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Considerations for Legal Arguments in Patent Prosecution

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Patent prosecution is often performed by addressing the technical merits of the art cited by the Examiner in the response. This may include submitting arguments about the teachings of a particular reference. However, patent prosecution should not be limited to a discussion of the technical merits. There are many legal arguments that may also be relevant that can stand on their own or be submitted along with the technical arguments.

One legal argument relates to the broadest reasonable interpretation (BRI). The BRI should not be interpreted as the broadest possible interpretation. Consequently, it is useful to ensure that the proper standard is being applied. When evaluating the BRI, the correct inquiry is not whether the specification proscribes or precludes a broad reading of a claim term adopted by the Examiner. The BRI, rather, is an interpretation that is consistent with the ordinary and customary meaning of the term (unless given a special definition) and that is consistent with the use of the claim term in the specification and drawings. *See* MPEP § 2111.

If the Examiner's interpretation of a term is too broad, the response may include evidence showing that the interpretation is too broad. Evidence may include demonstrating that the relevant document uses a term in a specific way and in a consistent manner. Evidence may also include illustrating that the Examiner's interpretation of that term is inconsistent with the use of the term in that document. Evidence can also be provided to show that the term has a specific meaning in the art.

Another legal argument relates to ascertaining the differences between the claimed invention and the prior art. Although this argument may have technical aspects, the Examiner is required to consider both the claims and the reference as a whole from a legal perspective. Failing to account for portions of a reference that teach away from the claimed invention, for example, does not consider the reference as a whole and does not adequately consider how one of skill in the art would understand the reference. Similarly, failing to consider the elements of a claim as a whole is an indication of an impermissible hindsight analysis.

The Examiner should also be consistent with regard to the person of ordinary skill in the art and use the same person of ordinary skill for both art and non-art rejections. The Examiner cannot assume, for example, that a person of ordinary skill in the art can understand complex telecommunication references in the context of an art rejection and also assume that the same person of ordinary skill cannot understand the term program in the context of a non-art rejection.

In sum, consideration should be given to both legal and technical arguments when engaged in patent prosecution.