

**Paperless Workflow, Office Action Analysis and Patent Examiner Interviews
in the Era of Hoteling, WebEx and Videoconferencing¹**

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July 28, 2013 Seminar

NAPP Nuts & Bolts of Patent Prosecution

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Thanks to Eamon Wall for his reading and helpful comments on this paper.

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Introduction

Believe in interviews, early interviews and desktop sharing interviews. The PTO doesn't care whether you believe, as long as you use interviews, because interviews get us to "yes" in less time, more productively. The PTO has proven that it's worth your while to interview.

Patent examiners do not sit behind desks in Alexandria as they once did. Many of them "hotel." That is, work from home. Even Supervising Patent Examiners (SPEs) are free to work from home at least one day a week. Beginning in Detroit and spreading, many examiners are home based in satellite offices. It may soon be difficult to line up a series of interviews trip to Alexandria, because that may not be where the examiners are.

During Under Secretary Kappos' term, the PTO upgraded its infrastructure to accommodate hoteling. All of the examiners received standard laptops that enable them to work as easily from home as in the office. Rules on hoteling changed to reduce the need for examiners to schedule regular face time in Alexandria. VPNs were set up and phones made to ring at home offices.

Patent attorneys can now benefit from this improved technology. The PTO built a WebEx portal for examiners and patent attorneys to use that integrates voice, video and desktop sharing. A demonstration of this capability is posted on YouTube, on the HBWIP channel. With video and desktop sharing, you can be more effective in a WebEx interview than a face-to-face interview. You don't need to have an office within walking distance of the PTO to fully engage with examiners.

1) The Start – Commissioner Doll's Business Card and WebEx Go-ahead

At that AIPLA meeting in October 2005, Commissioner John Doll talked about the backlog and listened to a pitch for interviews before first office actions, using desktop sharing. Both of these practices are common when trial attorneys work with expert witnesses. The Commissioner handed out an entertaining business card that listed his specialty as "Alchemy and Sorcery." His touch of magic was allowing use of desktop sharing during examiner interviews.

A month later, SPRE Pinchus Laufer wrote early interviews into the new one-year-to-a-patent accelerated examination (AE) program. That was the PTO's first embrace of early interviews.

2) The Metamorphosis of Interviews – Timeline and Remarkable Stats

Fiscal year 2010 marked a radical acceleration in reliance on interviews and early interviews, thanks to training and Director Kappos' decision to give credit for examiner-initiated interviews. Examiners clocked over 138,000 hours of interviews in FY 2010, up 40 percent over the prior year.³ In FY 2012, the goal of 160,000 hours was exceeded – examiners clocked a record 170,000 hours⁴ of interviews. Interviews are here to stay.

³ "How an Improved U.S. Patent and Trademark Office Can Create Jobs," Remarks before the Subcomm. on Intellectual Property, Competition and the Internet, Comm. on the Judiciary, U.S. House of Representatives (January 25, 2011) (statement of David J. Kappos, Under Secretary of Commerce for Intellectual Property, USPTO); Deputy Commissioner for Patents, Peggy Focarino, "PPAC Operations Update," slide 7 of 17 (Dec. 2, 2010).

⁴ Kappos, "An Examination of Software Patents" Center for American Progress Keynote Address (Nov. 20, 2012) http://www.uspto.gov/news/speeches/2012/kappos_CAP.jsp.

Consider the evolution of the MPEP. In 2005, it took an MPEP revision to authorize interviews before the first office action. Through revision 4, the PTO would not acknowledge any paper that requested an interview before the first office action.⁵ After the PTO launched the AE program, it changed the MPEP to allow early interviews, sometimes.⁶ When the PTO realized the benefit of early interviews, it revised the MPEP again⁷, this time to positively encourage early interviews. Unfortunately, the patent bar examination lagged behind the revisions.

Until April 2011, new applicants for the patent bar were tested under the old revision 4 rule, so they memorized the out-of-date, anti-interview rule. In mid-April, 2011, the PTO changed the examination to test new applicants on the current rule⁸ that encourages early interviews.

A series of new programs have relied on interviews before the first action and after final: AE in 2006⁹; FAI pilot program in 2008¹⁰; Enhanced FAI pilot program in 2009¹¹; corps-wide FAI program beginning on May 16, 2011¹²; Track I; and After Final Consideration Pilot 2.0¹³. The early interview programs have impressive statistics on first action allowances.

In the AE program, the PTO has allowed claims in 39.7 percent of 2745 first office actions.¹⁴ Forty percent of the time, the applicant did not need to pay for anyone to respond to an office action, because their accelerated application was allowed after just an interview.

Track 1 does not have reported first action allowance statistics, but they must be eye popping, as the *average* number of office actions to allowance is only 1.2, as compared to 1.7 office actions to allowance for AE applications and 2.7 office actions in other cases¹⁵.

⁵ Manual of Patent Examining Procedure (MPEP) §713.02 (8th ed., rev. 3, Aug. 2005) (“A request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. A request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).”).

⁶ MPEP §713.02 (8th ed., rev. 5, Aug. 2006) (“A request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. ****>**In all other applications, an interview before the first Office action will not be permitted unless the examiner determines that such an interview would advance prosecution of the application. ****>**”).

⁷ MPEP §713.02 (8th ed., rev. 6, Sept. 2007) (“A request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. In all other applications, an interview before the first Office action ****>**is encouraged where< the examiner determines that such an interview would advance prosecution of the application. ****>**”).

⁸ Testing under MPEP, Edition 8, Revision 4 continued until April 4, 2011, beginning April 12, 2011 the exam was updated to match the current version of the MPEP, Edition 8, Revision 8. Announcement posted at http://www.uspto.gov/ip/boards/oed/exam/reg_exam_source_material.jsp.

⁹ Changes to Practice for Petitions in Patent Applications to Make Special for Accelerated Examination, 1308 Off. Gaz. Pat. Office 106 (July 17, 2006); Federal Register, Vol. 71, No. 122, Monday, June 26, 2006, pp. 36323-27.

¹⁰ First Action Interview Pilot Program, 1329 Off. Gaz. Pat. Office 159 (April 22, 2008).

¹¹ Enhanced First Action Interview Pilot Program, 1347 Off. Gaz. Pat. Office 173 (October 20, 2009).

¹² Robert Stoll, email (May 9, 2011). Program described at http://www.uspto.gov/patents/init_events/faipp_full.jsp.

¹³ http://www.uspto.gov/patents/init_events/afcp.jsp. A requirement for AFCP participation is agreement to participate in an interview.

¹⁴ Table accessed at www.uspto.gov/patents/process/file/accelerated/ae_stats_v8_05jan2011.pdf (Jan. 5, 2011), showing first action allowances in 1090 of 2745 first actions.

¹⁵ Max Colice, Matthew A. Smith, and Andrew Cheslock, Expediting Prosecution: Comparing Track 1 Prioritized Examination, Accelerated Examination, the Patent Prosecution Highway, and Petitions to Make Special Based on Age (Dec. 27, 2012) accessed at <http://www.patentlyo.com/patent/2012/12/expediting-prosecution-.html>.

The First Action Interview program reports an overall first action allowance rate of 29.4 percent as compared with 11.5 percent of all original non-continuing applications in fiscal year 2012¹⁶. Earlier statistics ranged from 25 to 56.3 percent first action allowances. The statistics for the initial program in FY 2009 were the lowest. For the phase 2 of the Enhanced FAIP, Commissioner Stoll reported 56.3 percent first action allowances through May 2010.¹⁷ Assistant Commissioner Focarino reported 45.6 percent through August.¹⁸ The blended rate from both programs was 33.5 percent first action allowances, through March 2011.¹⁹ That is, near one-third of all applications in the program were allowed on the first action, over several years.

Outside these programs, first action allowances have plateaued around 12 percent, with variations among TCs. In 2009, Director Wendy Garber quoted a baseline of first action allowances in networking TC 2100 of just 3.9 percent.²⁰ In September 2010, Assistant Commissioner Focarino used 10.9 percent as the baseline.²¹ In January 2011 testimony, Director Kappos used 15.5 percent as the overall first action allowance rate, including the impact of the special programs.²²

With statistics like these, early interviews need to be part of your prosecution strategy. Colice *et al.* have calculated that the reduced cost of office actions is enough to justify the added fee for filing Track 1 applications²³. Applicants are sure to realize that money can be saved on responding to office actions, when many applications are allowed with just an interview.

3) Benefiting the PTO and its Customers – Reducing Backlog

Effective interviews are PTO management’s best tool for reducing backlog by increasing productivity. Here’s a sampling of what Deputy Commissioner Focarino, Commissioner Stoll and Director Kappos said as they launched the interviewing initiative. In an interview with IP Watchdog²⁴, then Acting Commissioner Focarino set the stage:

What kinds of training are you referring to, and whom do you envision doing the training?

Training plans include interview training, training on compact prosecution, search training in both group and an individualized manner, claim interpretation, restriction practice. OPQA staff will deliver some of this training as well as our SPEs, QASs and Patent Training Academy resources.

¹⁶ USPTO, Performance and Accountability Report, fiscal year 2012, p. 18 accessed at <http://www.uspto.gov/about/stratplan/ar/USPTOFY2012PAR.pdf>.

¹⁷ Commissioner for Patents, Bob Stoll, “Enhanced First Action Interview (EFAI) Pilot Program,” remarks to NAPP, July 2010, Slide 16 of 17, *available at* hmbay.com/wp-content/uploads/11-Stoll-EFAI-pilot-7-20-10.ppt.

¹⁸ Focarino, *supra* n. 3, Slide 10 of 17.

¹⁹ Dave Wiley, email with statistics (Mar. 28, 2011) (stats through March 4, 2011); *see also*, Deputy Commissioner for Patents, Peggy Focarino, “PPAC Patents Operations Update,” slide 4 of 11 (Sept. 23, 2010).

²⁰ Wendy Garber, “First Action Interview Pilot Program,” Biotech Customer Partner Meeting, slide 8 of 12 (June 2, 2009) *available at* http://www.cabic.com/bcp/060209/WGarber_FAIPP.ppt.

²¹ Focarino, *supra* n. 3, Slide 4 of 17.

²² Kappos, *supra* n. 3; *see also*, 2010 PTO Annual Report; Focarino, *supra* n. 3, Slide 9 of 17 (16 percent in 2010 vs. 11.8 percent in FY 2009).

²³ Colice *et al.*, *supra* n. 15.

²⁴ Gene Quinn, “An Interview with the Acting Commissioner for Patents,” IP Watchdog, May 12, 2009, <http://www.ipwatchdog.com/2009/05/12/an-interview-with-the-acting-commissioner-for-patents/id=3381/>.

When you talk about interview training, what exactly does that mean?

I have heard a lot of criticism from our stakeholders that many examiners are reluctant to grant interviews, and that when they do grant them there is a reluctance on the part of examiners to make any commitments during the interview. The **interview training will emphasize** to examiners several key practices: **interviews held earlier in prosecution are a benefit to better focus on issues** early in the examination process, **interviews lead to early indication of allowable subject matter**, interview usage later in prosecution may reduce unnecessary RCEs.

Director Kappos testified to a House committee:²⁵

Our new leadership team at the USPTO has undertaken a broad array of efficiency initiatives to improve the speed and quality of patent processing. ... Our first action interview pilot has led to an increased percent of first action allowances. Also, we are pleased to see a **sustained decrease in actions per disposal**, which is an indication that issues are being resolved more efficiently. While the average number has ranged from 2.8 to more than **2.9 in the past few years**, we are now seeing a sustained level of **approximately 2.3 in FY 2010**.

Similar remarks were part of Commissioner Stoll's frequent talks around the country.²⁶

Think about the powerful impact on examiner productivity of reducing the number of office actions that it takes to dispose of an application. The dashboard of the PTO's Data Visualization Center²⁷ gives monthly statistics for the number of office actions required for final disposition.²⁸ The number of actions varied from a high of 2.91 in February-March 2009 to only 2.18 in October 2010. In 2011-12, the number stabilized at about 2.5. At this improved rate, the Office is processing 20% more applications without adding any examiners. Making examiners more productive has a larger immediate impact on pendency than hiring.

Just how far can the PTO reduce the number of office actions? Early statistics on the Patent Prosecution Highway reported an average number of office actions of 1.7.²⁹ The most recent compilation by Colice *et al.* indicates just 1.3. Leading the way, Track 1 requires only 1.2 office actions to reach a final disposition³⁰. Even the Business Methods group has reduced its average number of office actions to final disposition.³¹

²⁵ "House Oversight Hearing," Remarks before the Comm. on the Judiciary, U.S. House of Representatives (May 5, 2010) (statement of David J. Kappos, Under Secretary of Commerce for Intellectual Property, USPTO).

²⁶ Stoll, *supra* n. 17; *see also*, Washington State IPA, [www.wspla.org/washingtonstate\(2\)\(Stoll1-19-11\)\(2\).pdf](http://www.wspla.org/washingtonstate(2)(Stoll1-19-11)(2).pdf); *see also* Colorado Bar Assn., www.ipsectioncolorado.org/content/.../IP_Colorado_Bar_11-12-10.ppt.

²⁷ Data Visualization Center: Your window to the USPTO, Patents Dashboard, February 2011, <http://www.uspto.gov/dashboards/patents/main.dashboard> (last visited Mar. 29, 2011).

²⁸ Actions per Disposal, <http://www.uspto.gov/dashboards/patents/kpis/kpiActions.kpixml> (last visited Mar. 29, 2011).

²⁹ Focarino, "PPAC Patents Operations Update," slide 20 notes (June 18, 2009).

³⁰ Colice *et al.*, *supra* n. 15.

³¹ Separate first action allowance statistics are not available for the Business Methods group of TC 3600, which has a low allowance rate. Director Coggins told the Business Methods Partnership Meeting on September 23, 2010 that the allowance rate for Class 705 had risen to 23 percent, from 17-22 percent in previous years. *See also*, Lemley and Sampat, "Is the Patent Office a Rubber Stamp?," 58 Emory Law Jnl. 101, 125 Appx. A (2008) (16.1 percent allowance rate for class 705, Business Methods).

These statistics should feel dramatic. They demonstrate the benefits to applicants and to the PTO from improved collaboration. A number of prosecution firms have taken up early interviews and gained early allowances³².

4) PTO Retrained the Examiners – Excerpts from Training

High school textbooks on American Government now teach that there are four branches of government, up from the three branches of decades ago. The Bureaucracy is the fourth branch.³³ Whether governmental or corporate, the Bureaucracy dampens reversals of political fortune because bureaucratic inertia slows change. Bureaucracy is one of the reasons that even the “Governator” in California could not turn things around by sheer force of personality. Examiners began changing their interview practices when they were retrained, beginning in 2009.

The PTO retrained the entire examining corps, covering both interviews and compact prosecution best practices. The training was interactive and well received. Follow-up training is ongoing, including training on use of WebEx and desktop sharing interviews.

One of the best ways to anticipate or to redirect examiner behavior is to know what the training materials said. Some of the materials are available on the PTO’s website³⁴ and materials obtained by FOIA request are available elsewhere.³⁵ Here are some of the high points from the interview training:³⁶

- Interviews are an opportunity to **explain rejections**, discuss prior art, clarify positions, and resolve issues.
- Interviews can be useful at **any stage** of the prosecution of an application.
- Interviews can lead to a **better understanding of Applicant’s invention**.
- Interviews can **bridge the knowledge gap** between the Examiner and the Applicant and lead to better understanding of each other’s position.
- Interviews are an effective method for **reaching agreement** and advancing prosecution.
- Have an open mind. **Be receptive to different interpretations of claim** language and prior art during the interview.
- Actively listen and **try to understand Applicant’s position** before drawing a conclusion.
- Interviews promote compact prosecution.

³² Gene Quinn, “A Patent Bigfoot? The Mytical First Action Allowances DO Exist! (Mar. 7, 2012), <http://www.ipwatchdog.com/2012/03/07/a-patent-bigfoot-the-mythical-first-action-allowances-do-exist/id=22628/>. Statistics compiled from PatentCore data identify 50 firms with 74 to 839 first action allowances. Top 50 art units also identified for first action allowances.

³³ See, e.g., Bardes et al., American Government and Politics Today: Essentials, ch. 12 (2011-12 ed.).

³⁴ Recent Examination Guidance and Training Materials, <http://www.uspto.gov/patents/law/exam/examguide.jsp> (last visited Mar. 29, 2011).

³⁵ Interview and compact prosecution training materials are also available at <http://hmbay.com/interviews/>. Useful videos also are posted on YouTube channel HBWIP.

³⁶ Interview Practice Training Summary, Effective Interview Practice, http://www.uspto.gov/patents/law/exam/interview_practice_training_summary.pdf.

The final point foreshadows the follow-up training dedicated to compact prosecution best practices.³⁷

- Applicants and **EXAMINERS should request interviews** to advance prosecution.
- A telephone **interview coupled with an Examiner’s Amendment is a preferred practice** for placing the application in condition for allowance. (slide 5)
- Ex parte Quayle: The examiner should **always attempt to** advance prosecution and **resolve remaining issues through a telephone interview**. (slide 6)
- In instances **where the examiner is aware of a particular amendment that would clearly resolve an issue, SUGGEST IT!** (Examiners without appropriate signatory authority should always verify the suggestion with whoever is signing the Office action). (slide 12)
- Avoid merely listing claim limitations and pointing to a large block of text in the reference. (slide 13)

In 2011, the PTO published a nine-page set of Interview Best Practices that is the best practical guide available³⁸. A copy is attached to this article.

Examiners accept these statements from their training materials as guiding principles. Now, examiners have been directed to view interviews as a collaborative process, to which they should actively contribute.

5) Plan the Lesson with Your Student in Mind

Going into an interview, you know more about your disclosure than the examiner does. Examiners have been trained to listen and learn from you, so prepare a lesson plan tailored to your audience.

Examiner attitudes and allowance rates vary among individuals, as described in a recent empirical study³⁹. After one or two interviews with a particular examiner, you should have a good idea of their personal approach and how to organize your presentation for them. The first time with an examiner is more challenging. Fortunately, there are multiple sources of information about an unfamiliar examiner.

Start by looking at the art unit and signature block of an Office Action. Examiner trainees are in a TC 4100 training unit. A training SPE signs their office actions and attends all interviews during training. Post-academy examiners without signing authority have their office actions signed by a SPE and, later, by a primary examiner. They have no negotiating authority and are usually accompanied at an interview by their SPE. Examiners with partial signing authority will sign on their own rejections. They may be accompanied by a Primary or SPE. At the top of the signing authority ladder are “Primary Examiners.” SPEs decline to attend interviews held with

³⁷ Best Practices in Compact Prosecution, Awareness Workshop, http://www.uspto.gov/patents/law/exam/compact_prosecution.pdf (ALL CAPS as in the training materials).

³⁸ USPTO, “Interview Best Practices” (2011), http://www.uspto.gov/patents/law/exam/interview_best_practices.pdf, Appendix.

³⁹ Tu, Luck/Unluck of the Draw: An Empirical Study of Examiner Allowance Rates 2012 Stan. Tech. L. Rev. 10 (2012), <http://stlr.stanford.edu/pdf/tu-luckunluckofthedraw.pdf>.

Primary Examiners, though the SPE will help you work through issues with a Primary. It is very rare for a SPE to write an office action.

Use your online research service to search by the examiner's name. The easiest way approach is to use PatentCore⁴⁰, a recently developed, unique compilation of historical data regarding examiner behavior. Important statistics to keep in mind include allowance rate, number of office actions to allowance, response to appeals and time to pick up an RCE. The allowance rate and number of office actions to allowance allow you to gauge what is at stake in the interview. The response to appeals and time to pick up an RCE will guide your response to a final office action. If you want to look through relatively easy and difficult prosecutions handled by an examiner, PatentCore supports downloading their history of issued patents with an indication of how many office actions it took in each case to reach allowance. The information about your examiner and their art unit will be useful to you and your client.

Alternatively, Lexis and other search tools have a separate search segment for the examiner's name. You can see how many years they have examined cases and how many they have allowed. You can look in PAIR at the transaction history of sample cases to count the number of office actions and notices of appeal that were required to obtain allowances. You can roughly match their signing authority to their seniority and assess whether they are on the fast or slow track in their career. For junior examiners, you can decide whether to insist on a three-way interview by invoking the MPEP provision that entitles you to have an examiner with negotiating authority present at the interview.⁴¹

Check your docketing system for other cases handled by the same examiner or in the same art unit. Ask a colleague or friendly examiner to tell you a little about the person with whom you are interviewing. Make notes of your interview for future reference.

The first interview with a junior examiner may be complicated by the dynamics of a three-way interview, including their SPE. In a three-way interview, the first five-minute segment demands your utmost attention and flexibility. How is the SPE going to be involved and how do you make the best of it?

The styles of SPEs can be compared to popular actors. Some are like Sean Connery in *Rising Sun*, who sat back and had the junior person conduct the interview. Others are like Jerry Seinfeld, who has a point of view on everything. My favorites are like Andy Griffith in *Ben Matlock*, who had a very modest approach, but was non-committal. Every once in a while, there is a Columbo, as played by Peter Falk, who asks endless questions. During the first five minutes of the interview, you need to size up the SPE and decide how to work with them. After that, a three-way interview should not be much different than a two-way interview, as long as you target the junior examiner as the person to persuade, as the person to draw into discussion.

6) Interviews to Teach Technology and Resolve BRI Issues

There are many issues that may need to be addressed in an interview. An interview should begin with teaching that gives an examiner a new perspective. Typically, the interview progresses to

⁴⁰ <http://patentadvisor.net/search.php>.

⁴¹ MPEP §713.05 (8th ed., rev. 9, Sept. 2012).

issues of the broadest reasonable interpretation (BRI), which benefit heavily from desktop sharing and present the ultimate test of your persuasiveness.

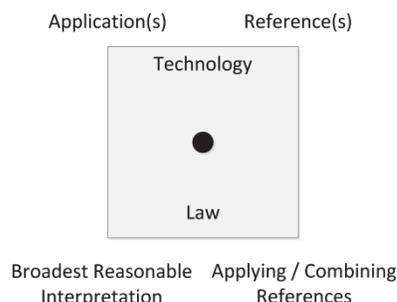
Framing a plan to give the examiner a new perspective depends on selecting the right angle of approach. One way to do this begins by putting a label on the lesson plan. Labels common to section 102 and 103 rejections include:

- art that is not close;
- art with one element missing;
- reference features recombined in an inappropriate way;
- claim misinterpreted by examiner;
- lack of clarity as to how examiner is applying the reference;
- failure to understand the reference “as a whole;”
- needing to sell a narrow distinction over prior art.

Issue labels particular to section 103 rejections include:

- questioning how the examiner proposes to combine the references;
- a proposed combination that defies the common sense, exhibiting hindsight;
- a proposed reason to combine that leads to a different combination;
- when the combination would either destroy or change the principle of operation for the primary reference;
- when objective indicia or secondary evidence apply.

Apply one of these labels to the rejection and it will be easier to construct a lesson plan. The diagram to the right may help you chose a label.



If the examiner has hit the bull’s eye for technology and law and for both the application and references, then it is time to amend. Ask yourself, does the office action demonstrate an understanding

of the application as a whole? Of the references from a problem and solution perspective? Is the examiner’s implied or express interpretation of the claim language broad but reasonable? Has the examiner made the mistake of applying BRI to the references, instead of applying them only for what the fairly discloses?⁴² Is the proposed combination of references a “common sense” combination⁴³ or does common sense lead a different direction, leaving only hindsight as a basis for reaching the proposed combination? Looking for errors in the four corners of the square can make it easier to chose a label and formulate a lesson plan.

A clear idea of what you consider to be the examiner’s mistake will be easier to choose words that will put blue sky between the technology in your claims and the technology fairly disclosed by the cited references, taken as a whole. Careful choice of words and emphasis helps the

⁴² In re Bowers, 359 F.2d 886, 149 USPQ 570 (CCPA 1966); c.f., MPEP 804, p. 800-29 (Rev. 5, August 2006) (quoting In re Bowers).

⁴³ KSR International Co. v. Teleflex Inc., 550 U.S. 398, 416, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007); Leapfrog Enters., Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1161 (Fed.Cir.2007) (citing KSR).

examiner understand the technology disclosed and appreciate the claimed invention. Then, it is just a matter of finding an agreeable claim wording.

The difference between your interpretation and the examiner's can usually be bridged with the right tutorial. Differences of opinion regarding interpretation of claims are inevitable when you combine the examiner's mission, our writing of "flat" patent applications, and time pressure that discourages examiners from studying specifications, especially long and detailed specifications. The examiner's mission is to secure fair notice for the public of the breadth and scope of our claims,⁴⁴ to eliminate the fuzziness. Most of our clients prefer healthy ambiguity. The litigators want flat applications without objectives, advantages or emphasis.⁴⁵ PTO's management is focused on examiner productivity,⁴⁶ subtly leading examiners to ask us to explain why their interpretation is unreasonably broad. A technology tutorial followed by a walk through of the claim language helps you navigate these shoals.

The interview structure in the PTO training materials⁴⁷ provides a good sequence of topics for an argument free interview.

"Suggested Sequence for an Effective Interview

1. Prior to interview, prepare by reviewing the record and the issues identified in the agenda. Discuss with your SPE or Primary Examiner if applicable.
2. At the interview, give the applicant an opportunity to explain the invention [technology disclosed]⁴⁸ and the novel features, and discuss the issues outlined in the agenda.
3. Openly discuss how inventive concepts are [the technology disclosed is] relayed or not relayed in the claims.
4. Discuss prior art and rejections.
5. Seek to establish common ground and understanding."

This structure minimizes argument, which is the bane of interviews. While lawyers and examiners love to argue, a spirited argument has spoiled many an interview by using up the available time⁴⁹ and challenging the examiner to defend a mistaken position.⁵⁰ Provoking the

⁴⁴ MPEP §§2106, 2164.08, 2171-72 (8th ed., rev. 6, Sept. 2007).

⁴⁵ Patent Resources Group, *Crafting & Drafting Winning Patents*, <http://www.patentresources.com/Courses.aspx?link=Crafting+%26+Drafting+Winning+Patents>.

⁴⁶ Production system explained in Request for Quote (RFQ) and Statement of Objectives (SOO), Patent Examiners Production Expectancy Goals Re-Assessment and Adjustment, at 5-8 (May 15, 2009), *available at* https://www.fbo.gov/?s=opportunity&mode=form&tab=core&id=e98904cdb91b9eac6ab56cb9fc747f7e&_cview=1 (Solicitation No. DOC52PAPT0901021) and http://www.uspto.gov/about/vendor_info/current_acquisitions/pgshom_rfqsoo.doc (actual RFQ).

⁴⁷ Interview Practice Training Summary, *supra* n. 36, at 2.

⁴⁸ The author urges you to be consistent and careful about discussing the technology disclosed and to avoid reference to the inventive concept, the point of novelty or anything similar during the technology tutorial, unless you have a good reason to do so.

⁴⁹ MPEP §713.01 (8th ed., rev. 9, Sept. 2012) ("It is the responsibility of both parties to the interview to see that it is not extended beyond a reasonable period, usually not longer than 30 minutes."). In practice, 50-60 minutes will be allowed by most examiners, if the examiner considers the interview beneficial.

judge sometimes works on a TV show, for James Spader in *Boston Legal* or Kathy Bates in *Harry's Law*, but it seldom works with examiners.

In item 2 of the interview structure, the PTO suggests beginning with what a District Court judge would call a technology tutorial.⁵¹ In prosecution, this tutorial is much less elaborate than in litigation, because there typically is little or no budget. So, a patent prosecutor uses the figures in the patent application.

The key to a successful tutorial is to select your vocabulary carefully and to emphasize disclosed features that are not found in the references. Select your vocabulary to match key terms in the claims. Use this vocabulary to explain figures from the application. Find the passages in the specification that give meaning to key terms and be prepared to show the examiner those passages.

The advantage of a tutorial is that you don't need to reference the claims in a five to ten minute tutorial. You can provide technical background without provoking an argument. Practiced use of the key terms makes your vocabulary clear enough to satisfy the public notice function. Preparation for the tutorial identifies terms in the claims that require special attention. The language used during the tutorial should create "daylight" between the claim language and references of record, without trying too hard, creating an understated sense of indisputable truth. Ask the examiner easy questions as you go through the tutorial, to keep her engaged. Remember, if the examiner is not saying anything, you have no way of knowing whether you are being clear and convincing.

Some interview practice pointers should reduce your litigator's anxiety. Stick to describing the technology disclosed, rather than the point of novelty or the invention, unless you have a good reason. Focus on your technology, rather than the cited references. From the technology tutorial, move on to claim language.

Item 3 of the PTO's interview structure suggests walking through the claim language.⁵² You need to choose which claim(s) to use and whether to walk through whole claims or just selected elements. For software, the first independent method claim is usually a good choice, unless it is too broad. Sometimes, you will need to walk through the claim and reach the last element to get to the all-important innovation. In the author's experience, if the last element is key, the examiner might have taken a position on patentability based on familiarity of the opening claim

⁵⁰ Fisher and Ury, *Getting to Yes*, at 52 (2d ed. 1991) (Surprisingly often "the argument is carried on as a ritual, or simply as pastime. Each is engaged in scoring points against the other or in gathering evidence to confirm views ...").

⁵¹ For discussions of technology tutorials in litigation, *see, e.g.*, Snow and Reed, "Tutorials in Patent Litigation: Educating District Court Judges," *Intellectual Property Litigation* (Fall 2009), available at http://apps.americanbar.org/litigation/litigationnews/practice_areas/intellectual-patent-district-court.html; Eyre et al., *Patent Claim Construction: A Survey of Federal District Court Judges*, 17-19 (Federal Judicial Center, Feb. 2008), available at <http://ftp.resource.org/courts.gov/fjc/patclaim.pdf>; Model Scheduling Order, District Court of Delaware, p. 5, at ¶9, available at http://www.ded.uscourts.gov/MPT/Forms/Rule16_Sched_Order-Patent.pdf.

⁵² Thanks to Supervising Patent Examiner Beth Boswell in the Business Methods group, who steered a contentious series of office actions away from debating the references to working on wording that captured patentable subject matter. Once we focused on the claim wording *ex* references, we made good progress.

elements. In that circumstance, your credibility benefits from conceding as you go that some of the claim elements are found in the prior art or, at least, not arguing otherwise.

Do not underestimate the impact of examiner fatigue on claim analysis. It is not uncommon with a long claim for later elements to be overlooked and given no patentable weight, especially when the earlier elements are familiar.

Walking through the elements, a good way to interact with the examiner is to ask questions, such as “how broadly do you read that element?” or “do you think that that wording fairly captures the technology that we disclosed?” or “how would you word this element to capture the technology that we explained?” Again, you need to engage the examiner in discussion. This is easiest to do before you get to the key elements, because both you and the examiner will be more relaxed and have less at stake. Be prepared to adjust the claim language and especially to make an amendment that does not narrow the scope of the claim,⁵³ in order to demonstrate your willingness to collaborate.

Walking through the claim language sometimes reveals a hidden difference in understanding that would never surface in a written exchange. In one instance, the examiner considered one word in the claim to be a verb, while the author considered it to be an adjective, part of a noun phrase. The meaning of the claim element depended on this grammatical difference. Once we figured out what separated us, we laughed and easily resolved our differences. Those 30 minutes of discussion both settled our differences and established a rapport that proved valuable in subsequent cases.

This author estimates that executing items 2 and 3 well avoids the need to reach item 4 more than half of the time. It is remarkable how often a well-constructed tutorial followed by walking through the claim language resolves all of the issues (subject to the inevitable update search.) Half of the time, the references of record are not discussed or characterized. Then, the interview summary accurately reflects the figures used in the tutorial, any amendments made, any paragraphs of specification that were used to explain claim terminology, and that the references of record were not discussed.

7) Permission to Use Desktop Sharing

Unambiguous approval for anyone to use Adobe Connect for desktop sharing came in an email from SPE David Wiley dated April 30, 2010. Mr. Wiley⁵⁴ is the liaison between Deputy Commissioner Focarino’s PTO operations and the Office of the Chief Information Officer (OCIO). His email⁵⁵ said that the PTO had “never discouraged or restricted any others from using the program,” which would seem to be a non-event, a non-decision, but for the executives copied. He copied this email to Commissioner Stoll, Deputy Commissioner Focarino, Director Coggins, Chief of Staff Hirshfeld, and OCIO PE2E Team Lead Schmidt, among others. To be

⁵³ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002)(*Festo VIII*) (“a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to estoppel.”); *see also, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359 (Fed. Cir. 2003)(*Festo IX*).

⁵⁴ Thanks to Dave Wiley for help with the statistics used in this talk. Of course, any errors in recounting the statistics are the author’s, not Mr. Wiley’s.

⁵⁵ Email from David Wiley, SPE (April 30, 2010), available at <http://hmbay.com/wp-content/uploads/2010-04-30-SPE-Wiley-approval-email-00236817.pdf>.

clear, the email says that the examiner needs to agree to use of desktop sharing, but that has only been a problem with examiners that did not receive our introductory package, which references Mr. Wiley's helpful email.

The 2010 Patent Public Advisory Committee Annual Report suggested PTO approval for the use of desktop sharing, without limitation to Adobe Connect.⁵⁶ “[T]he USPTO has accepted desktop collaboration as a tool for enhancing telephonic interviews and for reducing the need for hoteling Examiners to travel to the Office for interviews. . . . It was reported that Examiners will appreciate this tool as an effective adjunct in the interview process, particularly when crafting amended claim language.” Following release of the PPAC report, the PTO offered examiners training in use of Adobe Connect and contracted to use WebEx in the future. The OCIO recently has confirmed that use of WebEx is on the same footing as Adobe Connect for use in examiner interviews.⁵⁷

In 2011, the PTO resumed using WebEx and trained every examiner in how to use WebEx when hoteling and in interviews. The PTO now provides instructions on how to join a WebEx interview initiated by an examiner.⁵⁸ A demonstration video⁵⁹ is available that shows how the applicant's representative shares their desktop when the examiner initiates the WebEx session. While the PTO would prefer for security reasons to have examiners to initiate interview using the Office's customized platform, it may be 2014 before examiners are comfortable with doing so. In the mean time, be prepared to invite the examiner instead of expecting an invitation. If your firm does not have a privately branded WebEx site, get yourself a free account⁶⁰.

Consider sending an introductory email with a desktop sharing link at least two days before the interview, so the examiner has plenty of time to feel comfortable with the process⁶¹.

8) Catching the Wave – Informal First Action Interviews

Timing of an early interview is tricky for interviews before a first office action in applications that are not part of the FAIP, EA or Track I programs. Outside the organized programs, the practitioner needs to figure out the right time for an early interview, instead of relying on the examiner.

The obvious timing hint is not accurate enough. Private PAIR includes a tab for “First Action Prediction,” which can be off by more than six months.⁶² Any application that is within six

⁵⁶ Patent Public Advisory Committee Annual Report 2010, 1-51, at 42 (Nov. 1, 2010), *available at* http://www.uspto.gov/about/advisory/ppac/ppac_2010annualrpt.pdf. (Omission of reference to Adobe Connect was intentional, after discussion between PPAC and PTO staff, according to a personal communication between PPAC member Benjamin Borson and the author.)

⁵⁷ Personal communication with OCIO Chief of Staff Scott Williams (March 28, 2011).

⁵⁸ Web Conferencing and Collaboration, *available at* http://www.uspto.gov/patents/resources/web_conferencing.jsp.

⁵⁹ Demonstration Interview with Examiner Choi, *available at* <http://hmbay.com/napp> and on YouTube channel HBWIP.

⁶⁰ WebEx Meetings Basic, for free, *available at* <http://signup.webex.com/>.

⁶¹ Sample materials introducing desktop sharing to an examiner are posted at <http://hmbay.com/napp>.

⁶² Unrelated to interviews, recorded in the transaction history, a wildly distant First Action Prediction should be discussed with the art unit's SPE. Similarly, any case that has been the subject of multiple transfer requests, recorded in the transaction history, should be discussed with the art unit's SPE and escalated to the responsible Director (who will refer it elsewhere) if the SPE is frustrated with unwillingness of another art unit to take over the case.

months of the predicted first action deserves a telephone inquiry to the assigned examiner, if an interview before the first action is desired.

To be more precise about timing, experience indicates that a telephone inquiry is appropriate as soon as an application is assigned to a working examiner. As of this writing, an application is first assigned to an art unit by OIPE. When it is “dispatched” to an examiner by OIPE in the transaction history, it is assigned to the art unit’s SPE, who will assign it in turn to a working examiner. When the SPE assigns it, the examiner name under the “Application Data” tab of PAIR is updated with the name of the working examiner. The pattern of assignment is determined by the SPE. Some SPEs assign groups of ten cases at a time, which gives their examiners flexibility. Accordingly, the time between assignment to a working examiner and a first office action may vary between two weeks and three months. It typically is less than six months. The best time to make an inquiry is when PAIR indicates that a working examiner has been assigned.

Unless the examiner involved is familiar to you and your staff, calling the examiner until they answer the telephone is better than communicating through voicemail. When you reach the examiner, you need to ask when they would find an interview useful, as opposed to whether they would be available. Interviews are most productive in that one-week period between the examiner’s initial search and when the office action is written. Before that, the examiner will be unfocused; you are unlikely to realize the productivity of the FAIP. After that, you have the office action in hand. By voicemail, the easy thing for the examiner to do is accept whatever time frame you seem to want. In a conversation, you have the opportunity to sell the examiner on informally following the FAIP model, without requiring anything more from the examiner than identification of a reference or two from the preliminary search. This takes less work than participating in the FAIP and allows the examiner to earn two “counts” by issuing a notice of allowance.⁶³

Avoiding a deadline faced by the examiner is important to a first action allowance. Your timing needs to be responsive to the examiner’s calendar, before the deadline for mailing a first action approaches.

Alternatively, in April 2011, the PTO added a new document type to EFS for requesting an interview. Commissioner Stoll confirmed that you could request an early interview using this EFS document type and expect it to receive the examiner’s attention, even without joining the first action interview (FAI) program.

The current rate of first action allowances makes it safe for examiners in many Art Units to generate a first action allowance, which would have been difficult a few years ago. Expect the examiner to consult with others before issuing a first action allowance. Allowance may take two interviews, one 15-minute interview that helps focus the examiner’s search and a second that addresses the best art found. If you credibly are prepared to amend the claims as required by art,⁶⁴ a first action allowance is often doable, even without being enrolled in the established programs.

⁶³ Patent Examiners Production Expectancy Goals Re-Assessment and Adjustment, *supra* n. 46.

⁶⁴ The reader should not assume that applicants receive allowances without amendments, as Rick Nydegger commented in a recent discussion. In the author’s experience, an interview against art selected by the examiner

While this approach is tedious, the reward of a first action allowance is worth the effort. Examiners know the statistics for the FAIP. They have explicit permission to initiate interviews and collaborate with customers before a first office action.⁶⁵ They receive full credit of two counts for disposal of the application, without having to write up a rejection, if they work with you to put the claims in condition for allowance. This incentive can be pointed out when arranging the interview and should not be underestimated.

An interview before FOAM can anticipate specific rejections are reasonably foreseeable, such as a rejection due to a crowded art field, admitted prior art, recent IDS, or prior experience with Examiner. A preemptive discussion can eliminate one or more rounds of rejection with corresponding savings in office action response and reduction in grist for prosecution history estoppel. A preemptive discussion can explicitly acknowledge the likely rejections or adapt the technology tutorial in a BRI interview to forestall the rejections.

9) How-to Guide for Paperless Workflow During Office Action Analysis that Supports Desktop Sharing without Extra Work

It takes a few hours of experience or practice to master use of a desktop sharing for an interview. This is a skill that is worth learning, because you can apply it to office action analysis, interviews, licensing discussions, BPAI appeal appearances and even inventor interviews. Desktop sharing deserves a place in your toolbox.

This section walks you through the mechanics of analyzing an office action in a format that prepares you⁶⁶ to share your desktop and reveals a number of subtle tricks that make your presentation seamless and entertaining, both to experienced examiners who will have seen nothing like it and to younger examiners of the YouTube generation. A posted video⁶⁷ illustrates the analysis process described below.

Analysis of an Office Action can use the same titling, bookmarking and cross-linking techniques as desktop sharing interviews. With the right analysis technique, preparation for an interview is nearly complete by the time that you have analyzed the grounds of rejection.

This is a paperless workflow. Acrobat works best for analysis if you open the preferences dialog and override some defaults. First, uncheck the "document cross-links open in new window". If you don't, the office action will close when you link to the cited passage. Second, change the PDF archive "slash A" preference to never view documents in archive mode. In archive mode, you can't edit, link or annotate documents. Next, configure the Acrobat icon bar with frequently used buttons. Here are the buttons that I use the most. Get rid of seldom-used buttons, to make it easier to find the button that you need.

requires as much preparation as planning a response to an office action. The efficiencies realized include knowing that you have satisfied the examiner and writing an interview summary, instead of an argument.

⁶⁵ The 2009 reform of the count system included allowing an hour of "other time" for examiner-initiated interviews. Before the reform, examiners only received credit for applicant-initiated interviews. Following the reform and retraining, examiner interview hours increased 40 percent year-over-year!

⁶⁶ The first draft of this section was adapted from the How-to Guide accessible at <http://hmbay.com/wp-content/uploads/set-up-and-conduct-adobe-connect-102510.pdf>.

⁶⁷ Office Action Analysis Using Acrobat Bookmarks and Links, *available at* <http://hmbay.com/napp> and on YouTube, channel HBWIP.

Open the Office Action and the references on which the examiner relies. Set up individual documents with sensible titles. Acrobat's default is to show a document name, instead of title. Office Actions stored in document management systems have cryptic eight-digit number names, like this. Number names are worthless for navigation, especially during interviews, so use Acrobat to embed document titles. Go into document properties; override the default so that the title bar shows the document title instead of name. Give each document a meaningful title. Your new title will show up in the title bar at the top of the screen and in the windows pull down menu pick list. Set the document to open with "Bookmarks" showing.

All of your PDF documents should be OCR'd, especially the office actions. Acrobat does this for you with just a couple of clicks.

The first analysis step involves applying bookmarks to the Office Action that outline the text. Section titles and principal arguments in the Office Action can easily be bookmarked. Acrobat automatically copies text highlighted text into a bookmark. Shorten each bookmark so that it is only 4-5 lines long. If a bookmark doesn't point to quite the right place, reset it. Make sure that you apply bookmarks at the end of the office action, even if you skip a few pages in the middle, because the good news is always at the very end. Examiners identify allowable subject matter and offer hints on the last page or two. If you start working on the rejections before you see the good news, you waste a lot of time.

Cross-linking analysis follows bookmarking. The best analytical tool that Acrobat provides is the cross-link to another document. Cross-link or jump link analysis connects the examiner's citation to the actual reference. Once the link is in place, it is easy to see whether there is good support for the examiner's argument. The first link points to the cover page of the reference. Later links point to passages. Lassoing cited passages with red rectangles makes it easy to read, easier for my eyes than highlighting. Use just a little highlighting, for key words in a longer passage.

When you use bookmarks and cross-links to analyze the office action, you get most of the interview preparation for free. Bookmark and cross-link analysis prepares your document for a WebEx interview, by making it effortless to show the examiner the right document, turn to the right page and frame the right passage.

The only added effort to move from analysis markup to interview readiness is a few special zooms and selection of key figures from the application. Special zoom bookmarks make key passages and figures easier to find and read. Documents being used benefit from bookmarks for instant access to important figures and passages. These bookmarks can double as a path through your tutorial. It is useful for figures and passages to have links (hyperlinks) that allow you to jump directly to the relevant support. This also works for linking an office action to passages in references on which it relies.

If you are using non-patent literature (NPL) references that were printed from web pages, then scanned from the printed pages, consider generating a PDF directly from the web page, so the NPL will be more legible. Have both versions available, in case you need to answer questions about why your version looks better (different) than the examiner's version.

It is helpful to have two screens when you are sharing your desktop. One screen should be about 1200 by 1600 pixels, to match the screen resolution of examiners' desktops. The shared screen

should have the some orientation – portrait or landscape – as the examiner’s screen. Your desktop sharing tool should only share one screen, leaving the other screen available for staging content, while the examiner is looking at what is on display. If you love technology, consider getting a touch screen that functions like football commentator John Madden’s board, so that you can draw on the screen with a stylus and have the examiner immediately see your annotations.

Practice with a colleague before experimenting on the examiner. Learn the keyboard shortcuts for navigation among documents. In Windows: <alt-tab> cycles between programs; <alt>w<#> selects a particular document. In OS X: <cmd-tab> cycles between programs; <cmd-`> cycles among documents in a particular program. Have your colleague ask you a question and respond by switching to the document figure or passage that answers the question, until you can do it smoothly. You should consider the switching smooth when the change takes three seconds or so, and you are using keystrokes or bookmarks instead of remembering the page number or guessing. Get used to the lag time between changing what appears on your screen and when the examiner sees the new image.

On the day of the interview, get ready 20-30 minutes before the call. Select all of the documents that you are likely to use. This includes the application and figures, office action and references all in PDF format. It also includes the claims in an editable word processor format and sometimes the application in an editable format. Make sure that all of the selected PDF documents are open and that your bookmarks take you to the right page, opened at the right size to be easily readable. Have the bookmarks showing within an easy mouse gesture. Write out a cheat sheet that lists where everything can be found. Make sure your word processor has the claims loaded and change tracking turned on. Verify, after you start the session, that the desktop sharing option to enable “full screen” display by the examiner is selected. Then call the examiner. When she answers the phone, don’t start the substance of the interview until you have accepted her into the meeting and she confirms both that she is viewing your screen and is using “full screen” display mode.

Following these mechanical steps, you should be well on your way to a productive desktop sharing session with your examiner.

During the interview, keep in mind the following protocol. NEVER ask the examiner to share their desktop. The PTO prohibits this or should. You are better off typing anything that the examiner suggests, than giving the examiner control of your keyboard, because the lag time is awkward for the examiner. Your anxiety level will be lower and the results more predictable if you do the typing.

Notwithstanding the productivity of desktop sharing interviews, it is worthwhile to take one or two interview trips to the PTO to meet your examiners. Examiners are people who are as varied as the rest of us. The best way to see this is at the PTO. Even if you only have coffee or shake their hands, the personal connection makes the process more fun and productive. Once you meet your examiner, desktop sharing will be even more powerful.

10) Demonstration of Desktop Sharing and a Structured Interview

An interview demonstration⁶⁸ shows seamless handling of content that is being displayed to the examiner, using the content displayed to focus the discussion. Jump links, bookmarks and keystroke document shifting are all demonstrated, as well as interactive features.

Annotation is a useful interview dynamic. For instance, annotate the figures to emphasize elements and to make the interview interactive. While looking at claim language, highlight one phrase at a time as you discuss the phrase. When negotiating revised claim language, use change tracking to show the examiner the revised language as you type. This substantially increases the likelihood of reaching an agreement.

The author's experience is that desktop sharing interviews are more effective than in-person interviews. Enhanced telephone interviews have several advantages. First, many patent attorneys and examiners are shy.⁶⁹ Telephone interviews avoid the awkwardness of face-to-face conversations, while pointing at figures or passages across the desk. Working on the telephone allows the participants to focus on technical issues, instead of their demeanor.

Second, desktop sharing of images can be more persuasive than in-person presentations. As compared to a telephone interview, it is much easier to discuss a figure when you know just where the examiner is looking. As compared to an in-person interview, desktop sharing allows a faster and better-controlled progression through the figures, with control over how each figure appears on the screen. You can rapidly move through documents and sections of documents using bookmarks and embedded links. It is much easier to refocus attention using desktop sharing and jump links than to reach across a desk and flip pages that are upside down.

Third, desktop sharing makes amended language visible as you type, which keeps the examiner engaged. More often than not, the examiner makes an alternative suggestion, which opens a dialogue. Engaging in a dialogue does not commit you to making the amendment discussed; it reveals the examiner's thinking, which is crucial to being persuasive. In law school, Professor Amsterdam taught that an effective appellate argument requires eliciting questions from the panel. Without hearing the judges' questions, you can only guess how to persuade them. The same applies to examiner interviews. If an examiner does not talk about their concerns, if they only listen politely without speaking, there is little chance of changing their minds. Desktop sharing helps generate dialogue that opens the door to persuasion.

In the near future, in-person interviews may be unavailable, due to hoteling and regional offices. The lawyer who shows up at PTO headquarters in Alexandria for an interview may find themselves sitting in a video conferencing room and communicating with an examiner in the same way that they could from their desktop!

11) Conclusion

Consider the possibility that desktop sharing is a better way to conduct examiner interviews than in-person or videoconference interviews, because it frees both participants to focus on the technical substance and precise claim wordings at issue. Desktop sharing puts you and the

⁶⁸ Demonstration Interview with Examiner Choi, *available at* <http://hmbay.com/napp>.

⁶⁹ In colloquial terms, patent attorneys are sometimes "on the scale," like the character Jerry in *Boston Legal*. Patent attorneys and examiners who prefer working on their own can find in-person interviews stressful.

examiner on precisely the same page and lets you turn the page to material that supports your position at a pace that you control. Engaging in a desktop sharing interview before the first office action is very likely to produce a first office action allowance and to make an examiner happy to work with you.

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