Interview Best Practices

These "best practices" recommendations are intended to assist practitioners and examiners in providing productive interviews in accordance with current Office practices and procedures regarding interviews. Compliance with these recommendations alone should not be considered sufficient in any specific application to ensure compliance with any and all relevant laws, rules or Office policies and therefore should not be relied upon for such purposes. This document is divided into four parts: Accessibility, Preparation, Substance, and Recordation.

I. Accessibility for Interviews

Oral discussions between an applicant and an examiner are often indispensable to advance the prosecution of a patent application. Generally, interviews that improve the mutual understanding of specific issues in an application should be promoted. Both parties should consider the advantages of conducting an examiner interview to advance the prosecution of a patent application. Positions presented during an interview should be advanced with decorum and courtesy.[1] The following recommendations of best practices are provided to promote interview accessibility.

- When requesting an interview, verify the individual assigned to represent the other party. An applicant should check the private Patent Application Information Retrieval (PAIR) system to identify the current examiner of record for a specific patent application. An examiner should check the record to confirm the interview requester has proper authority to act in the case on behalf of the principal or to act in a representative capacity with express authority from the applicant.[2,3]
- Applicants are reminded that examiner availability for interviews may be limited during the weeks leading up to the end of each fiscal quarter (generally the weeks leading up to December 31st, March 31st, June 30th, and September 30th).

---

[1] 37 CFR 1.3; See also MPEP 714.25
[2] 37 CFR 1.32; MPEP 713.05
[3] If requester is acting in a representative capacity without express authorization from the principal, a request for interview may still be granted. See *Conducting an Interview with a Registered Practitioner Acting in a Representative Capacity,* 1357 OG 254, August 24, 2010.; See also 37 CFR 1.34

- Applicants should submit a request for an interview as early as possible, particularly when an in-person interview is being requested, to ensure the examiner of record and/or an examiner with negotiating authority will be available.
- The request for an interview should be given to the other party with sufficient notice, including a proposed agenda, to allow for sufficient preparation. Applicants should use form PTOL-413A and examiners should use form PTOL-413B for this purpose.[4]
- Both the applicant and the examiner should be flexible in attempting to arrange a mutually convenient date and time for an interview.
- In the ordinary course of business, both the applicant and the examiner should strive to reply to voicemail messages within one business day.
- Recorded voicemail greetings and voicemail messages should include helpful information such as the availability and/or unavailability of each party, applicable time zone, and contact information for alternate personnel who can provide assistance.
- Temporary voicemail greetings during extended absence should include date of return and contact information for alternate personnel who can provide assistance.
- An interview should be granted or continued when the nature of the case is such that the interview serves to develop or clarify outstanding issues in an application. Both applicants and examiners should understand that interview time is limited for both parties, and use interview time efficiently. Both parties should ensure the interview does not extend beyond a reasonable time, minimize interruptions during the interview and not abruptly end an interview.[5] Applicants and examiners should facilitate the grouping of interviews where effective.[6]
- Applicants should inform the Office of all related cases (particularly, but not limited to, continuations, continuation-in-part, and divisional applications) and, if

[4] MPEP 713.01 III and 713.04
[5] MPEP 713.01 III
[6] MPEP 713.05

deemed appropriate, the Office should assign related cases to the same examiner to promote grouped interviewing of related applications.

II. Preparation for Interviews

Effective preparation will result in a more productive interview. Accordingly, examiners should receive a detailed agenda along with any proposed amendments, arguments or evidence as far in advance of the interview as possible. The more lead time the examiner has to consider the amendments or arguments before the interview, the greater the likelihood of a successful interview. Attorneys and examiners should maintain an open mind and be prepared to discuss the overarching inventive concept, as well as any relevant details of the specification, claims and the prior art.

- Applicant should provide to the examiner a detailed agenda well in advance of the interview. Applicants should provide a general intent, or goal of the interview and, in the agenda, a brief summary of the arguments to be presented using form PTOL-413A.
- Examiners should be prepared to explain how the applied prior art is being interpreted, how the claims are being interpreted, and how the applied art discloses each limitation of the claims for which the art is being relied upon.
- Applicants should be prepared to explain the "inventive concept" of the invention and any differences between the prior art of record and the claims, as previously presented and/or amended.
- Applicant should be prepared to discuss how the inventive concept is substantively captured in the claims and to explain how the claims are distinguished over the prior art of record. Applicant should avoid being overly meticulous on minor or trivial details in the application.
- Where applicable, applicants should submit a proposed response in advance of the interview to allow examiners sufficient time to prepare and conduct a well organized interview.

- Any proposed response submitted to the examiner should include all proposed amendments to the specification, claims and drawings, if any, along with citations to the specification to support all newly proposed amendments, citations to the portions of any references to be discussed during the interview, additional evidence and, if not already provided in an interview agenda, a brief summary of the arguments to be presented. The submission of a proposed response fully compliant with 37 CFR 1.111 is unnecessary prior to the interview.
- Examiners should review any proposed amendments, arguments and/or evidence prior to conducting an interview.
- Examiners should at least have negotiating authority for the interview and, if the examiner does not have signatory authority, the examiner should include a primary/supervisory examiner in the interview (in person or by telephone) or at least consult a primary/supervisory examiner before conducting the interview.
- If a post interview reversal of any agreement reached occurs, the primary/supervisory examiner should promptly call an applicant to discuss the issue and/or arrange for a follow-up interview.
- An applicant's representative should consult with the applicant prior to the interview to discuss the invention and all relevant current issues and obtain applicant approval and/or negotiating authority to accept at least a range of reasonably foreseeable proposals that may arise during an interview. The applicant's representative should notify the examiner in advance of the interview if they do not have negotiating authority as normally interviews are not granted and conducted unless the party has sufficient authority.[7]
- Before the interview, for efficiency and where appropriate, the examiner should fill out the top portion of the Interview Summary form PTOL-413 or PTOL-413B, including identifying the rejections, claims and prior art documents to be discussed

[7] MPEP 713.05

and optionally the interview participants, date, and type of interview, and bring a copy of this form to the interview.[8]

- Examiners and applicants should identify any new issues with the case not already of record (e.g., in a previously issued Office Action or previously filed amendment) before conducting the interview and communicate them to each other along with any questions that may arise during the interview.
- Both the examiner and applicant should be thoroughly conversant with the specification, claims, relevant prior art, all grounds of rejection, relevant arguments and issues currently of record in the application.
- Both the examiner and the applicant should look for opportunities to resolve as many outstanding issues as possible.
- Applicants should be prepared to identify "real world" applications of the claimed invention to assist in enhancing the examiner's understanding of the claimed invention.

III. Substance of Interviews

Properly conducted, an interview can bridge the gap between an examiner and an applicant with regard to the substantive matters at issue in an application. Interviews help to advance prosecution and identify patentable subject matter in accordance with the Patent statutes. Examiners and applicants should not conduct interviews as adversaries, but rather, should conduct interviews with the objective of meeting the common goals of advancing prosecution and resolving issues. Interview requests should be considered at any stage during prosecution in accordance with current USPTO policy, practice and procedure. Applicants should appreciate that even if agreement is reached regarding patentability during an interview, an examiner will perform a final update and interference search, which can produce prior art that negates the patentability agreement reached in the interview.[9]

[8] MPEP 713.04
[9] MPEP 719.05, 904 and 1302.08

- If an examiner of record participating in the interview is new to the case, at the beginning of the interview, applicant should provide the new examiner an introductory summary/discussion of the invention, referencing the claims, specification and figures, to the extent necessary.[10]
- When proposing claim amendments, both the examiner and the applicant should identify support in the specification for the proposed claim amendments.
- Examiner should evaluate the claims over the prior art and assist the applicant in identifying allowable subject matter. Both the examiner and applicant should cooperatively work toward identifying allowable subject matter, if any. Examiners should suggest allowable subject matter when satisfied that the prior art has been fully developed.[11]
- Both parties should refrain from using an interview to re-present the same positions previously presented and addressed and instead utilize the interview to further advance prosecution of the application.
- Both the examiner and the applicant should be prepared to explain the rationale for any positions taken during the interview. For example, the examiner should be able to articulate why a proposed amendment does not overcome a rejection of record. The applicant should be able to explain why any examiner-suggested claim amendments are unacceptable (e.g., too narrow in light of the prior art of record).
- The following recommendations should be considered to help ensure a mutual understanding of the claims during an interview discussion:
    - Consider addressing claim language, semantics, conjunctions, punctuation, etc.
    - Consider reading a claim out loud to make it clear how the claim is intended to be interpreted.

[10] MPEP 713.01 V
[11] MPEP 707.07(j) III

- Consider diagramming the elements of the claim and their interrelationships to determine claim scope.

IV. Recordation of Interviews

Oral discussions between applicants and examiners must be summarized in a writing on the record to satisfy the USPTO requirement that all business be transacted in writing[12] as all actions of the USPTO are based exclusively on the written record. No agreements, promises, stipulations or understandings will be recognized that are not on the written record in the Office.[13] Interviews are well recognized as advancing prosecution. Often an applicant will provide the examiner with a proposed amendment for substantive discussion. Practitioners have reservations regarding the inclusion of unpersuasive proposed amendments, due to the potential of an adverse impact upon claim scope that might occur due to the presence of an unpersuasive proposed amendment on the record. However, by statute, the USPTO is required to preserve all records received in connection with the transaction of public business.[14] This statutory mandate extends to all documents submitted to the USPTO regardless of the manner of submission, e.g. email,[15] EFS-Web,[16] or facsimile.[17] Therefore, the potential exists that these competing interests may undermine the advancement of prosecution using interviews. Accordingly, the following recommendations are provided to ensure that the benefits of interviews are supported.

- Applicants are reminded that, according to USTPO policy, agendas and proposed amendments submitted by any means to the Office, including facsimile or email communications will be retained as a record by the USPTO.
- According to USPTO policy, all discussions between the applicant/practitioner and the examiner regarding the merits of a pending application will be considered an interview and will be made of record.
- Time should be reserved at the end of a personal or telephonic interview to discuss what should be included in an Interview Summary Form.

---

[12] 37 CFR 1.2
[13] Id.
[14] See 44 U.S.C. § 3301
[15] USPTO *Internet Usage Policy*, 64 FR 33056 (June 21, 1999) (See MPEP 502.03)
[16] *Legal Framework for Electronic Filing System – Web (EFS-Web)*, 74 FR 55200 (October 27, 2009)
[17] MPEP 502.01

- A complete and proper recordation of the substance of an interview, by both applicant and the examiner, should include the items listed in MPEP 713.04 including a brief identification of each argument or issue discussed, indication of any other pertinent matters discussed regarding patentability, the results or outcome of the interview, and an indication as to whether or not agreement was reached on the issues raised.
- Even though an examiner completes a PTOL-413 Interview Summary form, applicant is expected to provide a separate summary of the interview unless the examiner indicates in writing on the PTOL-413 that a written summary of the interview by the applicant is not necessary.
- Examiners are expected to carefully review the applicant's record of the substance of an interview to ensure the record is complete and accurate.[18]

The following list of examples is illustrative of the appropriate expression of the substance of matters discussed in an interview. The list is not intended to be exhaustive.

A. Examples of Suitable Examiner Interview Summary Content (By Examiner or Applicant)

The following examples are suitable interview summary comments to capture the thrust of the issues/arguments raised in an interview:

1. Applicant argued the prior art combination of Smith in view of Jones does not render the claimed invention obvious because the Jones reference teaches away from the combination of the teachings. See Jones at col. 5, lines 10-20.

2. Applicant argued that the examiner's interpretation of the claim term "superabsorbent" was unreasonably broad in light of the definition of "superabsorbent" found on page 5, lines 10-15 of the application specification.

3. Applicant's argument that Smith does not expressly teach the claim limitation of "adding sodium to promote the growth of micro-algae" requires further consideration in light of the Smith teaching of adding Sodium Hydroxide to buffer a microbial medium.

[18] MPEP 713.04

4. Agreement was reached that material incorporated by reference on page 5, lines 10-11 of the application specification is necessary for one skilled in the art to identify the structure that performs the function of monitoring to support the "means for monitoring" limitation of claim 5. Applicant is required to amend the specification to include the corresponding structure in accordance with MPEP 2181 III and clearly link the corresponding structure to the "means for monitoring" limitation in accordance with MPEP 2181 IV.

5. A proposed amendment to claim 1 was discussed. The examiner agreed that the proposed amendments would overcome the enablement and utility rejections under 35 U.S.C. §112, first paragraph and 35 U.S.C. §101 respectively, if the claim language of independent claim 1 was modified as follows: the "including the inserted information" limitation after the claim term 'message' on the last line of the proposed amendment to claim 1 should be deleted and replaced with --the computer-- (See Claim 1 of the attached proposed amendment). Claim 1 was also discussed in connection with the obviousness rejections. The examiner recommended that the claims be further amended to clarify the operation of the claimed collaboration server because, in the examiner's view, the proposed claim language does not sufficiently distinguish the Smith reference's collaboration server teaching. No agreement was reached regarding the obviousness rejections.

B. Examples of Unsuitable Examiner Interview Summary Content (By Examiner or Applicant)

The following examples are unsuitable interview summary comments because they do not capture the thrust of the issues/arguments raised in an interview:

1. Issues of Anticipation/Obviousness were discussed regarding the cited prior art.

2. Issues of claim interpretation were discussed.

3. The issues raised would require further search and/or consideration.

4. Agreement was (or was not) reached because the claims are found patentable (or unpatentable).

5. A proposed amendment to claim 1 was discussed. The examiner explained that the proposed amendments as presented would not overcome the rejections under 35 U.S.C. §112 or 35 U.S.C. §101. The examiner recommended that the applicant reconsider his arguments regarding the Smith reference. No agreement was reached.