

Applicant's Pre-Examination Interview Talking Points

(The matters listed below are designed to facilitate a comprehensive discussion of an application before first Office action. The listing is non-exhaustive and should not be considered limiting. All matters listed may not apply to every application. Applicant must be prepared to fully discuss any and all of the interview talking points relevant to the application with the intent to clarify and resolve all issues with respect to patentability during the interview.)

(A) Background or Summary of the Invention (MPEP § 713.02):

Discuss the nature of the invention (improvement, combination or pioneering, etc.).

Discuss the current state of the art relative to the present invention.

Discuss reference(s), which exemplify the current state of the relevant art.

Discuss any seminal references relevant to the present invention.

Discuss any other patents, patent application publication, and/or pending patent applications or other printed publications in the same or similar/related art field (foreign or domestic) by the same inventive entity.

(B) Claim Construction (MPEP §§ 2111-2116):

Discuss the broadest reasonable interpretation of the claims.

Discuss the ordinary meaning and/or art/application specific claim term meanings.

Discuss affects of preamble language, transition phrases and non-positive claim language (*e.g.*, adapted to/for, whereby, wherein; intended use/results language; functional language; and invention environment language etc.)

Discuss implications of special patent claim formats (*e.g.*, product-by-process, Jepson, Markush, etc.)

(C) Discussion/Statement of 35 U.S.C. 101 issues:

Patent Eligibility (MPEP § 2106)

Discuss the patent eligible category that the claimed invention falls under.

Utility (MPEP § 2107)

Discuss disclosure for a specific and substantial utility and/or a readily apparent well-established utility.

(D-1) Discussion/Statements of 35 U.S.C. 112, First Paragraph Issues (MPEP §§ 2161-65):

Support/Written Description (MPEP § 2163)

Discuss and identify any relevant passages in the specification (or in the specification of a prior-filed (parent) application) to support the claims.

Discuss the properness of any incorporation by reference.

Discuss any issues of new matter (See also MPEP § 608.04)

Enablement/scope of enablement (MPEP § 2164)

Discuss Wands Factors.

Best Mode (MPEP § 2165)

Discuss and identify the best mode known to the inventor at the time of filing.

(D-2) Discussion/Statements of 35 U.S.C. 112, Second Paragraph Issues (MPEP §§ 2171-73):

Essential Subject Matter (MPEP § 2172)

Discuss the subject matter that applicant regards as his or her invention.

Particularly pointing out and distinctly claiming the invention (MPEP § 2173)

Discuss the definiteness of the claims (*i.e.*, insure they are not vague and indefinite).

Proper claim format

3rd para. – Independent & dependent claims only.

4th para. – Definition/properness of dependent claims.

(D-3) Discussion/Statements of 35 U.S.C. 112, Sixth Paragraph Issues (MPEP §§ 2181-86):

Identify every means- or step- plus function claim element.

Discuss any means/steps claim format requirements/issues to insure 35 U.S.C. 112, ¶6, is properly invoked.

Discuss and point out the corresponding structure, material, or acts described in the specification and equivalents thereof for each claim element that invokes 35 U.S.C. 112, ¶6.

(E) References Deemed Closely Related (See attached claim charts if provided/present):

Discuss qualification of reference as Prior art (MPEP §§ 2121-29).

Anticipation-- 35 U.S.C. 102 (MPEP §§ 2131-38).

Discuss how the claim language avoids anticipation by any possibly anticipatory references.

Obviousness-- 35 U.S.C. 103 (MPEP §§ 2141-45).

Discuss how the claim language avoids obviousness by any references which may render the claimed invention obvious.

(E-DISQ) Identification of References Disqualified as Prior Art under 35 U.S.C. 103(c) (MPEP § 2146):

Discuss the merits of any prior art disqualification assertions made under 35 U.S.C. 103(c).

(E-DEP/SEQ) Biological Deposit/Sequence Listings (Biotech Only) (37 CFR 1.801 – 1.825):

Discuss any biological deposits and/or sequence listings to insure the submissions conform to the rules.

(F) Detailed Discussion/Explanation of Patentability (See Attached Claim Chart if present/provided):

Discuss any claims designated as allowable.

Discuss claims objected to for other reason but which are designated allowable.

Discuss any suggested claim language to facilitate allowability.

(G) Matters subject to Objection:

Drawing (37 CFR 1.83 and 1.84, MPEP § 608.02)

Claimed subject matter not shown (37 CFR 1.83(a))

Numerals incorrect or missing (MPEP § 608.02)

Insufficient view of figures (37 CFR 1.84(h))

New matter (MPEP § 608.04)

Figures that illustrate only that which is old should be labeled “Prior art” (MPEP § 608.02(g))

Abstract (37 CFR 1.72(b) MPEP § 608.01(b))

Missing

Too long/too short; 50-150 words and not greater than 15 lines

Improper language (use of legal terms; merits of invention)

More than one paragraph

Non-narrative

Must be descriptive—suggest descriptive language

Must be on a separate sheet

Specification- Formal Matters (37 CFR 1.171, MPEP § 608.01)

Arrangement (MPEP § 608.01(a))

Minor informalities; *e.g.*, spelling grammar, non-idiomatic English

Reference to continuing data or domestic priority

Missing text; missing pages

New matter (MPEP § 608.04)

Brief description of each Figure of the drawings (MPEP § 608.01(f))

(H) Formal Matters:

Oath or Declaration (37 CFR 1.63, MPEP §§ 602-605.07)

Review and understand clause

Duty to disclose clause

Willful false statements clause (in declarations)

Citizenship for each inventor

Other objections

Mailing address

Check for domestic benefit /foreign priority claims

(I) Misc. Matters:

Information Disclosure Statement [IDS] (37 CFR 1.97 and 1.98, MPEP § 609)

Use of form PTO/SB/08 or equivalent

Supply legible copy of references or an electronic information disclosure statement [e- IDS]

State relevance of reference if not in English

Verify citation of reference by initialing or lining through the citation on the PTO/SB/08

Any case-specific matters not covered by the above listed matters