



# Interview Practice Within the USPTO



# Topics

United States Patent and Trademark Office

- Effective Interviews
- Reaching Agreement
- Requesting Interviews
- Issues Discussed
- Documenting Interviews



# Effective Interview

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- What makes an interview effective?
  - 3 Keys
    - Preparation
    - Cooperation
    - Communication



# Effective Interview (cont.)

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- Preparation
  - Use an Agenda (preferably PTOL-413A)
  - Review record in advance
  - Consult with SPE or Primary if needed
  - Any suggested claim language?





# Effective Interview (cont.)

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- Cooperation
  - Keep an Open Mind
  - Positive attitude
  - Seek common ground
  - Work on claim language



# Effective Interview (cont.)

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- Communication
  - Active Listening
    - Eye contact
    - Body language
    - Proper tone and volume
  - Stay focused on agenda
  - Seek common understanding



# Effective Interview (cont.)

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- Outcome
  - Issues are resolved, reduced or clarified
  - Better Understanding
    - Applicant's Position
    - Examiner's Position
    - Claim interpretation



# Effective Interview (cont.)

United States Patent and Trademark Office

- Benefits
  - Better Understanding
    - Applicant's Invention
    - Applicant's Position
    - Examiner's Position
    - Claim Interpretation
  - Advances / Promotes Compact Prosecution
    - Doubles the chance of disposal in next Office action

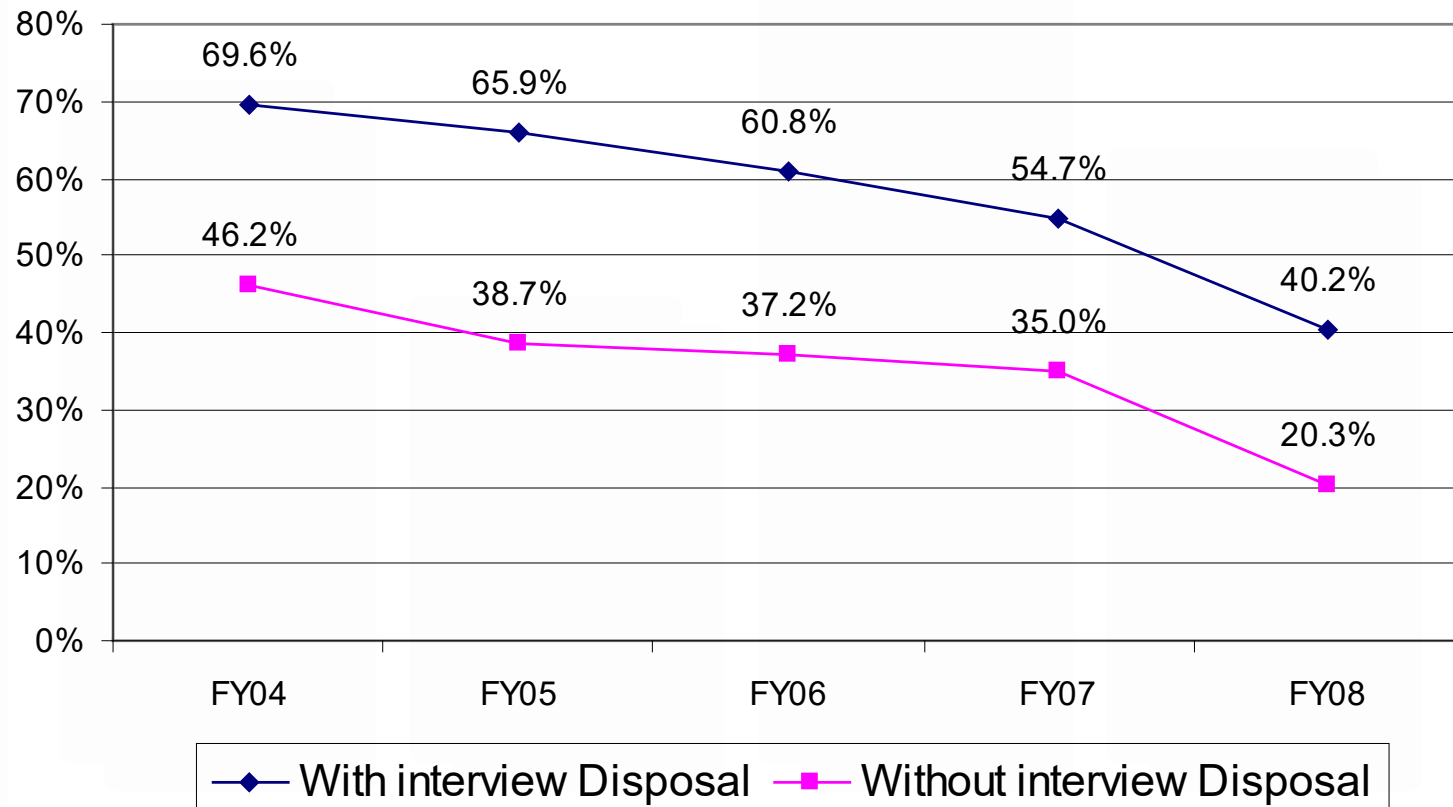




# Increase Allowances

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## Percentage of a Disposal after a Non Final Rejection





# Effective Interview (cont.)

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- Challenges
  - Lack of Agenda
    - “Fishing” expedition
  - Unprepared party
    - Applicant / Representative
    - Examiner
  - Time Concerns
    - Scheduling



# Effective Interview (cont.)

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- Suggested Sequence for an Effective Interview
  - Applicant / Representative explains invention
  - Discuss how inventive concepts are (or are not) set forth in the claim language
  - Discuss prior art and rejections
  - Discuss any proposed language (from either party)
  - Establish common ground
    - Each topic – agree or not



# Reaching Agreement

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- Agreement is reached
  - Allowance (not the only agreement)
  - Reduce # of rejections
  - Resolve other issues / formalities
  - Simply “Agree-to-Disagree” on topics
  - Decide next step
    - Allowance, Abandonment, CIP, RCE...





# Interview Requests

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- Inquire about the purpose/intent
- Request an agenda (PTOL-413A)
- Any proposed amendments
- See MPEP 713 (Interviews)



# Interview Requests (cont.)

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- When can an interview be helpful?
  - Before 1<sup>st</sup> Action ? (see MPEP 713.02)
  - After 1<sup>st</sup> Action ?
  - After Final ? (see MPEP 713.09)
- When can the Examiner deny an interview?
  - After Final (particularly after Appeal Brief filed)
- Before 1<sup>st</sup> Action Interview Program (Pilot)
  - Business Method and Electrical TC areas



# Interview Requests (cont.)

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- Granting Interviews
  - Examiners are instructed:
    - To be Accessible
    - To be Flexible
    - To adjust work schedule (within reason)
    - To use multiple formats (phone / in-person)
    - To find a common time and place that works
- We simply ask that you (Applicant / Representative) do the same



# Typical Interview Topics

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- Overview of the invention
- State of the art
- Claim interpretation
- Prior Art used in rejections
- Language in proposed amendment
- 35 U.S.C. 101
- 35 U.S.C. 112(1), 112(2), 112(6)





# Documenting Interviews

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- Interview Summary (PTOL-413)
  - What to include?
    - Details (enough to clarify the record)
    - Claim limitations discussed
    - Claim interpretation issues
    - Details of proposed amendment
    - Agenda Items
      - Topics resolved (agreed to)
      - Topics unresolved (not agreed to)



# Documenting Interviews (cont.)

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- What makes a discussion an “interview”?
  - Any discussion that touches on the merits of the case (claim language, prior art analysis, clarification of a rejection, etc.)
- Do Not Prosecute “Off the Record”
- Note MPEP 713.04, 502.01 (fax), 502.02 (e-sig), & 502.03 (email)



# Conclusion

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Thank You

Questions/Comments?