

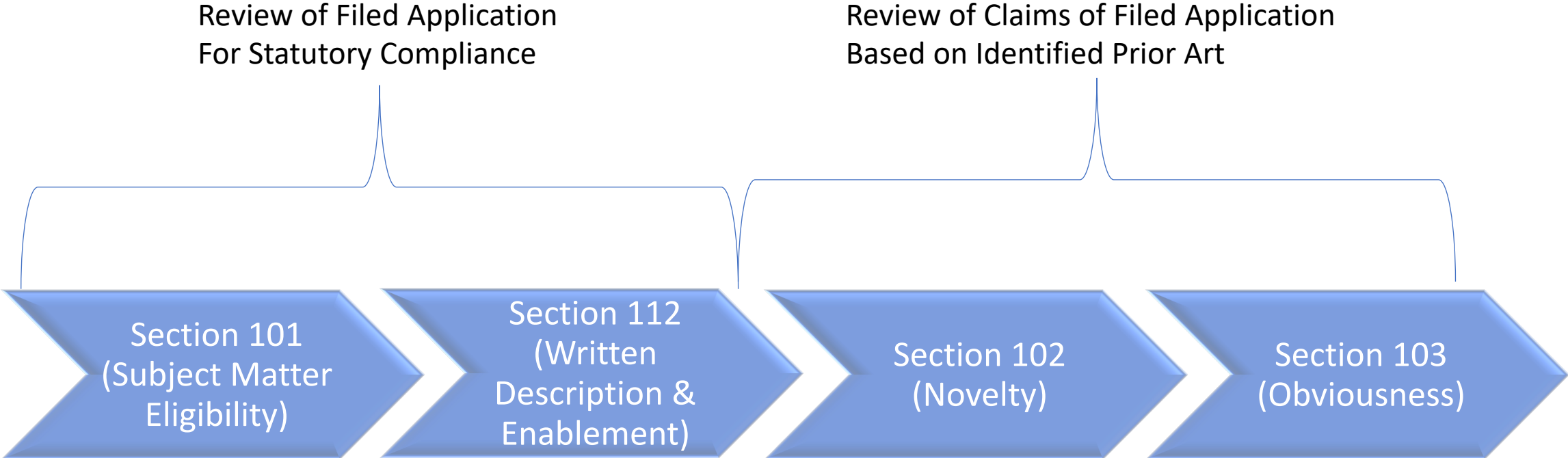
Knobbe Martens Webinar
Series: Strategic
Considerations in Conducting
Examiner Interviews

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Statutory Requirements – Applicability of Patent Office Interviews



Mechanics of Interview

Different Methods of Interviews

- Telephone
 - Convenient and economical
 - Important to provide a concise and persuasive agenda
- Video Conference
 - Often times with hoteling examiners (those working at home office)
- In-person
 - Can bring inventors (caveat: need to fully prepare) and/or demonstrables

Examiner Initiated Interviews

- Examiners can request oral election of embodiments prior to issuing restriction requirement
- Examiners can propose allowable claim amendments
 - Can be very urgent to meet internal deadlines
 - Scope of amendments can vary from formalities (e.g., change “the” to “a”) to substantive change (e.g., combining dep. with indep.)
 - Frequently occur after an applicant initiated interview
- Examiners sometime call and ask applicant’s attorney to:
 - explain the claimed invention
 - review newly found prior art (after an initial interview) and further discuss claim amendments
- Very important to timely respond to the examiner’s proposal or request to avoid a written action

Interview Agenda

- Most Examiners want an interview agenda prior to interview
- Information included (required)
 - Identification of participants
 - Method of participation
 - Identification of all issues to be discussed

Interview Agenda (cont.)

- Information included (not required):
 - Proposed claim amendments
 - Claim amendments should be provided if Examiner agreement is desired
 - Alternative claim amendments are acceptable
 - Proposed new claims as a fallback position
 - Citations to specification for reference– Beneficial for Section 112 or Section 101 discussions
 - Citations to specific portions of cited references
- Interview agendas will become part of the prosecution history.
- Proposed claim amendments are typically not entered by inclusion in interview agenda

Interview Benefits for Applicants

- Information Gathering
 - Provide an opportunity to explain the inventive concept and claiming strategy
 - Seek clarification and understanding of Office Action rejections and objections
 - Interpretation of claim terms – Broadest Reasonable Interpretation (BRI)
 - Understanding and application of MPEP
 - Interpretation of the cited prior art and secondary references
 - Understand position/attitude of Examiner/Supervisor

Interview Benefits for Applicants

- Advancing Prosecution
 - Receive Examiner-identified subject matter that will advance prosecution
 - Advocate for overcoming rejections/objections
 - Confirm agreement by Examiner – limit written response
 - Negotiate breadth of allowable subject matter
 - Select responsive filing (AFCP; Appeal; RCE)

Interview Benefits for Examiners

- An opportunity to explain rejections, discuss prior art, clarify positions, and resolve issues;
- Can lead to a better understanding of Applicant's invention;
- Can bridge the knowledge gap between the Examiner and the Applicant;
- Can lead to better understanding of each other's position;
- An effective method for reaching agreement and advancing prosecution.

Interview: “Effective Examination Tool”

“Interviews can be useful at any stage of the prosecution.”

Quote from PTO FAQs

Interview Timing

- Prior to First Office Action
 - First Action Interview Program - Cancelled
- After receipt of a Non-Final Office Action (matter of right)
- After receipt of a Final Office Action (permissive)
- After filing a response/appeal (permissive)

Interview Strategies

Portfolio Strategy - Examiner Interviews

- Company A
 - Rarely uses examiner interviews
- Company B
 - Only important cases or difficult Office Actions are interviewed
- Company C
 - Interviews are held every step of prosecution
 - Issues are resolved early in prosecution
 - Expectation is that the number of Office Action and overall prosecution costs will be reduced and written record will be sparser

News Update

- USPTO Director Iancu resigned January 19, 2021
 - Urged “eligibility reform”
 - President Biden will likely nominate a new director
- First Action Interview (FAI) Program ended January 15, 2021
 - Allowed for interview before first full office action
 - Had been running for 12 years
 - Only 0.2% participation rate



Strategies for Successful Interviews – Pre-Interview



- Understand the Examiner
 - High allowance rate versus low allowance rate
 - Junior versus senior
 - Technical background and experience

Strategies for Successful Interviews – Pre-Interview

- Understand the scope of claimed invention and target subject matter
 - Understand full claim set and support
- Know the cited prior art
 - Distinction between claimed invention and closest prior art
- If appropriate, prepare secondary arguments/suggestions



Strategies for Successful Interviews – During Interview



- Prioritize important issues
 - Typical interview lasts <30 minutes
 - Examiners get one hour credit to prepare, interview and write summary
- Connect with Examiner
- Listen carefully

Strategies for Successful Interviews – During Interview

- Solicit suggestions/engagement from the Examiner
 - May incorporate into interview agenda
- Avoid excessive argumentation
 - Framework for argument in the agenda
- Understand when to stop interview



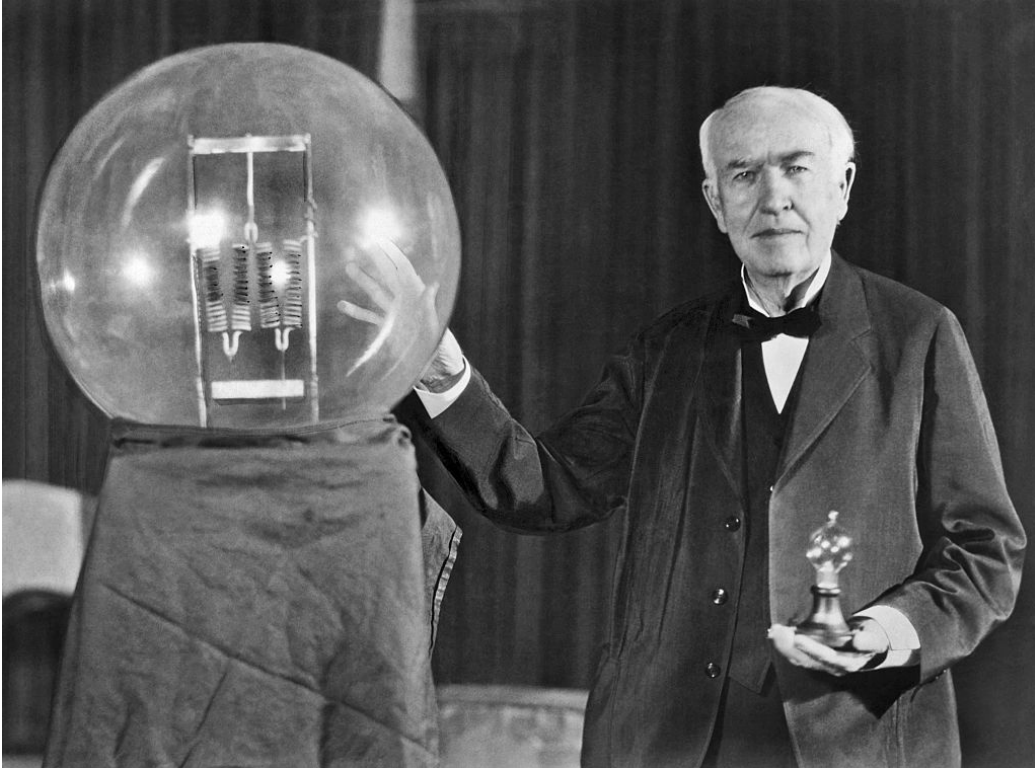
Strategies for Successful Interviews – Post Interview

- Promptly file post-interview response
 - Stays fresh
- Consider supplemental amendment
- Provide support for the amendments (if requested)
- File a separate interview summary, if needed
 - Often filed with Office Action Response

Potential Outcomes of Examiner Interviews

- Highly positive outcomes
 - Allowable outright
 - Allowable pending filing of amendment or Examiner's amendment
 - Overcome current rejection, further consideration/updated prior art search required
- Decent outcomes
 - Further discussion with additional amendments, need a follow-up interview or email exchange
 - Examiner suggests general subject matter to move the prosecution forward
- Less positive outcomes
 - Examiner not persuaded and maintains the current rejection
 - Consider an interview with a supervisor or an appeal (be careful!)

Inventor Participation/Demonstrations in Interviews



- PTO values input from inventors
 - Examiners generally enjoy meeting inventors
 - Examiners often give greater weight to inventor’s position
 - Inventor may be most familiar with invention
 - In-house counsel
- Inventor/Expert Declaration

Educate the Examiners

- Site Experience Education (SEE) Program
 - USPTO funds travel to commercial, industrial, and academic institutions within the United States
 - Exposure to technology
 - On-site training with companies
- Patent Examiner Technical Training Program (PETTP)
 - In person presentations at Alexandria, Detroit, or Denver
- Cannot circumvent normal prosecution



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