

The Importance of Examiner Interviews by Gregory Lunt

Most patent applications are initially rejected by the Patent Office. With that rejection comes the opportunity to interface with the application's assigned patent examiner. While this interfacing can be done entirely in written form, seasoned attorneys recognize that real opportunity for influence lies in the examiner interview.

United States Patent Examiners are authorized to conduct brief meetings (usually 30 minutes or less) with applicants. These meetings are commonly referred to as "interviews." Interviews can be conducted over the phone, in-person, or over a web-based video conferencing technology provided to examiners referred to as "WebX."

During an interview, the attorney has the opportunity to present his or her best case to the examiner, explaining why an application should be allowed over the cited art. The attorney has the opportunity to explain the invention to the examiner and help him or her understand the problem the invention is attempting to solve. Discussions regarding other issues such as subject matter eligibility (101) or formality rejections (112) are also highly beneficial.

Each type of examiner interview has its relative advantages and disadvantages. Having conducted hundreds of in-person and telephonic interviews, as well as a handful of WebX interviews, I have generally observed the following:

In-person Interviews

- Examiners tend to be well prepared for in-person interviews - they know they are going to sit down with an attorney face-to-face and generally don't want to appear unprepared.
- Attorneys can get to know the examiners—many in-person interviews are conducted in the examiner's (or the supervisor's) private office which often has pictures or other clues regarding examiners' family or outside interests. Short conversations about these items can help break the ice and befriend the examiner. Knowing an examiner personally can yield great dividends on future applications with that examiner.
- Attorneys can bring highlighted figures and documents, and can draw illustrations on-

the-fly to help the examiner understand what is being invented and why it's different from the cited art.

- Attorneys can see the examiners' body language and his or her reaction when various points are made, indicating agreement or lack thereof.
- Downsides include travel costs and lack of centrally-located examiners—indeed, many examiners work from home or at different patent offices spread throughout the country.

WebX Interviews

- WebX interviews have many of the same benefits as an in-person interview, without the travel cost.
- Attorneys can see the examiners' reactions, can show highlighted documents or figures using the camera, and examiners are usually well prepared .
- Downsides include potentially having to work out technological problems that, for example, result in one side without video or audio, etc.

Telephonic Interviews

- While slightly less effective than in-person interviews, telephonic interviews can be valuable and beneficial to the client.
- Telephonic interviews cost less, and most often the examiner is just as prepared for the interview as they would be for an in-person interview.
- Experienced attorneys can listen for audible clues (other than words) as to the examiner's demeanor and relative acceptance of the arguments.
- Downsides include not having a visual insight into the examiner and his or her surroundings. Nevertheless, a little bit of small talk and pleasant conversation can go a long way into having a productive interview.

At the end of the day, regardless of which interview method is chosen, any interview is much better than no interview at all. Many times attorneys can save a full round of prosecution

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simply by setting up an interview and asking the examiner's opinion on a proposed claim amendment. Furthermore, even if the proposed amendment isn't accepted, examiners will often provide advice regarding which direction to go in future claim amendments. As the examiners are subject matter experts in the field, and are also judge, jury and executioner when it comes to applications, it pays to listen to any advice they provide in an interview.