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

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## **I. Introduction**

Examiner interviews provide an excellent opportunity to gain direct and indirect insights into what the Examiner is thinking about your application, about relevant challenges in the law, and about relevant challenges in the patent office. Examiner interviews can also improve prosecution efficiency by shortening the overall prosecution which can reduce the overall prosecution timing and costs as well as limiting the introduction of unnecessary amendments. Examiner interviews are available in all applications and can include the applicant, the US patent practitioner, and other parties (e.g., foreign counsel) when the US patent practitioner is present. In order to encourage more applicants to take part in interviews, the USPTO has created multiple programs to formalize the interviewing process including the First Action Interview Pilot Program (FAIPP) and the After Final Consideration Pilot (AFCP) program. The success of interviews is clear: for example, as of May 2018, the average first action allowance rate for applications as part of the FAIPP Program is around 29%, which is more than double the average first action allowance rate of around 12% for applications that have not been interviewed.

## **II. Examiner Interviews**

Examiner interviews are known to lead to higher allowance rates. For example, the First Action Interview Pilot Program was introduced to provide an opportunity to conduct an interview prior to a first office action. The statistics from this program demonstrate a first action allowance rate that is more than double that of the first action allowance rate of regular applications.<sup>1</sup> This is at least partially, if not entirely, due to the improved communications at the beginning of the interview as afforded by the Examiner interview prior to the first office action.

Along with a higher allowance rate, Examiner interviews also tend to identify allowable subject matter earlier. Thus the number of office actions needed to reach an allowance is typically reduced when interviews are carried out. The interview tends to cost less than preparing a full response. As a result, the costs of obtaining a patent can be reduced by avoiding one or more written responses. Even when the number of responses is the same, the responses

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<sup>1</sup> <http://www.uspto.gov/dashboards/patents/main.dashxml> (last accessed: October 17, 2018) (listing a 29.2% first action allowance rate for FAIPP applications as compared to a 12.2% allowance rate for regular applications).

after an interview are generally more focused on the amendments discussed during the interview. Thus, the cost of preparing the response can be reduced.

In some instances, an Examiner can indicate that they do not believe that anything in the application is allowable. Having this information early in the application may allow the applicant to decide to abandon the application or proceed directly to appeal. Typically, an applicant may try to incorporate a number of amendments to reach a resolution in these cases, none of which may be satisfactory to the Examiner. Knowing that the Examiner does not believe that anything is allowable can avoid the inclusion of these amendments prior to filing an appeal.

There are very few, if any, downsides to conducting an Examiner interview. When balanced with the advantages, it becomes clear that at least one interview (if not more) should be conducted with each round of prosecution.

#### **A. Purposes of an Interview**

Interviews serve several purposes. First, the interview allows the applicant to educate the Examiner about the application. This can include conveying both the technical aspects of the application as well as the story of the challenges overcome or reasons the claims are inventive. Due to the time constraints associated with the examination process, most Examiners do not have time to study the application along with conducting a full search and drafting a rejection. Rather, the Examiner may proceed directly to the claims, analyze the terms, conduct a search of the prior art, and apply the art to the claims. When an Examiner does read an application, they may only read a portion of the application or skim the application without getting a full understanding of all of the advantages and nuances. The interview may be the first opportunity to fully explain the invention to the Examiner, which can be invaluable to advancing prosecution.

Having provided a more comprehensive story of the underlying application, the interview may provide the Applicant an opportunity to get an insight into how the Examiner perceives the case at a high level rather than strictly buried in the details of the claims. There are benefits to trying to find areas of agreement or understanding of differences on the principle view of what makes the invention different and beneficial (and interesting). This more common language exchange can give fairly rapid insight into where the real challenges are which can provide better feedback for the client and better focus for the continuing discussion.

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