NEGOTIATING WITH PATENT EXAMINERS

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Survival is instinctive. As little children, we quickly acquire the spirit of Competition. We grow to maturity in an intensely competitive society. As lawyers, we become experts in adversarial thought, technique and strategy. We battle to win, - to defeat our adversarial counterparts. For the most part we play a win/lose game on a win/lose battlefield, presuming that in order for one of us to win, the other must lose. Each player wants, at the end of the game, to be able to say, "I win - you lose".

This "win/lose" attitude may well be appropriate in an interference proceeding or in an infringement suit; but it is absolutely inappropriate in a negotiation interview with a patent examiner, where the common aim is to reach agreement on the issuance of a patent which is mutually acceptable to all parties. If you approach the negotiation interview with an aggressive win/lose attitude, you will almost certainly fail to achieve the best possible outcome. You will fail to elicit the positive support of the examiner because you're viewing him or her as your adversary, and an air of confrontation will emerge quickly. The examiner doesn't see it that way at all. The examiner sees the relationship as an alliance, with both of you working together on behalf of the inventor and the public. You will also not do as well as you otherwise might, because the examiner is not even playing your game. The examiner is not into the win/lose game. The examiner doesn't want you to lose, and isn't even running against you, but is running with you as a member of the same relay team, hoping to pass the baton back and forth in negotiations to win together.

Patent examiners prefer a "win/win" resolution; wherein everyone involved wins; wherein there are no losers, because the inventor, the public, the attorney, and the examiner, are all winners. The examiners want you to win. Their ongoing mission is to issue valid patents as quickly as possible. When you win, your client wins. When your client wins, the public wins. When the public wins, the examiner wins; because he or she has faithfully and expeditiously fulfilled that mission. In about two-thirds of your patent applications they will do their level best to help you win. In about one-third you'll be on your own, because the inventions are just not novel, unobvious or useful.

Incidentally, we in the U.S. Patent and Trademark Office (PTO) feel that you, too, bear the obligation to continuously strive for the accomplishment of that mission. We feel that you should do your best to expedite the prosecution of patentable applications to allowance. Also, we would like to believe that you would not

pursue or accept for our client patent claims which you know are not patentable under the law, and that you would permit abandonment of applications which add nothing to the wealth of technological knowledge. We must all share in the responsibility for making the patent system work, and it is in this spirit that the win/win theme flourishes.

Some say that the win/win scenario is applicable to all interactions. Others say its applicability is situational. I subscribe to the latter view, particularly for trial attorneys. However, the win/win approach is the only way to go in negotiations with patent examiners; because they are not in the posture of opponents to you or your client; nor in the posture of an infringer's counsel seeking to invalidate your client's patent claims. So don't set them up as such. Remember, they want you and your client to win.

Actually, both you and your clients are the examiners' clients; and although the examiners are there to serve you, it is well to remember that they serve another client whose interest is paramount. It is this other client's interest that generates the underlying motivation for the examiners' philosophy, attitude and approach to negotiations of patentability. That client is the public at large. It is in the interest of the public at large that our Constitution affords the patent process to secure monopolies to promote progress in the useful arts. Thus, in the public's interest the examiners seek to allow patents for inventions which render to that public the required consideration, an advance in technology, and to deny such monopolies for inventions which do not. In this light it is easy to see just what the examiners want in the course of an interview. They want to be convinced that the application before them adequately describes a new, useful and unobvious invention, and that each of the proposed claims specifically recites that invention. Your role in the interview is not so unlike that of the salesman, the difference being that this buyer, the examiner, hopes you can make the sale.

Let us assume that your client's invention does have patentable merit, and that you have followed the golden rule of including in the application as filed claims of scope ranging from the broadest claim to which you feel entitled to the narrowest claim you would be willing to accept. Let us assume further that you have received a first Office action which reveals that the examiner is not yet of a mind to allow any of your claims, and that you can't live with that and have decided to interview the examiner. Permit me, at this point, to make some recommendations, which should facilitate the best possible outcome, - particularly now that you have resolved to adopt the win/win alternative.

PREPARING FOR THE INTERVIEW

1. Review and know the subject matter of the application.

2. Study and understand the applied prior art.

3. Analyze and understand the examiner's rejections.

4. If an amendment is being proposed, carefully study the non-applied prior art cited by the examiner in order to ensure that the amendment avoids it.

5. If an amendment is to be proposed and discussed, prepare three copies (for distribution at the interview to avoid having to look over each other's shoulder), and highlight all language added to the claims.

6. Ensure that language and features added to the claims find support in the description.

7. Prepare three copies of any pages of the prior art or affidavits you intend to refer to and highlight the relevant language.

8. Prepare papers correcting all formal errors or deficiencies so that the application would be in condition for allowance if agreement is reached on allowance of the claims.

9. Gather, organize, and package all materials you intend to bring to the interview, including a model if available.

10. Verbalize the inventive concept(s), and vocalize the contribution(s) to the technology, for your own understanding as well as in preparation for your presentation to the examiner.

11. Identify a few representative claims you will discuss in detail. Time will not permit a detailed discussion of the specifics of twenty claims.

12. Outline and prioritize the points you intended to make in the interview.

13. Plan your presentation to run no more than 30 minutes.

14. If you do not have independent and final commitment authority, seek approval of your proposals prior to the interview.

CONDUCTING THE INTERVIEW

1. Arrive at the scheduled time.

2. Enter on a positive note, - smile, relax, be courteous; opening with small talk is OK if kept to a bare minimum.

3. Set a cooperative, joint-venture tone, e.g., "together we should be able to get this fellow his patent", "let's see what we can do for this inventor", "with your help we should be able to wrap up this case today."

4. Outline the issues, e.g., formal matters, operability, anticipation, obviousness, double patenting, etc.

5. State those issues on which you agree with the examiner, e.g., formal matters and 35 USC 112 defects, and show the steps you have taken to resolve those matters.

6. Give a very brief statement of: the invention (focusing on the patentable novelty); the remaining issues (which form the basis for the interview); and your position on those issues.

7. Distribute copies of any proposed amendments (preferably highlighted) and copies of relevant pages of the applied references (preferably highlighted).

8. Explain which features (in the claims) are not shown in the prior art (35 USC 102) and why they are patentably significant. Don't focus on unimportant details.

9. Explain the support in the description for any language added to the claims.

10. Explain why you believe the examiner's modification of the primary reference or the examiner's combination of references would not have been obvious; i.e., there is no motivation or suggestion to modify or combine (35 USC 103), the references are not analogous, the modification destroys the purpose of the primary reference, the references teach away from the modification.

11. Explain, if relevant, why the proposed modification or combination of references, even if obvious, would not produce the claimed invention, e.g., essential features are still absent, the combination would be inoperative to produce the intended results of either reference.

12. Present and explain your logic, or affidavit evidence, or a model if operability is an issue.

13. Present a copy of a terminal disclaimer and/or explain and show how the inventions differ (as claimed) if double patenting is an issue.

14. Express your readiness to promptly file your proposed amendment and arguments, if you have not already done so. If the amendments are clear and minor, indicate that you would have no objection to the examiner making them by Examiner's Amendment.

15. Listen to and be receptive to any and all recommendations or suggestions made by the examiner. Don't interrupt his or her delivery of observations or advice. If you sense that you have not succeeded in your presentation, state that you would appreciate any advice or recommendations the examiner can offer.

16. Avoid becoming unduly aggressive or defensive. If the interview turns sour or bitter through no fault of your own, only then would it be appropriate to ask that a third party (Primary Examiner or SPE) be brought in.

17. End the interview on a positive note, even if you were not successful on the spot. Keep your options open. The examiner, or you, may think of something later which could produce agreement in a phone conversation; or the examiner may just reconsider and allow the case upon receipt of your amendment and arguments.

AVOIDING PITFALLS

1. Think twice before bringing the inventor along unless it is absolutely necessary, e.g., to explain an extremely complex concept, or you have another genuine need and purpose in having him/her there, or the inventor insists. More often than not the inventor's obsession interferes with objectivity and effective negotiations based on patent law and practice. In many instances the inventor makes needless patentably insignificant derogatory remarks about the operability or effectiveness of the prior art inventions; and quite frequently the inventor makes statements contrary to the point being made by the attorney and detrimental to the inventor's own interest. If a presentation by the inventor is to be made, rehearse it; and counsel the inventor to volunteer no additional opinions or observations during the interview. If the inventor won't sit still for that, arrange to temporarily leave the interview, caucus with him/her, and then return to continue the interview.

2. Don't use the interview process as a fishing expedition. Arriving at an interview with only a vague, general view that you should be able to get "something" allowed, with no

amendment or specific points to make, or with an opening line such as "What do you think, - anything allowable here?" is a major turnoff to the examiner. Under the PTO practices of compact and positive prosecution the examiner would have told you in the prior action if allowable matter was present. Most examiners draw a conclusion, rightly or wrongly, that such "fishing" interviews are merely an opportunity for the attorney to bill the client for expenses, or a conclusion that the attorney is incompetent. Don't do this, - it gives the profession a bad image.

3. Don't try to bully the examiner, particularly the young examiners and the female examiners; because you will absolutely not be successful and the examiner will remember you for the rest of his/her career. Almost all senior examiners remember an instance early in their career of such bullying; many still remember the very case, and the attorney's name. Although the examiners will hear a bully out, they will not be listening in order to cooperate in negotiations. Don't ask questions like, "Well, how long have you been in the Office?" at a point in the interview or in a manner which would imply condescension.

4. Don't try to bluff your way through the interview, e.g., by relying on arguments unsupported by fact and sound reason, or by repeatedly arguing functional aspects after the examiner has told you that the claims lack structure to afford the function. Examiners recognize insincerity almost immediately.

5. Be reasonable and realistic about the breadth of the claims. The examiner will not say "yes" to an unreasonably broad claim. If you spend a lot of time persisting on getting such a claim the examiner will abandon the win/win philosophy and you'll get little, if any, help with the rest of the claims; because the examiner senses an appeal will be taken anyway.

6. Don't try to threaten the examiner by saying you're going to appeal or ask to bring the supervisory in if you don't get your way. It won't work, and it is perceived by most examiners as an immature statement by an attorney with a weak case. If you want to appeal, or call for the supervisor, don't threaten or talk about it, - just do it. Moreover, if the examiner is a Primary Examiner, the supervisor will refuse to get involved except in matters of improper personal conduct.

7. Don't surprise the examiner with the presentation of an additional broad claim after favorable negotiation on the existing claims has been concluded. That's regarded as foul play by the examiners. Be open and above broad. Put all of your cards on the table, - no surprises.

8. Don't be surprised if the examiner is a female. Nineteen percent (19%) are female; twenty-five percent (25%) of those hired in 1989 are females. Avoid patronizing remarks and chauvinistic expressions such as, "Whatever possessed you to become an engineer?" or "I'm really impressed, - a lady engineer!!!"

9. Don't be surprised if the examiner is a minority. Many examiners of Asian origin have been hired in recent years, and many more will be hired. In some instances their oral communication may be hampered by the language, though their technical and technological skills and knowledge are exceptional. Speak clearly and slowly, and listen hard. Don't hesitate to ask them to repeat a statement.

10. Don't wait until you get a Final Rejection to seek an interview. One interview after Final is available; however, the purpose of the interview must be clear, specific, and communicated to the examiner in advance. Also, although the examiner will be receptive to amendments which correct or clarify or are readily seen as being mutually beneficial in favorably disposing of the application, the examiner will be far less helpful in suggesting claim language than before Final. Further, remember that entry of amendments after Final is not a matter of right, even for purposes of appeal.

11. Don't let the psychology of competition of the win/lose attitude interfere with your ability to secure the positive cooperation and assistance of the examiner. Remember, your self-esteem is not on the line, and it will certainly not become part of the record in the application file, - only the reasons, substance and outcome of the negotiations will appear in the record. Hopefully that record will be a patented file. Mutual respect, and the cooperative spirit of the win/win approach, are essential to yielding the best possible results, - for all parties in interest.

12. Please become familiar with and observe the Patent and Trademark Office policies set forth on the following page, entitled: "PTO Policy Regarding Appropriateness of Interviews With Patent Examiners".

PTO POLICY REGARDING
APPROPRIATENESS OF INTERVIEWS WITH PATENT EXAMINERS

Prior to filing, no interview is permitted, only search assistance may be given to the attorney, searcher or inventor.

Prior to first action, an interview is ordinarily granted only in continuing or substitute applications; a request for an interview is untimely and will not be granted prior to first action in all other applications.

After final rejection, an interview will not be denied merely because a final Office action has been rendered. Normally, one interview after a final rejection is permitted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. In requesting an interview after final rejection, the intended purpose and content of the interview must be presented briefly, either orally or in writing. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or a new search will be denied.

After a case is sent to issue, it is technically no longer under the jurisdiction of the primary examiner (37 CFR 1.312). Requests for interviews on cases already passed to issue should be granted only with specific approval of the Group Director upon a showing in writing of extraordinary circumstances.

The ideal time for personal interviews, during which time an interview is clearly available, is the "Conference Period," which is the time between the filing of applicant's thorough first response to the examiner's first action on the merits and a concluding action by the examiner.

In reexamination proceedings, an interview with the owner is permitted after first action. Requests that reexamination requesters be permitted to participate in or attend interviews will be denied.

Protestors are not permitted to participate in interviews, and the examiner will not communicate in any manner with such protestors.

When an interference has been declared, all questions involved are to be determined *inter partes* and will not be discussed *ex parte*.

Following the grant of a United States Patent, an examiner must refuse to express any opinion or view as to the invalidity of the patent, except on the record in the course of examining a reissue application or a reexamination proceeding. Even in the case of search assistance on an invention, if an examiner is aware that the invention has been patented in the United States, the searcher will be referred to the prosecution file history, and the examiner will make no comment on the appropriateness of the search conducted or the references cited.

No interview regarding an application will be conducted with an attorney who is not registered or who has been suspended or excluded from practice, unless the attorney is the applicant in the application.