



Patent Prosecution

Intellectual Property- 301

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Meet the Faculty

Panelists

[Brian Landry](#) - Saul Ewing LLP

[Robert Rosenthal](#) - Howard IP Law Group, PC

Moderator

[Ellyar Barazesh](#) - Baker Botts L.L.P.

About This Webinar

Patent Prosecution

Patent prosecution can be managed and carried out using a variety of approaches. Some in-house counsel prefer to be highly involved, while others are more apt to let outside counsel run with things. Attorneys (or patent agents) doing the work of response drafting, brief drafting, carrying out interviews and other tasks employ many different approaches and strategies. This webinar provides insight as to how to efficiently manage outside counsel while ensuring quality.

About This Series

INTELLECTUAL PROPERTY- 301

Using outside counsel to assist in patent application preparation and prosecution is an incredibly valuable manner in which to generate and maintain a robust patent portfolio. Having patent applications prepared and prosecuted by outside counsel can improve short-term workflow management and provide many long-term advantages once a patent has issued. However, utilizing outside counsel can be costly, ensuring quality can be challenging and managing patent portfolios can require a balance of information not always available to all involved. Whether working with a small or large number of outside firms and whether they are small or large in size, this series provides insight that will assist both inside and outside counsel in creating a more effective working relationship. Each episode is delivered in Plain English understandable to business owners and executives without much background in these areas. Yet, each episode is proven to be valuable to seasoned professionals. As with all Financial Poise Webinars, each episode in the series brings you into engaging, sometimes humorous, conversations designed to entertain as it teaches. And, as with all Financial Poise Webinars, each episode in the series is designed to be viewed independently of the other episodes, so that participants will enhance their knowledge of this area whether they attend one, some, or all of the episodes.

Episodes In This Series

1. Patent Application Preparation

Premiere date: 05/22/25

2. Patent Prosecution

Premiere date: 6/26/25

3. Patent Portfolio Management

Premiere date: 7/24/25

Episode #2

Patent Prosecution

Each Financial Poise Webinar is delivered in Plain English, understandable to investors, business owners, & executives without much background in these areas, yet is of primary value to attorneys, accountants, & other seasoned professionals. Each episode brings you into engaging, sometimes humorous, conversations designed to entertain as it teaches. Each episode in the series is designed to be viewed independently of the other episodes so that participants will enhance their knowledge of this area whether they attend one, some, or all episodes.

Patent Basics

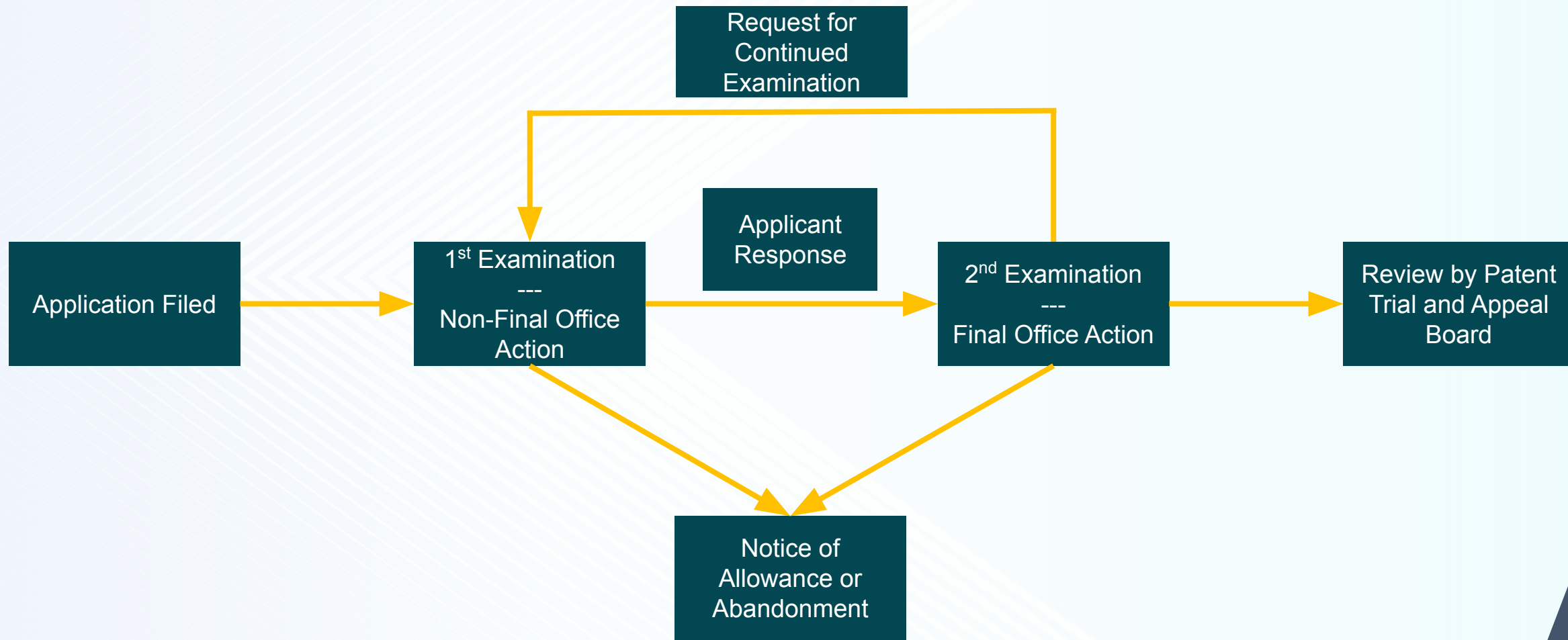
- A patent involves conveyance of a right or title to exclude others from making, using or selling what is characterized as an invention, for a limited time period
- A patent for an invention is the grant of a property right to the inventor, issued by the United States Patent and Trademark Office. Generally, the term of a new patent is 20 years from the date on which the application for the patent was filed in the United States, or from an earlier priority date (if applicable).

Patent Basics *(cont'd)*

Types of Patents

- Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof;
- Design patents may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture; and
- Plant patents may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant

U.S. Patent Prosecution Overview



What Happens After You File Your Patent Application With The USPTO?

- Your Application is assigned to a Patent Examiner with a scientific expertise which helps them understand your invention.
- The Examiner has about 10 hours to examine your application, search for prior art and prepare rejections (Restriction Requirements, First Office Action, Final Office Action, Interviews).
- Your patent attorney or agent prepares responses to the Examiner rejections
- Your application is allowed and issues as a patent or continues to be rejected

USPTO Examining Actions

- Restriction Requirement
- Office Action
 - Non-Final
 - Final

Patent Prosecution Basics

Restriction Requirement:

- Restriction can be made where 1) a claim or group of claims is considered to be independent or distinct, and 2) there would be a serious burden upon the Examiner if restriction is not required. See M.P.E.P. § 803(I)
- The term “independent” (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. See M.P.E.P. § 802.01
- Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is **PATENTABLE** (novel and nonobvious) **OVER THE OTHER** (though they may each be unpatentable over the prior art). See M.P.E.P. § 802.01

Patent Prosecution Basics *(cont'd)*

Restriction Requirement Cont'd:

- Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction there between as set forth in the following sections. See M.P.E.P. § 808.
- Where a restriction office action merely states a conclusion regarding reasons as above, restriction may be improper.
- While there may be rationale to acquiesce, traversing can be useful and readily accomplished by demonstrating that the requirements for supporting restriction (including establishing a “serious burden”) have not been met. See M.P.E.P. § 806 for further ammunition.

Patent Prosecution Basics *(cont'd)*

Office Action:

- Prior art rejections under § 102 and 103
- Subject matter eligibility rejections under § 101
- Written Description/indefiniteness under § 112
- Drawing Objections
- Specification Objections

Patent Prosecution Basics *(cont'd)*

Office Action Response and Claim Amendments

- Applicant prepares and files a written response to the rejection(s) and/or objection(s) of the Office Action
- All rejection(s) and objection(s) must be addressed
- Applicant may amend claims

Patent Prosecution Basics *(cont'd)*

Prior art rejections under § 102 and 103:

- Analyze the examiner's argument about how the prior art maps to claim elements – look for any holes in the examiner's analysis
 - Do the cited reference(s) qualify as prior art?
 - All claim elements addressed by the office action?
- Consider if amendments are needed to distinguish over cited art
- Be sure to think about bang for buck – consider tailoring efforts, particularly for robust rejections, with business needs in mind.

Claim Review And Amendment

Questions to ask when reviewing claim amendments:

- Do the amended claims still cover your core technologies?
- How would the claims stand up in litigation?
- Are backup claims included to address the current rejections and/or highlight issues with the rejection?
- Would amendments create estoppel, and if so is it warranted?
- Can a final rejection be avoided by allowing an independent claim to stand?

Claim Review And Amendment *(cont'd)*

Who would infringe the claims?

- Is there coverage for competitor activities? Supplier activities?
- Is there a single entity that would infringe at least some of the claims?
- Consider the *Akamai v. Limelight* decision (Fed. Cir. 2015) and related interpretation regarding single-actor and multiple-actor infringement, for direct infringement and related damages.
- Remember the law may change again!

Claim Review And Amendment *(cont'd)*

Do the claims (and amendments) meet subject-matter eligibility?

- Section 101 requires claims to be directed to a process, machine, an article of manufacture, or a composition of matter ... and cannot fall under a judicially recognized exception, such as an abstract idea, natural phenomena or law of nature.
- Additional features can provide significantly more than one of the exceptions above.

Claim Review And Amendment *(cont'd)*

- Are the claims directed toward a specific technological advancement (species), versus an overly-broad genus?
- Do amendments adequately address any Section 101 issues raised by the Examiner?

Claim Review And Amendment *(cont'd)*

Section 112 Rejections

- Review effort; often minor amendments can be made to avoid argument
- Ensure the Examiner has used the appropriate test and that arguments address the same
- Consider claim amendments carefully to ensure that they do not implicate 112 issues – ensure adequate support in the specification and clarity

Allowable Subject Matter

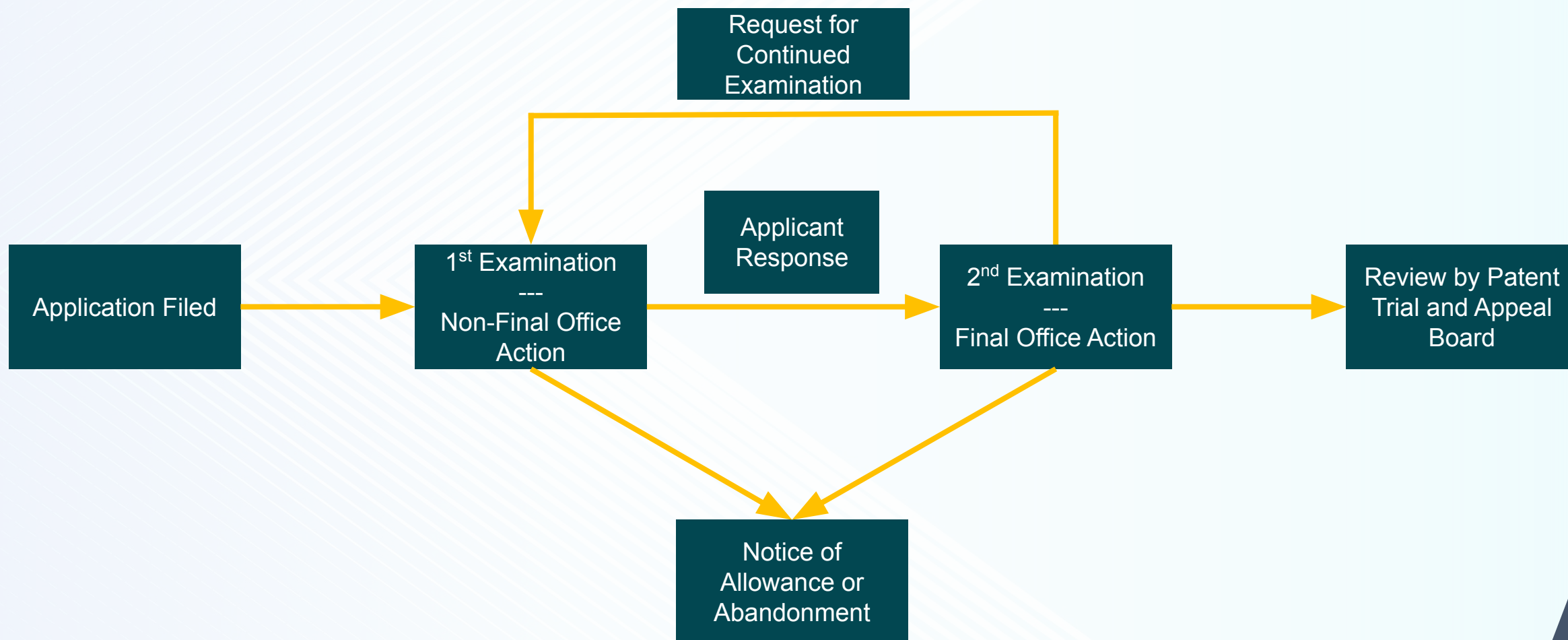
The Examiner has indicated that one or more claims contain allowable subject matter. How to proceed?

- Consider business needs, estoppel, net cost, value of rapid allowance, and more
- Taking allowable subject matter and filing a continuation application may be cost-effective and result in an additional patent
- Rapid allowance may be desirable for garnering investments, litigation (or staving off litigation), and saving costs

Allowable Subject Matter *(cont'd)*

- Consider the Patent Prosecution Highway
- Taking allowable subject matter and filing a continuation application can allow a fresh look at broad claims with the added knowledge of the instant prosecution, and can allow tailoring claims to technology
- Conveying business needs to the prosecuting attorney can be critical in these situations

U.S. Patent Prosecution Overview



After-Final Practice

Despite an applicant's response and amendment, the Examiner may issue a Final Office Action. What are an applicant's options?

- **After-Final Response**
 - Present arguments against final rejection(s); present claim amendments
 - May not be effective: the Examiner has discretion on how to consider the response and may simply issue an "advisory action"
- **Request for Continued Examination ("RCE")**
 - Applicant pays a USPTO fee to restart prosecution, but with the knowledge gained from the prior office actions and interactions with the Examiner
 - Consider an Examiner interview before and after filing an RCE
- **Appeal**
 - Appeal the Examiner's final rejection(s) to the Patent Trial and Appeal Board
 - Can be beneficial to force the review by others of an Examiner's rejection; can result in the reopening of prosecution without undergoing the full appeal process

Rapport With The Examiner

- Developing a positive relationship with the examiner can help in prosecuting not only the application at hand, but also other applications that might be assigned to that particular examiner
 - Important when prosecuting a large portfolio in a particular technology area
- Examiner interviews can be very helpful
 - Consider timing (i.e., end of quarter? end of the bi-week?); may impact examiner decision making
- Ensure that the Examiner looks good; a response should characterize the rejections in a manner as necessary to succeed without denigrating the Examiner
 - Avoid being argumentative, both in written responses and during any interviews or phone calls with the Examiner
 - Always remain professional and courteous

Why Can't I Just Handle Prosecution Myself?

- You can, but proceed with caution
- Sample communication from the patent office to someone who tried to prosecute their invention:
 - “An examination of the application reveals that applicant is unfamiliar with patent prosecution procedure. While an applicant may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.”
- Communication skills are important
- Maintaining a clean record is important – avoid “patent profanity” and disclaimer

Questions or Comments?

If you have any questions about this webinar that you did not get to ask during the live premiere, or if you are watching this webinar [On Demand](#), please do not hesitate to email us at info@financialpoise.com with any questions or comments you may have. Please include the name of the webinar in your email & we will do our best to provide a timely response.

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Meet The Faculty

Ellyar Barazesh - ellyar.barazesh@bakerbotts.com



Ellyar Y. Barazesh is a Senior Associate in Baker Botts' Intellectual Property Practice group. His practice focuses on patent prosecution and counseling, post-grant proceedings before the Patent Trial and Appeal Board (PTAB), and patent litigation.

He has significant experience working with clients in a wide range of technology areas, including computer hardware and software, control systems, networking technologies, location tracking systems, video and image processing, semiconductor devices, data encryption, graphical user interfaces, and medical devices.

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Brian Landry – brian.landry@saul.com



Brian Landry draws on a broad base of intellectual property experience and technical expertise to help clients identify, protect, and enforce their IP. Brian has significant experience in medical devices as well as consumer products, building materials, and devices and software having research, diagnostic, and therapeutic applications.

Brian handles patent matters involving a variety of medical technologies including cryotherapies for medical and cosmetic indications, phototherapies, urologic devices, neurologic interfaces, surgical tools, and novel uses of existing therapeutics. Brian also works with companies to harmonize their IP strategy across trademarks, designs, copyrights, and trade secrets to strengthen their offensive position and reduce risks.

Brian draws upon experience guiding clients through diligence for acquisitions and public offerings as well as contested proceedings before the USPTO Patent Trial and Appeal Board, U.S. District Courts, and U.S. Court of Appeals for the Federal Circuit to deliver and execute strategies that create long-term business value. [Read More](#)

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Mr. Rosenthal practices in domestic and international patents, trademarks, trade secrets and copyrights. Mr. Rosenthal's practice includes patent preparation and prosecution and advising on patent infringement and validity issues; advising on trademark availability and infringement issues and prosecution of trademark registration applications; conducting and supervising intellectual property due diligence and drafting and negotiation of intellectual property agreement provisions in connection with mergers and acquisitions; advice and strategy on copyright protection and avoidance of infringement; drafting and negotiating of agreements involving computer hardware and software acquisitions and intellectual property licensing; and advising on protection and enforcement of intellectual property rights. [Read more](#)

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