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The adversarial process of working with patent examiners — and how to speed up a patent application

By Aldo Martinez, Esq., *Oblon*

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Anyone who has applied for a patent knows the process can be long and difficult.

This process can be made easier and can even be shortened significantly by holding an "interview" with the patent examiner assigned to the application at the U.S. Patent and Trademark Office.

Patent practitioners and entities that file many patent applications are well aware of this fact. Nonetheless, many fail to take the steps needed to maximize the effectiveness of an interview and, unsurprisingly, are disappointed by the results.

Preparing for a productive interview begins by understanding that the working relationship between the patent examiner and the applicant (or the practitioner representing the applicant) can at times be adversarial.

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Under this standard, the examiner is entitled to give the claim language its broadest reasonable construction, or meaning, in light of the specification as it would be interpreted by one of ordinary skill in the art.[1]

Given the use of somewhat subjective terms, such as "broadest," applicants often disagree with examiners on what the broadest reasonable interpretation of the claims of an application should be.

However, because the examiner also determines — at least at first — whether an applicant's written response overcomes a rejection or not, merely arguing with the examiner that their interpretation of the claims is incorrect can quickly lead to a breakdown in the examination process. That can needlessly place the application on a path to appeal at the USPTO's Patent Trial and Appeal Board.

FINDING COMMON GROUND

An applicant can minimize the possibility of a contentious interview with an examiner by seeking common ground early in the discussion.

For example, the applicant can start by discussing the context for the invention, the problem it solves and how it is reflected in the claims of the application.

The examiner should also be invited to ask questions at this stage, and the applicant should listen carefully and answer any questions directly wherever possible.

This is an important step because it signals to the examiner that the applicant wants the examiner to benefit from the interview. An examiner who benefits from the interview is more likely to engage in the conversation.

It is also important to have several options to discuss during the interview. If an impasse is reached on a first option, the conversation can be refocused on another option rather than belaboring a point on which the examiner will not budge. That is not to say that applicants cannot express disagreement with the examiner.

They can, and they can also explain why they believe the examiner is incorrect. But if the examiner is not persuaded, it is far better to move to another topic than risk frustrating the examiner.

A frustrated examiner is less likely to engage in meaningful conversation, and progress, therefore, will effectively end. Of course, having several options to discuss during an interview requires preparation.

Doing the bare minimum to prepare for an interview limits an applicant's ability to discuss other topics the examiner might raise, and therefore limits the benefit that the examiner may receive from the interview.

Spending some time studying the application, the examiner's rejection and the prior art documents used in the rejection will not only allow an applicant to have multiple options to discuss during

the interview; it will also give the applicant the ability to effectively discuss any other topics that the examiner may raise.

Oftentimes if an examiner proposes an amendment to the claims of the application, the amendment will overcome the current rejection of the application. Being able to discuss such proposals with an examiner is a big plus even if it requires additional preparation.

The timing of an interview can be just as important as what is discussed. One of the best times to hold an interview is after receiving the first rejection of the application.

At this point, the examiner is familiar with the application and has searched the body of prior art documents for documents that can be used to reject the application. However, in the typical case the examiner's opinion on whether the application includes patentable subject matter is not yet fully formed.

Therefore, holding an interview at this stage — even if it is to simply ensure that the examiner understands the invention and its significance — can often be enough to significantly advance the examination of the application.

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Many applications, however, receive more than one set of rejections since an examiner must update a search after receiving a written response from the applicant. This updated search can uncover new prior art documents that can form the basis of new rejections.

Therefore, holding an interview with an examiner at a later stage of examination of a patent application is often necessary. In these later interviews the examiner is likely to have already formed an opinion on the patentability of the application, and further progress may be more difficult to achieve.

However, an interview at these later stages can still be very valuable in obtaining further insight into the examiner's thought process in making the rejections, and in drilling down to the key issues that prevent the examiner from allowing the application.

In such an interview, there is no need to provide an overview of the invention. This is because the examiner is likely very familiar with the application, and may have even interviewed previously. But it is still important to have several options to discuss, and to be willing to answer any questions the examiner might have as well as to discuss topics that are important to the examiner.

By being flexible and ensuring that the examiner gets something from the interview, the applicant can avoid impasses even in late-stage interviews.

REALISTIC GOALS AND 'HARD' INTERVIEWS

Regardless of the timing of the interview, or what is discussed with the examiner during it, it is important to set realistic goals. Of course, the overall goal is to get a patent.

However, examiners more often than not refuse to grant a patent, and trying to get an examiner to allow an application during an interview will only lead to frustration.

Instead, there are several smaller goals that can reasonably be attained during an interview.

Good goals to have for every interview include:

- Ensuring that the examiner understands the invention and the problem it solves.
- Reaching agreement on an interpretation of the claims of the application.
- Reaching agreement on how the specification of the application provides support for the claims of the application.
- Reaching agreement on what is or is not described in the prior art references used in a rejection.
- Reaching agreement on an amendment to the claims of the application that will overcome the current rejection or rejections.
- Obtaining clarification of the rejection.
- Obtaining the examiner's reasoning as to why, or why not, a particular amendment or argument overcomes a rejection.

At the very least, the last two goals should be attainable at any interview and are surprisingly effective in providing an applicant with a path to further progress in the examination process.

Lastly, it is important to embrace the "hard" interview, and interview often. Interviews in which the examiner disagrees with all of applicant's amendments and arguments, and refuses to withdraw the rejection of the application, can be very challenging, and are dreaded by practitioners and applicants alike.

But there is no need to. Realize that in explaining why they do not find amendments and arguments persuasive, an examiner provides you with a road map to overcoming the rejection and possibly obtaining allowance of the application.

The tools and techniques discussed here will keep the dialogue going in the toughest of interviews — and maximize their effectiveness.

Note

[1] U.S. Patent and Trademark Office, Manual of Patent Examination Procedure, MPEP § 2111, citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359 (Fed. Cir. 2004).

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ABOUT THE AUTHOR

Aldo Martinez is a partner in the Electrical Patent Prosecution group at **Oblon** in Alexandria, Virginia, one of the largest law firms in the United States focused exclusively on intellectual property law. He can be reached at amartinez@oblon.com.