

# Interview Practice Training Summary

## *Effective Interview Practice*

### **Interviews are an effective examination tool**

- Interviews are an opportunity to explain rejections, discuss prior art, clarify positions, and resolve issues.
- Interviews can be useful at any stage of the prosecution of an application.
- Interviews can lead to a better understanding of Applicant's invention.
- Interviews can bridge the knowledge gap between the Examiner and the Applicant and lead to better understanding each other's position
- Interviews are an effective method for reaching agreement and advancing prosecution.
- Interviews promote compact prosecution

### **Keys to Effective Interviews**

There are 3 keys to conducting an effective interview:

#### **I. Preparation**

- Ask for an agenda (PTOL 413A) to outline the purpose and intent of the interview.
- Thoroughly review the record including the prior art.
- Focus on the issues identified and look for opportunities to resolve issues.
- Consult with your SPE or Primary Examiner and discuss the relevant issues.

#### **II. Cooperation**

- Have an open mind. Be receptive to different interpretations of claim language and prior art during the interview
- Actively listen and try to understand Applicant's position before drawing a conclusion
- Keep in mind the applicant's position and look for areas of agreement
- Remember the common goal is to advance prosecution. Be willing to resolve issues and cooperate with Applicant to achieve this goal

#### **III. Communication**

- Clearly state the Office's position
- Use appropriate tone and volume of voice
- Watch your body language. Be attentive and make eye contact
- Be polite and respectful.
- Always act in a professional manner.

## **Requests for Interviews**

- Ensure that the interview requestor is authorized to prosecute the application
  - Must be a registered practitioner and Attorney of Record (Note MPEP 713.05)
- Inquire about the purpose or intent of the interview
- Request an agenda (PTOL-413A) to identify specific issues for discussion
  - Allows both parties to better prepare and have a more focused discussion
- Discuss the case with your SPE or Primary Examiner and, depending on level of signatory and negotiation authority, ask them to attend the interview.
- Follow-up promptly with the attorney (and your SPE/Primary Examiner if applicable) to schedule a time for the interview.

## **Possible interview topics**

- Nature of the invention and the state of the art.
  - What problem was solved or what improvement is provided?
- Claim interpretation and scope.
  - For example, preamble, functional language, means-plus-function limitations, intended use language, non-positive claim language, and clarity.
  - What is the meaning of a particular limitation? How is the limitation supported by the specification? What is the broadest reasonable interpretation of the claim?
- Statutory subject matter
- Prior art
- Rejections and objections
- Proposed amendments

## **Suggested Sequence for an Effective Interview**

1. Prior to interview, prepare by reviewing the record and the issues identified in the agenda. Discuss with your SPE or Primary Examiner if applicable
2. At the interview, give the applicant an opportunity to explain the invention and the novel features and discuss the issues outlined in the agenda
3. Openly discuss how inventive concepts are relayed or not relayed in the claims
4. Discuss prior art and rejections.
5. Seek to establish common ground and understanding.
6. Follow up with applicant on any unresolved issues.
7. Document the results of the interview

## Granting a request for an interview

- There is no bad time for an interview. Examiners are encouraged to have an interview at any point during the life of an application in which an interview can help further prosecution, shorten pendency, or provide a benefit to the Examiner.
- Be accessible. Answer your phone during work hours and promptly return voicemail.
- Be flexible in scheduling interviews. Seek a mutually agreed upon time and venue.
- Examiners participating in the Patents Hoteling Program, or on flexible work schedules, need to be available for interviews during regular working hours
- Work schedules may need to be adjusted to accommodate interviews
- Always consider holding telephonic interview if an in person interview cannot be scheduled. Don't deny an in-person interview request without seeking a mutually agreeable time to hold a telephone interview
- Telephonic interviews can be conducted from an alternate work site

## Denying interview requests

- Situations where an interview would not normally be granted:
  - After an appeal brief has been filed in the application;
  - When the requestor is not a registered attorney;
  - When the interview is not prearranged (for example, the attorney or applicant show up at the examiner's office with no prior notice).
- Although an interview request can be denied, examiner's are expected and encouraged to grant these requests and utilize the interviews to resolve or clarify issues to move prosecution forward

## Attorney not of record

- When an interview request is received from an individual not of record in the application, the examiner should determine if the individual is the inventor or a registered practitioner
  - If the inventor has legal representation, notify them that they need to have their attorney schedule the interview.
  - If pro se inventor, the interview should be granted under normal interview procedures.
  - If an unregistered practitioner, deny the interview request. (Note MPEP 713.05).
  - If a registered practitioner, have them supply a power of attorney before the interview.
  - If a power of attorney cannot be supplied, the interview is conducted solely from the practitioner's file - the Examiner's and USPTO's files are closed.

## Documenting an interview

- Use the Examiner's Interview Summary form (PTOL-413)
- An interview summary should include:
  - Attendees, date
  - Prior art, claims and exhibits discussed
  - Details of the discussion that was held
    - Include specifics about the issues discussed, the claim limitations discussed, any proposed claim amendments, and any agreement as to allowability of claims or agreement as to any next steps to be taken in the application
  - Document agreements - reached or not
    - Agreement can be reached for various issues, such as allowability, interpretation of claim language, dates of priority, application of case law, next steps to be taken such as filing of a proposed amendment or withdrawal an outstanding rejection.
  - If proposed amendment is agreed to, attach a copy or otherwise make the record clear as to what specifically was agreed to
  - If electronic communication (e-mail) has been authorized by applicant, attach copies of all e-mail correspondence
  - Do not include comments of a personal nature
- Any discussion with the Applicant that touch on the merits of the invention or application is to be considered an interview and should be documented
- The purpose of the interview summary is to complete and clarify the record
- Do not prosecute "off the record"
- Further guidance can be found in MPEP 713.04 (interviews), 502.01(fax), 502.02 (e-sig), & 502.03 (email)