

PIPLA NEWS

The official newsletter of the Pittsburgh Intellectual Property Law Association

FEBRUARY BREAKFAST MEETING & CLE

Wednesday, February 18, 2015

Rivers Club
One Oxford Centre
301 Grant Street, Ste. 411 (Allegheny Room)
Pittsburgh, PA 15219
Phone: 412-391-5227

Time: 8 A.M. (Buffet)

Payment Required - \$30-Lunch / \$20-CLE. Check payable to PIPLA. Mail to:

PIPLA
c/o The Webb Law Firm
One Gateway Center, Ste. 1200
420 Ft. Duquesne Blvd.
Pittsburgh, PA 15222

OR Paypal via website: www.piplaonline.org (click on "February 18, 2015 Breakfast Meeting & CLE"). Please RSVP by February 13th; late RSVPs contingent upon seating/meal availability with an additional \$20 fee.

Speaker: Mark Schildkraut, Sr. IP and Worldwide Cybersecurity Counsel at Becton, Dickinson Company, Franklin Lakes, NJ

The title of Mr. Schildkraut's talk will be "*Information Security: Protecting Us from Within*"



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2015 Inventor of the Year Award Nominations

The Pittsburgh Intellectual Property Law Association announces that it is accepting nominations for its 2015 INVENTOR OF THE YEAR AWARD.

The INVENTOR OF THE YEAR AWARD is awarded annually to honor living inventors whose patented inventions have a significant impact on the economy, the social wellbeing, and the advancement of technology. To be eligible, an inventor or team of inventors must reside or work within, or have some special connection to the Pittsburgh tri-state area.

Nominations may be made on the basis of one or more issued United States Patents, regardless of date of issue. It is not necessary that all of the inventors named on the patents on which a nomination is based be included in the nomination. Inventors who were nominated in prior years may again be nominated.

A plaque recognizing the Inventor of the Year will be presented to the winning nominee at the April 15, 2015 luncheon meeting of the Association.

NOMINATIONS MUST BE RECEIVED NO LATER THAN March 30, 2015. Nominations forms are available on the PIPLA website.

Interview with Ex-Examiners of the USPTO

Sometimes it is useful to get an alternative perspective so we asked a couple former UPSTO Examiners for their thoughts on some common patent prosecution-related questions.

Michael P. Alexander (MPA) is a Senior Associate at The Webb Law Firm. Michele K. Yoder (MKY) is a Patent Agent at The Webb Law Firm. Both Michael and Michele worked as Examiners at the USPTO. Thanks to them for providing very insightful answers!

Q1. How long did you work as an Examiner and with which Art Unit?

MPA: For almost two years, I reviewed metallurgical and electrochemical patent applications in former Art Unit 1742, which is now 1733 (metallurgical) and 1754 (electrolysis). It was enough time to see a healthy number of patent applications go through the examination process to allowance or appeal.

MKY: 9 years, 2 as a primary examiner, in art unit 131, which is now art unit 1746. Specialized Chemical Engineering processes and apparatuses.

Q2. What attorney/agent practices got on your nerves as an Examiner?

MPA: Asking for an amendment after final containing a new feature to be entered without an RCE.

MKY: Not being prepared for telephone interviews and being argumentative during the interview. Preparing the response and glossing over the rejection and/or not addressing the combination of references. Citing a multitude of court cases or the MPEP in the rejection. Most Examiners are not attorneys. They will not read the court case. Also, every Examiner knows the MPEP very well. They read it all the time. They don't need you to recite it to them.

Q3. What attorney/agent practices helped streamline your examinations?

MPA: The best way attorneys/agents streamlined my examination process was to submit overly broad claims. If they were extremely broad, I might know of an anticipatory reference immediately after reading the claims. The goal of an attorney/agent is to complicate, rather than streamline, the examination process by submitting claims that are difficult to reject.

MKY: Writing a quick summary of the rejection before launching into the arguments. Keeping the response as short as possible, while thoroughly addressing the rejections. When responding to a novelty rejection, quickly list the features not shown in the reference. When responding to an obviousness rejection, attack the combination as soon as possible in the rejection, then add your supporting arguments.

Q4. What is the single biggest mistake you saw in submitted applications?

MPA: Typos, sometimes in enormous quantities.

MKY: Bad drawings.

Q5. In your opinion, what is the most effective tone to take when responding to an Examiner's rejection(s)?

MPA: Respectful. Even during my short tenure as an examiner, I received responses that were inappropriate in tone. The most offensive were passed around the office.

MKY: Argue your position, but use a nice tone. Put yourself in the shoes of the Examiner. You have the assistance of the inventor. They do not. They might not be very familiar with the technology and may have made a mistake when writing the Office Action.

Q6. At what point is it appropriate and useful to contact the Examiner's Supervisor?

MPA: Great question. The most appropriate time to directly contact a supervisor is when there is a non-substantive issue that is causing problems with the application. If an examiner is being

unreasonable in regards to substance, the best way to involve a supervisor is to request their attendance at an interview with the junior examiner.

MKY: Never.

Q7. What arguments are most convincing to an Examiner when traversing a restriction requirement?

MPA: That search and examination of all the claims can be made without serious burden. Just kidding. I don't know the answer.

MKY: It is pretty rare for an Examiner to withdraw a restriction requirement, no matter what has been argued. Sometimes a species requirement will be withdrawn or modified if you can show that you have a generic claim. If there is no generic claim, the Examiner will often let you add one.

Q8. How does one maximize the usefulness of a phone interview with the Examiner to further prosecution?

MPA: It depends. Early in the examination process, the goal might be to better understand the Examiner's thinking, in which case I might prepare a number of talking points to develop a conversation.

Later in the examination process, my goal might be to obtain an Examiner's commitment, such as a commitment that a proposed amendment will overcome the known prior art, which is particularly valuable if the amendment will require an RCE. In that scenario, I would keep the interview simple and focused on the most important issue.

Including an inventor in an interview is helpful to emphasize the importance of a patent application. As an examiner, I wanted to believe that my job was important and that my decision would have a great effect. If an inventor took the opportunity to explain the importance of the technology, then I was more likely to call the attorney/agent with suggested amendments to fulfill my destiny as a granter of important patents.

MKY: A few days prior to the interview, email your proposed claim amendments and/or a brief paragraph summarizing the arguments.

Q9. Any final advice on interacting with Examiners?

MPA: After leaving the USPTO, I practiced in Washington, DC, for five years, so I was only a 25 minute Metro ride from the King Street Station in Alexandria. Although time-consuming, I believe the best way to advance prosecution in a difficult application is to conduct an in-person interview. As opposed to a telephone interview, the expectation of all parties is that an in-person interview will last much longer than a telephone interview. It's not outrageous for an in-person interview to last for an hour or longer. This extra time permits good things to happen.

MKY: Just be nice and use common sense. If you are talking with them on the telephone and you know they have a valid point, let them know you agree with them. If the interview was helpful, let them know that too. When writing responses, invite them to contact you if they believe an interview will advance the prosecution of the application.

FROM THE NEWSLETTER COMMITTEE

We hope you've enjoyed this issue of the 2015 PIPLA News, an informative and hopefully entertaining look at the goings on in IP law. We invite our entire readership to contribute to this endeavor with articles, announcements, and job postings of your own. If you have something you would like included in PIPLA News or have questions about how you can contribute, please contact Ying Cao at 412-394-9575 or at ycao@jonesday.com.

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