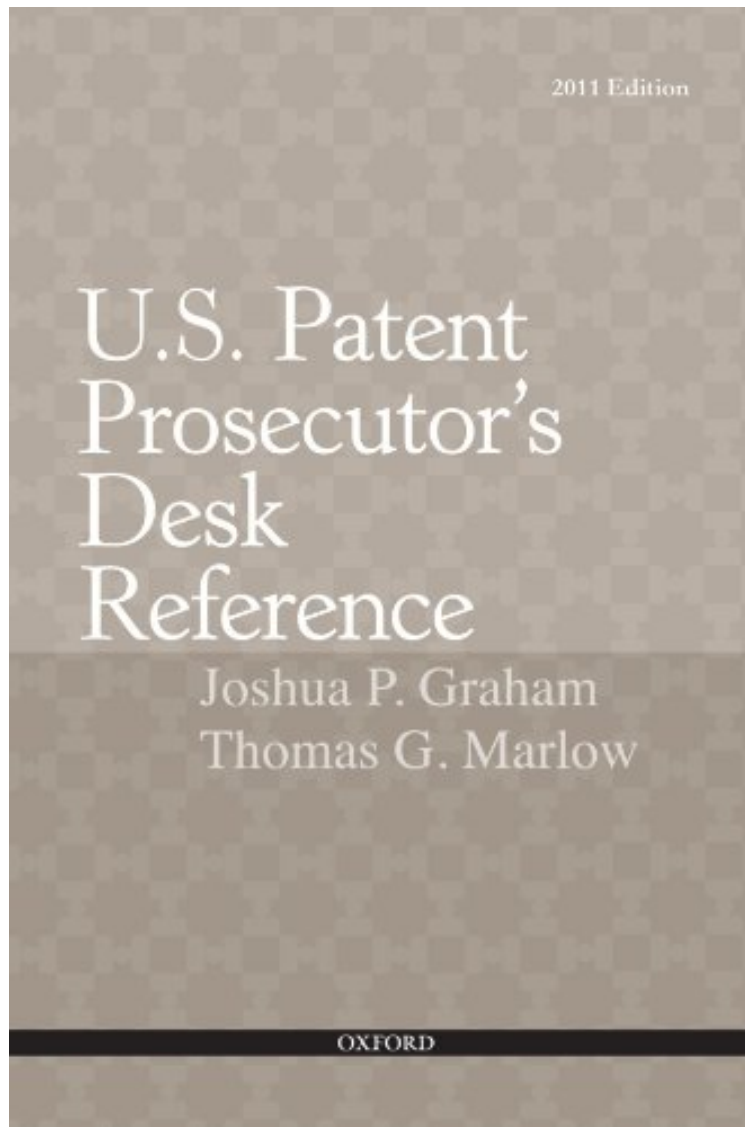


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Patent prosecution is more than drafting patents-it is also advocating positions. The challenge that each patent prosecutor be an effective draftsman and advocate is compounded by mounting pressure to procure high quality

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 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 Author Joshua P. Graham is Patent Counsel for Research In Motion, where he is a patent prosecutor and portfolio manager for the Advanced Technology group. Previously, he worked for Merchant and Gould, where his practice focused on patent litigation and appeals as well as proceedings in the U.S. Patent and Trademark Office. Mr. Graham was also a judicial intern for the Honorable Steven J. McAuliffe, Chief Judge of the U.S. District Court for the District of New Hampshire. 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.