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**Michael Moore**

holds the position of deputy general counsel, Intellectual Property at Rambus, Inc. Moore leads the Intellectual Property Development group and is responsible for developing complex IP portfolios to support product development, licensing and bringing innovation to market.



**Daniel Ovanezian** is a partner in the Palo Alto, California office of Lowenstein Sandler LLP, specializing in intellectual property law.

## Using Old Tech to Get New Tech Patents

Your company just invested to get an application on Track One prioritized examination. Now what? The Track One prioritized program does not guarantee an applicant to get an allowance — only a final disposition that can be a final rejection. What else can an applicant do to facilitate the allowance of their patent application? One of the most effective ways to advance prosecution of a patent application is an old and relatively inexpensive way: Pick up the phone and call the examiner at the USPTO assigned to the application.

With written communication, it can sometimes be difficult to persuade the examiner regarding technical nuances or, more frequently, appreciate the examiner's point of view from the Office action itself. Often when learning patent prosecution, junior patent prosecutors may read Patent Office actions and develop the impression that the examiner did not fully understand the invention or formulated an incomplete rejection. However, the vast majority of time examiners do "get it," but the written form of the examiner communication may not clearly convey the examiner's logic to the applicant. There may be ambiguity on how claims are being interpreted, which reference teachings are being analyzed, and which legal authority is alleged to apply. As a result, applicants and examiners are sometimes writing at cross purposes, each thinking that the other does not understand their position.

An effective way to address this is to speak directly with the examiner through the interview process, either over a telephone call or through an in-person discussion at the USPTO. Further, examiner interviews provide a valuable way to deepen the professional relationship with the examiner corps. Applicants frequently encounter the same examiner or group of examiners within a particular USPTO art unit that are assigned to examine their applications. By taking the time to speak with the examiner, teach her about the technical merits of the invention, how it operates, and how it is distinguished over the art, one can improve the examiner's technical understanding of the invention and also the quality of the examination, thus leading to a higher standard of final issued patent. This benefits all stakeholders in the patent process and furthers the public interest in and trust of the patent system.

From the perspective of return on investment, the relatively low cost investment of an over-the-phone examiner interview is more than rewarded by faster prosecution and quicker allowances. We have observed that when such an examiner interview is conducted early in prosecution, cases are generally allowed with at least one fewer office action than cases where no interview is conducted.

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When developing extended portfolios with multiple family members (e.g., continuation and divisional filings), the same examiner is often assigned to examine subsequent family members. In this scenario, it is particularly helpful to ensure the examiner has a clear understanding of both the claimed inventions and the prior art. This can assist with understanding the distinguishing points of novelty over the art, and the benefit or value associated with those.

Having addressed the merits of conducting examiner interviews, when and how should interviews be performed? First, an applicant can pick up the phone any time during the prosecution of an application after it has been assigned to an examiner and request an interview with the examiner. An interview can even be done before an examiner takes up an application and issues an Office action. As noted above, the interview can be particularly beneficial in educating the examiner on complex technologies. There is no formal requirement to request an interview, as an applicant can simply call the examiner and request one. However, the examiner may require the applicant to submit an examiner interview agenda. The agenda should address the goal or purpose of the interview, provide a concise synopsis of the applicant's arguments to be presented, and should use the PTOL-413A form.

A few years ago, the USPTO implemented a new pilot interview program called First Action Interview (FAI) pilot program.<sup>1</sup> The initial FAI pilot program was implemented on May 6, 2011, and has since been extended and revised. The FAI pilot program is active and is available for all patent applications regardless of technology areas or filing date. Under the program, applicants are permitted to conduct an interview with the examiner after reviewing a pre-interview communication providing the result of a prior art search conducted by the examiner. Applicants have benefited through (1) the ability to advance prosecution of an application; (2) enhanced interaction between applicant and the examiner; (3) the opportunity to resolve patentability issues one-on-one with the examiner at the beginning of the prosecution process; and (4) the opportunity to facilitate possible early allowance.

What advantages does the FAI program offer over traditional interviews? One benefit to using the FAI pilot program is that it guarantees that an interview will be conducted after a search is performed by an examiner but before an Office action is issued. This provides an opportunity to discuss and potentially resolve any patentability issues with the examiner prior to a formal Office action rejection, and thus possibly facilitate a quicker allowance. If an applicant were to call an examiner outside of the FAI pilot

program to request that an interview be conducted after the search and before an Office action rejection were to be issued, an examiner would not be required to grant such an interview. The USPTO provides interview talking points (several dozen) for the FAI pilot program,<sup>2</sup> the most important among them in our experience being "[d]iscuss the broadest reasonable interpretation of the claims" and "[d]iscuss the ordinary meaning and/or art/application specific claim term meanings." Not to discount the value of explaining inventions (particularly in complex technologies) or distinctions over the prior art, but the biggest roadblock to compact prosecution tends to be misunderstandings surrounding the broadest reasonable interpretations being applied by examiners. An examiner interview can help resolve any such misunderstandings quickly, and provide for more efficient prosecution overall.

One side note that the use of the FAI Pilot Program requires an application to have no more than three independent claims and 20 claim total. However, according to the FAQ's on the pilot program, an applicant may submit an amendment to add more claims in response to an FAI Office action being sent out (i.e., after an interview has been conducted) as long as the Office action is not an allowance.<sup>3</sup>

Another interview option is the After Final Consideration Pilot (AFCP) 2.0 program. The AFCP 2.0 program provides examiners with additional time for considering amendments that are made to the claims of an application after a final rejection. Although an examiner is not required to conduct an interview under the AFCP 2.0 program, an examiner can elect to do an interview and is provided with additional allotted time for it under the program. The interview can be used by examiners to discuss, with the applicant, the results of any updated search and/or consideration of the amendments even if they did not consider the amendment to place the application in condition for allowance. In this way, applicants can benefit from the interview with the examiner afforded by AFCP 2.0, even without an immediate allowance, by providing guidance to the applicant to potentially file a different amendment with a request for continued examination or an appeal, if necessary.

It should be noted that applicants are not limited to only one interview and use of one program does not exclude use of other programs. In many cases, issues cannot be resolved with just one interview. For example, an examiner may perform an update search once she has a better understanding of the invention, claim terms and field of prior art, etc., and issue a new rejection with different prior art references than previously cited. In such cases, additional interviews may be just as beneficial as initial interviews in advancing applications to allowance.

In conclusion, the examination process is a collaborative effort between the applicant, the applicant's counsel, and the examiner corp., and anything the applicant can do to develop clear communication, rapport and understanding with the examiner will benefit all parties involved, and lead to the issuance of higher quality patents, which foster innovation and reward investment in R&D. This is the ultimate goal of the patent system.

#### Endnotes

1 [www.uspto.gov/patents/init\\_events/faipp\\_full.jsp](http://www.uspto.gov/patents/init_events/faipp_full.jsp)

2 [www.uspto.gov/web/offices/pac/dapp/opla/preognotice/fai\\_talking\\_points.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/fai_talking_points.pdf)

3 [www.uspto.gov/patents/init\\_events/faipp\\_full\\_faqs.pdf](http://www.uspto.gov/patents/init_events/faipp_full_faqs.pdf)