

# COMPACT PROSECUTION AND EXAMINER INTERVIEWS

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# 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!

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