Personal Interviews With Examiners at the United States Patent and Trademark Office ("USPTO")

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In most human interactions, face-to-face negotiation between knowledgeable parties is very helpful. Indeed, sometimes it is the only hope of success.

An interview means an informal communication with the examiner about the merits of a case.[2]

A ***personal*** interview means a face to face meeting with the Examiner at the USPTO during which the applicant and the Examiner are free to converse. A ***personal*** interview is often the best (quickest, most efficient, least expensive, and with the least file history) way to bring a case to allowance. Keep in mind that the task during examination, for any applicant, is to address all of the issues of concern to the Examiner, those stated in the office action as rejections and objections, and those unstated and residing only in the mind of the Examiner which can sometimes only be elicited at a personal interview. Obviously, a patent attorney whose office is near the USPTO is in the best location to conduct a ***personal*** interview.

The rules of practice encourage the examiner to allow an interview after a first office action and before a final office action.[3] Unfortunately, many applicants conduct no interview, and others employ only telephone interviews.

Some applicants use a personal interview (if they use it all) only to argue for the patentability of the existing claims, without exploring possible amendments or scientific evidence that could be submitted to support allowance. Such possibilities, if pursued on paper in the context of a formal amendment, might limit the claims unnecessarily. But in the relatively informal setting of a 30 to 60 minute negotiation with the examiner during a personal interview, the applicant may obtain valuable information and insights about useful alternatives that one could never get from an exchange of papers or even from a telephone conversation!

Other applicants, typically those remote from the USPTO, only conduct telephone interviews. However, telephone interviews are generally less useful than personal interviews. First, an examiner need not prepare for a telephone interview. In contrast, an examiner scheduled to conduct a personal meeting with the applicant is likely to be fully prepared, having reviewed the file. Second, a telephone interview may not result in communication with the true decision maker. This is because the examiner may not be the true decision maker. If the examiner is a junior examiner, the true decision maker is likely either a Primary Examiner or a Supervisory Patent Examiner directing the work of the junior examiner. If so, the supervisor is <u>very likely</u> to attend a personal interview with the examiner and the applicant's representative providing the applicant a chance to communicate directly. However, the supervisor is <u>very unlikely</u> to participate in a telephone interview with the examiner and the applicant's representative. Third, telephone interviews do not allow the applicant to observe the Examiner and obtain non verbal communications, such as issues about which the Examiner appears defensive, or issues that the Examiner appears to consider inconsequential.

Here are some tactics that might be used, that I and other attorneys have used, while conducting personal interviews with the Examiners. Many of these tactics are not otherwise possible.

One might put out an opening offer to limit the claims in some minor way. Such amendments would generally change "the invention" under examination, and thus the issues in the case, without affecting the value of the patent. Sometimes *any* kind of amendment permits the examiner to gracefully withdraw an inappropriate or questionable rejection that they would not otherwise withdraw.

In other cases, an examiner might not understand the invention or the prior art. If so he would be uncomfortable recommending allowance. But a knowledgeable attorney when discussing the technology can often overcome that problem, both educating the examiner and explaining why the claimed invention is therefore patentable.

In situations where there are complicating facts and law, one might use the personal interview to float various ideas, claim amendments, evidence, and arguments, to see which ones the examiner would consider in order to allow the application.

At some personal interviews, the examiner suggests an argument and/or claim amendment, the presence of which results in allowance ("Put *that* argument in your response.")

Occasionally, after a long exchange resulting in no agreement, silence on the part of the attorney results in the examiner offering her own ideas. At such times examiners may even begin writing proposed claim amendments! If that happens, the case is very likely to be allowed, with only formal details remaining to be resolved.

We recall one case in which an application that was on its sixth continuation was transferred to our firm. The case had to do with chemical vapor processing. The former attorneys from a prominent DC law firm had never interviewed the examiner. We sent a letter to our foreign associate asking if there were any special facts or evidence relating to the case, and why they thought it was important enough to file continuations in face of continued rejections. The foreign associate wrote back that the case was co-owned with a government agency, and it was important for that reason to obtain a patent. We conducted an interview with the examiner. At the interview, in addition to discussing the technology, we showed the examiner the letter from the foreign associate. When the examiner read the letter, he stated something like "Oh, so it is a political issue!" The examiner then instructed us to limit the range in the independent claim and made a particular argument. We did that and the Examiner allowed the case. That type of interaction would never have occurred without a personal interview.

In conclusion, personal interview are an effective tool for patent attorneys. A patent attorney who understands the subject matter of the invention, who is located near the USPTO, and who employs personal interviews when appropriate, can effectively prosecute patent applications.

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1. We can be reached via our firm web site: www.Neifeld.com.

2. MPEP section 713 defines "interview", stating:

713 Interviews

The personal appearance of an applicant, attorney, or agent before the examiner or a telephone conversation or video conference or electronic mail between such parties presenting matters for the examiner's consideration is considered an interview.

3. 37 CFR 1.133 expressly provided for interviews. It reads:

1.133 Interviews.

(a)(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

(3) The examiner may require that an interview be scheduled in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135. [Para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(2) revised, 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]