INTERVIEW PRACTICES FOR PRODUCTIVE PATENT PROSECUTION

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The materials presented herein may not represent official USPTO policy

Berenato & White, LLC

Securing Your Innovations®
Benefits

- Facilitate communications between applicant and the PTO
- Clarify and resolve issues
- Negotiate claim language
- Advance examination
Interview time (2008-2014)
Percent of disposals having at least one interview (2008-2015)
Data from top 20 filing organizations

Practices for productive prosecution

- When to interview?
- First Action Interview Program
- After Final Consideration Pilot 2.0
- Inventor
- Analytics
When to Interview?

- Preferably early during the prosecution history – before final office action
  - Interviews before final Office action had the same grant rate as those that did not.
  - Interviews after final had a much higher grant rate than applications with final Office action but no interview (74% v. 60%)
Scheduling of interview

- Call Examiner
- Automated Interview Request (AIR)
- Examiner may request an agenda
PTO programs encouraging interviews

- First Action Interview Program
- After Final Consideration Pilot 2.0
First Action Interview Program

- File request before first Office action on the merits
- No more than 20 claims and no more than 3 independent claims
- No traversal of restriction
FAIP (cont.)

- File FAI
- Search
- NOA
  - Allowed
  - Not allowed
  - Pre-interview communication
- FAIOA Summary
- Interview
- Current practice

Current practice
Efficiency of FAIP

<table>
<thead>
<tr>
<th></th>
<th>FAI</th>
<th>Overall average</th>
</tr>
</thead>
<tbody>
<tr>
<td>1St OA allowance*</td>
<td>29%</td>
<td>13%</td>
</tr>
<tr>
<td>Issuance rate**</td>
<td>90%</td>
<td>60%</td>
</tr>
<tr>
<td>Number of action**</td>
<td>0.7</td>
<td>1.9</td>
</tr>
</tbody>
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**Kate Gaudry, A Look a the Results of USPTO’s Interview Program, Law360, Jan. 9, 2014.
Possible improvements to FAIP

- Allow applicant to file amendment as a matter of rights after interview and before 1st Action
Interview Office Action Summary
- Replace 1st Action Interview Office Action Summary with a full Office action
After Final Consideration Pilot 2.0

- Non-broadening amendment one independent claim
- Applicant willing and available to participate in an Examiner’s requested interview
- If Examiner deems the amendment not in condition for allowance, s/he will request an interview
Efficiency of AFCP 2.0

- 30% result in allowance
- 30% result in advisory action
- 40% were denied consideration

Consider bringing an inventor

- Very helpful if the inventor has a compelling story on product development
- Must prepare inventor
Consider using analytics

- Several websites provides analytics on patent prosecution (e.g. Examiner Ninja, Examiner Reports)

- Statistics may be useful for applicant to decide whether to interview
Sample analytics (Examiner Ninja)

**Interviews**

<table>
<thead>
<tr>
<th>Allowance Rate With No Interview</th>
<th>Allowance Rate With Interview</th>
<th>Relative Benefit of Interview</th>
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<tbody>
<tr>
<td>27.7%</td>
<td>53.3%</td>
<td>+93%</td>
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About this graph

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QUESTIONS?

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