

GETTING INTO THE EXAMINER'S HEAD: INTERVIEWS AS A TOOL TO AIM AND FOCUS YOUR PROSECUTION

CONLEY ROSE

INTELLECTUAL PROPERTY LAW

Michael W. Piper, President

2

Examiner Interviews: Traditionally

- Tool to advance prosecution
- Higher allowance rates
- Identify allowable subject matter faster
- Reduce overall prosecution costs
- Identify difficult cases early
- Limit Prosecution History Estoppel
- *First Action Interview Pilot Program*

More Than a Conversation about Claims

- Educate the Examiner about application by telling technical details and the “story” of the application
- Narrow from the story to a claim-level discussion to bring out pieces of the story that the Examiner finds interesting
- Gain insight into the Examiner’s high-level opinion of application and the Office’s current approach to examination, internal guidance, and changes to law

Goals of the Interview Beyond the Claims

- Determine the Examiner’s general position or feelings towards the application beyond the claims
- Develop a rapport and working relationship with the Examiner
- Determine how certain claim elements are being treated by the Office at the time

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Getting Into the Examiner's Head: Interviews as a Tool to Aim and Focus Your Prosecution

Also available as part of the eCourse

[2018 Advanced Patent Law \(Austin\) eConference](#)

First appeared as part of the conference materials for the
23rd Annual Advanced Patent Law Institute session

"Getting Into the Examiner's Head: Interviews, Insight, and Analytics as Tools to Aim and Focus Your Prosecution"