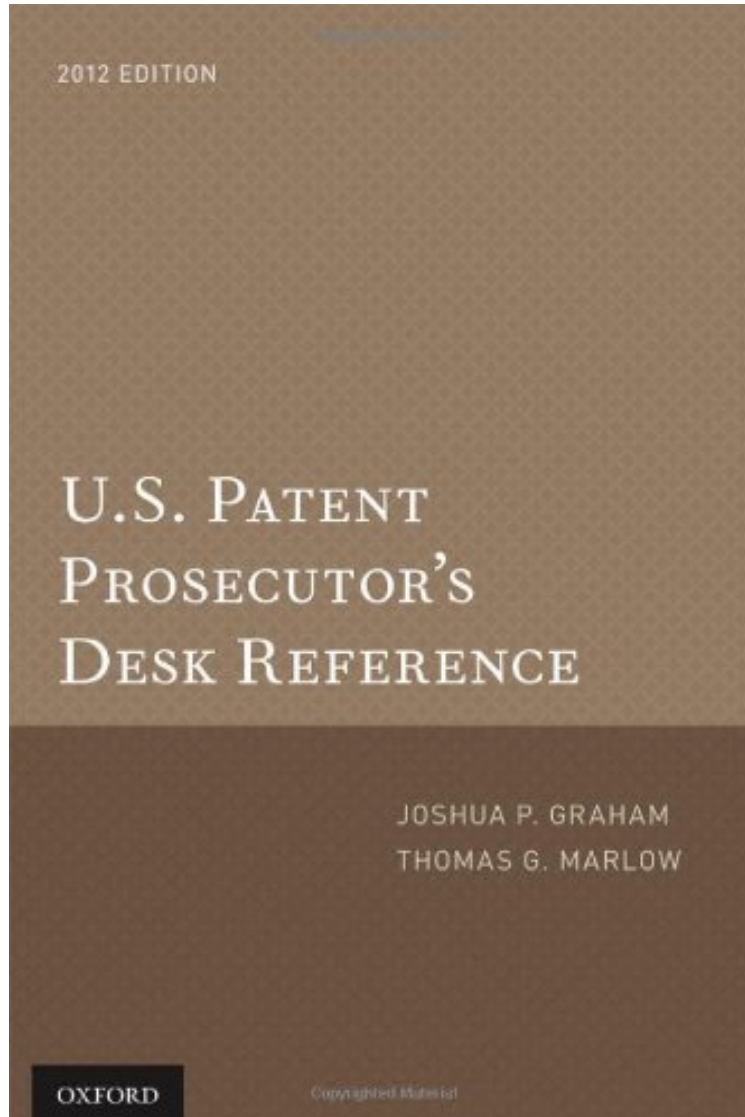


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U.S. Patent Prosecutor's Desk Reference 2012 Edition

Joshua P. Graham, Thomas G. Marlow

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Joshua P. Graham, Thomas G. Marlow : U.S. Patent Prosecutor's Desk Reference 2012 Edition before purchasing it in order to gage whether or not it would be worth my time, and all praised U.S. Patent Prosecutor's Desk Reference 2012 Edition:

3 of 3 people found the following review helpful. Poor Formatting and Content, No KSRBy Eric CatfishThis book attempts to tackle a difficult subject, but doesn't quite succeed. It collects a lot of useful data, but offers little in the way of big-picture prosecution strategy.FORMATting. The table of contents is a mess, and the formatting does not

aid usability. For example, chapter-contents pages are labeled "CHAPTER 3: Section 3000 Content." This tells me nothing. 'Section 3000' is just repeating that its chapter 3. No one cares. I want to know what chapter 3 is about. A useful title might be "Ch 3: Obviousness."CONTENT. Content entries start with a case cite, but there is no division between entries. This makes it easy to forget whether the case cite refers to content above it (as is standard practice) or content below it (the practice in this book).A standard entry takes this format:In re Case Cite, 123 F.3 456 (Fed. Cir. 2011).Technology Area: ElectricalQuotable Language: " some quotes "Rejection Response: "Form response"Relevant Facts: "Summary of the facts"MY THOUGHTS:The "quotable language" portion is sometime useful. But other times, the language is just parroting the statute. Thats not useful.The form "rejection response" should be the heart of the book. Some of the proposed responses would seem to lead towards dangerous admissions or unnecessary narrowing of claim scope (e.g. claim distinguishes the reference). These proposed responses should probably include a warning label.Summarizing the relevant facts of a complex technology is extremely difficult. This book does a mediocre job.LAW: KSR v. Teleflex is mentioned once, but only in passing.I wish I had more time to write this review. Patent Prosecutors Desk Reference does some things quite well. Its just easier to point out the shortcomings.At \$200, I can't really recommend this book.

Patent prosecution is more than drafting patents--it is also advocating patentability. The challenge that each patent prosecutor be an effective draftsman and advocate is compounded by mounting pressure to procure high quality patents at minimum cost. There is a need for a quick, reliable reference to assist prosecutors in creating, researching, and supporting patentability arguments.In the U.S. Patent Prosecutor's Desk Reference, Joshua P. Graham and Thomas G. Marlow assist patent prosecutors in responding to Office Actions issued by the United States Patent and Trademark Office (USPTO) rejecting patent application claims. It provides a comprehensive and updated source of law, organized by sections corresponding to the types of rejections made by the USPTO. Each section of this reference work includes the basis for the rejection, responses to the rejection, and legal authority supporting the responses. This 2012 Edition includes all cases from the Federal Circuit and Board of Patent Appeals through December 31, 2011, and is updated with:-Federal Circuit and Board of Patent Appeals and Interferences opinions issued in 2011-A focus on precedential and informative opinions from the Board of Patent Appeals and Interferences-A new section on rejections under 35 U.S.C. 251 based on the recapture rule-Full text of cited sources available at www.usppdr.com (<http://www.usppdr.com>)This desk reference cites five different authority sources: statutes that govern the granting of patents; the Manual of Patent Examining Procedure, Eighth Edition, which dictates how examiners determine whether a patent application should be allowed; decisions by the Board of Patent Appeals and Interferences, which is the administrative body of the U.S. Patent and Trademark Office that reviews decisions made by the examiners; the U.S. Court of Customs and Patent Appeals, which was the body that reviewed decisions made by the Board of Patent Appeals and Interferences until the Federal Circuit came into existence in 1982; the U.S. Court of Appeals for the Federal Circuit, which reviews decisions made by the Board of Patent Appeals and Interferences. The U.S. Patent Prosecutor's Desk Reference provides a comprehensive and reliable guide for prosecutors who create, research, and support patentability arguments.Discussions of the decisions made by the Board of Patent Appeals and Interferences, the U.S. Court of Customs and Patent Appeals, and the U.S. Court of Appeals for the Federal Circuit generally have four parts: Technology Area, Quotable Language, Rejection Response, and Relevant Facts.

"After reviewing Graham Marlow's new desk reference for patent prosecution, I kept asking myself why no one had ever published anything like this before. In short, this is an absolutely wonderful resource for patent prosecutors who need to quickly draft effective and authoritative responses to a myriad of different USPTO rejections. You can either spend hours delving through a confusing array of regulations and court decisions, or you can pick up this desk reference and get the guidance and authorities you need for most prosecution questions in less than two minutes. I would strongly recommend it for any prosecutor." - Steven W. Lundberg Patent attorney and a founding partner of Schwegman, Lundberg Woessner"The U.S. Patent Prosecutor's Desk Reference is an essential practice guide for every patent attorney. It is much easier to rebut an Examiner's rejection when you have at your fingertips a collection of decisions by the CAFC, CCPA and BPAI in which the Examiner's rejection was reversed. Because these decisions are organized by rejection type, you can quickly find authority to bolster your argument that a particular rejection is improper. Using this reference will make even experienced patent prosecutors more efficient and effective." - Ann McCrackin Professor of Law and Director of the Patent Prosecution Program University of New Hampshire School of Law (formerly Franklin Pierce Law Center)About the AuthorJoshua P. Graham was Patent Counsel for Research In Motion, where he managed an international patent portfolio for the Advanced Technology group. He was also a Senior Editor for IDEA: The Intellectual Property Law , and was a judicial intern for the Honorable Steven J. McAuliffe, Chief Judge for the U.S. District Court for the District of New Hampshire. Mr. Graham is a graduate of the University of New Hampshire School of Law (formerly Franklin Pierce Law Center).Thomas G. Marlow is Intellectual Property Counsel and Director at Fairchild Semiconductor, where he manages worldwide product line and business unit patent strategy, enforcement, and procurement. His work includes generating a strong intellectual property portfolio around

Fairchild's current and future technology focus areas. Previously, Mr. Marlow worked for Schwegman, Lundberg Woessner, where his patent practice included prosecution and analysis of technologies in the electronic arts, including semiconductors, integrated circuit design and fabrication, wireless communications, and computer networks.