

Patents: Responding to an Office Action (Update)

Online Continuing Legal Education

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Patents: Responding to an Office Action

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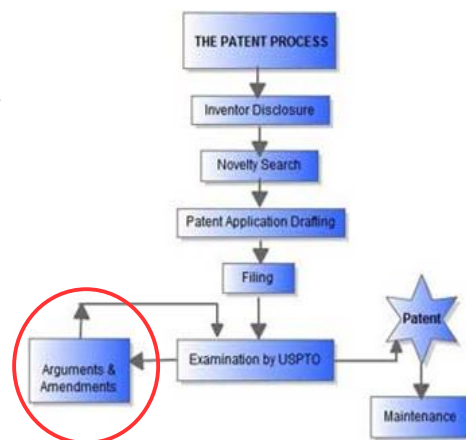
Outline of Today's Presentation

1. Introduction
2. Draft Patent with the Office Action in Mind
3. Non-Prior Art Rejections (e.g. § 101)
4. Prior Art Rejections (e.g. § 102, 103)
5. Examiner Interview
6. Writing a Response to an Office Action

Introduction

Quick Background on the Process...

- - Receive disclosure from inventor; generally conduct a Novelty Search
- Draft and File Patent Application
- First Office Action on the Merits 1 to 3 yrs later
- ^ **Response = topic of today's presentation**

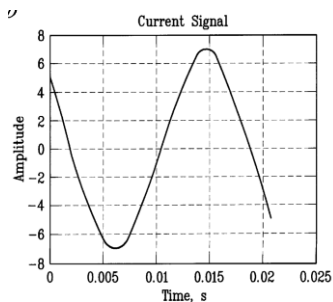


Response to Crazy Office Action

- Claim in the application:
- “7. The device of claim 1, wherein said ... device is coupled to a neutral wire.”
- Office Action: “see Hart 5B”, no further explanation. (Presumably, the Examiner means “Figure 5B”)
- So we look at Figure 5B in Hart...

Response to Crazy Office Action

- Anyone see anything coupled to a neutral wire in that figure?
- Telephone interview – Examiner refuses to discuss claim; I forced the issue, as it was so egregious.
- After 20 minutes of back and forth, Examiner finally says, “we're so pressed for time.”
- Common refrain – not enough time to examine applications.



**Draft your Patent
with the
Office Action in Mind**

**Draft your patent with the Office Action
in mind**

- Many Examiners will read the claims, little more.
- Define all key terms used in your claim language.
- Avoid 112 rejections – e.g. if you say “substantially”, define “substantially” in the Specification.
- Have backup terminology and variations in specification, in case you need to amend.
- Use signals and precise language so you can find it years later when you receive the Office Action, e.g. “alternate embodiment”, “defined as X or Y”.

Background (optional section)

- You can use the 'background' section to discuss the prior art – what is the problem with the prior art?
- “sell” your invention to the Examiner
- Tell the Examiner what you’re talking about, where to search
- Be Careful - Anything you write here is admitted prior art

Summary (optional)

- Tracks the claim language in plain English
 - Avoid words like “comprising” in the summary.
 - Write it as close as possible to “regular” English
- When you draft the summary from the claims, it helps ensure that everything you claimed is in the specification.
- Might be what a Judge will read in determining infringement

Drawings

- Makes your life easier when responding to an Office Action
- Good practice: copy a relevant portion of drawing in a Response so the Examiner needs only look at one document.
 - Can also show next to a picture of the prior art cited.
 - Visuals make your arguments easier to understand
- With method claims, use corresponding flow charts; try to use wording from the claim.

Be Expansive in Your Application

- Issued Patents used to fit on 1 to 3 pages – today, more like 10 pages (single spaced, small font)
- Don't limit yourself - be expansive
 - e.g. disclose “comprising” and “consisting of” in case you need to narrow the claim language (where applicable)
 - e.g. use “may” or “in another embodiment”
- No new matter after filing (unless CPA), so get it all in
- Don't talk badly about the technology (or prior art)

Claim Drafting with Office Action in Mind

- If you have support for variations, you'll be better prepared if the Patent Office finds art that reads on some of your claims; can amend claims.
- Make your claims count – include novel variations in dependent claims.
- Draft claims limited to what is new and unobvious over prior art, but as broad as possible.
- Two schools of thought on claims in Office Action – fight for claims, or amend to let Examiner feel a “win”.

Non-Prior Art Rejections

When You First Receive an Office Action .

• •

- Send it to the client without comment or review it first?
 - What is sophistication level of the client?
 - Most clients will want at least some comment on it
- How well do you understand the technology vs. your client?
 - You may need to send the cited art to the client for comment on what's different about his tech.
- Keep the goal in mind: Respond in the best manner to get broadest claims allowed.

First, a Note About Deadlines

- Mailing Date on the Cover – used for calculations
- Docket dates: (typical dates are as follows)
 - 1 month – 'ping' client (personally, I send an invoice right away, due in 30 days with automatic reminders)
 - 2 month – begin work, if haven't already
 - 3 month – regular DEADLINE
 - 5 month – incessantly 'ping' client – one month left!
 - 6 month - ABANDONED

Office Action Summary

- Not always accurate, but gives you something of a 'roadmap'
- May want to take allowed claims to protect them; file a Divisional Application for the rest of the claims
- If Office Action is 'final' Examiner more limited in what he can do
 - Sometimes, won't search further, but many have more time for it
 - Consider 'Notice of Pre-Appeal' – threat can be used to get Examiner to move, or
 - Be on top of your client to respond quicker
 - If filing Request for Cont. Exam (RCE), treat like non-final, but more \$\$\$ to government

Office Action Summary

- Not always accurate, but gives you something of a 'roadmap'
- May want to take allowed claims to protect them; file a Divisional Application for the rest of the claims
- Should state types of rejections (more serious), objections (less serious), and allowable matter (desired).
- If twice rejected, almost always a “Final Rejection”

Final Rejections

- Option 1: Continuation – try again + pay fee to gov.
 - Especially if Examiner's position is strong
- Option 2: Negotiate allowable claims
 - Examiner may have time for more searching
 - May get you no where; may want to threaten:
- Option 3: Pre-Appeal then Appeal
 - Respond within two months for “Advisory Action”
 - Pre-Appeal Brief is 5 pages, reviewed by 4 at PTO

<p>PATENT AND TRADEMARK OFFICE</p> <p>UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov</p>				<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <p><small>Extensions of time must be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed if the date of this communication is the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Set period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Within three months after the mailing date of this communication, even if timely filed, may reduce any 7 CFR 1.704(b).</small></p>
<p>Communication(s) filed on <u>16 February 2011</u>.</p> <p>2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>in condition for allowance except for formal matters, prosecution as to the merits is with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>				
TE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
00	Bertil Ronald Erickson	ERK002	1514	
03/23/2011	EXAMINER			
in	LAYNO, BENJAMIN			
	ART UNIT	PAPER NUMBER		
	3711			
	MAIL DATE	DELIVERY MODE		
	03/23/2011	PAPER		
<p>ached an Office communication concerning this application or proceeding.</p> <p>y, is set in the attached communication.</p>				
<p>Attachment(s)</p> <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)</p> <p>Paper No(s)/Mail Date <u>10/08/10</u></p> <p>4) <input type="checkbox"/> Interview Summary (PTO-413)</p> <p>Paper No(s)/Mail Date _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p>				

Restriction Requirement

MPEP § 803: “There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent or distinct as claimed; **and**
- (B) There would be a serious burden on the examiner if restriction is not required.”
- Often applied improperly and can often be overcome with a semi-reasonable Examiner.

Restrictions Increasing, Overcoming Restrictions Also Increasing

- Example: Biotech Art Unit:
 - 1993: ~1000 restrictions; ~32,000 Office Actions
 - 2008: ~22,000 restrictions; ~42,000 Office Actions
 - (source: Jon Dudas, Former USPTO Director, 2009)
- But Overcoming Restrictions Also Rising:
 - Biotech: 54% overcome; Chemical: 21% overcome
 - Computer: 6% overcome; Mechanical: 18% overcome
 - (source: Patently-O blog, 2010, based on sampling of 20,000 applications)

Example of Restriction that will Stay

- Likely to stick:
 - Claims 1-10, drawn to a method of making [complex article of manufacture], classified in class 265, subclass xxx.xx
 - Claims 11-20, drawn to a device for making [same thing], in class 425, subclass xxx.
 - Prior Art Search had revealed that for the past 20 years, all the close prior art was restricted like this.
 - Examiner properly applied MPEP § 803 as follows . . .

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Example of a Restriction you May Overcome

- Restriction was as follows:
 - Claims 15-20 – method of playing game of chance, class 273, subclass 269
 - Claims 11-14 – balls for **ball selector**, class 273, subclass 144A
 - Claims 1-10 – **ball selector**, class 463, subclass 17
- Office Action: There would be a burden of search on the part of the Examiner.
 - WHAT?! That's your job! Sorry to burden you, but that is not the legal standard! (Don't say it this way.)

More Clues to Overcome Restriction

- Look at Examiner's Search Report
 - It's right after the Office Action
 - What classes/subclasses did they search?
 - Was the class/subclass even relevant? (on the right, nope!)
- Argue language of MPEP § 803 (for some reason, Off.Action's seem to use a different text) with quotations.

Hits	Search Query	DBs
3394	(rdif or RDIF or (radio adj1 frequency adj1 identification) or antenna or tag or circuit or chip) near7 (inside or within or contain or contained or containing or interior or imbed?) near7 (ball or dice or ((game or playing) adj1 (piece or token)))	US-PGPUB; USPAT; EPO; JPO; DERWENT; IBM_TDB
3402	(rdif or RDIF or (radio adj1 frequency adj1 identification) or antenna or tag or circuit or chip) near7 (inside or within or contain or contained or containing or interior or imbed?) near7 (ball or dice or ((game or playing) adj1 (piece or token)))	US-PGPUB; USPAT; EPO; JPO; DERWENT; IBM_TDB
391	(rdif or RDIF or (radio adj1 frequency adj1 identification) or antenna or tag or circuit or chip) near7 (inside or within or contain or contained or containing or interior or imbed?) near7 (ball or dice or ((game or playing) adj1 (piece or token))) and (game or lotto or lotter? or keno or bingo)	US-PGPUB; USPAT; EPO; JPO; DERWENT; IBM_TDB
2	("20060046837").PN.	US-PGPUB; USPAT; EPO; JPO; DERWENT; IBM_TDB

A Winning Argument - Example

- Must provisionally elect one grouping (no choice).
- Must say you are electing one group with traverse.
- Must provide arguments with your traversal.
- Best argument: “intertwinement” between groupings
 - means search burden of one grouping makes exam of additional groupings less than a “substantial burden”
 - Overlap in limitations between one group and another
- Another Argument: “The Search covers both anyway.”

A Winning Argument - Continued

- “patent for any one of these groups likely placed in each subclass” ... or the subclass is the same
- Examiner will argue: “but independent claim 1 has A, B, C, and D and claim 11 has A, B, C, and E”
 - Preempt/argue that, e.g. claim 2 depends on claim 1 and has element E; claim 12 depends on claim 1 and has element D
 - Argue that “E” doesn't add a substantial search burden
 - e.g. “a bettery holder” (this really happened . . .)
 - Argue if we followed your logic, we'd need an 8-way restriction and that can't be what § 803 means

Rejection under 35 U.S.C. § 101

- § 101 limits patentability to: "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."
- In practice, most § 101 rejections (for “properly” written applications) are in business method patents (software); come to wording
- *Bilski*: Supreme Court said one test is “transformation of matter” or “tied to a specific machine”

Overcoming Many § 101 Rejections

- Acceptable wording changes every few years
 - In 2007 we'd say “computer readable storage medium” even with no direct support in specification
 - In 2012, we'd say, “processor” - no support in specification is needed whatsoever
 - In 2013, we now say, “non-transitory storage medium.”
- Often just follow the Office Action's suggestion
- Avoiding 101: Can't patent law of nature, but maybe can patent “creating conditions for ball lightning”

Prior Art Rejections

First Review of Office Action

- Goal is to break down the Office Action into manageable pieces
- Avoid getting caught up in the Office Action – focus on Prior Art Cited
- Review in a systematic order:
 - Review your patent application, claims first
 - Review major prior art cited
 - Look for differences
- Do high level analysis, then LOTA method . . .

Before We get Started . . .

- Check earliest filing date of each cited reference
 - Make sure it's a valid prior art citation
 - (until 2013, can 'swear behind' a reference)
- Look at Search Report – see where Examiner Searched, did they find a lot, did they spend a lot of time, . . . gives you some clues.
- Reality: Most first Office Actions are poor
- Reality: Most Applications get at least one rejection, whether warranted or not.

1) High Level Analysis

- What's the “point” (e.g. problem solved) of your technology?
 - Review / refresh recollection before getting side-tracked by prior art
 - Put this in your head; or even better . . .
 - Write out a paragraph in your own words, with citations
 - Review cited prior art – what's its point?
 - Put this in your head / write out a paragraph, with citations
 - Why is it different?

High Level Analysis Example: Now U.S. Patent 8,128,089

- a spherical ball with internal transponder freely movable about in interior space such that the transponder falls to the gravitational bottom (paragraph [039]).

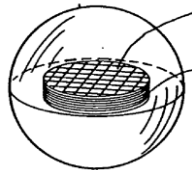
- This prevents the ball from getting lost by rolling away as the transponder is constantly working against the centrifugal motion of the ball.

Further, as recited in paragraph [039], “this has important implications for efficient reading of data on the transponder” as the reader is placed immediately below or next to the known position of the transponder when the ball is in a resting position.

High Level Analysis Example: Cited Prior Art to My Client's Patent

US 2006/0046837 to Ito *et. al.*, is directed towards balls that are made of translucent resin with an RFID tag (paragraph [0054])

Figure 3 of the Ito reference shows the RFID tag 3 fixed to a plane passing through the center of a ball 2. No reference has been located stating whether the ball is hollow or solid (?), or that the RFID tag is anywhere other than in it's fixed position shown in Figure 3.



High Level Analysis Recap

- We have reviewed our claims
- We have looked at the prior art ourselves
- We have picked out differences in claimed features
- We are now clear on where we stand.
- Now look at the arguments in the Office Action.

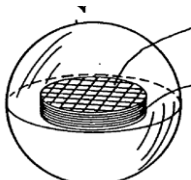
LOTA Method Explained

- **LOTA** is a systematic method of responding.
- **Limitation** – Copy and Paste each limitation
- **Office Action** – Copy and Paste rejection for limitation
- **Text** – Copy and Paste cited text.
- **Argument** – Does the text match the Limitation?
- Repeat until cycled through each and every limitation.

2) LOTA Method – Delving into the Rejection

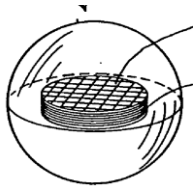
- Remember: An Office Action is improper unless each and every limitation is cited in the prior art
 - § 102 – Not Novel - In one piece of art
 - § 103 – Is Obvious - in multiple pieces of prior art
- If § 103 used, must give reason for obviousness.
 - That being said, the most successful arguments are that a feature is not shown, alone or in combination.
 - Trying to argue “not obvious” to combine is like winning an argument with a sibling.

Carrying out the LOTA Method: Iteration 1

- Limitation: "generally spherical encasement with a **hollow** interior"
- Off. Act: Each ball comprises a spherical encasement with a hollow interior, see Fig. 3 The
- Text:

•
- Argument: Figure 3 not enough to show “hollow”

Carrying out the LOTA Method: Iteration 2

- Limitation: "generally spherical encasement with a **hollow** interior"
- Off. Act.: Each ball comprises a spherical encasement with a hollow interior, see Fig. 3 The
- Text:



- Argument: Figure 3 not enough to show “hollow”

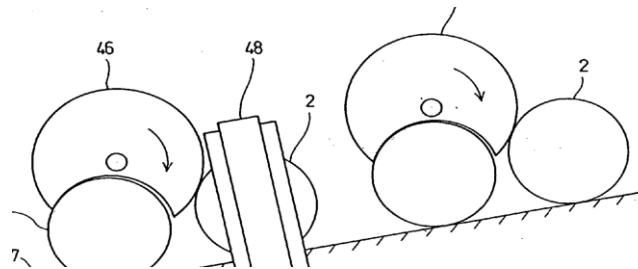
Carrying out the LOTA Method: Iteration 3

- Limitation: “a near field communication reader below an exit tube”
- Office Action:
ball selector also comprises a near field communication reader, antenna 48, which is
below an exit tube, ball recovery box 32, paragraph [0067]. The exit tube 32 (ball
- Text: No recitation of “Antenna 48” in paragraph [067]! Find it myself...
 - Why? Not being in the Office Action properly isn't enough – need to make sure it's not in the prior art!

Found it . . .

- Paragraph [0068]:
direction in which the balls 2 move. The antenna 48 is disposed between the rotating disks 45 and 46. The antenna 48 has rectangular coils surrounding the guide duct 47.

- ... which
- Describes
- Figure 8:



Conclusion of LCTA, Iteration 3

- Limitation – reader (or antenna...) below exit tube
- Office Action – bogus; but we looked further and found a “proper” citation of the antenna
- Text – shows antenna is a coil around ball, not under the exit tube
- Argument: This prior art citation does not show “reader below exit tube” because the reader is actually around the ball path, and above the exit tube.

Repeat LOTA for Each and Every Limitation

- Rejection under 35 U.S.C. § 102 and § 103 treated exactly the same in this regard
- If you can't find a proper citation for each and every limitation (it happens), then don't argue it
- If, and only if, there is a proper citation for each and every limitation – amend claims (add limitations)
 - Can take limitation of dependent claim
 - Can add limitation from specification
- Keep your High Level + LOTA notes in order

Examiner Interview

Examiner Interview

- Etiquette and good manners are critical!
- Statistics show shorter prosecution, greater allowances when an Interview is conducted
 - In person, best
 - Telephonic, second best
- Often, easier to explain with a “give and take” of direct communication than on paper
- Can also understand Examiner's position better

When To Have an Examiner Interview

- Early and often.
 - Before final rejection, an Examiner will have the most leeway to act.
- Patent Office allocates 1 hr, per application for Examiner's to talk to you.
- Do your homework (High Level and LOTA analysis) and:
 - Be prepared with claim amendment; and/or
 - Be prepared to explain difference over prior art

Writing a Response to an Office Action

Your Response

- Part I: Cover Sheet
- Part II: Amendments
- Part III: Arguments
- Part IV: Declarations
 - (e.g. test results, swearing behind, . . .)

Cover Sheet

- Heading Block
- State what it is
- State what page each item starts on.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE			
Application of:			
Serial No.:	12/620,012	Art Unit:	3662
Filed:	11/17/09	Examiner:	Sotomayor, John B
Title:			

To: Commissioner of Patents
Via Electronic Filing

RESPONSE TO OFFICE ACTION OF NOVEMBER 16, 2011

Interview Summary begins on page 2 of this paper.

Amendment to the Claims begins on page 3 of this paper.

Remarks begin on page 9 of this paper.

Interview Summary

- Examiner will also provide one.
- Good idea to state (politely) what was discussed.
- Creates a paper record.

INTERVIEW SUMMARY

The undersigned thanks Examiner Sotomayor for the telephonic interview of December 6, 2011, and appreciates the Examiner's extra efforts in contacting the undersigned despite technical problems at the USPTO.

The claims amendments submitted herewith were submitted for consideration during the interview and, during the interview, it was agreed by both parties that the amended claims overcome the objections made in the Office Action.

Amended Claims

- Use status identifiers on amended claims:
 - Original
 - Currently amended
 - Withdrawn
 - Canceled
 - ...
- Underline new text, strike-through deleted.

18. **(currently amended)** The ground penetrating radar measurement device of claim 15, wherein said means for measuring a composition of a heterogeneous material further comprise means for measuring said composition ~~is measured~~ to a resolution of at least one inch.

Remarks (Arguments)

- State what the Office Action said succinctly.
 - Rejection under ?
 - Allowance of certain claims?
 - Restriction?
- State what you are doing.
 - Arguing?
 - Amending?

REMARKS

Claims 11-14 have been rejected under 35 U.S.C. § 102 (b) as being anticipated in view of Ito et. al. (US 2006/0046837). Arguments are provided below to overcome these rejections. The Office Action has further restricted examination to claims 11-14. Applicant traverses this restriction.

Writing Up Response to 102/103 . . .

- Paragraph on your patent app (with citations).
- Paragraph on each prior art reference (with citations).
- From your 'high level analysis'

I. Rejections Under 35 U.S.C. § 102 (b) in View of Ito et al.

Claims 11-14 of the present application are directed towards a spherical ball with internal transponder which is freely movable about in interior space such that the transponder falls to the gravitational bottom (paragraph [039]). This prevents the ball from getting lost by rolling away as the transponder is constantly working against the centrifugal motion of the ball. Further, as recited in paragraph [039], "this has important implications for efficient reading of data on the transponder" as the reader is placed immediately below or next to the known position of the transponder when the ball is in a resting position.

US 2006/0046837 to Ito et. al., is directed towards balls that are made of translucent resin of different colors (paragraph [0054]) such as red, green and yellow with an RFID tag. Figure 3 of the Ito reference shows the RFID tag 3 fixed to a plane passing through the center of a ball 2. No reference has been located stating whether the ball is hollow or solid, or that the RFID

State the Law

- 102 court case >
 - With legal test.
- 103 court case >
 - With legal test.

Referring now to the claims, in order to demonstrate anticipation under 35 U.S.C. § 102, the Office Action must show "that the four corners of a single, prior art document describe every element of the claimed invention." *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). Moreover, the reference must also disclose those elements "arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

Then, Use Your LOTA for each Limitation . . .

- Limitation →

Claim 11 of the present disclosure is directed towards a plurality of balls with each ball having a "generally spherical encasement with a hollow interior". The Office Action states, that this limitation is shown in Ito as follows:

- Office Action →

Each ball comprises a spherical encasement with a hollow interior, see Fig. 3 The encasement comprises a human-readable indicia (color), paragraph [0054]. A radio frequency identification tag 3 is located within the hollow interior, paragraphs [0054], [0055], [0070]. The radio frequency identification tag is adapted to transmit data

- Text →

As recited above, Figure 3 fails to show that the spherical encasement is hollow. Rather, the RFID tag appears to be held at a central plane, implying that the ball is solid. No text has been located within the written specification of Ito one way or the other, and as such, the Office Action has not met the burden of showing that the prior art discloses each and every limitation of claim 11. Further, as recited above, the balls are produced from translucent resin, so it is highly unlikely that these balls are produced hollow. Therefore, claim 11 is allowable.

- Argument -->

Conclusion

- Please allow the claims . . .

III. Conclusion

Withdrawal of the rejections and early acceptance of all claims is requested.

Sincerely,
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(12) **United States Patent**
Erickson

(54) **AUTOMATED BINGO GAME BASED ON RFID-TAGGED BALLS**

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(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 12 days.

(21) Appl. No.: **12/856,781**

(22) Filed: **Aug. 5, 2010**

(65) **Prior Publication Data**
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(51) **Int. Cl.**
A63F 3/06 (2006.01)

(52) **U.S. Cl.** 273/144 A, 273/144 R, 273/269; 273/138.2, 463/17, 463/19

(58) **Field of Classification Search** 273/144 A, 144 B, 269, 138.2, 463/17, 19
See application file for complete search history.

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(10) **Patent No.:** **US 8,128,089 B2**

(45) **Date of Patent:** **Mar. 6, 2012**

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Primary Examiner — Benjamin Layno

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(57) **ABSTRACT**

Embodiments of the disclosed technology provide a method of integrating radio frequency identification (RFID) and near field communication (NFC) to add excitement, features, automation or semi-automation, and digital connectivity to a traditional Bingo or lottery game. Any game of chance may be played using embodiments of the disclosed technology. Balls used for purposes of randomization comprise freely movable RFID tags situated therein. When a ball is chosen, such as when it is the first or only ball to pass through an exit tube of a mixing apparatus, its RFID tag (with data corresponding to indicia on the ball) is read, and appropriate action can be taken, such as to update a video screen accordingly, check Bingos, check lottery winning tickets, and so forth.

10. A plurality of balls usable for a ball selector, each ball of said plurality of balls comprising:
a generally spherical encasement with a hollow interior;
human-readable indicia on said spherical encasement; and
a radio frequency identification tag freely movable within said hollow interior and adapted to transmit data corresponding to said human-readable indicia.

11. The plurality of balls of claim 10, wherein said radio frequency identification tag is freely movable within said hollow interior and drops to the gravitational bottom of said hollow interior when said ball is stationary.

12. The plurality of balls of claim 11, wherein said ball selector comprises a near field communication reader below an exit tube above a resting location for said stationary holding of a ball of said plurality of balls.

13. The plurality of balls of claim 12, wherein upon said near field communication reader reading indicia stored in a said radio frequency identification tag of a said ball, said human-readable indicia are displayed on a video screen.

14. A method of playing a game of chance comprising:
placing a plurality of balls within a chamber of a mixing apparatus, each ball of said plurality of balls comprising a hollow interior with a freely moving radio frequency identification tag therein said radio frequency identification tag having unique indicia stored therein;
while mixing said plurality of balls in said chamber, opening access to an exit tube at least until a first ball of said plurality of balls exits through said tube;

19 Claims, 8 Drawing Sheets

How do you respond to an examiner's continued use that s/he takes official notice that limitations in dependent claims are old and well known in the art as a basis for rejecting claims?

- Official notice is where an examiner will say that I have not found this is any reference, but I take official notice that it is well known and done before
- Make better arguments
- Google MPEP Official Notice
 - Find out if it meets requirements
 - Find Prior Art

Do you know of any adverse consequences of the first-to-file system on patent applications that are filed after march 16 that claim priority to provisional filed prior to march 16?

- Provisional applications tend to be narrowed down applications
 - Disclose more in non-provisional
- In order to avoid legal issues, be cautious and file ahead of time

What else can you do to protect beyond the provisional application?

- Use confidentiality agreements where you can
- Keep trade secrets

Design Patents

- Very Different Process
- Only protect the look of a functional object
- Write-up only describes the drawings
- Ordinary Observer Test
- Can file many variations – not as broad protection

What are your thoughts regarding the copyright of a design prior to filing a design patent?

- This would be used to initiate licensing discussions under a CDA
- Copyright office will not allow things that are functional
 - A lot of overlap, questioned in *Bilski* case
- Copyrights is an inexpensive way to get something, has to be artistic

Thank You . . .

- Questions? Reach Michael J. Feigin, Esq. at:
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- Disclaimer: This presentation is meant to be a broad overview and is a teaching aid – no legal advice is contained in the presentation.