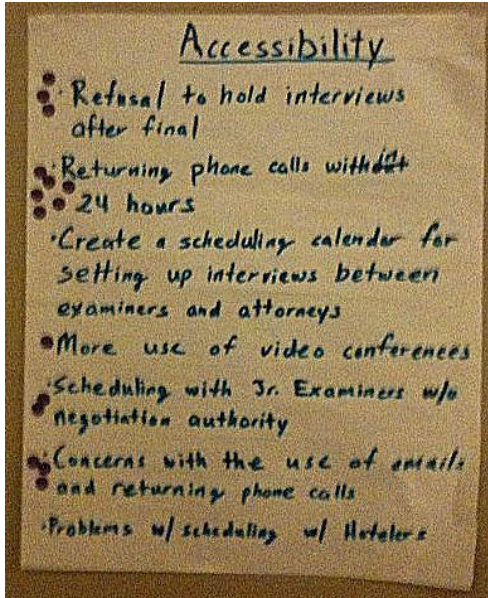


# THE RENEWED FOCUS ON USPTO INTERVIEW PRACTICE

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Concerns regarding accessibility of Examiners, raised at the Focus session of Partnering in Patents XVI

Changed circumstances in the U.S. economy have impacted many sectors of government; the U.S. Patent and Trademark Office (USPTO) is no exception. The USPTO now faces funding issues, in addition to an on-going frustrating back log of cases. Applicants and their counsel have little patience for management directives or guidelines that seek to meet USPTO objectives at the expense of Applicants.

While many of us in the patent bar are excited by the numerous “applicant friendly” promises of the new USPTO director, David Kappos, perhaps the most exciting revelation thus far is the oft quoted an “interview can help the examiner and the applicant get to the heart of the patentability determination quickly and efficiently.”

Interview practice at the USPTO is a “common sense” prosecution strategy. The applicant meets either by phone, or in person with a USPTO examiner to candidly discuss outstanding issues in an application that typically could not be quickly resolved in the usual “paper cycle” of written Office Actions and responses.

While interview practice has obvious benefits to both examiners and Applicants, scarce attention has been given to this practice, as evident by the limited and vaguely written regulations, set forth in MPEP § 713. Therefore, successful interview practice has historically resulted only from a combination of conscientious examiners, and creative practitioners who are able to maximize the limited opportunity an interview affords, in view of the constraints placed on interview practice.

However, practitioners can look forward to exciting changes to the interview practice, in view of recent events at the USPTO. In his “Joint Labor and Management Count System Task Force Proposal” Director Kappos has set forth provisions that encourage examiner-initiated interviews. Also, the USPTO has been holding additional interview practice training for examiners.

Further, on October 14, 2009, at the Partnering in Patents XVI, jointly sponsored by the USPTO and AIPLA, a focus session on interview practice was held. This session allowed practitioners to have an open dialog with USPTO examiners regarding effective strategies for interview practice.

At the focus session, examiners and practitioners were seated together in groups to discuss a variety of issues concerning the effective use of interview practice. The topics of discussion included scheduling interviews, conducting interviews, and after interview procedures. Each group of examiners and practitioners discussed issues of concern, and then presented the issues to the entire body of attendees. While the overall concerns reflected a need by the USPTO to improve management of interviews, including granting more time for examiners to prepare for an interview, several useful practice points were discussed.

Specifically noted were the following: 1) reduce the amount of preparatory work for an examiner before an examiner interview by submitting a clear and informative Interview Agenda in advance of the Interview; 2) if presenting an amendment at the examiner Interview, be sure to have in advance, authority from the applicant to have the proposed amendment entered into the record; 3) prepare focused and detailed explanations of all cited prior art references and application claims to be discussed; 4) understand the time limitations of the examiner and keep the duration of the Interview under one hour.

Overall, the new leadership at the USPTO appears to understand the importance of interview practice. Therefore, if not already a fundamental part of a practitioner’s practice, the present time is a good time to further develop interview practice skills and seriously consider interview practice as an alternative to the lengthy and expensive “paper cycle” of written Office Actions and responses.