

Concise Technical Writing:

# The Office Action

Developed for the U.S. Patent and Trademark Office

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Note to website visitors. This is an excerpt – the first eight pages – from a 92-page manual. It's intended to show how we tailor a Tech Writing workshop to a particular document. In this case, the document is what the Patent Office calls an "Office action," which is a patent examiner's written response to an application for a patent. (They capitalize the "O," but not the "a," and no power on earth or in heaven can change that.)

The Office action is governed by Title 35 (patent law, which is not written as clearly as it should be), concerns highly specialized subject matter in engineering, science, and law, and follows a number of unique conventions. Some of the examples on the pages included here will not make much sense to you, but they make sense to the examiners and to their readers, the patent attorneys.

# DEVELOPING THE RIGHT HABITS OF MIND

## How people read

The nature of reading varies widely. The kind of attention a document receives depends entirely on the kind of document it is.

When we read something for pleasure (a novel, feature article, or letter from an old friend), we expect a “storytelling” sort of presentation. We expect, in other words, a rambling journey through ideas. We don’t mind being kept in suspense by a good mystery story, and we don’t care whether our friend’s letter contains a bottom-line point. But we read such documents because *we choose* to read them. Because we choose to read them, we disregard wordiness, the lack of focus, and quirks of personal style. After all, we read these documents for entertainment. They need not make any practical point or offer a coherent demonstration. They don’t need to be written practically, because they aren’t read with an appetite for any practical result.

## How Office actions are read

*Office actions receive a much different reading.* Like all other business and technical documents (contracts, analyses, proposals, reports, and so on), office actions are read **functionally** (i.e., with a far different set of expectations), and for this reason they must be written functionally.

**Know what your readers expect.** The reader of an Office action (typically a patent attorney) wants clear writing. For example, when you object to something in the drawings or specification, he wants to know (1) exactly *why* you are objecting and (2) exactly *what he has to do* in order to overcome the objection. When you reject a claim under a section of U.S.C. 35, he wants to know why you think something is unclear or non-enabling, why you maintain that a claim has been anticipated, or why you find that a claim is unpatentable over another.

**The reader of the Office action isn’t interested in elegant style, merely in clarity.** Since he is always looking for holes in your reasoning, he will pounce on anything ambiguous, and then he will call you on the telephone and ask you what you meant. You then have to spend time on the phone, or in an interview, to clarify something that should have been clear in the first place. This wastes your production time.

**The reader of the action expects economy of expression.** Descriptive or discursive writing is fine in novels and essays, and stylistic quirks are fine in personal letters. But the language of Office actions should be as concise as you can make it. Work hard to be straightforward and direct. If you do, you will never write (for example) “The patent to Pang discloses” but simply write “Pang discloses.” If you respect the meanings of words,

you would never write “in consideration of the fact that,” but write “because” instead. When a phrase is necessary, use a phrase, but when a single word will do, it’s best to use the word.

**The reader expects you to prove your point.** When we cut to the bone, every Office action consists of a series of persuasive arguments. We’ll say more about this later. The important point, for now, is that you recognize that the heart of a good persuasive argument is (1) a clear contention, followed by (2) clear support. Not merely contention and support. A *clear* contention, followed by *clear* support, and written so that the reader can easily follow the path your thinking has taken.

**The reader expects format to clarify the organization of ideas.** When we read a novel, we are accustomed to reading paragraph after paragraph of text. But a novel tells a story, and we are reading it because we wish to. The Office action does not immerse us in dream. Instead, the reader must *act* on it. A functional document must have a functional format. Avoid page after page of paragraphs. Avoid page-long paragraphs. Break up the text with devices that provide instant guidance as to where ideas occur and how those ideas relate.

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## Habits of mind that foster precise writing

### 1. Honor the reader’s “default” understanding

What this means is that you don’t need to spell out every imaginable detail for every reader. For example, if I said, “I’m going to Paris on Saturday,” I would expect you to understand that I’m talking about the Paris in France. It’s true that there are a number of other Parises on the planet, but the more important point is that “France” is your default for the word “Paris.” If I were going to Paris, Texas, or to Paris, Virginia, then I would certainly add “Texas” or “Virginia” because in that case I would have to clarify my intent.<sup>1</sup>

If I write, “The satellites remain in orbit,” I expect you to understand that they are orbiting Earth. This gives me the freedom not to add the unnecessary phrase, “The satellites remain in orbit *around the earth*.” If they were orbiting some other body, I would have to be more specific (e.g., “The satellites remain in lunar orbit”).

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<sup>1</sup> Anticipating quibbles on this point, let me state that if we lived near Paris, Virginia, and I were going to the Paris in France, then I would have to write, “I’m going to Paris, France, on Saturday.” I would have to specify France because if we lived near the Paris in Virginia, then that particular Paris would be the “default Paris” for us.

In Office actions, when you cite the patent number every time you mention a reference, you are forgetting that you have already established that patent number as the default. (You indicate the patent number when you introduce the reference.) Even if you use the 3-digit form thereafter, and say “Kafka ‘399 teaches this” and Kafka ‘399 discloses that,” you are ignoring the default when you are using only one reference to Kafka. When you indicate to the reader how you’ll be characterizing a reference from now on – for example, when you introduce Frazier et al. and then write something like “hereinafter referred to as Frazier” – you are forgetting that the reader does not need such guidance *because of convention*. Simply by honoring conventional usage, you can save a lot of time and improve the precision of your writing.

A warning. Don’t read this instruction to mean that you can take shortcuts. When distinctions are necessary or when qualifications are required, the honest writer supplies them.

## 2. Prefer the specific to the general

Much of the writing in Office actions is ghostly stuff, shape without body. Clarity improves when ideas have bodies that the reader can grasp. The following sentence – which I did not invent, but merely plucked from an action – is a prime example of the problem.

*Note that the reference teaches the above elements as discussed below.*

In this very short sentence are three abstractions: *reference*, *above*, and *below*. This is what I mean by “ghostly” writing. The writer refers to nothing concrete, but gives us abstract terms that are difficult to grasp. Use words that are specific and remind the reader of what you are talking about:

Note that Carr discloses both the detergent and the surfactant. Regarding the detergent, Carr teaches that . . .

Which of the following is easier to grasp?

This modification of the basic reference in light of the secondary prior art is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other.<sup>2</sup>

This modification of Yamita in light of Svensen is proper because the references are so closely related that the appearance of features shown in one suggests the application of those features to the other.

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<sup>2</sup> This sentence is further complicated because the writer has committed “elegant variation.” He has varied his nouns, first calling it a “reference” and then calling it “prior art.” While the reader can probably follow what the writer is trying to say, the reader would have less trouble -- and the argument would be much stronger -- if the writer simply used the specific names.

### 3. Don't repeat what the reader already knows.

There is no information, only clutter, when a writer laboriously repeats something that has already been written. Below is an all-too-typical example of the problem.

It would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Gore regarding the porous polytetrafluoroethylene to modify the PTFE of Aldridge with the microporous PTFE of Gore motivated with the expectation that the microporous properties of the PTFE of Gore would be an enhanced insulation.

You will recognize this sentence as the concluding statement pertaining to why a claim is obvious. Because it is the concluding statement, chances are 100% that the reader has already encountered the idea that Gore uses microporous polytetrafluoroethylene (PTFE). Thus there is no need to repeat the idea twice more, as the writer has done. Below is the original again, and beside it is a revision that takes into account what the reader already knows.

#### Original

It would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Gore regarding the porous polytetrafluoroethylene to modify the PTFE of Aldridge with the microporous PTFE of Gore motivated with the expectation that the microporous properties of the PTFE of Gore would be an enhanced insulation.

#### Revision

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the PTFE of Aldridge with microporous PTFE since Gore teaches that microporous PTFE provides enhanced insulation.

Judgment is involved here, certainly, and if you are in doubt as to whether you need to repeat an idea, it is best to repeat it. But repeat something only because you think that the reader benefits from the repetition. In other words, repeat ideas only when you think the reader needs to encounter the ideas once more to remember what you're talking about.

### 4. Prefer primary words.

Here on my desk I have an Office action in which the examiner has written that something "would be within the ambit of the skill of the artisan." Within the what? Within the *ambit*. I have never seen that word before. I wouldn't bother looking it up if I were reading a magazine or a novel (in that case, I'd just guess), but since it's in a legal document, I have no choice but to see what the dictionary says about it. So I look it up, and I see what the dictionary thinks the word means – but I still don't know what the writer meant by it. (Sometimes writers use words in private ways.)

What has happened here? I have been sent to the dictionary! Nothing non-technical in an Office action should send me scurrying to the dictionary because *the purpose of the*

*action is not to increase my vocabulary.* The purpose of the action is to convey information on the first reading. It does not matter whether we know that “apposite” means “appropriate” or that “tachisto” is a Greek prefix for “speed.” What matters is whether the reader knows these things. And if she does not, and we use them anyway, then we are not writing. We are mumbling to ourselves.

I have read dozens of actions in which (these are merely examples) “subsequently” is used to mean “consequently” and “i.e.” is confused with “e.g.” “Subsequently” and “consequently” are fine words, to be sure, if you are writing a thesis in college, but they are not primary words. The primary words for these thoughts are “later” (or “then”) and “therefore” (or “thus”). If the writer had used primary words, he would not have confused them. If the writer had written “that is” and “for example” when he meant those ideas, he would not have confused them.

Many examiners seem overly fond of “above,” “abovementioned,” “instant,” and “said.” We get sentences that run wild about “the said this of the said that in the said somesuch for the said purpose of said doing something in the instant claim.” Such constructions are silly. Form disguises meaning. It’s important to remember that no one forces examiners to use these words. And it is much better to use the primary words *this*, *that*, *these*, and *those* to remind the reader that you’ve already mentioned the thing.

Let’s make something clear. The Office action is complicated enough. Second-order words, unfamiliar words, and unnecessary legal phrases do not make the action “more professional.” All they do is make the action more difficult. No one can stop you from referring to a dog as a “canine” and to the act of chewing as “masticating.” But if you do that, your writing will remain unduly difficult. It is better to let the dog chew.

# Precise Words

Good writing is clear on the first reading. The reader should not have to *make* sense of the text – “making” sense is the writer’s job. To achieve precision, writers must first commit to using the right words. For any word to be the “right” word, it must be technically precise, legally accurate, and familiar to the intended reader.

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## Huh?

The oath or declaration is defective because:

The quality of the oath or declaration is illegible. Specifically, the Applicant’s residence and Post Office cannot be understood. The oath or declaration should be of such clear quality that it is legible so that all written documentation can be easily read and understood.

When things go wrong with words, it’s hardly the fault of the words. Every word in the language has its place; the trick is in knowing when to use it and how to use it. Use “utilize” only when you’ve been ingenious in your use of something; use “prioritize” for comic relief; use “biannual” to generate calls asking what you meant. Please pay attention to your words. We all know better than to write *The examiner respectively disagrees* and *It would be a matter of routine experimentation for a skill in the art*. But we might as well not know better if we don’t pay attention and eliminate such minor miscues with words.

In the example above, how can “quality” be “illegible”? Does the writer mean “ascertained” instead of “understood”? Is “written documentation” a redundant phrase? Finally, couldn’t the point have been made much more simply? What’s the idea that the writer wants to make plain to the reader?

## Unique usage of words in the Patent Office

Anyone encountering Patent Office writing for the first time thinks he is suddenly reading a foreign language. He may as well be! In the Patent Office, dozens of words have entirely different meanings than they do in plain English. Even common words such as “teaches” and “discloses” have acquired distinct Patent Office usage. *Harris discloses an illumination source* would bewilder the layman. To the layman, “disclose” means “to suddenly reveal something that has been intentionally kept secret.” *The patent to Harris describes* would convey the meaning.

Fortunately or unfortunately, both you and your readers are stuck with many technical terms and specialized words – unique and peculiar meanings of *traverse*, *election*,

*restriction, reference, object, reject*, and so on. You and your reader are also stuck with the wording of the statutes and form paragraphs, regardless of whether the wording is clear to everyone. But you are not compelled to complicate further. In fact, precisely because the very nature of Office action writing imposes so many complications, you should always try to simplify what you create. What this means is that (as Einstein said) you make it as simple as it can be – but no simpler. Don't write "nexus" if you mean "link."

## Problems with words in the Patent Office

We cannot make the argument plain unless we make the sentences plain. We cannot make the sentences plain unless we make the words plain. Here are some tips about words – not rules, but tips – for making your writing much more straightforward. Everything suggested below is legally sound.

1. **Don't complicate things.** Things have gone badly wrong when someone means that a surface is exposed to the air but writes that the surface "*is in direct communication with the ambience.*" Say that it is exposed to the air. If you mean torso, then do not write "*the torso portion of an individual.*" Say torso. Difficult words disguise meaning; simple words reveal it.

2. **Honor the "little" words.** Use them for clarity. For example, instead of writing about *a unimolecular chemical degradation prevention method*, use "little" words and present the thought as follows: *a method to prevent the degradation of unimolecular chemicals*. Here we have put words in a slightly different order and added "to," "the," and "of."

4. **Eliminate "(s)."** In the form paragraphs we use, we frequently see nouns expressed in optional form: *inventor(s)*, *claim(s)*, *invention(s)*, *defect(s)*, and so forth. When you are actually writing the action, you know whether what you are writing about is singular or plural, and you should choose the term that truly applies. It will be, for example, either *defect* or *defects*. The construction *defect(s)* should never appear in the action.

5. **Include "that" where necessary for clarity.** When an examiner writes, "Wang shows a power pin includes a ground pin mode," we have an ambiguous construction. Simply including the word "that" in this sentence would reveal whether Wang teaches that a power pin includes it, or whether Wang teaches a power pin that includes it.

6. **Respect the distinction between "that" and "which."** The word *that* introduces a phrase essential to your meaning, and *which* introduces a phrase that is non-essential. We'll cover this distinction in the class.

7. **Avoid unnecessary legalisms.** When the examiner writes *As discussed supra*, he is using a specious word. "Supra" is a mute duck for many readers, while "previously" quacks quite well for everyone. Use words that quack! You are stuck with *prima facie*



and *de minimis* because the phrases have slunk into law, but no one forces you to write *supra*, *sine qua non*, *nunc pro tunc*, *inter alia*, or any other Latin confections. Write in English.

8. **Always include articles.** In other words, rather than write “Woo shows method of forming semiconductor device,” write *Woo shows a method of forming a semiconductor device*. Rather than write, “Examiner has carefully reviewed applicant’s arguments,” write *The examiner has carefully reviewed the applicant’s arguments*.

9. **Avoid referring to your prior art as “the reference.”** When patent has a name, use the name instead. In other words, avoid writing, “The reference teaches X.” Say “Farinas teaches X.” Be specific.

10. **Avoid referring to your reference as “the prior art.”** When the patent has a name, use the name instead. Rather than write, “The secondary prior art teaches X,” write, “Lawson teaches X.” Be specific.

11. **Avoid “above” and “abovementioned.”** When the examiner, after seven or eight pages, refers to something “abovementioned,” the reader begins a safari. Be specific. Write, “As stated in paragraph 3 of this Office action,” or “As explained in the preceding paragraph,” or “As discussed under the section on 102 rejections...”

12. **Minimize your use of “instant.”** The word will not be wrong, necessarily, but it is usually superfluous. When you write something like, “The instant specification fails to explain,” the reader certainly does not need the “instant.” When you write, “Gunther anticipates instant claims 1-4,” you are adding a word that contributes nothing. The only time you ever need to use “instant” is when you are distinguishing one application (or claim, or group of claims, etc.) from another. (This workshop will clarify exactly when distinctions are necessary.)

13. **Minimize your use of “said.”** Precisely the same habit of mind that leads to the overuse of “instant” leads to the overuse of “said.” Use *the*, *this*, *that*, *these*, or *those*, whichever is appropriate. Instead of referring to a molecule just discussed as “said molecule,” call it “this molecule” or “the molecule.” Instead of referring to two steps as “said steps,” use “these steps.”<sup>3</sup>

14. **Avoid “same.”** Only very rarely does the word suffice to remind the reader of what you’re discussing. Rather than discussing two limitations and then writing, “Geisler anticipates same,” write, “Geisler anticipates these limitations.”

## Exercise: Choosing the right word

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<sup>3</sup> Some attorneys, because of the way they have been taught, argue that “said” is an important legal word. Other attorneys, because of the way they have been taught, argue that “said” is old-fashioned and silly. One thing is certain: the word complicates the text.