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Examiner Interviews and Their Place in Patent Prosecution

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After your patent application has been filed with the United States Patent and Trademark Office, you will most likely receive an Office Action. When this happens, you have now entered what is known as prosecution. Prosecution is the back and forth between the Examiner and your Patent Practitioner in an attempt to obtain a patent on your behalf. As many patent applications are rejected on some grounds, prosecution is where rejections may often, but not always, be overcome. As all business with the United States Patent and Trademark Office must be conducted in writing¹, there are few opportunities for face to face, verbal discussions with the Examiner. One opportunity for this, however, is the Examiner Interview.

An Interview with the Examiner

There are times during the prosecution of a patent application where a discussion with the Examiner may be useful. The personal appearance of an applicant, patent agent or attorney before the Examiner, or a telephone or video conference where matters are presented for the Examiner's consideration, is considered an interview. There are specific rules that govern how an interview is conducted, including how, when and where they are scheduled, and what must be done after the interview. These details are found in the Manual of Patent Examining Procedure (MPEP). An interview cannot, however, be held to discuss the patentability of a pending application before a first Office Action (unless the application is a continuing or a substitute application or eligible for a new pilot program² in the USPTO).

Typically, the patent practitioner should be very familiar with the Office Action that has been received on the patent application, and should be prepared to discuss the Office Action with the Examiner in detail. If the patent attorney, agent or applicant is not so prepared, the interview should not be permitted. In addition, it is desirable for the patent practitioner to submit to the Examiner a proposed amendment or provide in writing what issues he or she desires to discuss during the interview. This permits the Examiner to prepare in advance for the interview. An interview for the purpose of "sounding out" the Examiner is not permitted³.

Scheduling an Interview

An Interview is arranged for in advance by writing or placing a telephone call to the Examiner. Depending on the Examiner, the interview will be scheduled at a mutually agreeable time and date, or some Examiners may ask that a form PTOL-413A ("Applicant Initiated Interview Request Form") be filled out and submitted prior to scheduling the interview.

During the Interview

An interview can be held by telephone, or one can appear at the Examiner's office in the

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United States Patent and Trademark Office in Virginia. Many times the interview is held between the Examiner and the patent practitioner without the applicant present, but the applicant may wish to attend for a variety of reasons. The discussion that takes place during an interview usually relates to claim language and the rejections that have been provided by the Examiner in the Office Action. For this reason, it is routine to hold a telephone interview, especially when it is not convenient for the practitioner or applicant to travel to the USPTO. There are times, however, when a face to face interview is worth the trouble and expense. Oftentimes a demonstration or a working model of the invention can be taken to an on site interview, and may make travel worthwhile. That is, of course, if the invention can be taken through airport security without difficulty. (A practitioner cannot likely explain



an invention to airport security personnel without breaking the oath of confidentiality.)

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After the Interview

Because all business is conducted in writing, individual interview summaries must be prepared by the Examiner and the Patent Practitioner. The Patent Practitioner may include the applicant's interview summary in the Office Action Response if it has not already been submitted. The Examiner must check the applicant's summary for accuracy, and indicate agreement or any differences on the record.

Patent Models—Still useful after all these years

The invention can also be exhibited or demonstrated during the interview by way of a model. This can be very effective in overcoming rejections if done properly. A model can be physically taken to the Patent Office if the interview is to be conducted on site, or it may be shipped to the Examiner for use during a telephone interview if appropriate. Years ago,

the submission of a model of the invention was required. Now, the use of a model is optional, and the model is not permanently retained by the USPTO. Of course, the applicant or practitioner is responsible for getting the model back once the interview is complete.

The Use of Advanced Technology Tools During an Interview

The Patent Office permits the viewing of "video tapes" during an interview if they are relevant to the invention. While we don't work with video tapes these days, we have successfully sent short video clips to the Examiner by way of email or our FTP site. We have also used 3D models of the invention and an appropriate software viewer to assist with an interview. A YouTube™ video was once even used during a telephone interview. These tools all have their place if done properly, and most Examiners are very receptive to models and various technology tools.

The Value of an Interview in Patent Prosecution

So, does an interview help to overcome rejections and get patent applications allowed? The answer is - "it depends." In a perfect world, an interview is a way to present additional information to the Examiner in support of patentability, and it should always help. Unfortunately, when you deal with the human element, things are not always so straightforward. The goal of an interview is to advance prosecution of the patent application. There have been times, however, when an Examiner has refused an interview, is difficult to communicate with (sometimes due to language barriers), or refuses to withdraw a rejection of claims in spite of rock-solid evidence and arguments. These can be very frustrating moments for both the practitioner and the applicant. In general, though, the Examiner interview can be a very valuable tool to help overcome rejections, and should always be considered during prosecution.

1. 37 CFR 1.2

2. See http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/faipp_v2.htm.

3. MPEP 713.03

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