

Biotechnology/Chemical/Pharmaceutical
Customer Partnership (BCP) Meeting

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EYEING THE EXAMINER INTERVIEW: Insider Tips for Successful Patenting of Life Sciences Inventions

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USPTO

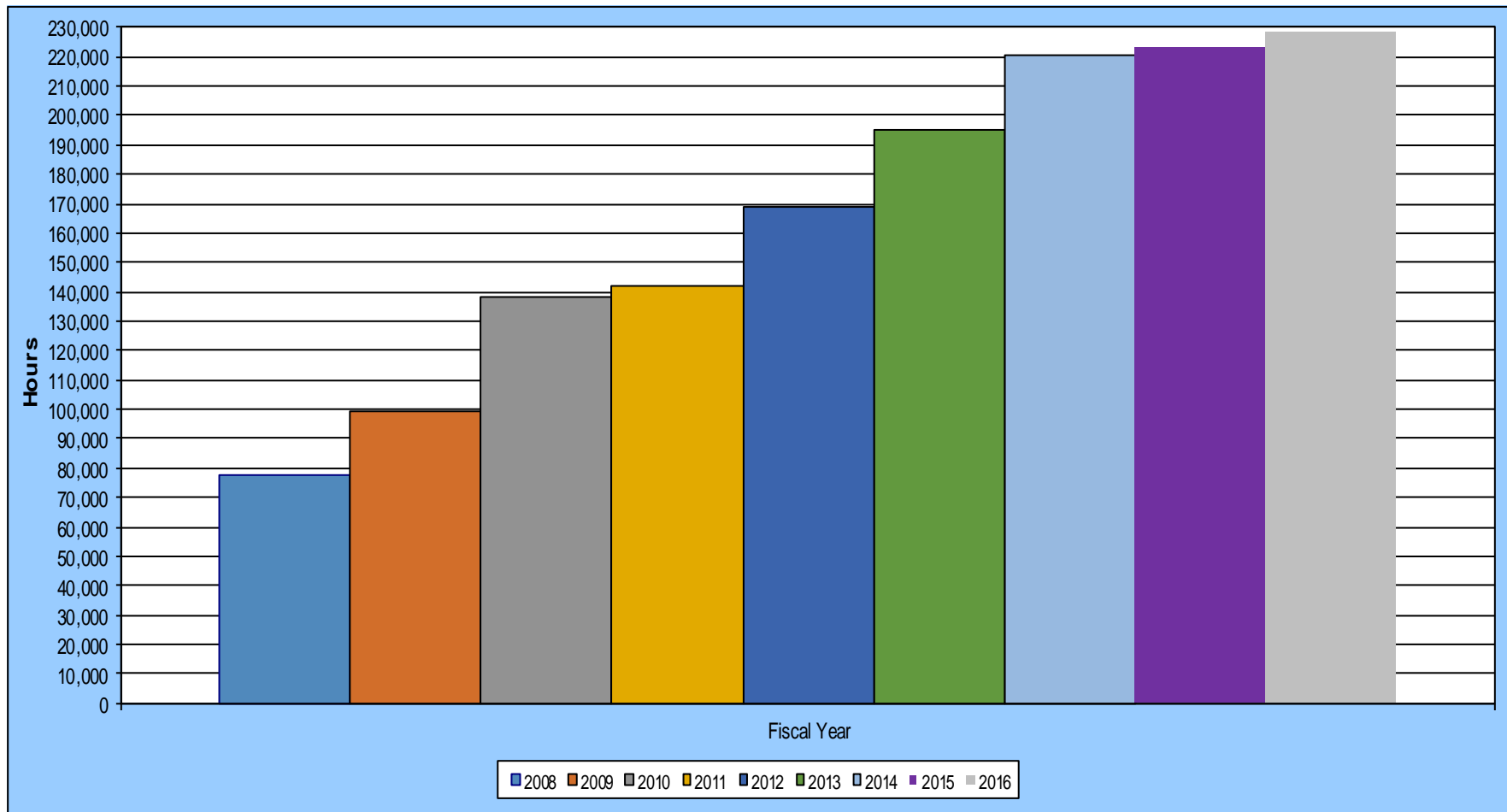
EYEING THE EXAMINER INTERVIEW: Insider Tips for Successful Patenting of Life Sciences Inventions

- Interview Stats
- Enhancements to Interview Practice
- FAQs

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- **Interview Stats**

Interview Time FY 2008 – FY 2016

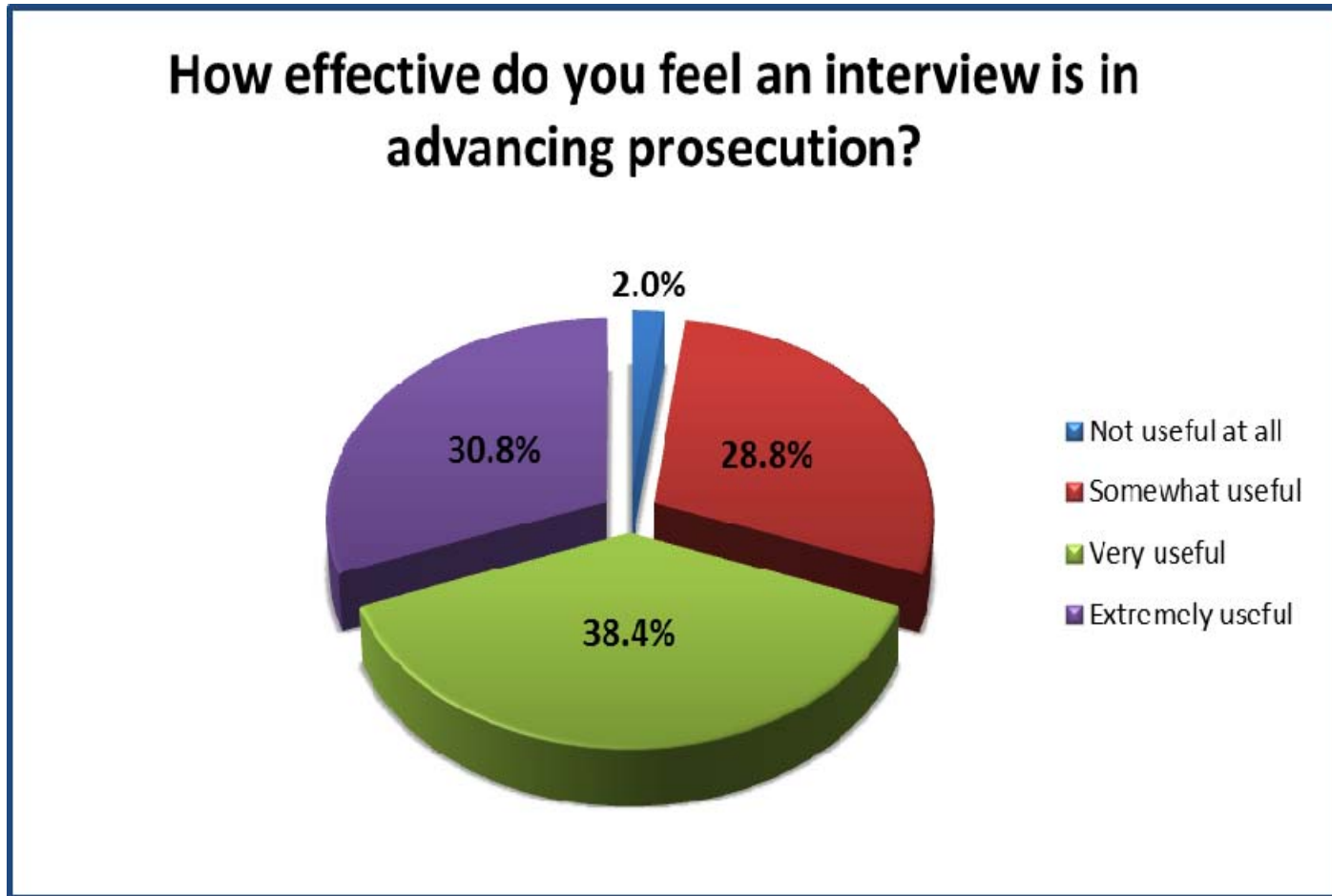


General Interview Statistics for 2016

phone		video		in-person		Total
applicant initiated	examiner initiated	applicant initiated	examiner initiated	applicant initiated	examiner initiated	
130,813	89,093	2,126	71	6,664	183	222,950

Interview Survey Results

- For advancing prosecution, Applicants were very positive.



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- **Enhancements to Interview Practice**

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- **Phone** (preferred by Examiners)
- **WebEx** – USPTO offering training.
- **In-Person** – Important to know if examiner works on campus or hotels
 - Option: In-person meeting with SPE and Examiner on phone or via webex.

Automated Interview Requests

<http://www.uspto.gov/patent/laws-and-regulations/interview-practice#step1>

Interview Practice

Interviews enable Applicants and Examiners to discuss and resolve issues and are an effective tool to advance the prosecution of an application. The USPTO encourages Examiners to take a proactive approach to examination by reaching out and engaging our stakeholders in order to shorten prosecution.

1 USPTO AIR

2 Video Conference

3 TC Interview Specialist

4 Policy and Guidance

5 Training and FAQs

6 Survey

7 Federal Register Notice

8 Contact Us

USPTO AIR



A new web-based tool that allows Applicants to schedule an interview with an Examiner for their pending patent application.

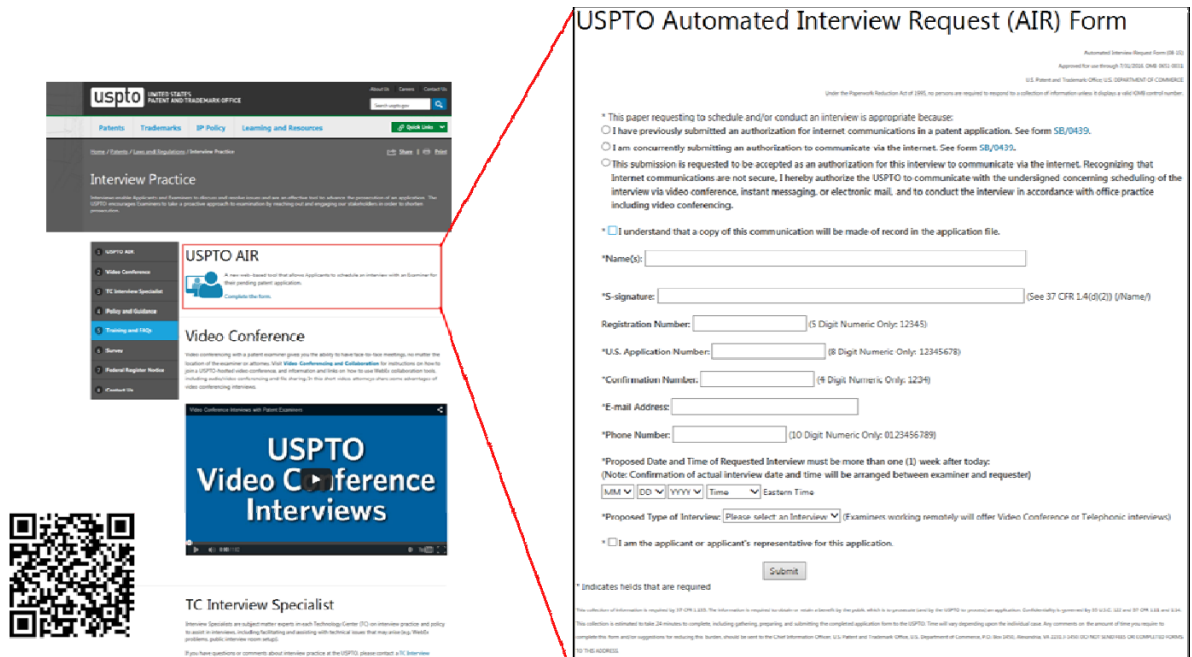
[Complete the form.](#)

Video Conference

Video conferencing with a patent examiner gives you the ability to have face-to-face meetings, no matter the location of the examiner or attorney. Visit [Video Conferencing and Collaboration](#) for instructions on how to join a USPTO-hosted video conference, and information and links on how to use WebEx collaboration tools, including audio/video conferencing and file sharing. In this short video, attorneys share some advantages of video conferencing interviews.

AIR Form

- New web-based tool that permits Applicants to schedule an interview with an examiner



The image shows a screenshot of the USPTO website interface on the left and the actual USPTO Automated Interview Request (AIR) Form on the right. A red line connects the 'USPTO AIR' link in the website sidebar to the form.

USPTO AIR Form Details:

- Title:** USPTO Automated Interview Request (AIR) Form
- Version:** Automated Interview Request Form (SR 03)
- Approved for use through:** 7/15/2024 (OMB 0011-0016)
- U.S. Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE**
- Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.**
- * This paper requesting to schedule and/or conduct an interview is appropriate because:**
 - ☐ I have previously submitted an authorization for Internet communications in a patent application. See form SB/0439.
 - ☐ I am concurrently submitting an authorization to communicate via the Internet. See form SB/0439.
 - ☐ This submission is requested to be accepted as an authorization for this interview to communicate via the Internet. Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned concerning scheduling of the interview via video conference, instant messaging, or electronic mail, and to conduct the interview in accordance with office practice including video conferencing.
- * ☐ I understand that a copy of this communication will be made of record in the application file.**
- *Name(s):**
- *S-signature:** (See 37 CFR 1.41(d)(2) (Name))
- Registration Number:** (5 Digit Numeric Only: 12345)
- *U.S. Application Number:** (8 Digit Numeric Only: 12345678)
- *Confirmation Number:** (9 Digit Numeric Only: 1234)
- *E-mail Address:**
- *Phone Number:** (10 Digit Numeric Only: 0123456789)
- *Proposed Date and Time of Requested Interview must be more than one (1) week after today:**
(Note: Confirmation of actual interview date and time will be arranged between examiner and requester)
/MM/DD/YYYY Time: Eastern Time
- *Proposed Type of Interview:** (Please select an Interview) (Examiner working remotely will offer Video Conference or Telephonic interview)
- * ☐ I am the applicant or applicant's representative for this application.**
- Submit**
- * Indicates fields that are required**
- This collection of information is required by 37 CFR 1.408. The information is required to obtain or maintain a patent by the USPTO to process an application. Confidentiality is governed by 37 CFR 1.401 and 37 CFR 1.402. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 5450, Alexandria, VA 22304-5450 (301-756-6000).

Types of Authorization:

- ☐ I have previously submitted an authorization for internet communications in a patent application. See form [SB/0439](#).
- ☐ I am concurrently submitting an authorization to communicate via the internet. See form [SB/0439](#).
- ☐ This submission is requested to be accepted as an authorization for this interview to communicate via the internet. Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned concerning scheduling of the interview via video conference, instant messaging, or electronic mail, and to conduct the interview in accordance with office practice including video conferencing.

Oral Authorization for Video Conferencing

- **Change to Internet Usage Policy to Permit Oral Authorization for Video Conferencing Tools**
 - The USPTO is updating its policy to make it easier for patent applicants to authorize the use of video conferencing tools to conduct examiner interviews. The policy change to MPEP § 502.03 now allows the applicant or his/her representative(s) to use only Oral request to authorize a WebEx interview, in the same way they would request a telephone or in-person interview with the examiner, instead of submitting a written request. See ["Change to Internet Usage Policy to Permit Oral Authorization for Video Conferencing Toont Examiners" 80 Fed. Reg. 23787.](#)
- The change is intended to make the interview process more efficient but it is important that the details of the authorization be noted on the record. For example, an examiner can state in the interview summary or a separate written communication that "In a telephone communication on 10/10/2015, Attorney John Doe, Reg. No. xx,xxx, authorized the use of USPTO video conferencing tools to conduct the interview."
- This authorization is limited to the video conference interview being arranged and does not extend to other communications regarding the application.

AIR Form Stats

- Since September 2015, the Office has received almost **6,000 interview requests** using the AIR form.
- 92% of those requests were for telephonic interviews.

TC Interview Specialists

- Subject matter expert on interview practice and policy in each Technology Center
- To assist Examiners and Applicants in facilitating effective interviews
- The list of TC Specialists can be found here:
<http://www.uspto.gov/patent/laws-and-regulations/interview-practice/interview-specialist>

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- **FAQs**

Including a proposed amendment when e-mailing a request for interview

Question: While corresponding to set up a phone interview, applicant's attorney sends an e-mail establishing the date and time of the interview. Attached to the e-mail is a proposed amendment that is to be used for discussion purposes during the interview. No written authorization to communicate electronically has been established of record from applicant. **Does the e-mail have to be placed in the file wrapper?**

Including a proposed amendment when e-mailing a request for interview (cont.)

Answer: Yes. If an email contains any information beyond scheduling an interview such as an interview agenda or authorization, it must be placed in the application. Therefore, while the e-mail only contained information regarding setting up an interview time, because it also included an attached “proposed” amendment, the e-mail and the “proposed” amendment must be placed in the application as part of the file wrapper. See MPEP §502.03 II.

Tip: the Examiner should notify you during the interview that the ‘proposals’ or “discussion” amendment will be put into the file.

“Do Not Enter” – Okay to Enter?

Question: As part of an interview, an examiner receives a paper (e.g., proposed amendment) with the words “**Do Not Enter Into Record**” or “**For Discussion Purposes Only**” in big bold letters at the top of the paper. Should the examiner enter the paper into the file wrapper?

“Do Not Enter” – Okay to Enter? (*cont.*)

Answer: Yes. Place the paper into the file wrapper, even if it says “**Do Not Enter Into Record**” or “**For Discussion Purposes Only**”. See MPEP §713.04:

- A complete written statement as to the substance of any in-person, video conference, electronic mail, telephone interview, or electronic message system discussion with regard to the merits of an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview. The requirement may be satisfied by submitting a transcript generated during an electronic mail or message exchange. See [37 CFR 1.133\(b\)](#) and [MPEP §§ 502.03](#) and [713.01](#).
- The complete and proper recordation of the substance of any interview should include at least the following applicable items:
 - (A) a brief description of the nature of any exhibit shown or any demonstration conducted;...
 - (D) identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary form completed by the examiner;
 - (E) the general thrust of the principal arguments of the applicant and the examiner should also be identified, even where the interview is initiated by the examiner. ...
 - (H) in the case of an interview via electronic mail a paper copy of the contents exchanged over the internet **MUST** be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form, PTOL-413, is entered.

“Do Not Enter” – Okay to Enter? (*cont.*)

File wrapper image vs. on the record:

- Scanning in an email or fax with proposed amendments into the file wrapper makes it clear what was discussed in the interview it does not however make those amendments ‘of record’ for examination purposes or mean that applicant does not need to file a response to an outstanding office action.
- Only applicant filing an official response to an outstanding office action via i) EFS web, ii) regular postal mail, iii) USPTO dropbox or iv) central Fax results in something made of record for consideration in the next office action and the purpose of stopping the time period for reply (see MPEP 502) and the aforementioned ‘scanned images’ of an email or personal fax do not meet this.

Internet Authorization

- **Question:** How do I check if my application has proper internet authorization?

Checking for “Internet Authorization”

Select New Case	Application Data	Transaction History	Image File Wrapper	Continuity Data	Foreign Priority	Published Documents	Address & Attorney/Agent	Assignments	Di Refe
This application is officially maintained in electronic form. To View: Click the desired Document Description. To D									
Available Documents									
Mail Room Date	Document Code	Document Description							
11-09-2016	ECOMM.AUTH	Internet Communications Authorized							
11-09-2016	N417	EFS Acknowledgment Receipt							
11-02-2016	A...	Amendment/Req. Reconsideration-Aft							
11-02-2016	CLM	Claims							

Best practice tip to determine if applicant filed Internet Authorization:

- Quickly check the file wrapper to see if applicant submitted an **Internet Authorization form** PTO/SB/439 (doc code **ECOMM.AUTH**).
- If the form is not present in the file wrapper, then call applicant and ask if and when they submitted a proper Internet Authorization form. Check the file wrapper for that date to confirm.

<http://www.uspto.gov/sites/default/files/documents/sb0439.pdf>

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Thank you

Frederick Krass

Art Unit 1612

571-272-0580

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- **Do's and Don'ts**

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- Always be prepared – agenda's preferred.
- Always show up/call.
- Don't simply use the interview to tell the Examiner why their rejection is "wrong".
- Do not use the interview as a "fishing expedition" for allowable subject matter.

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- Enhancements to Interview Practice

Video Conferencing and Collaboration

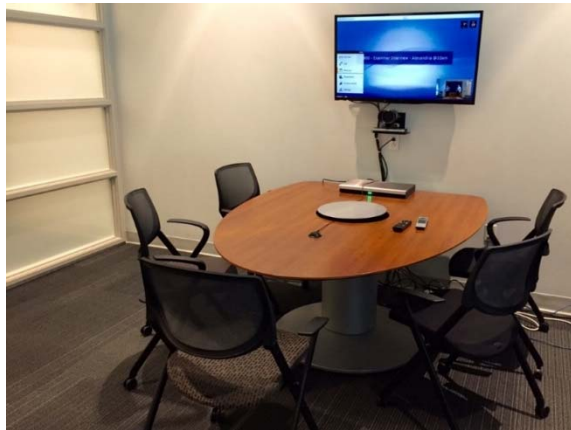
- Internet Usage Policy has been updated to permit oral authorization for video conferencing tools
- MPEP § 502.03 now allows a verbal request to authorize a video conferencing, instead of submitting a written request.
- Examiners set up video conferencing for interview using WebEx, a web-based service that you can use it from any computer (Windows, Mac, Linux, or Solaris) with no software needed.

Public Interview Rooms

- Video conference rooms on each USPTO campus
- Designated for Applicants to use to connect and collaborate with examiners that are working remotely or at a different USPTO campus

Public Interview Rooms, cont.

- Must be reserved by Examiner at least two business days prior to interview.
- Video conference room examples:



Alexandria



Dallas

One-On-One Training

- Applicants interested in more detailed WebEx training may request a one-on-one WebEx training session with an interview specialist.
- Email your request to ExaminerInterviewPractice@USPTO.gov with some possible dates and times.
- Please give at least one week notice.

Interview Practice Website

- **Visit our website to find out more about:**
 - USPTO Air form
 - Video Conferencing
 - TC Interview Specialist
 - Policy and Guidance
 - Training and FAQs

<http://www.uspto.gov/interviewpractice>

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- Always follow chain of command.
- USPTO:



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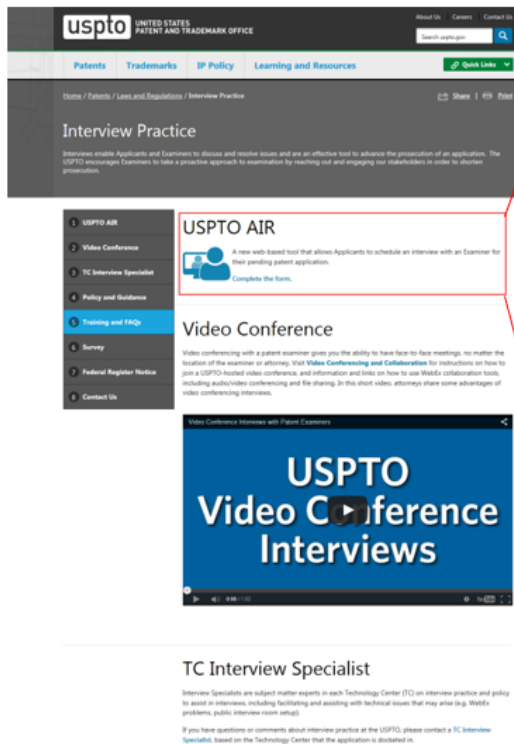
- **Know the Examiner's stage of Career**
 - Office Action gives tips...
 - Empathy is key.
 - Junior Examiner-must have primary or supervising examiner present
 - Partial Signatory Authority-not a primary yet, but can conduct interviews without a primary or supervisory examiner present
 - Full Signatory Authority-primary examiner, can conduct all aspects of interviews without supervision

EYEING THE EXAMINER INTERVIEW: Insider Tips for Successful Patenting of Life Sciences Inventions

- FAQs

Automated Interview Request (AIR) Form

Question: What is the AIR form?



USPTO Automated Interview Request (AIR) Form

Automated Interview Request Form (IR 15)

Approved for use through 7/31/2016. OMB 0651-0031

U.S. Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

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* ☐ I understand

*Name(s):

*S-signature:

Registration No.

*U.S. Application

*Confirmation

*E-mail Address

*Phone Number: (10 Digit Numeric Only: 0123456789)

*Proposed Date and Time of Requested Interview must be more than one (1) week after today:
(Note: Confirmation of actual interview date and time will be arranged between examiner and requester)

MM DD YYYY Time Eastern Time

*Proposed Type of Interview: Please select an Interview (Examiners working remotely will offer Video Conference or Telephonic interviews)

* ☐ I am the applicant or applicant's representative for this application.

Submit

* Indicates fields that are required

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to prosecute (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14.

This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to

complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

Reminder: AIR form is an easy way to get applicant to request an interview and provide "written authorization" for internet communication

USPTO Automated Interview Request (AIR) Form

Automated Interview Request Form (08-15)

Approved for use through 7/31/2016. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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* ☐ I understand that a copy of this communication will be made of record in the application file.

*Name(s):

*S-signature: (See 37 CFR 1.4(d)(2)) (/Name/)

Registration Number: (5 Digit Numeric Only: 12345)

*U.S. Application Number: (8 Digit Numeric Only: 12345678)

*Confirmation Number: (4 Digit Numeric Only: 1234)

*E-mail Address:

*Phone Number: (10 Digit Numeric Only: 0123456789)

*Proposed Date and Time of Requested Interview must be more than one (1) week after today:
(Note: Confirmation of actual interview date and time will be arranged between examiner and requester)

Eastern Time

*Proposed Type of Interview: (Examiners working remotely will offer Video Conference or Telephonic interviews)

* ☐ I am the applicant or applicant's representative for this application.

Submit

* Indicates fields that are required

Types of Interviews:

Please select an Interview

In-person

Telephonic

Video Conference

Public Interview Room

Alexandria

Dallas

Detroit

Denver

Silicon Valley

WebEx Interview Reminders

- Face-to-face interviews should normally be granted.
- Obtain Oral or written authorization from applicant prior to sending Outlook/WebEx meeting invite (see MPEP §§ 502.03 and 713.01, and 80 Fed. Reg. 23787, April 2015).
- Face-to-face video conference through WebEx is a great alternative to in-person interviews and should be offered when an in-person interview is not available.
- Webcam needs to be turned on to allow video conferencing.
- Examiner (and not applicant) must host the WebEx session and send the WebEx invitation link.015).

International Phone Calls

Question: If applicant has an international phone number can an examiner return your phone call?

Making an International Phone Call



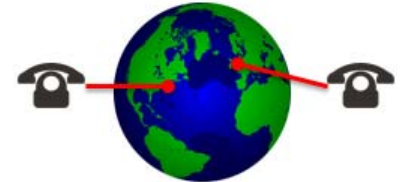
A request for an international telephone call interview should NOT be denied because the examiner does not have international calling rights

- The Examiner informs SPE of application number and reason for call (i.e. telephonic interview) and access will be given to call applicant for limited period of time (i.e. 1 week, in order to schedule and conduct the interview).

International WebEx Interviews

Question: Can someone outside of the U.S. join in on a WebEx interview?

International WebEx Interviews (*cont.*)



- WebEx can be used to host an international WebEx interview without any need for SPE assistance.
- An international applicant should dial-in to join the audio component by using the “**I will Call In**” option.

