

AMENDED and NEW CASE DOCKET TIPS

Work Organization

It helps if you organize your work efficiently. You might consider the following:

1. **One bin for new cases:** In it you should place all the new cases you requested as well as the co-pendings which were properly transferred to you. Do not request any new cases until you have acted on all the ones in that bin. No case should remain in that bin for more than 13 or 14 days.
2. **One bin for phone calls:** In it you should place all the cases which can be fixed with a phone call or where you need to discuss a problem with the applicant. That includes new cases which will be handled with an examiner's amendment or a priority action or amended cases that can be disposed of with an examiner's amendment. Call the first day you review the case so that time works for you, not against you. Some applicants need to check and might not call back for a week. Call again if you do not hear back after 4 days or so.
3. **One bin for examiner's amendments:** In it you should place all cases where you have reached an agreement with the applicant and where you need to write an examiner's amendment.
4. **One bin for office actions:** In it you should place all cases which need office actions, whether they be priority actions or regular office actions. You should probably organize these cases by types so that you write all the priority actions, the 2(e)(1)s and the 2(d)s in sequence, etc.
5. **One bin for questions and research:** In it you should place all the cases which need some type of research done (2(d), 2(e)(1), I D). Also place cases where, after doing research, you are still unsure as to what course of action to take. After you determine the proper course of action, place the file in one of the bins discussed above. Make use of the interns when we have them. If you are writing a first office action which will require extensive research down the line (configuration, descriptive, 2(d) refusals), include some evidence in your first office action and immediately make a request to have the interns do a comprehensive research and evidence gathering. This evidence will then be ready for you when the amended comes back and you need to issue a final refusal.

Daily Routine¹

1. At the beginning of each day, check your cases to make sure that you are not late on any case. If any new case is 13 days old, place it on your pile of cases that need handling that day.
2. When examining new cases, make a short list of all the issues, preferably on a Post-It® note. It is all too easy to overrely on the checklist instead of actively examine the case.
3. Check your amendeds as soon as you receive them. Go through them and dispose of the ones which are in condition for publication right away. It will also help visually and emotionally since you will have smaller piles of amendeds to deal with and will not feel as overwhelmed. Review the requirements and refusals which you made and list them on a Post-It® note or on the registration review report and check them against the response ("okay" "no" or "?").
4. Write the due date on the Post-It® note or registration review report.
5. If you issued a 2(d) refusal, put a Post-It® note on the copy of the cite. It will save your time when referring back.

General Tips

1. Develop a routine and stick to it. For instance, search 10 cases every morning and handle all of them that day. Or, search 20 cases every other day, etc.
2. Remember RETRO CREDITS.
3. Use AutoText. Develop form letter, such as 2(d), 2(e), ornamental, etc. Put headings on AutoText and group form paragraphs that are usually combined, for example, L32 and L33, L41 and L42, S11 and A5, etc.
4. Organize each letter in the same way so that you can refer back easily to your letters once you examine your amendeds: refusals, id, specimens, disclaimers, drawing, miscellaneous.
5. Do not edit form paragraphs. Do not overwrite your letters. Occasionally, you will find an issue that is not covered in the form paragraphs: cut and paste from the TMEP (and put it in AutoText). However, if you find yourself constantly finding issues that are not covered in the form paragraph book, you are probably thinking too much and going into areas that examining attorneys are not expected to cover.
6. If you find that you frequently have to write second action non-final letters, chances are you are not writing clearly and concisely enough in your first actions. The vast majority of amendeds should result in pubs, finals or suspensions, especially given the new Office ID policy of going final even if the amended ID is beyond the scope of the original ID, as long as the proper form paragraphs were included.
7. Ask questions of your colleagues—you both will learn.
8. Do not agonize over a particular case!! In most cases, your inability to make a decision probably arises from a lack of research on the issues. If you really can't make up your mind, ask around and move on.

¹ Thanks to Essie Borsuk for some of the valuable tips above.