

Friday Seminar Series

September 17, 2010

Examiner Interviews

MPEP 713

- *The personal appearance of an applicant, attorney, or agent before the examiner or a telephone conversation or video conference or electronic mail between such parties presenting matters for the examiner's consideration is considered an interview.*

MPEP 713.01 - 37 CFR 1.133

- 37 CFR 1.133
- a)
 - (1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.
 - (2) An interview for the discussion of the patentability of a pending application will not occur before the first Office Action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.
 - (3) The examiner may require that an interview be scheduled in advance.
- (b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

At The USPTO

- Interviews must be conducted on the Office premises, such as in examiner's offices, conference rooms or the video conference center.
- Interviews are permissible during normal business hours on Monday through Friday except the hours in which the examiner is working overtime.

Special Procedures For Using Internet Electronic Mail

- Internet e-mail shall NOT be used to conduct an exchange or communications similar to those exchanged during telephone or personal interviews unless a written authorization from the applicants or an attorney/agent of record has been given to use Internet e-mail. See MPEP § 502.03. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form is entered.

Video Conference Center

In the interest of providing better service to its customers, the U.S. Patent and Trademark Office (USPTO) has established a Video Conference Center (VCC) to expedite patent and trademark prosecution. The VCC is presently administered by the Office of Patent Training and is available for authorized official business during normal business hours (8:30 AM - 5:00 PM, EST). The VCC equipment includes a high resolution document camera, direct computer input, VCR display capability, and a high speed, high resolution G-4 facsimile machine. The Patent and Trademark Depository Library Program office maintains a current list of all the off-site locations where a video conference may be held. At this time, use of the VCC will be limited to our partnership Patent and Trademark Depository Libraries (PTDLs) located at Sunnyvale, Calif. and the Great Lakes Patent and Trademark Center at the Detroit Public Library, which have duplicate video equipment. Customers wishing to utilize the facilities at the above noted PTDLs, rather than coming to the USPTO for a face-to-face interview, should contact the patent examiner and identify two alternative dates and times for a video conference. The patent examiner will then contact Office of Patent Training personnel who will, in turn, make all the arrangements. The customer will be notified as to the date and time of the video conference by Office personnel.

Scheduling And Conducting An Interview

An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present and available in the Office. When applicant is initiating a request for an interview, an "Applicant Initiated Interview Request" form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed.

PTOL-413 Form

Doc Code: M865 or FAI.REQ.INTV PTOL-413A (10-09)
Approved for use through 07/31/2012 OMB 0951-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.: _____ First Named Applicant: _____
 Examiner: _____ Art Unit: _____ Status of Application: _____

Tentative Participants:
 (1) _____ (2) _____
 (3) _____ (4) _____

Proposed Date of Interview: _____ Proposed Time: _____ (AM/PM)

Type of Interview Requested:
 (1) Telephonic (2) Personal (3) Video Conference

Exhibit To Be Shown or Demonstrated: YES NO
 If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

Continuation Sheet Attached
 Proposed Amendment or Arguments Attached

Brief Description of Arguments to be Presented:

An interview was conducted on the above-identified application on _____.
NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).
 This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

 Applicant/Applicant's Representative Signature _____
 Examiner/SPE Signature

 Typed/Printed Name of Applicant or Representative

 Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.111 and 1.114. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
 If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Interview

A copy of the completed "Applicant Initiated Interview Request" form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative. Applicants are encouraged to use form PTO-413A, however, the fact that applicant does not submit an "Applicant Initiated Interview Request" form is not, by itself, grounds for the examiner to deny a request for an interview. An interview in the Video Conference Center must be arranged at least 3 days in advance. When a second art unit is involved (Patentability Report), the availability of the second examiner should also be checked. See MPEP § 705.01(f). An appointment for interview once arranged should be kept. Many applicants and attorneys plan trips to Washington or off-site video conferencing locations in reliance upon such appointments. When, after an appointment has been made, circumstances compel the absence of the examiner or examiners necessary to an effective interview, the other party should be notified immediately so that substitute arrangements may be

Telephone Call

When a telephone call is made to an examiner and it becomes evident that a lengthy discussion will ensue or that the examiner needs time to restudy the situation, the call should be terminated with an agreement that the examiner will call back at a specified time. Such a call and all other calls originated by the examiner should be made through the Office's telephone system even though a collect call had been authorized. It is helpful if amendments and other papers, such as the letter of transmittal, include the complete telephone number with area code and extension, preferably near the signature of the writer.

Surprise Visit

The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the examiner may well justify his or her refusal of the interview at that time, particularly in an involved case.

Allowable Subject Matter

An examiner's suggestion of allowable subject matter may justify indicating the possibility of an interview to accelerate early agreement on allowable claims.

Issues

An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application. Thus, the attorney when presenting himself or herself for an interview should be fully prepared to discuss the issues raised in the Office action. When it is obvious that the attorney is not so prepared, an interview should not be permitted. It is desirable that the attorney or applicant indicate in advance what issues he or she desires to discuss at the interview by submitting, in writing, a proposed amendment. This would permit the examiner to prepare in advance for the interview and to focus on the matters set forth in the proposed amendment.

Interruptions

Examiners should avoid unnecessary interruptions during interviews with attorneys or inventors. In this regard, examiners should not take incoming telephone calls unless such are of an emergency nature. As appropriate, examiners should familiarize themselves with the status and existing issues in an application or reexamination proceeding before an interview.

Further Consideration/Search

The examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study. Nor should the examiner hesitate to conclude an interview when it appears that no common ground can be reached nor when it becomes apparent that the application requires further amendment or an additional action by the examiner. However, the examiner should attempt to identify issues and resolve differences during the interview as much as possible.

30 Minutes

It is the responsibility of both parties to the interview to see that it is not extended beyond a reasonable period, usually not longer than 30 minutes. It is the duty of the primary examiner to see that an interview is not extended beyond a reasonable period even when he or she does not personally participate in the interview.

After Final

Examiners may grant one interview after final rejection. See MPEP § 713.09.

Request in Amendment

Where the reply to a first complete action includes a request for an interview, a telephone consultation to be initiated by the examiner or a video conference, or where an out-of-town attorney under similar circumstances requests that the examiner defer taking any further action on the case until the attorney's next visit to Washington (provided such visit is not beyond the date when the Office action would normally be given), the examiner, as soon as he or she has considered the effect of the reply, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Where agreement is reached as a result of an interview, applicant's representative should be advised that an amendment pursuant to the agreement should be promptly submitted. If the amendment prepares the case for final action, the examiner should take the case up as special. If not, the case should await its turn.

Video Tapes

The U.S. Patent and Trademark Office has video tape equipment available for viewing video tapes from applicants during interviews with patent examiners. The video tape equipment may use VHS and UHS (3/4-inch tape) cassettes.

Attorneys or applicants wishing to show a video tape during an examiner interview must be able to demonstrate that the content of the video tape has a bearing on an outstanding issue in the application and its viewing will advance the prosecution of the application. Prior approval of viewing of a video tape during an interview must be granted by the supervisory patent examiner. Also, use of the room and equipment must be granted by the Office of Patent Training. The central training facility is located on the second floor of Madison West, 600 Dulany Street, Alexandria, VA 22314.

Video Tapes

Requests to use video tape viewing equipment for an interview should be made at least 1 week in advance to allow the Office of Patent Training staff sufficient time to ensure the availability and proper scheduling of both a room and equipment.

Interviews using Office video tape equipment will be held only in the Office of Patent Training facilities. Attorneys or applicants should not contact the Office of Patent Training directly regarding availability and scheduling of video equipment. All scheduling of rooms and equipment should be done through and by the examiner conducting the interview. The substance of the interview, including a summary of the content of the video tape must be made of record in the application. See MPEP § 713.04.

Prior to First Official Action

A request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. In all other applications, an interview before the first Office action is encouraged where the examiner determines that such an interview would advance prosecution of the application. Thus, the examiner may require that an applicant requesting an interview before the first Office action provide a paper that includes a general statement of the state of the art at the time of the invention, and an identification of no more than three (3) references believed to be the "closest" prior art and an explanation as to how the broadest claim distinguishes over such references. See 37 CFR 1.133(a), MPEP 713.02

Sounding Out

Interviews that are solely for the purpose of "sounding out" the examiner, as by a local attorney acting for an out-of-town attorney, should not be permitted when it is apparent that any agreement that would be reached is conditional upon being satisfactory to the principal attorney.

Substance of Interview

A complete written statement as to the substance of any face-to-face, video conference, electronic mail or telephone interview with regard to the merits of an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview. See 37 CFR 1.133(b), MPEP § 502.03 and § 713.01.

- *37 CFR 1.2 Business to be transacted in writing.*
- All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Substance of Interview

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, except where the interview was initiated by the examiner and the examiner indicated on the "Examiner Initiated Interview Summary" form (PTOL-413B) that the examiner will provide a written summary. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiner-Initiated Interview Summary	Application No.	Applicant(s)	
	Examiner	Art Unit	

All Participants: _____ **Status of Application:** _____

(1) _____ (3) _____

(2) _____ (4) _____

Date of Interview: _____ **Time:** _____

Type of Interview:

Telephonic

Video Conference

Personal (Copy given to: Applicant Applicant's representative)

Exhibit Shown or Demonstrated: Yes No

If Yes, provide a brief description:

Part I.

Rejection(s) discussed:

Claims discussed:

Prior art documents discussed:

Part II.

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

Part III.

It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.

It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

(Examiner/SPE Signature) _____ (Applicant/Applicant's Representative Signature – if appropriate)

Interview Summary

Examiners must complete an Interview Summary form PTOL-413 for each interview where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. If applicant initiated the interview, a copy of the completed "Applicant Initiated Interview Request" form, PTOL-413A (if available), should be attached to the Interview Summary form, PTOL-413 and a copy be given to the applicant (or applicant's attorney or agent)

Interview Summary	Application No.	Applicant(s)
	Examiner NAHIDA SULTANA	Art Unit 1791

All participants (applicant, applicant's representative, PTO personnel):

(1) NAHIDA SULTANA (USPTO); (2) JOSEPH DEL SOLE (USPTO); (3) ROBERT E GOOZNER (Applicant's representative); (4) _____.

Date of Interview: 16 September 2010.

Type: a) Telephonic b) Video Conference
c) Personal [copy given to: 1) applicant 2) applicant's representative]

Exhibit shown or demonstration conducted: d) Yes e) No.
If Yes, brief description: _____.

Claim(s) discussed: 1.

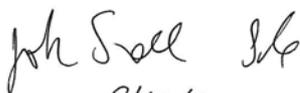
Identification of prior art discussed: Stefan (EP 0941829).

Agreement with respect to the claims f) was reached. g) was not reached. h) N/A.

Substance of interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of interview requirements on reverse side or on attached sheet.


9/16/2010

Interview Summary

Continuation Sheet (PTOL-413)

Application No. 

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant's representative amended claim to incorporate new limitation "the first shell (12) faces upward with the first shell support (6) and the first shell (12) selected so that the active molding surface forms a bottom of a cup having edges delimited by a substantially cylindrical edge portion." Examiner agreed that the amendment to the claims incorporating language above, appears to overcome the Stefan reference. Furthermore, examiner believes that amendment to the claim raises new issues, which requires a further search in order to determine the patentability of the claims.

Substance of Interview

The PTOL-413 form also contains a statement reminding the applicant of his or her responsibility to record the substance of the interview.

The complete and proper recordation of the substance of any interview should include at least the following applicable items:

- (A) a brief description of the nature of any exhibit shown or any demonstration conducted;
- (B) identification of the claims discussed;
- (C) identification of specific prior art discussed;
- (D) identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary form completed by the examiner;

Substance of Interview

(E) the general thrust of the principal arguments of the applicant and the examiner should also be identified, even where the interview is initiated by the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner;

(F) a general indication of any other pertinent matters discussed; and

(G) if appropriate, the general results or outcome of the interview.

If Not in Next Amendment

The reply filed on [1] is not fully responsive to the prior Office action because it fails to include a complete or accurate record of the substance of the [2] interview. [3] Since the above-mentioned reply appears to be bona fide, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Or if no amendment is due, a separate paper must be filed within one month.

Statement Example

Statement of Substance of Interview

The Examiner is thanked for graciously conducting a personal interview with the Applicant's representative on [DATE]. During the interview the patentability of the present invention over the applied art of [REFERENCE(S)] was discussed, along with potential amendments to the claims. At the end of the interview the Examiner prepared an Interview Summary. The Interview Summary has been reviewed and it appears to accurately reflect the substance of the interview

Special Situations MPEP 713.05

For Saturday interviews, see MPEP § 713.01.

Except in unusual situations, no interview is permitted after the brief on appeal is filed or after an application has been passed to issue.

An interview may be appropriate before applicant's first reply when the examiner has suggested that allowable subject matter is present or where it will assist applicant in judging the propriety of continuing the prosecution.

Office employees are forbidden to hold either oral or written communication with an unregistered or a suspended or excluded attorney or agent regarding an application unless it is one in which said attorney or agent is the applicant.

Accelerated Examination

From the guidelines:

“Any pre-first action interview should be held within two weeks from the initial contact by the examiner. Failure to comply with the interview provisions in a timely manner will result in the application being returned to regular status in the examining queue with an Office Action issuing in due course.”

See:

<http://www.uspto.gov/patents/process/file/accelerated/index.jsp>

Deaf Examiner

- Interview via telephone
- I talked to a transcriptionist provided by the USPTO

Thank You