

COMPACT PROSECUTION AND EXAMINER INTERVIEWS

Rick Neifeld and Robert Hahl

NEIFELD IP LAW, PC

ALEXANDRIA, VA, USA

TEL: 1-703-415-0012

URL: <http://www.neifeld.com>

OUTLINE

- WHAT IS COMPACT PROSECUTION IN THE USPTO?
- WHAT IS A PERSONAL INTERVIEW
- WHY PERSONAL INTERVIEWS ARE VERY USEFUL

PAPER

FOR MORE DETAIL, SEE OUR PAPER

**“Personal Interviews With Examiners
at the United States Patent and
Trademark Office (“USPTO”)”**

AT:

<http://www.neifeld.com/Interviews.pdf>

WHAT IS COMPACT PROSECUTION?

- 1 BITE AT THE APPLE
- (1 CHANCE TO AMEND TO OBTAIN ALLOWANCE)
- EFFECT OF FINALITY

WHAT IS THE EFFECT OF A PERSONAL INTERVIEW?

- THE EFFECT OF A PERSONAL INTERVIEW IS LIKE A SECOND BITE AT THE APPLE, *ON STEROIDS*
- IT IS A VERY EFFECTIVE WAY TO OBTAIN MORE INTERACTIONS WITH THE EXAMINER BEFORE CLOSE OF PROSECUTION

WHAT IS A PERSONAL INTERVIEW?

- FACE TO FACE MEETING
- WHERE IT IS HELD
- GOAL – ADDRESS STATED AND UNSTATED CONCERNS OF THE EXAMINER

AUTHORIZATION FOR PERSONAL INTERVIEWS

- PATENT RULES AUTHORIZE PERSONAL INTERVIEWS (37 CFR 1.133)
- NEW PTO DIRECTIVE PROVIDES EXAMINERS CREDIT FOR ALL INTERVIEWS
- EXAMINERS ARE NOW MOTIVATED TO HAVE INTERVIEWS
- PILOT PROGRAM EXISTS FOR INTERVIEWS ***BEFORE*** FIRST ACTION

HOW TO USE A PERSONAL INTERVIEW

- EXPLORE POSSIBLE AMENDMENTS
- EXPLORE POTENTIAL SCIENTIFIC EVIDENCE
- OBTAIN INFORMATION AND INSIGHTS ON ALTERNATIVES
- DO *NOT* JUST ARGUE FOR PATENTABILITY OVER EXISTING REJECTIONS

NOT THE SAME AS A TELEPHONE INTERVIEW

- EXAMINER NEED NOT PREPARE FOR A TELEPHONE INTERVIEW
- EXAMINER IS FULLY PREPARED FOR A PERSONAL INTERVIEW
- TELEPHONE INTERVIEW NOT WITH TRUE DECISION MAKER
- EXAMINER LEVELS: JUNIOR, PRIMARY, SUPERVISORY

NOT THE SAME AS A TELEPHONE INTERVIEW

- PERSONAL INTERVIEW - SUPERVISORY VERY LIKELY TO ATTEND
- TELEPHONE INTERVIEW – SUPERVISORY VERY LIKELY NOT TO ATTEND
- TELEPHONE INTERVIEWS DO NOT ALLOW YOU TO OBSERVE THE EXAMINER DEMEANOR FOR NON VERBAL SIGNALS

PERSONAL INTERVIEW *TACTICS*

- OFFER AN INSIGNIFICANT CLAIM LIMITATION TO ALLOW EXAMINER A REASON TO WITHDRAW AN INAPPROPRIATE REJECTION
- EXPLAIN COMPLICATED INVENTION OR PRIOR ART
- FLOAT IDEAS, EVIDENCE, ARGUMENTS, AMENDMENTS IN FACE OF COMPLICATED FACTS AND LAW

PERSONAL INTERVIEW *TACTICS*

- OBTAIN EXAMINER SUGGESTED ARGUMENTS
- SILENCE, - - PROMPTING EXAMINER SUGGESTIONS
- ALLOW EXAMINER TO HELP WRITE CLAIM AMENDMENT, ENSURING ALLOWANCE

CONCLUSION

PERSONAL INTERVIEWS
CAN BE VERY EFFECTIVE

THE END

THANK YOU FOR YOUR
ATTENTION!

RICK NEIFELD, PH.D., PATENT ATTORNEY

ROBERT HAHL, PH.D., PATENT ATTORNEY

NEIFELD IP LAW, PC

TEL: 1-703-415-0012, EXT. 25