

4 TOP TAKEAWAYS

Smart Prosecution for Value

Kilpatrick Townsend Partners [Eugenia Garrett-Wackowski](#), [Paul Haughey](#), [Babak Kusha](#), and [Karam Saab](#) recently presented on issues and strategies to consider when writing and prosecuting patent applications to withstand *Alice* challenges; to withstand post-grant challenges; using examiner interviews, accelerated examination, and Track 1 filings to expedite prosecution and allowance; and applying data tools to understand examiner tendencies.

Four top takeaways from the discussion, include:

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Invest effort up-front in drafting applications to withstand *Alice* rejections.

- Frame with non-generic technology and use product-specific boilerplate.
- Use patent classifier tools to help structure application and select right terminology.
- Model claims based on USPTO examples of patent-eligible subject matter.
- Coach inventors to explain inventions from back-end rather than user-interface aspects.

Invest in quality applications to survive post grant challenges.

- Do patentability search.
- Consider putting articles on commercial success in record without a declaration.
- Avoid financial terms to avoid a Covered Business Method, particularly in independent claims.
- Include a lot of claims with a variety of terms, scope, and unusual terminology not easily found in prior art.

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Consider expedited examination.

- Consider Track 1 Prioritized Examination or Patent Prosecution Highway. The up-front costs are usually covered by reduced and faster prosecution.
- Don't use Accelerated Examination - costly, must discuss search results, and rarely used.
- Consider First Action Interview Pilot, and possibly combine with Track 1. Also, consider After Final Consideration Pilot.
- For design patent, use Design Patent Rocket Docket.

Invest time in getting to know your examiner and talking with him/her.

- Review your examiner's statistics and career track ahead of your first interaction, include primary and supervisory examiners as needed.
- Develop a relationship with the examiner, especially if multiple cases in front of him/her.
- Use in-person, video-conference, or phone call-based interviews in that order.
- Use examiner statistics to assess how aggressive to be on continuations.

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