production
- Extra production can be billed as overtime
- Salary+bonuses+overtime maxes out at congressional pay, currently \$164k
highest base salary is \$118k => 40% raise for making bonuses and overtime

Patent Examiner Pay Scale, Fiscal Year 2018



Day in the Life: Production

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

- Counts
 - 2.0 counts per round of prosecution
 - 1 round of prosecution = first action --> second action --> disposal (RCE, appeal, allow, abandon)
1.25 0.25 0.5
- Examining Time
 - get non-exam “other time” for: training, interview preparation (30 min), AFCP consideration (2 hr)
 - no “other time” for: regular after-final practice, non-interview phone calls, misc communications between submitting OA and receiving response

To maximize production: (i) maximize counts, and (ii) maximize “other time”

- if you're asking the examiner to do something that won't result in counts or the ability to bill other time, there's no motivation for the examiner to do it
- you can still motivate the examiner, however, if you have leverage

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Day in the Life: Prosecution

First Action On the Merits

- Text Search
 - supposed to search the inventive concept as described in the spec (compact prosecution)
 - if the spec is long, the inventive concept is otherwise unclear, or the claims are so basic that a review of the spec is unnecessary, examiners will just look at the claims
 - even if the spec is brief and explicitly spells out the inventive concept, examiners will reject based on the claims anyway, especially if they can understand the claims
- Rejection Strategy
 - cover all the bases (especially if on the sig program) by making a couple quick objections for informalities, a 101 rejection, a couple 112 rejections if possible, and a 102 or 103 rejection
 - junior examiners are more likely to ignore allowable subject matter because it can sometimes be a hassle to get permission to designate as such, especially on a first action

Day in the Life: Prosecution

First Action On the Merits (cont.)

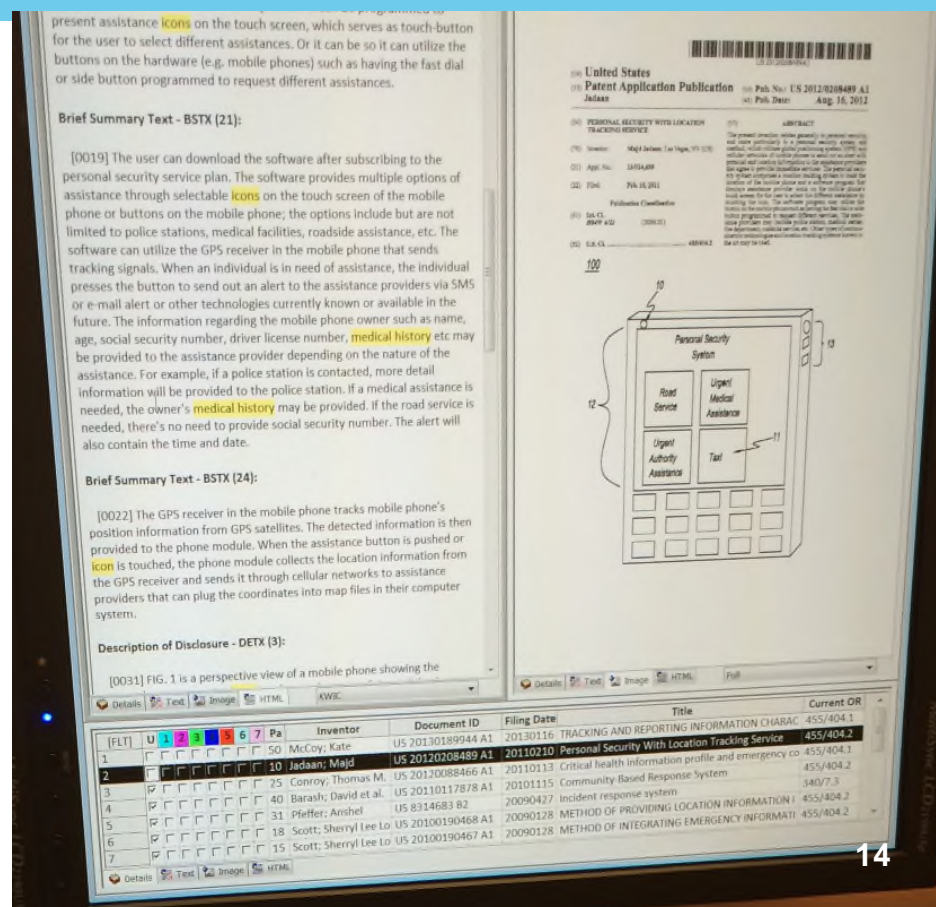
- Search strategy for 102/103 rejections
 - 1) look for the perfect reference (102)
 - break concepts into words and strings of synonyms for those words
 - look at references that use various combinations of those words in the same sentence, paragraph, group of paragraphs, and so forth
 - 2) settle for a combination (103)
 - if no perfect reference exists, break up the inventive concept into component concepts, search each component separately
 - combine the references with any motivation statement (even if it's not a TSM or KSR rationale)

Day in the Life: Prosecution

First Action On the Merits (cont.)

- Notes on Examiner Search
 - examiners know that the prior art teaching is not the same as the claimed feature, but the reference may still work if the claims are broad
 - if examiner can't find the concept in the prior art, examiner will just focus on finding words that can be mapped to the words in the claims

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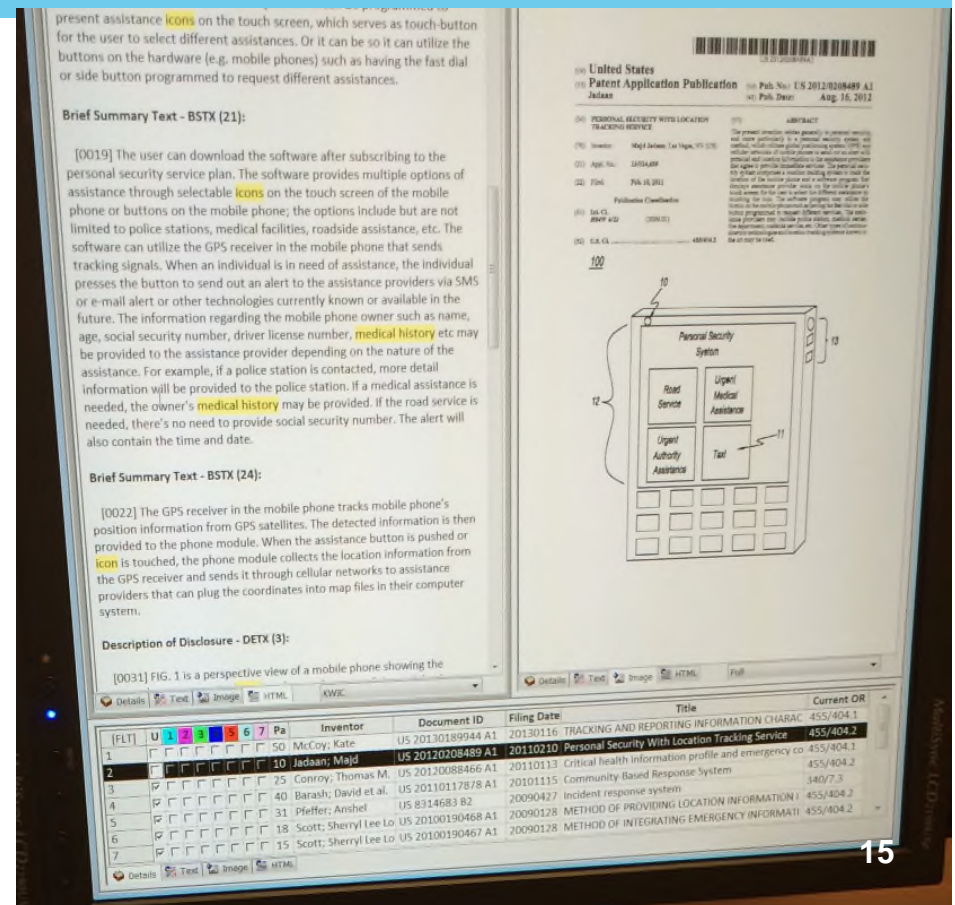


Day in the Life: Prosecution

First Action On the Merits (cont.)

- Problem: Buzzword Bingo!
 - Words pulled from disparate parts of the reference
 - separate/conflicting embodiments
 - features that don't make sense when combined
 - dicta/commentary
 - Example
 - claim for a support surface
 - examiner searches for "support" and "surface" in the same paragraph
 - cites to the user's ear AND a table

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Day in the Life: Prosecution

All subsequent actions

- Look at the applicant's arguments

if the arguments are good:

- if the applicant amended, have more leeway to find new references
- if the applicant did not amend, respond to the arguments or allow the case

if the arguments are not good:

- respond to the arguments, maintain the rejection
- more time to respond to arguments and look for new references if RCE (vs. final or after final)

Day in the Life: Prosecution

Allowable Subject Matter

- Easier for junior examiners to get permission to allow after one or two amendments
- Must get permission from a primary or SPE; amount of scrutiny related to examiner's dependability
- Allowances are a pain to write up

Day in the Life: Prosecution

Appeal

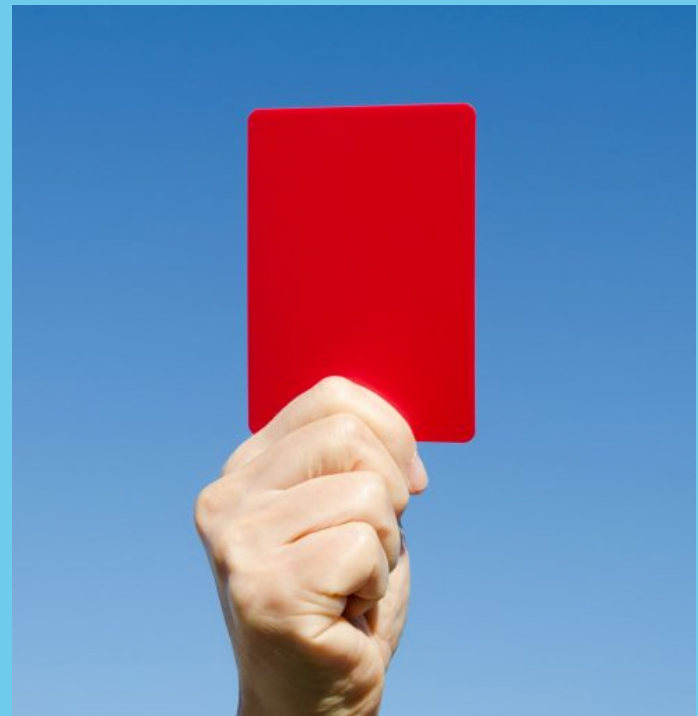
- Treated as a regular response
 - respond to the arguments, get counts
- After submitting the examiner's answer, no more skin in the game
 - does no good to threaten to appeal during an interview
- If examiner is overruled, examiner picks up where the case left off
 - reject again? get permission to allow?

Day in the Life: Examiner's Toolkit

- **Broadest Reasonable Interpretation (BRI)**
 - no easy way to win this argument with the examiner; more of an issue for appeal
 - instead, talk about concepts and talk about using alternative words that describe the concept but don't have the same BRI that is allegedly taught by the reference
- **Motivation Statements**
 - no easy way to win this argument with the examiner; more of an issue for appeal
 - can try to note that dependent claim rejections are missing motivations to combine (examiner needs them for every new embodiment in the reference)
- **Vagueness**
 - lack of clarity in BRI and obviousness statements, bulk citations, single response to multiple arguments
 - fix by getting the examiner to take a more specific position during the interview

PART 2

GETTING LEVERAGE



Sources of Leverage

- QIR (Quality Index Reporting)
 - SPE is graded by the Art Unit's average QIR => the SPE is marked down for:
 - (1) % employees averaging >2 actions/disposal
 - (2) disposal = RCE (vs. appeal/allow/abandon)
 - (3) restriction made after 1st action
 - (4) **2nd nonfinals**
 - (5) **final reopened** (after final, pre-appeal, appeal)
- Examiners are highly motivated to avoid (4) and (5), because it affects the SPE
- If you find an error that results in (4) or (5), this gives you leverage

Golden Rules

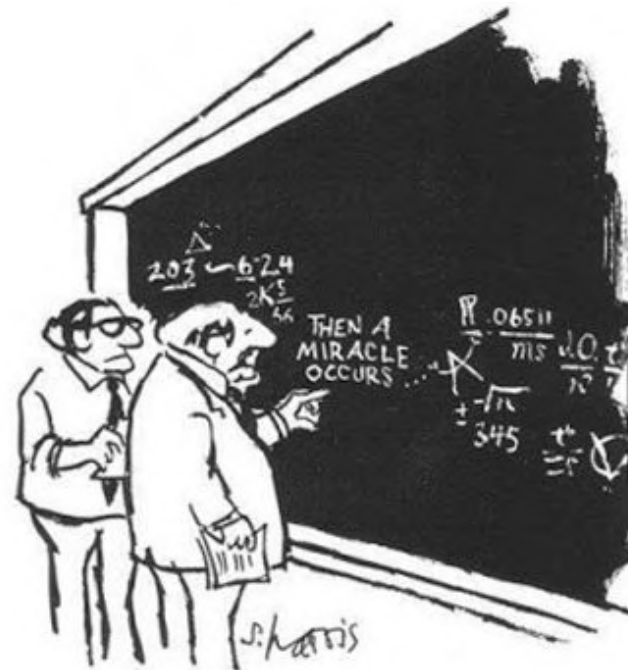
Breaking these rules = new ground of rejection
(do-over)

1. Map every word in the claims to a teaching in a reference OR explain obviousness or inherency
2. Address every argument in the applicant's response

Buzzwords: "Clarity of the Record"

(Examiners must show their work!)

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

Rule 1: Map Every Word

Account for every word in the claim by either (i) mapping it to a reference, or (ii) explaining why it doesn't need to be mapped.

- If mapped, must use paragraph or column/line numbers; no bulk citations
 - can't appeal this, but problematic for the examiner nonetheless
- If not mapped, ask whether the examiner is arguing obviousness or inherency
 - if obviousness, some kind of rationale is required (either TSM or KSR)
different from the obviousness used to combine references; this is pulling a seemingly obvious limitation out of thin air and is much more difficult to correctly pull off
 - if inherency, easy to challenge in the response; cite to MPEP 2101(IV)
“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”
“The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”

Rule 1: Map Every Word

Reasons for not mapping every word of the claim

- Examiner just couldn't find a better reference, and will probably agree with your argument distinguishing that claim element over the reference
- Examiners sometimes mix up 112a (lack of support) and 112b (indefiniteness) and then they don't do prior art mapping
 - Examiner: "Applicant didn't describe how A performs B based on C" = 112a rejection
 - In response: The claims include a relationship between A/B and C; there's support for these relationships in the spec
 - Even if this were a 112a issue, Compact Prosecution rules require the 102/103 rejections to map the limitations to the reference anyway
 - Bottom line: examiners only get a pass for 112b issues (the claims are so indefinite that the examiner doesn't understand how to search them)

Rule 2: Address Every Argument

- Label arguments with big bold headings: "Argument 1: ____" and include a form paragraph at the end requesting, "for purposes of compact prosecution" that the next Office Action include separate explanations for each of the above arguments
 - maximizes chances of getting a response + makes your case for a do-over stronger
- If the examiner misses an argument:
 - address the office action's response to the previous arguments (responses should be in this section of the OA)
 - examiner may try to pass off the mistake by saying the argument is answered in the rejection section
 - if so, don't settle for a citation to a reference; the answer should address the substance of the argument instead of merely repeating the previous rejection

Rule 2: Address Every Argument

- If the examiner misses an argument (cont'd):
 - if the response maintains the rejection but doesn't address every argument, call examiner and ask for another office action; possibly get the SPE involved
 - say that the client requests this => maintain examiner/attorney goodwill ("the client is instructing me to try to get a response to this argument on the record before we can proceed.")
 - if you can't get a second office action, use the call as an impromptu interview and set up a follow-up call to get an answer
 - don't wait for the official interview to try to get an answer! this will waste the opportunity to properly respond to the examiner's answer during an official interview
 - difference between official interview and impromptu phone calls = examiners get 30 minutes of other time to prepare for the official interview
 - if the examiner is not prepared, you are entitled to a follow up call (possibly get the SPE involved)
 - if calling/interview fails to get an answer to the argument, respond without amending, then petition to withdraw finality of the next OA (MPEP 706.07)
 - grounds for petition: unaddressed traversal from previous response

PART 3

USING YOUR LEVERAGE



Moving Prosecution Forward

You now have leverage. A major claim element wasn't mapped to the reference.
An important argument was not addressed. Now what?

Interview!

Interview

First, consider adding oversight. Look at the signature block at the end of the office action.

- If signed with initials => junior examiner (have right to primary/SPE oversight)
- If signed with full name, but not labeled as a primary examiner => still a junior, but in the process of becoming a primary (may have right to oversight after final)
- If signed with full name and labeled as a primary examiner => no right to oversight



Interview

Next, focus on clarifying the record.

- At least half of the interview should be spent doing this, vs. explaining/arguing/talking - let the examiner do all of the talking
- The three most important clarity goals:
 1. Get the examiner to take a position re: missing claim elements and argument responses
 2. Get the examiner's positions on the record (interview summary)
 3. Use the examiner's clarified positions in your next response

Interview: Get the Examiner to Take a Position

- Ask: how are you mapping limitation A to the reference X?
 - Just dive right in without offering to explain anything; if examiner didn't prepare, you already have leverage and the interview hasn't even begun yet
 - Remember law school oral advocacy lessons regarding being brief and succinct in front of a judge
 - don't go on too long about the invention while the examiner's sitting on the phone;
 - do a quick 15 second introduction if you have to, but you should really just dive right in to the discussion points
 - Keep the focus on the words in the claims and the words in the reference

Interview: Get the Examiner to Take a Position

- If examiner deflects (e.g., mixes up scope with clarity), keep asking until you get an answer
 - During the interview, stay focused on the agenda points
 - Examiners conflate prior art issues with:
 - scope (ex: how are you mapping this? “well it's so broad it can mean anything”)
 - support (ex: how are you mapping this? “well what's your support?”)
 - indefiniteness (ex: how are you mapping this? “well I'm not sure what it means”)
 - procedural deflections (ex: “include this argument in a formal response”)
 - the argument has already been “formally included” in this interview agenda and the applicant is entitled to an answer now; we're willing to schedule a follow-up call so you can take a look at it

Interview: Get the Examiner to Take a Position

- Conflating prior art issues with 112 issues (cont'd)
 - If a claim is not rejected over prior art, or not completely mapped:
 1. Clarify there are no 112 issues (since there is no 112 rejection)
 2. Confirm claim is allowable over prior art (since there is no 102/103 rejection)
 3. If Examiner doesn't give confirmation, ask why there wasn't a 112 rejection
 4. Interview Summary: document examiner's "explanation"
Arguments: document "explanation" as an admission, and ask 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
 - => second nonfinal, or withdraw finality
 - => examiner is highly motivated to find allowable subject matter
 - If next OA maintains the rejection but does not include missing rejections
 - => grounds for petition (improper final), mention this to the SPE

Interview: Get the Examiner to Take a Position

- Offer to schedule a follow-up call if that would help to get an answer
 - Examiner should have used the 30 minutes to review the agenda topics and prepare quick responses
 - Most examiners don't use the 30 minutes (if they use any time at all)
 - Examiners are more likely to consider proposed amendments, and do a quick search of the art already of record to consider if further search/consideration is required
 - "Further search/consideration"
 - Fine if being used for proposed amendments
 - Not ok if being used to ignore an agenda item asking a clarity question regarding the last office action

Interview Summary

- Get the examiner's positions 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 he is interpreting limitation B as ____."

Response Following the Interview

- Use the examiner's positions in the next response
 - In the arguments section, cite to the admissions the examiner made during the interview (it will be easier to distinguish based on these admissions)
 - The point is to get the examiner to come to his/her own conclusion, during the interview, that his interpretation of limitation X is Y, so you can argue in the response that Y is not X;
 - The farther you can get Y during the interview, under the guise of clarifying the record (vs. arguing BRI), the easier it will be to distinguish in the response AND the better the applicant's position will be on appeal
 - The key is to focus on clarifying a vague point in the office action 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
 - A broad interpretation can be narrowed to fit an amended claim; but if the interpretation is narrowed during the interview, the examiner must (i) find new references, or (ii) keep the references and have a losing argument on appeal = leverage

Interview: Addressing BRI

In addition to vagueness (lack of clarity), BRI is one of the examiner's most potent tools

- Examiners are trained to think in terms of concepts. Ask:
 1. Ignoring the words used in the claims for a moment, would you agree that this is a different concept? (frame the question in a way that the answer is always yes)
 2. What words can we use to cover our concept but not read on this concept in the reference?
 3. Interview summary: "Examiner agreed that words ABC do not read on concept Y (can use this language even if the examiner needs further search/consideration before agreeing that the claims distinguish over the reference as a whole)

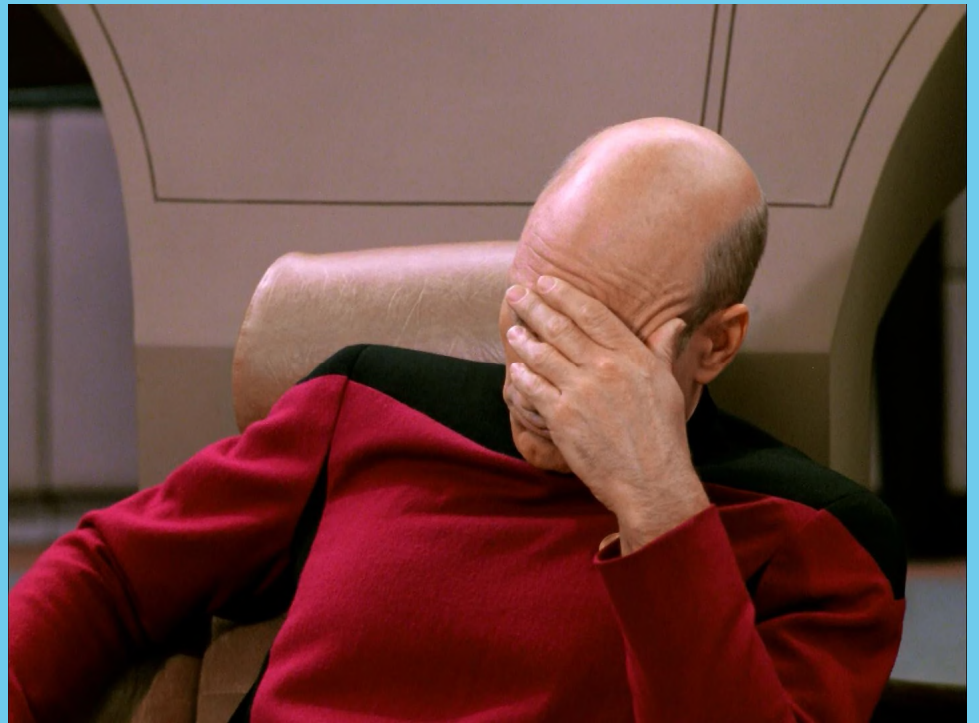
Interview Takeaways

Takeaways

- Before the interview: draft the interview agenda to clarify broad interpretations: ask for specific paragraph/line numbers, focus on 1-3 words in the claim at a time
- During the interview: keep the focus on clarifying the examiner's position; keep the examiner on track, don't entertain the examiner's deflections (clarity vs. scope, clarity vs. support, clarity vs. indefiniteness, procedure)
- After the interview: include a detailed accounting of the examiner's clarified positions in the interview summary.
 - use the phrase "clarity of the record" (e.g., "The examiner clarified the record by offering the following additional explanation regarding interpretation of [limitation X].")
 - proceed with the next response based on the examiner's clarified positions

PART 4

WHEN DIPLOMACY FAILS



Steps to Take Before Appeal

1. Reach out to the SPE
 - This is the SPE's job
 - Better to explain what the examiner did wrong than to reiterate the actual argument
2. Pre-appeal brief
 - Keep this as short as possible; a 1-pager is ideal
 - Examiner gets 1 hour of other time, no counts
3. Reach out to workgroup director
 - Not the director's job, but this was the Commissioner's suggestion
4. Email the Commissioner
 - Will not help with particular case, but the issue may be included in future training

PART 5

UPDATES TO 101 GUIDANCE



Old 101

- Step 2A: Are the claims directed to an abstract idea?
 - Examiners used a case law chart
 - There was no actual analysis in the rejection (e.g., EPG form paragraph)
 - Examiners didn't know how to respond to our case law analysis
- Step 2B: Do the claims have additional limitations that amount to significantly more than the abstract idea?
 - Examiners limited the analysis to "processor" and "memory" and ignored the claim as a whole
 - Direct quote from a SPE: "How can I ask my examiners to analyze the same limitations in both Step 2A and Step 2B? That's too much work."
 - Berkheimer guidance required evidence for examiners' "well-understood, routine, conventional" findings, but examiners often ignored this

New 101

- Step 2A: Claims (i) ~~directed to~~ recite an abstract idea? (ii) practically apply the abstract idea?
 - “Recite” is narrower; claims have to more explicitly recite an abstract idea vs. merely being based on the idea = better for Applicants
 - No more case law; instead, three “enumerated groupings” of abstract ideas
 - Mathematical Concepts (relationships, formulas, equations, calculations)
 - Mental Processes (human mind: observation, evaluation, opinion)
 - Organizing Human Activity (economic principles, commercial/legal interactions, managing personal behavior/relationships)
 - “Practically apply” = same arguments as Step 2B (improvements to technology, etc.) but examiners can no longer rebut with “well-understood, routine, conventional”

New 101

- Step 2B: Unchanged
 - Continue to call out Berkheimer violations (no evidence for “well-understood, routine, conventional” findings)
 - The arguments regarding “improvements to technology” are now made in Step 2A Prong Two (they still apply here though)

101 Examiner Guidance

- Step 2A Prong One: does claim recite an abstract idea?
 - Claims must **explicitly recite** one of the enumerated abstract ideas (if claim is merely “based on” the idea, it does not “recite” the idea)
- Step 2A Prong Two: is claim directed to the abstract idea? or is it a **practical application** of the abstract idea?
 - “practical application” = “more than just a drafting effort to tie up the abstract idea” (no help there)
 - New eligibility examples 37 – 42 provide more clarity (Google: USPTO SME)
 - Training slides will be released soon

101 Examiner Training Slides

- Example 37: relocation of icons on a GUI
 - slide 66: (claim 1) step 2A **prong two**: additional elements recite a specific manner of automatically displaying icons to the user based on usage which provides a specific improvement over prior systems, resulting in an improved user interface for electronic devices => claim as a whole integrates the mental process into a practical application
 - slide 74: (claim 2) step 2A **prong one**: the "determining" step requires action by a processor that cannot be practically performed in the mind. In particular, the step of [x] is not practically performed in the human mind, at least because it requires a processor accessing computer memory indicative of application usage. => claim doesn't recite a mental process

101 Examiner Training Slides

- Example 38: simulating an analog audio mixer
 - slide 101: step 2A **prong one**: claim includes limitations that may be based upon math; however, the math formulas/calculations are not explicitly recited in the claim => claim doesn't recite a mathematical concept
 - slide 102: step 2A **prong one**: claimed steps are not practically performed in the human mind => claim doesn't recite a mental process

101 Examiner Training Slides

- Example 39: training a neural network for facial detection
 - slide 114: step 2A **prong one**: claim includes limitations that may be based upon math; however, the math formulas/calculations are not explicitly recited in the claim => claim doesn't recite a mathematical concept
 - slide 115: step 2A **prong one**: claimed steps are not practically performed in the human mind => claim doesn't recite a mental process

101 Examiner Training Slides

- Example 40: adaptive monitoring of network traffic data
 - slide 129: step 2A **prong two**: integrates the mental process into a practical application; although each of the collecting steps analyzed individually may be viewed as mere pre- or post-solution activity, the claim as a whole is directed to a particular improvement in collecting traffic data; the additional elements recite a specific manner of collecting additional NetFlow protocol data whenever the initially collected data reflects an abnormal condition, which avoids excess traffic volume on the network and hindrance of network performance. the collected data can then be used to analyze the cause of the abnormal condition, which provides a specific improvement over prior systems, resulting in improved network monitoring.

101 Examiner Training Slides

- Example 41: cryptographic communications
 - slide 166: step 2A **prong two**: the combination of additional elements use the math concepts in a meaningful way beyond generally linking the use of the math concepts to a particular technological environment, such that the claim as a whole is more than a drafting effort to monopolize the exception; in particular, the combination of additional elements use the math formulas and calculations in a specific manner that sufficiently limits the use of the math concepts to the practical application of transmitting the ciphertext word signal to a computer terminal over a communication channel; thus, the math concepts are integrated into a process that secures private network communications, so that a ciphertext word signal can be transmitted between computers of people who do not know each other or who have not shared a private key between them in advance of the message being transmitted, where the security of the cipher relies on the difficulty of factoring large integers by computers => claim as a whole integrates the mathematical concept into a practical application
 - slide 168: step 2A prong two excludes evaluation of **WURC** => even WURC subject matter can integrate an abstract idea into a practical application; in this example, even though receiving a signal, transforming it and transmitting it to a second computer are described in the background as being conventional, they still integrate the abstract idea in step 2A prong two.

101 Examiner Training Slides

- Example 42: transmission of notifications when medical records are updated
 - slide 182: step 2A **prong two**: claim that allows access to records and receives updates falls within "certain methods of organizing human activity" grouping; however, the combination of additional elements discussed in slide 181 integrate the abstract idea into a practical application; recites a specific improvement over prior art systems by allowing remote users to share information in real time in a standardized format regardless of the format in which the information was input by the user. => the claim as a whole integrates the certain method of organizing human activity into a practical application

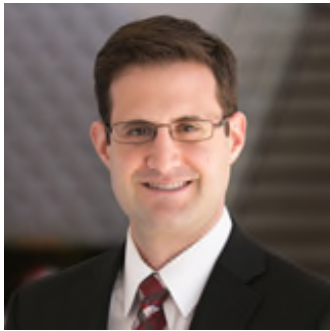
101 Takeaways

- Before revised guidance:
 - Applicant argues improvements in Step 2B,
 - Examiner rebuts with WURC,
 - Applicant rebuts with Berkheimer defense,
 - Examiner repeats initial rejection
- After revised guidance:
 - Applicant argues improvements in Step 2A, examiner no longer has WURC rebuttal
 - Applicant also has new weapon: no explicit recitation of an enumerated abstract idea under prong one (cite to examples)
 - If that's the case, then prong two – practical application – doesn't even apply, but might as well argue both prongs anyway (cite to examples)

QUESTIONS?



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 design 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.

Biography



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Serving as the leader of Morgan Lewis’s semiconductor practice, 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 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, and before the US International Trade Commission.

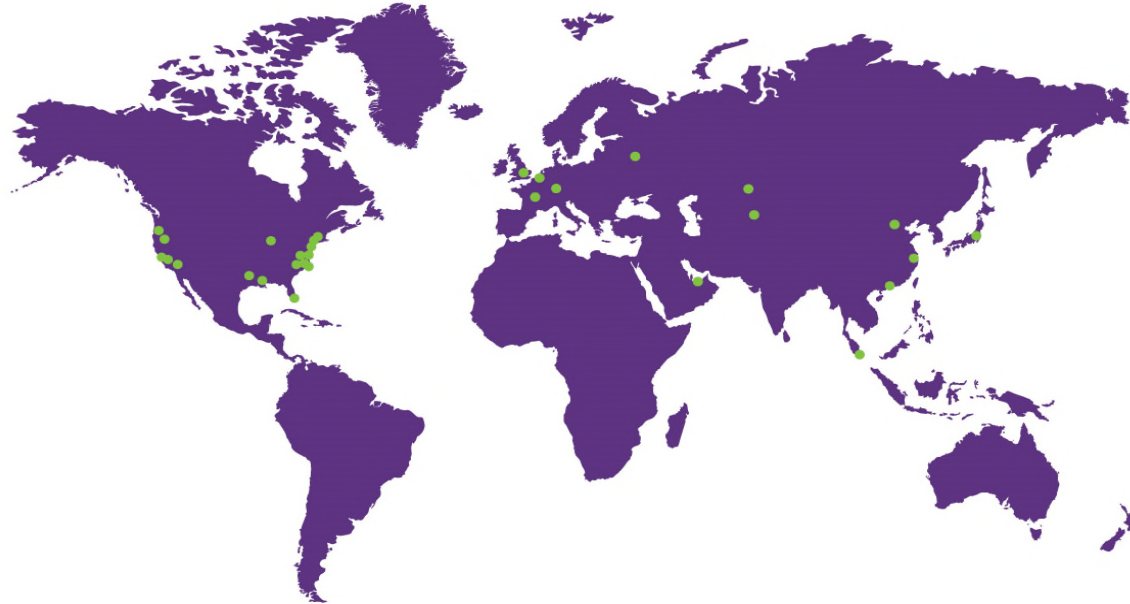
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