Examiner-Initiated Interviews

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Previously we wrote about the benefits of conducting applicant-initiated examiner interviews to clarify issues and advance prosecution of a patent application toward allowance. Examiner-initiated interviews may similarly advance prosecution of a patent application if the examiner presents issues that can be resolved with a telephone call. In some situations, it may be preferable from the client's/applicant's perspective to have the issues reduced to writing and appear in the file wrapper for the application. What follows are some general guidelines for addressing different issues that may be presented by the examiner.

Restriction Requirements

Phone calls from examiners seeking elections of one of multiple patentably distinct inventions for prosecution in patent applications are relatively common. Restriction requirements can be expected in applications disclosing and claiming multiple embodiments of an inventive concept, for example, but examiners can seek restrictions based on various criteria. If the restrictions are appropriate, these phone calls can save the time and expense of exchanging written Restriction Requirements and applicant responses with elections. When proposed restrictions look to be proper between independent or patentably distinct inventions, making provisional elections over the phone will expedite prosecution. Examiners understand that input from the client may be necessary to determine which invention has the most immediate commercial value, and that a follow up call with the election is necessary.

When proposed restrictions appear to be too restrictive, it is appropriate to decline making elections over the phone and ask the examiners to prepare written Restriction Requirements with their reasoning for the restrictions. To be proper, the examiner must show that the restriction is necessary because the inventions are independent and/or patentably distinct, and that examining the inventions in the same patent application poses a serious search and examination burden. If the allegedly distinct inventions do not appear to be clearly distinct, or search and examination should not be overly burdensome because the inventions may have similar classifications and fields of search, the client may be better served by requesting the written Restriction Requirement and use the allotted response time to determine whether the restriction is proper and an election should be made, or the restriction is improper and should be traversed in the written response.

Housekeeping Issues

Examiners may use a phone call to discuss minor issues with patent applications that can be resolved via Examiner's Amendments. Such issues can include typographical errors in the specification or the claims, dependency issues between the claims or antecedent basis issues for limitations recited in the claims, for example. These phone calls may come before first Office actions on the merits are issued, or after amendments are filed that create the issues. These are the phone calls that we hope to get from examiners. They usually mean that the examiners have no substantive rejections to raise, and agreements on the proposed amendments should lead to the issuance of Notices of Allowance. Depending on the issues and the examiners' proposals, it may be prudent to review the proposed amendments to ensure they do not create new issues. Examiners typically understand an applicant's need to review the changes and provide authorization in a follow up phone call.

Same Art, New Issue

A response to a prior art rejection with claim amendments and/or arguments may overcome the previous rejections, but claims still might not distinguish over the reference applied in the rejections, either alone or in combination with other cited prior art. When this is the case, a phone call from the examiner usually means they think the application includes patentable subject matter, but the claims are not quite in condition for allowance and they hope agreement can be reached to get the case allowed without issuing another Office action. This can be a win-win for the examiner and the client. The parties may be able to find agreement during the initial call where the examiner proposes clarifying language or substantive amendments that are not unduly limiting to overcome the new rejection. In some situations, discussion between the parties can result in persuading the examiner that the claims in their present form actually do distinguish over the prior art. When more substantive amendments are proposed or the examiner raises a new combination of references, it is appropriate to ask for time to consider the examiner's position, confer with the client if necessary, and have a follow up phone call.

In some cases, either during the initial phone call or after looking at the examiner's proposal, it is apparent that the client is best served by having the examiner issue a new Office action with the new rejections. This is the better course if the rejection does not appear to be well founded, or if a proposed claim amendment may be too limiting. This also puts the examiner's feet to the fire to ensure all elements of the claims are disclosed by the references and that combinations of references are proper. Where the proposed rejections do not appear to be proper and the examiner cannot clearly explain their reasoning, the examiner's offer should be declined even without conferring with the client. In extreme examples, examiners have determined that the proposed rejections were not proper after further consideration, and ultimately issued Notices of Allowance.

"Let's Make a Deal"

It is common to receive phone calls from multiple examiners as the end of a Patent Office quarter is approaching and examiners are trying to dispose cases and increase their counts to meet or exceed their quotas. These phone calls may be similar to the phone calls discussed in the previous section, but with greater urgency. It can be advantageous to work with the examiners to take clearly allowable subject matter, especially since continuation applications seeking broader protection will likely be direct to the same examiners. However, the client's interests still dictate the decision. As with other situations, it may be best to accept the examiners' proposals if the rejections appear to be valid and the allowable claims provide meaningful protection for the clients. If the rejections are dubious or the claim scopes are too narrow, the examiners' offers should be declined as soon as practical out of courtesy so they can concentrate on other cases that could be disposed by the end of their quarter.

Conclusion

Similar to applicant-initiated interviews, examiner-initiated interviews may expedite prosecution of patent applications and patent grants by eliminating cycles of written correspondence with the examiners. However, examiner proposals should only be accepted when they are in the clients' best interests and provide the clients with the scope of patent protection to which they are entitled. If it is not clear that the clients will benefit from the proposals, the better course may be politely declining the proposals and asking the examiners to issue appropriate written communications. The clients should be no worse off, and may occasionally receive better outcomes, after the examiners have more time to reflect on the cases.

We have extensive experience in conducting examiner interviews, and in assessing and responding to examiner proposals to maximize the quality of our clients' patents while reducing the time to issuance and overall cost.

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