



## IP: Mr. (Patent Attorney) Smith Goes to Washington - Successful patent examiner interviews

**IN-PERSON INTERVIEWS ARE OFTEN INDISPENSABLE FOR SUCCESSFUL PATENT PROSECUTION.**

Patent examiner interviews are often invaluable for advancing prosecution. This article provides some practice tips for the time spent leading to, during, and immediately following an in-person interview at the U.S. Patent and Trademark Office (USPTO).

At the outset, it is helpful to think of the interview process from the examiner's perspective. It is likely that the examiner and applicant have exchanged written rejections and patentability arguments on numerous issues. Going into an interview, then, the stage has been set for confrontation. The challenge is for applicants to appreciate the examiner's perspective and offer evidence and guidance as to why the examiner's positions are unsound. This challenge is best met by preparing diligently for the interview, building a relationship during the interview, and following up on task items promptly after the interview.

In-person interviews can be very productive following a

first Office Action or with an examiner that is new to the applicant. Likewise, although time might be limited as examiners press to clear items from their docket, applicants may often find motivated examiners during the weeks leading up to the ends of fiscal quarters at the USPTO — December 31, March 31, June 30 and September 30.

### Before the interview

Once the date and time have been set, it is highly recommended that applicants thoroughly consider at least the following questions:

- ◆ Who will attend the interview (on the applicant's behalf as well as personnel from the USPTO)?
- ◆ Will a detailed agenda be sent to the examiner prior to the interview?
- ◆ What are the applicant's primary and back-up positions?

Productive interviews may result from a 30-minute conversation between a single patent agent or registered patent attorney and the prosecuting examiner. Where the technology of the claimed subject matter is complicated, where the pending claims are highly valuable to the applicant, and/or when the applicant and examiner seemingly cannot agree on a particular issue, it is often valuable to bring an expert (*e.g.*, an inventor), and to invite one or more examiners. An expert can be particularly helpful when the claimed subject matter lies within a crowded technology field. The expert should be prepared to discuss, for example, the aspects of the invention that distinguish it from the art, and should avoid legal commentary. Where multiple individuals are present on behalf of the applicant, be certain to decide in advance who will lead the interview. In this author's own experience, pre-defined roles, prepared talking points, and buzz words (*e.g.*, to signal an expert to interject) have proven very

helpful.

Careful consideration should be given when inviting a Supervisory Patent Examiner (SPE) or a Quality Assurance Specialist (QAS) to the interview. Although seemingly helpful, applicants run the risk of unintentionally souring the applicant-examiner relationship by appearing to go over the examiner's head in an attempt to reach an agreement. As discussed below, a good applicant-examiner relationship can be quite helpful and steps should be taken to build and maintain the relationship.

An agenda should be shared with the examiner well in advance of the interview. At a minimum, the agenda should provide the examiner with enough information to prepare thoughtfully for the interview. Applicants should prepare the agenda under the assumption that the examiner will place the agenda in the file wrapper and thus be publicly available.

Lastly, the applicant's primary and back-up positions should be understood by all individuals attending the interview. Knowing in advance how hard to push or how easy to fall back can save a lot of aggravation (and a lot of time and money) and prevent weakening the relationship you are trying to strengthen.

### **During the interview**

Commit yourself to building a

relationship with the examiner! In this author's opinion, too many patent attorneys view prosecution as an adversarial procedure whereby attorneys, dressed in suits and with their Ivy League education, puff their chest and wax poetic to their examiner "opponent." To the contrary, in-person interviews should be two-way conversations. Egos should be checked at the door.

The first portion of the interview should be spent *teaching* the examiner the technology since he/she is (likely) not an expert in the field, has limited time to review the patent application and search results, and because teaching allows the opportunity of planting the seeds of distinction applicants will rely on later. Inventors can be extremely helpful in this regard, if for no other reason than to offer the examiner an opportunity to meet the scientist or engineer and hear how exciting the technology is "straight from the horse's mouth." So, too, can be diagrams, exhibits, slide shows, demonstrations, and the like. This author has used Venn diagrams, for example, when distinguishing claims from cited art and has heard stories from colleagues about how explaining a certain technology related to pore sizes using hand gestures made all of the difference to one examiner. Take advantage of being in the same room, face-to-face, with the examiner and use resources that are not otherwise available during the course of prosecution.

A few Do's and Don'ts: DO understand the technology and be prepared to discuss it in detail; DO come with questions like "what type/amount of evidence is required to place claims in condition for allowance?"; DO introduce the working agenda and state the goals of the interview to set the tone and table, and reserve time for important issues; DO verbally summarize the discussion and request that any agreements reached be included on the interview summary form; and DO prepare a task list and request a follow-up phone call to address any minor, outstanding issues to "keep in touch" on the case. DO NOT waste time by reading the previous arguments and restating previous responses; DO NOT introduce completely new claims and expect the examiner to make a decision on the fly; and DO NOT come to the interview underprepared — prepare to veer from the script.

### **After the interview**

Aside from the formality of the interview summary form, be sure to address items on your task list and follow-up with the examiner in a reasonable amount of time. A follow-up phone call can help keep the case fresh in the examiner's mind, and gives the examiner an opportunity to be on the lookout, for example, for a paper that the applicant has filed. If nothing else, a courtesy phone call thanking the examiner for his/her time is certainly appropriate and yet another step towards building a

good relationship.

In summary, in-person interviews are often indispensable for successful patent prosecution. The challenges of travel and examiners that take advantage of the USPTO's hotelling option notwithstanding, applicants should not underestimate the benefits of face-to-face conversations. While not all situations are ripe for in-person interviews, the opportunity to introduce, explain and/or distinguish difficult technologies should be welcomed, especially in situations where the same examiner is expected to handle continuing applications in a family.

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