



Clarity of Record Pilot: Interview Summaries and Pre-search Interview Option

2/25/2016

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Goals of the Pilot:

- More thoroughly document discussions with applicant to provide an enhanced written record
- Raise the awareness, and analyze the effectiveness, of the pre-search interview option



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The Pilot Will Focus On:

Going beyond current interview practice by:

- More thoroughly capturing the discussion of:
 - Each statutory basis of rejection as it relates to the prior art, claim limitations, and amendments
 - Arguments or issues raised by applicant and the examiner
 - Issues of claim interpretation
- Articulating the merits of an interview in greater specificity to enhance the written record
- Encouraging use of the pre-search interview option, when appropriate



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Thoroughly Capturing the Discussion

A thorough interview summary should:

- Identify principal **arguments or issues raised** by applicant and the examiner
- Identify specific issues of claim interpretation (particularly with respect to computer-implemented functions, special definitions, intended use/functional language, and non-functional descriptive material)
- Identify prior art teachings and set forth prior art interpretations that were discussed

Set forth the general **results** or outcome of the discussion including any agreements reached

Provide **next steps** in prosecution, as discussed



Enhanced Interview Summary

Example

The applicant asserted that “the translation arm being hinged to the articulation fingers” is not taught by Smith. The applicant explained that the invention is hinged to fold the fingers over the arm. The examiner directed the applicant to Figure 3 of Smith which shows the fingers (14) secured to the translation arm (25) by a joint mechanism which pivots between two positions. The examiner explained that, although not taught by Smith, the claim does not require the hinge to fold the fingers over the arm. The applicant will file a response to the outstanding Office action amending the claim to further define the hinge as folding the fingers over the arm.



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Pre-Search Interview Option

- This option is Examiner-initiated
- Useful to clarify issues prior to searching so that a complete and thorough search can be performed
- Helps ensure the best possible prior art is found at the onset of prosecution to enable compact prosecution and eliminate re-work



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Pre-Search Interview Option

- Initiating a pre-search interview is encouraged when an initial review of the application reveals, for example:
 - A substantial issue under 35 USC §112
 - The scope of the claimed invention is ambiguous
 - Any issues that can be resolved to advance prosecution or aid in finding the best possible prior art



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Pre-Search Interview Option

- Be prepared and articulate issues where discussion can be helpful
- If the reason for a pre-search interview is a substantial issue (*e.g.*, a substantial issue of enablement under 35 USC §112), have an outline of the proposed rejection readily available for discussion during the interview
- Ensure that applicant's arguments/explanations are supported by disclosure



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Questions

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