

# Welcome



## **Why and How to Master Desktop-Sharing Examiner Interviews** **by Ernest J. Beffel, Jr.**



Intellectual Property Law

# IKEA job interview



CANARY PETE

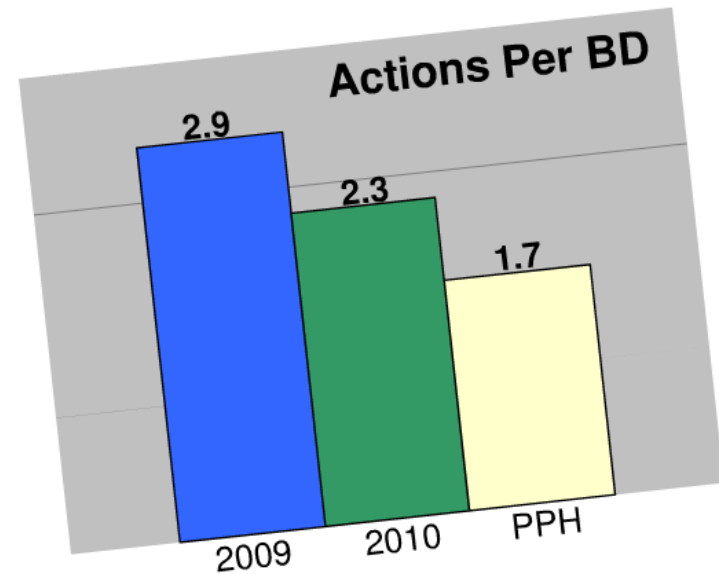
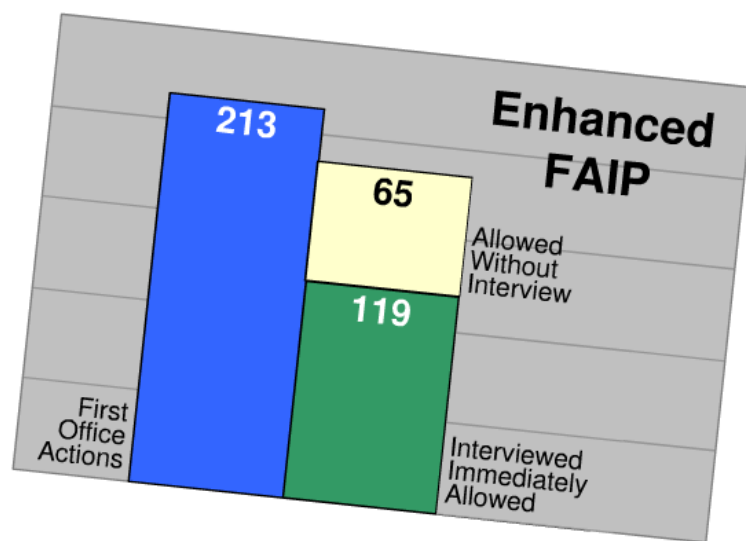
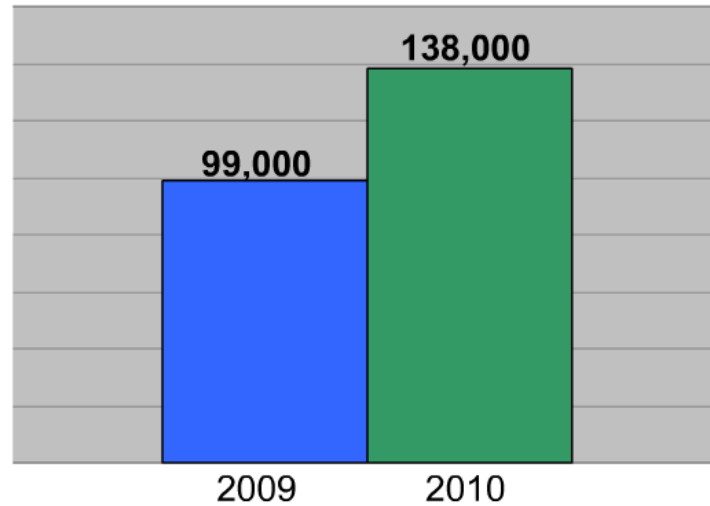


At PTES: John Dill, Pinchas Landier, Beth Rosenc, Jeff Smith, Wynn Cuggins, Jay Korman, Josef Hoenigsmann, Dave Kappas, Nick Goddard, Bill Stoll, Drew Hirschfeld, Dore Wiley, Scott Williams, Joseph Weiss, Jennifer Rankin Byrne, Debrale Forbes.

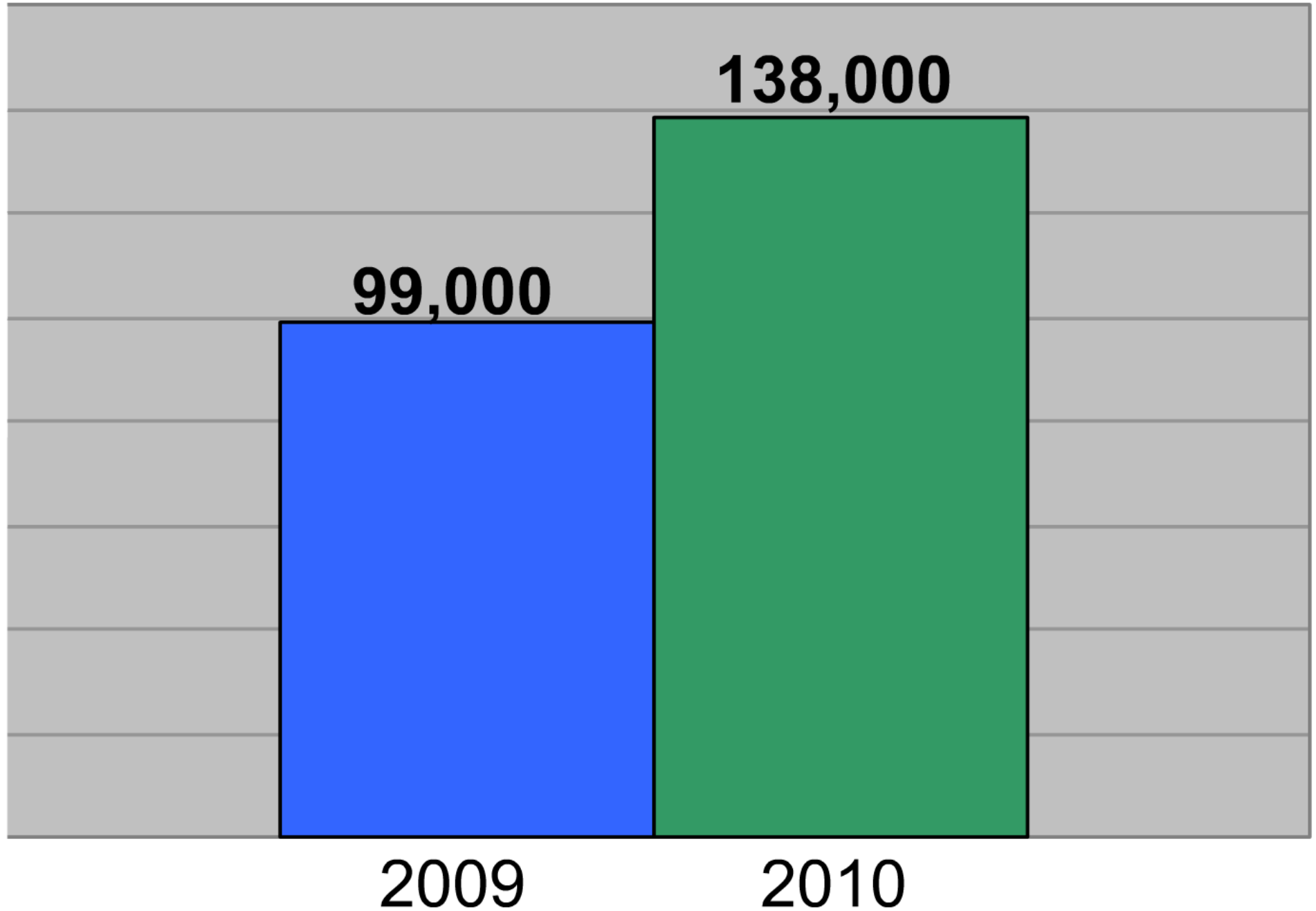
On the Street: Mark Haynes, Fred Zastak, Hans Trotsch, Ben Borison, Rick Neugeger.

# Amazing Stats

Hours in Interviews



# Hours in Interviews



# Enhanced FAIP

213

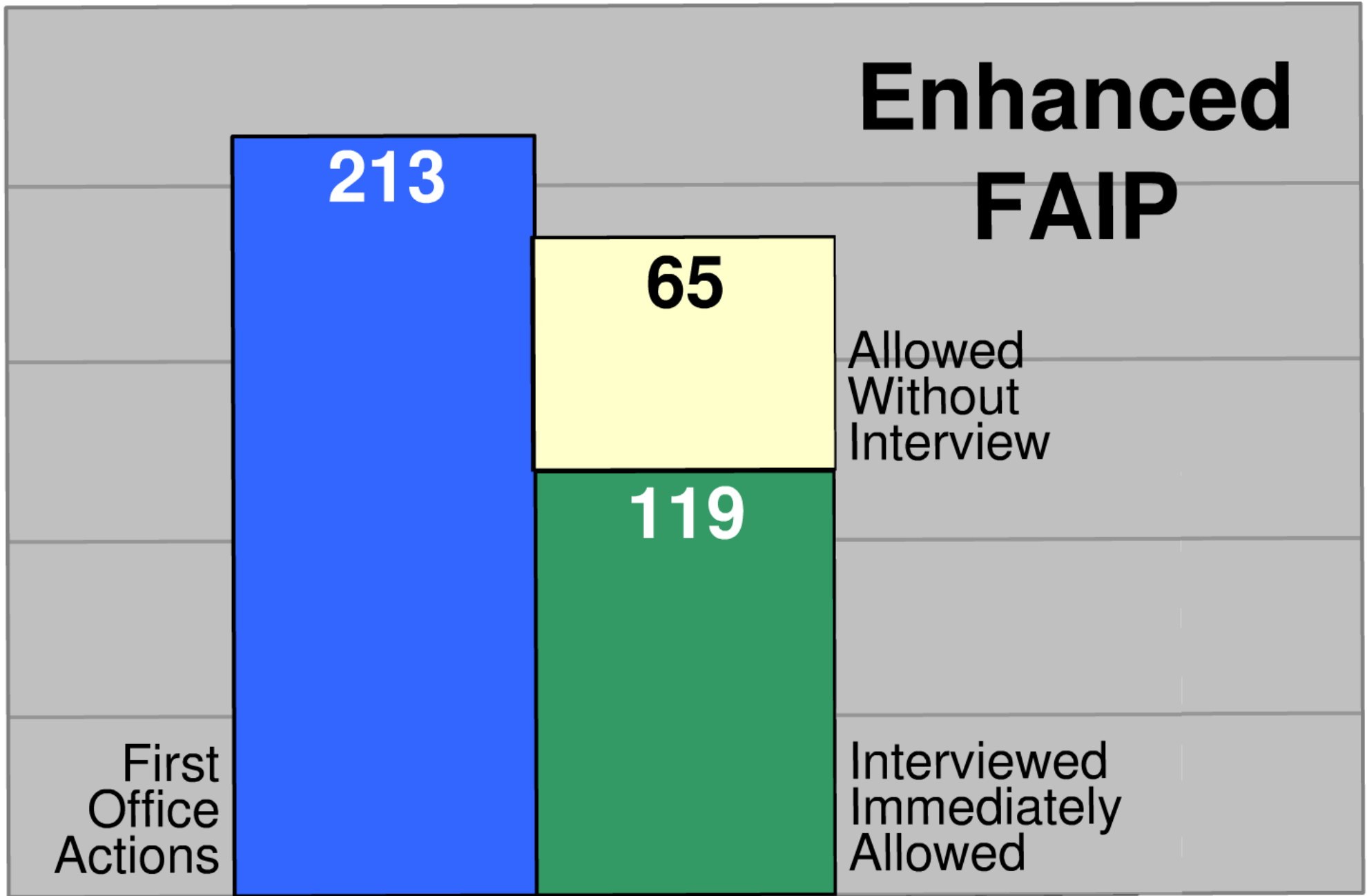
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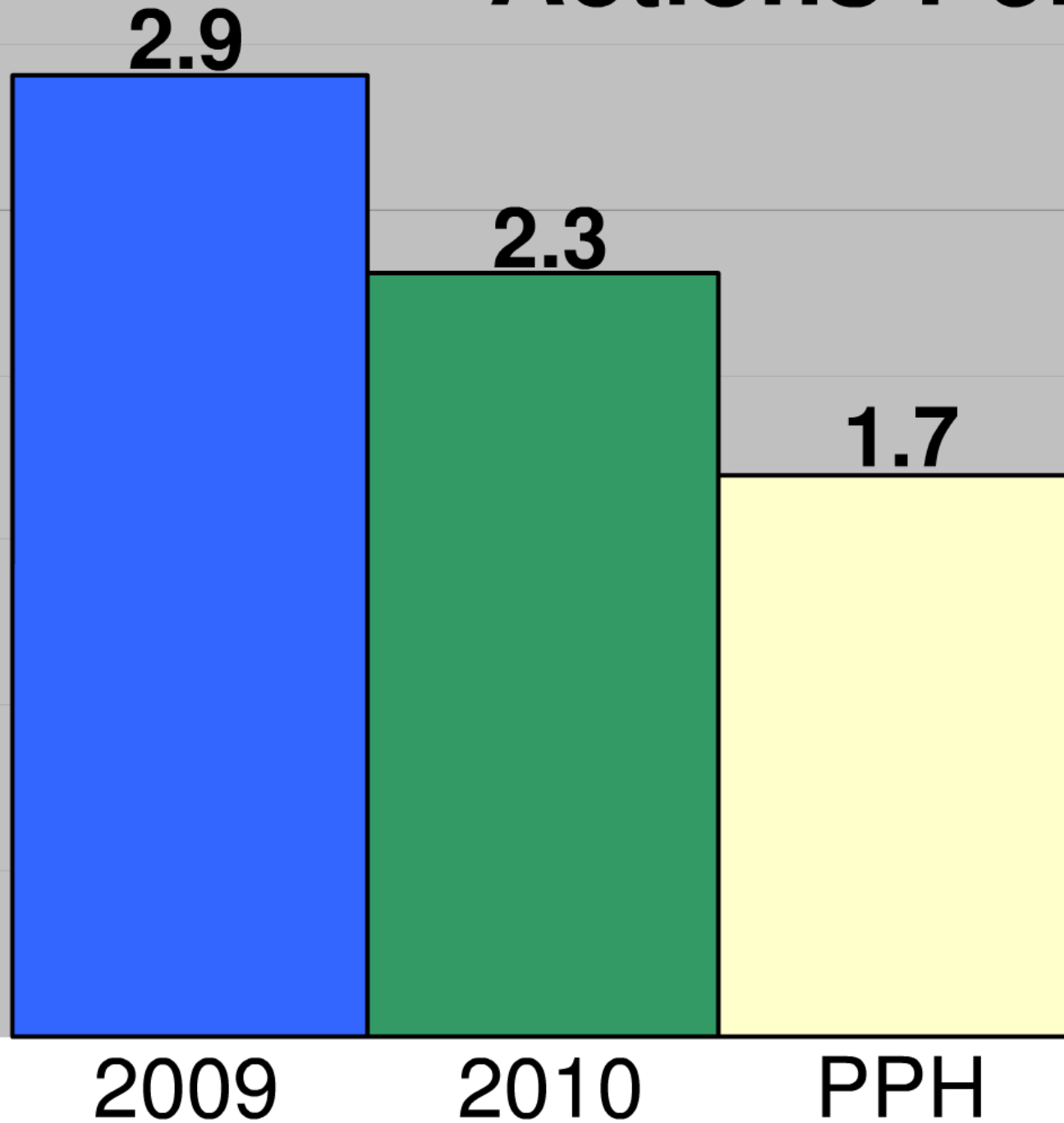
Allowed  
Without  
Interview

Interviewed  
Immediately  
Allowed

First  
Office  
Actions



# Actions Per BD





MPEP

713.02 Interviews Prior to First Official Action (B-4)

Prior to filing an interview a potential interviewee, at the discretion of the Director, is limited to one interview. The interview is intended to provide the Director with information regarding the interviewee's qualifications, experience, and other relevant information. The interview is not a substitute for the interviewee's application. The interview is not a guarantee of employment. The interview is not a commitment to hire. The interview is not a promise of a job. The interview is not a contract. The interview is not a binding agreement. The interview is not a final decision. The interview is not a final offer. The interview is not a final acceptance. The interview is not a final rejection. The interview is not a final decision. The interview is not a final offer. The interview is not a final acceptance. The interview is not a final rejection.

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2005

2006

2007

2008

2009

2010

2011

Accelerated Examination


First Action Interview Programs

Track I

Training: Interviews & Compact Prosecution



U.S. PATENT AND TRADEMARK OFFICE

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MPEP

713.02 Interviews Prior to First Official Action [R-1]

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713.02 Interviews Prior to First Official Action [R-5]

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713.02 Interviews Prior to First Official Action [R-6]

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2005

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Accelerated Examination  
First

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**When you talk about interview training, what exactly does that mean?**

I have heard a lot of criticism from our stakeholders that many examiners are reluctant to grant interviews, and that when they do grant them there is a reluctance on the part of examiners to make any commitments during the interview. The interview training will emphasize to examiners several key practices: interviews held **earlier in prosecution** are a benefit to better focus on issues early in the examination process. Interviews lead to **early indication of allowable subject matter**, interview usage later in prosecution may **reduce unnecessary RCEs**.

May 12, 2009 - Acting Commissioner Focarino



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#### 11. Patent initiatives

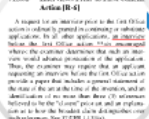
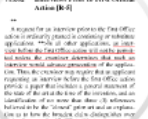
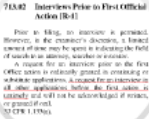
Our new leadership team at the USPTO has undertaken a broad array of efficiency initiatives to improve the speed and quality of patent processing. These initiatives include a "first in a generation" reform of the patent examiner court system. We expect this new system to create an environment where ~~examiners~~ examiners efficiently review applications and ~~work with practitioners~~ work with practitioners to come to correct decisions more quickly. Our ~~first action interview~~ first action interview pilot has led to an increased percent of ~~first action allowances~~ first action allowances. Also, we are pleased to see a sustained decrease in ~~actions per disposal~~ actions per disposal which is an indication that issues are being resolved more efficiently. While the average number has ranged from 2.8 to more than 2.9 in the past few years, we are now seeing a sustained level of approximately 2.3 in FY 2010. Importantly, these accomplishments have been made ~~without~~ without ~~any sacrifice in quality~~ any sacrifice in quality.

May 5, 2010 - Director Kappos testimony to Congress

### III. Patent Initiatives

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# 2011

## Track 1

## First Action Interview Programs

## Training: Interviews & Compact Prosecution

# 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

# Interview Practice Training Summary

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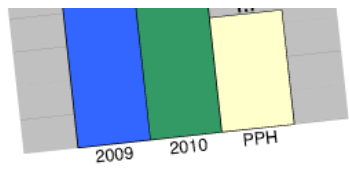
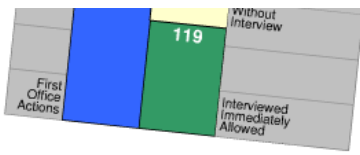
# Best Practices in Compact Prosecution



- “Applicants and **EXAMINERS** should request interviews to advance prosecution

A telephone interview coupled with an **Examiner’s Amendment** is a **preferred practice** for placing the application in condition for allowance.” (slide 5)

- Ex parte Quayle: “The examiner should **always** attempt to advance prosecution and **resolve remaining issues through a telephone interview.**” (slide 6)
- “In Instances where the **examiner** is aware of a **particular amendment** that would clearly resolve an issue, **SUGGEST IT!** (Examiners without appropriate signatory authority should always verify the suggestion with whomever is signing the Office action).” (slide 12)



# Get Ready

## Time Pressure



Broadest Reasonable Interpretation

## Lesson Plan

102/103

- Not close
- One element missing
- Elements recombined
- Claim misinterpreted
- Cannot tell how examiner is applying the ref
- Reference as a whole
- Selling a narrow distinction

103

- How combined?
- Combination defies common sense-hindsight
- Motivation leads to a different combination
- Destroying or changing principle of operation for primary reference
- Objective indicia

Know Your Audience



## Invite the Examiner



# Go Sharing

## Arrange Your Docs

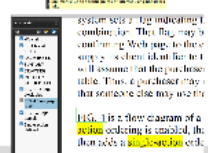
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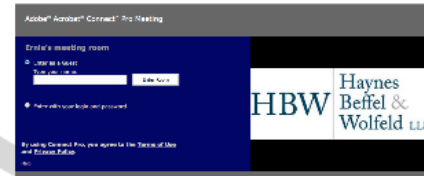
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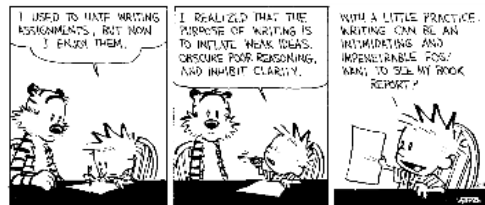


### Load Docs



# Get Ready

## Time Pressure



## Broadest Reasonable Interpretation

## Lesson Plan

102/103

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- One element missing
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- Reference as a whole
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103

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- Combination defies common sense-hindsight
- Motivation leads to a different combination
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- Objective indicia

## Know Your Audience



## Invite the Examiner

Dear Examiner Trestle:

Please join me in a Connect Pro Meeting for our interview on Thursday, May 12, 2011.

Meeting Name: Ear Smith  
Summary: App No. 120589.839 (Atty Docket EJB 0001)  
Invited By: Ernest Soffel (eroffel@hbm.com)  
When: 07/14/2011 2:00 PM Eastern

To join the meeting:  
[http://tiny.cc/afpafat.com/for-smith-jones/](http://tiny.cc/afpafat.com/for-smith-jones)

Use of Adobe Connect on a pilot basis during examiner approved by the CIO, per SPE Dave Wiley. Director Kai Soffel have expressed their enthusiasm for using the tool.

SPE Jay Kramer and I prepared the attached introductory Connect, which you may find useful. We suggest that you take about five minutes before the interview begins.

My display is in landscape mode. If you'd prefer portrait, know before I start the meeting or at the beginning of it, are in sync.

Regards,

[Adobe Connect Desktop Sharing Session to Enhance Telephone Interviews](#)

Ernie will send you a link to his meeting. The typical meeting room is at:

<http://tiny.cc/afpafat.com/for-smith-jones/>

When you connect to the meeting room, you'll be logging in as a guest. This is what the first screen looks like:

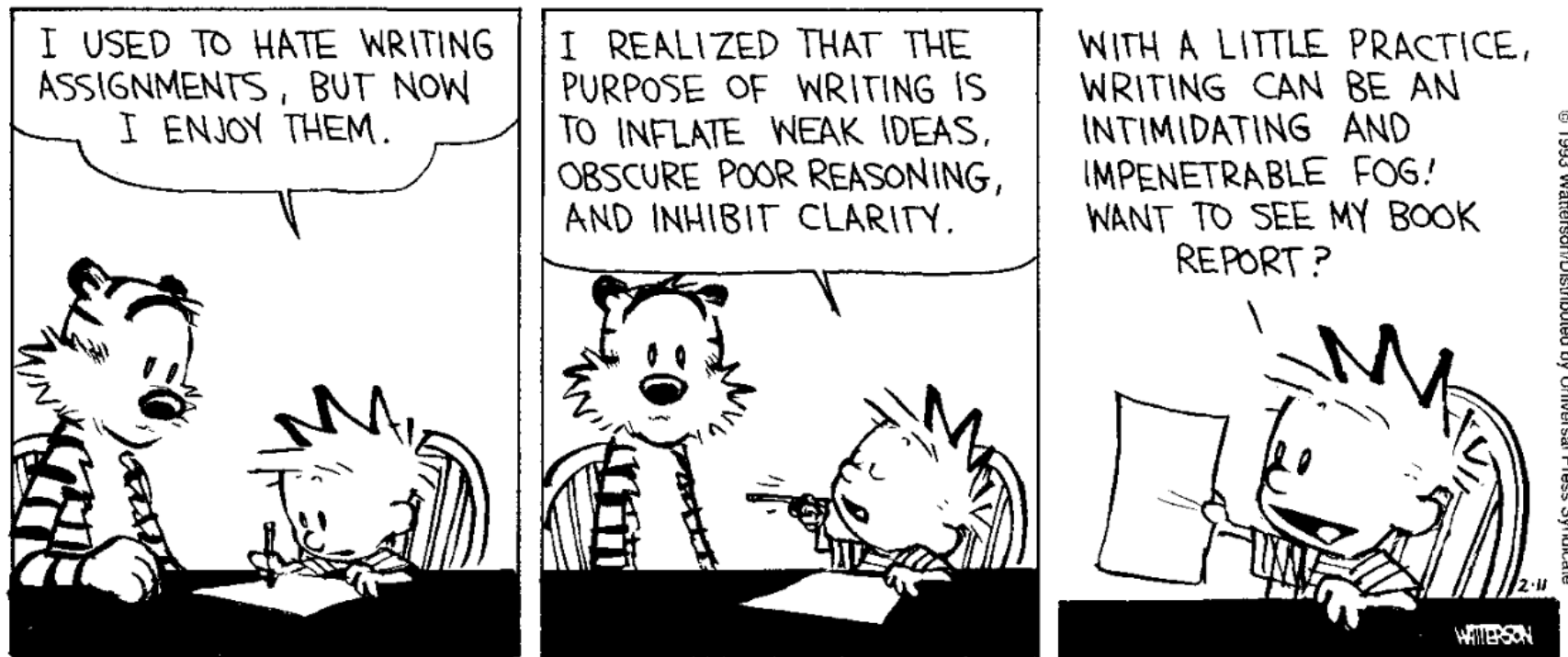


Put in your name. Ernie will accept you as a moderator and you'll be looking at what's on his desk.

To keep the matter simple, plan to use the desktop. Ernie's phone number is (505) 712-0545. He'll probably call you, after starting the meeting. The meeting room is typically open five minutes before the scheduled interview.

A useful tip at the onset is to make sure both the host and you have monitors turned to the same orientation, either portrait or landscape. A mismatch may cause viewing size issues. Ernie's default is landscape, but he is happy to use portrait, if you prefer.

# Time Pressure



Broadest Reasonable  
Interpretation

# Lesson Plan

## I02/I03

- Not close
- One element missing
- Elements recombined
- Claim misinterpreted
- Cannot tell how examiner is applying the ref
- Reference as a whole
- Selling a narrow distinction

## I03

- How combined?
- Combination defies common sense-hindsight
- Motivation leads to a different combination
- Destroying or changing principle of operation for primary reference
- Objective indicia

# Know Your Audience



# Invite the Examiner

Dear Examiner Troesh:

Please join me in a Connect Pro Meeting for our interview on Thursday, May 12, 2011.

Meeting Name: Exr Smith

Summary: App No 12/999,999 (Atty Docket EJB 0001)

Invited By: Ernest Beffel (ebeffel@hmbay.com)

When: 07/14/2010 2:00 PM Eastern

To join the meeting:

<http://hmbay.acrobat.com/exr-smith-jones/>

Use of Adobe Connect on a pilot basis during examiner approved by the CIO, per SPE Dave Wiley. Director Ka Stoll have expressed their enthusiasm for using this too interviews.

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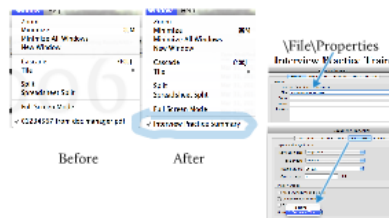
To keep the audio simple, plan to use the telephone. Ernie's phone number is 650-712-0340. He'll probably call you, after starting the meeting. The meeting room is typically open five minutes before the scheduled interview.

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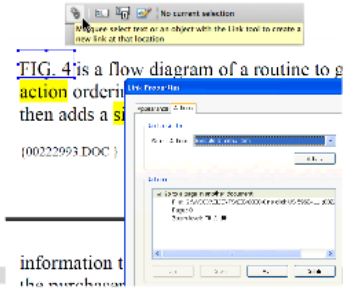
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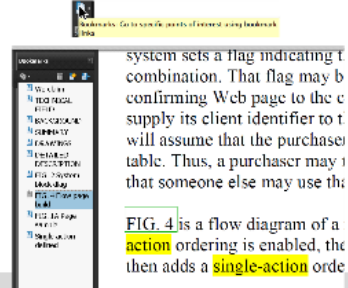
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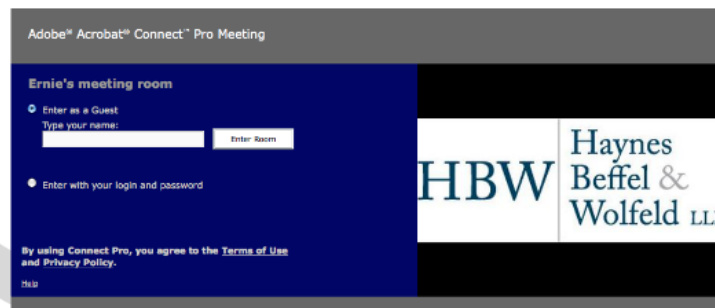
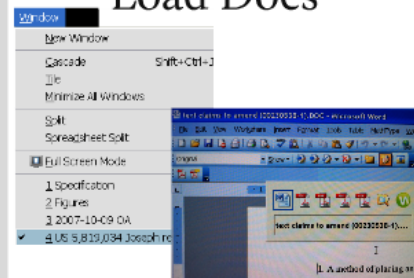
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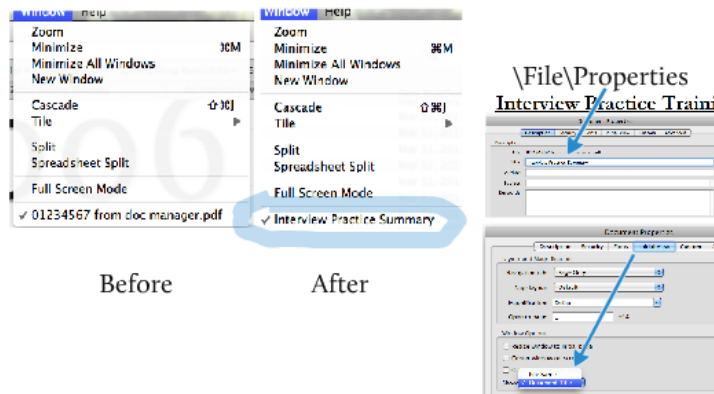


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# Arrange Your Docs

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Before

After

## Cross-Links

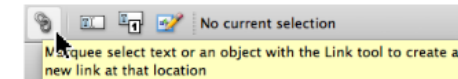
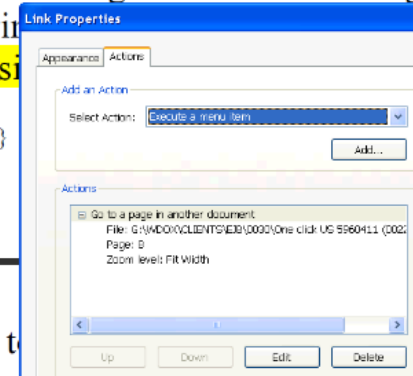


FIG. 4 is a flow diagram of a routine to go to a page in another document. The routine then adds a single-action order.

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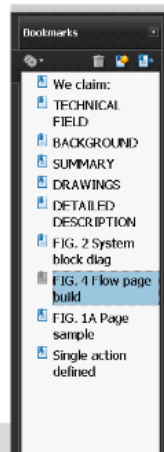
information to the purchaser



## Bookmarks



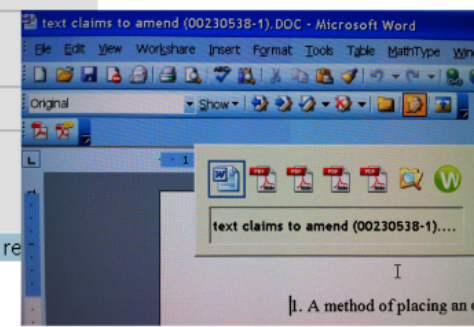
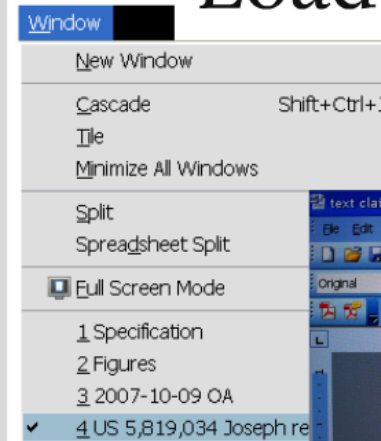
Bookmarks: Go to specific points of interest using bookmark links



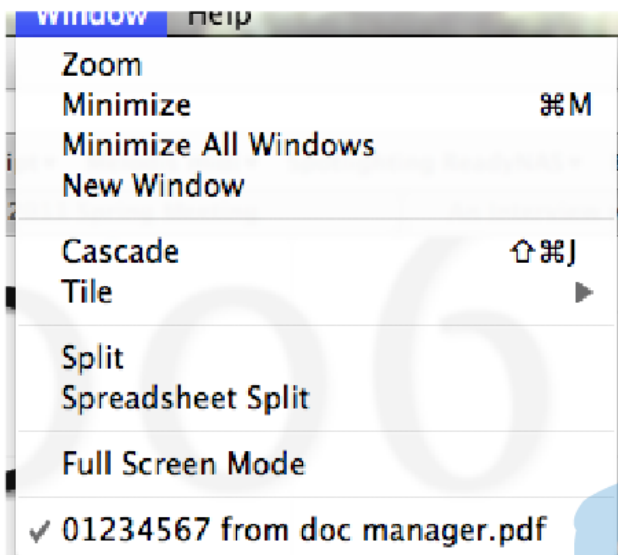
system sets a flag indicating a combination. That flag may be confirming Web page to the system supply its client identifier to the system will assume that the purchaser is a table. Thus, a purchaser may use that someone else may use the

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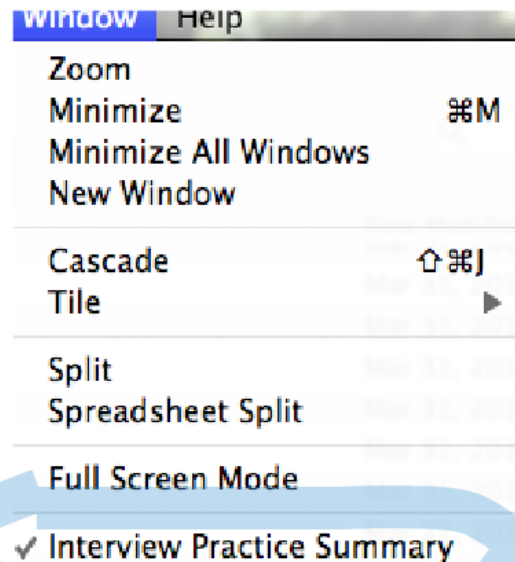
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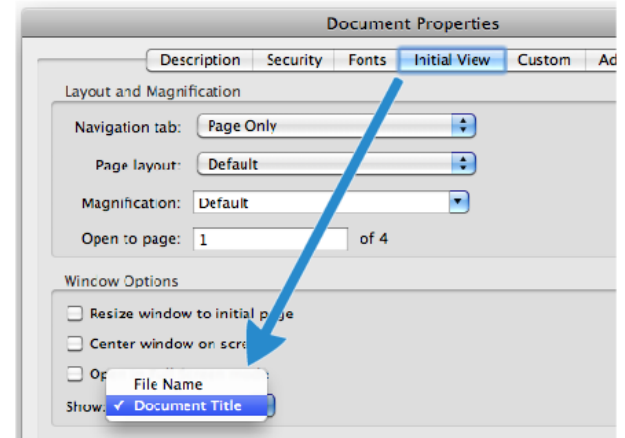
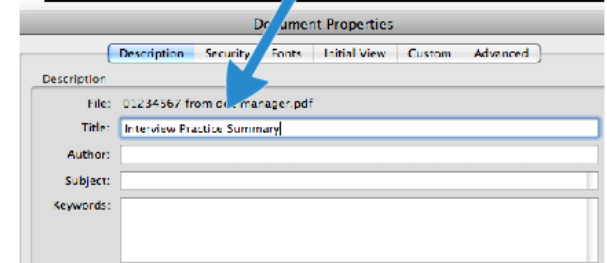


Before

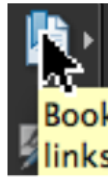


After

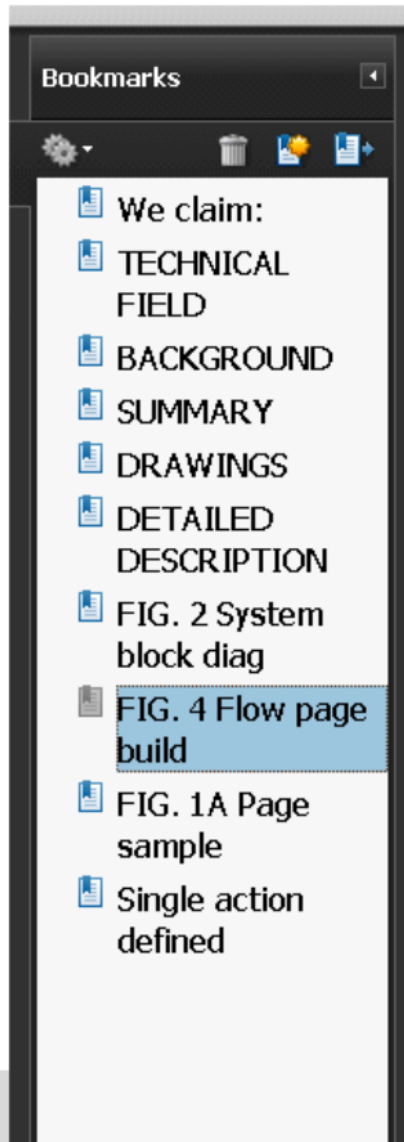
\File\Properties  
Interview Practice Traini



# Bookmarks



Bookmarks: Go to specific points of interest using bookmark links



system sets a flag indicating the combination. That flag may be confirming Web page to the client supply its client identifier to the system will assume that the purchaser is a table. Thus, a purchaser may indicate that someone else may use the

FIG. 4 is a flow diagram of an action ordering is enabled, the then adds a single-action order

# Cross-Links

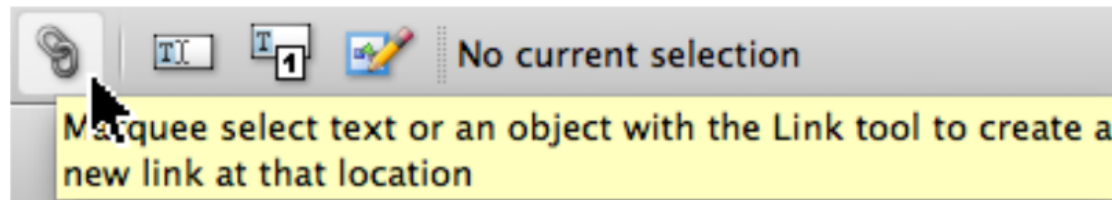
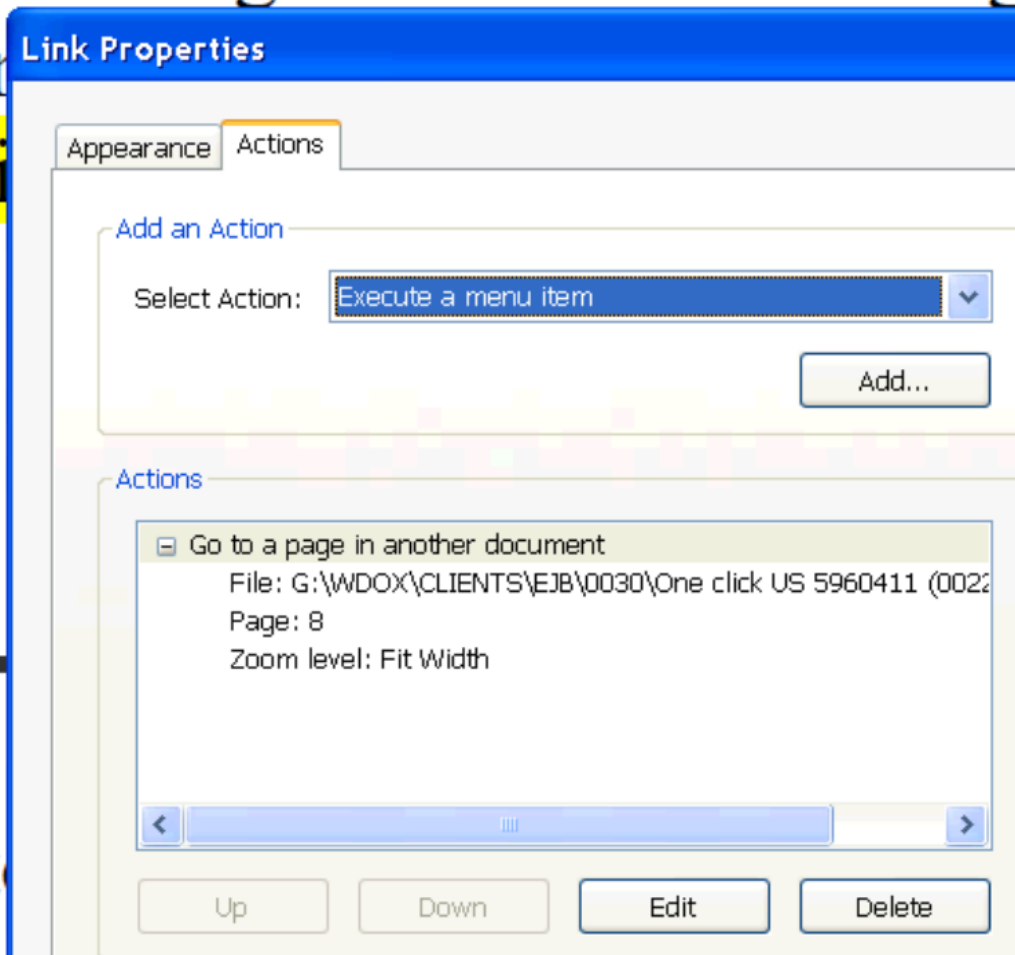


FIG. 4 is a flow diagram of a routine to generate action ordering then adds a snippet {00222993.DOC }

information to  
the purchased



# Load Docs

Window

New Window

Cascade

Shift+Ctrl+J

Tile

Minimize All Windows

Split

Spreadsheet Split



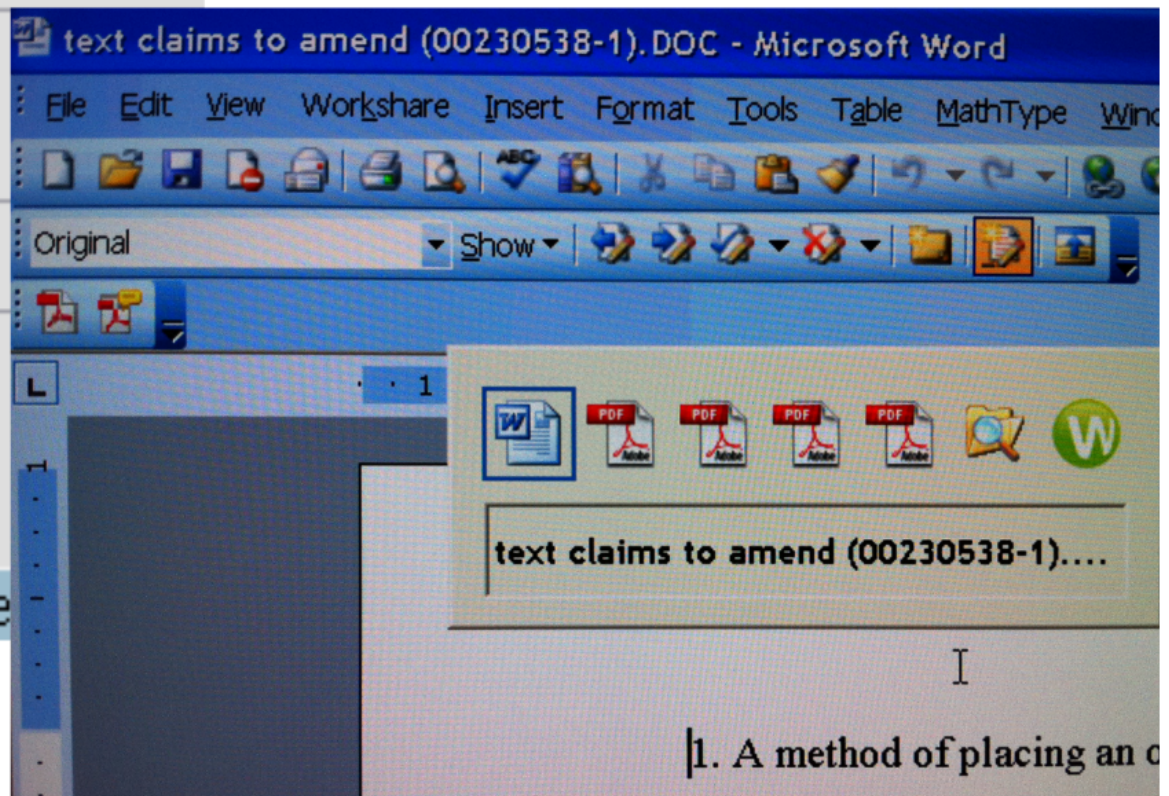
Full Screen Mode

1 Specification

2 Figures

3 2007-10-09 OA

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then adds a **single-action** orde

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