

TALK WITH THE EXAMINER

Have you considered an Examiner interview? Often talking with the examiner can resolve outstanding issues -- and may even result in obtaining an allowance.

In-person examiner interviews are held only at the PTO facilities in Alexandria, Virginia. If the examiner is a junior examiner, it will be necessary for a "primary" examiner to be present at the interview. Alexandria is reachable by air or rail (Amtrak). There are many affordable hotels within an easy drive to the PTO.

If a personal interview is not practicable, the next best thing is to have a teleconference with the examiner. Although not quite as good as being there in person, a telephone interview will still usually prove helpful. However, ensure that you are not interrupted or distracted during the interview. Also, if you talk with the examiner using a cell phone, make sure that you have a good connection.

When to schedule the interview? Usually, the best point to have an examiner interview will be after the first Office Action (before replying to it). The PTO will generally not grant an interview request before the first Office Action except in the case of a continuing application. And, if the application has been finally rejected, whether to grant the interview is at the discretion of the examiner. Although most examiners will grant after-final interviews, the examiner will often want the applicant to state a specific reason for having the interview.

Talking with the person who decides whether to allow your patent application can be one of the most important things that you do. However, it is important to note that the interview cannot be used for "sounding out" the examiner. Instead, the interview must be used to clarify issues and to advance prosecution.

If you intend to amend the claims, it will be a good idea to fax the Examiner a marked-up set of "Proposed Amended Claims" prior to the interview. (It is very important to write that these proposed claims

are not to be officially entered). Also, if you wish to discuss the references cited by the Examiner, make sure that you highlight particular portions of the references that you will be talking about during the interview.

To schedule an interview, have your attorney call the examiner to arrange a suitable date and time. The PTO now requires using form PTOL-413A (available on the USPTO Web site) to arrange the interview. Inventors represented by patent practitioners are usually allowed to be present and participate at examiner interviews. However, you may just want your attorney do it alone.

At the conclusion, the substance of the interview must be made in writing. This writing will then be made of record (included in the application file wrapper and subject to inspection after the application has issued). For personal interviews, generally the Examiner will complete a written summary on form PTOL-413B. However, note that if the interview was requested by the applicant (the usual case) it will be applicant's ultimate responsibility to make sure that a written summary has been completed. The written summary will generally include the names of the persons at the interview, the date the interview was held, whether agreement was reached, and a brief summary about which claims were discussed and the substance of the interview.

George D. Morgan, Esq. is a registered patent attorney and former patent examiner. For more information, visit www.PatentAZ.com or send email to info@patentaz.