

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**

**uspto**

# Professional Responsibility and Practice Before the USPTO

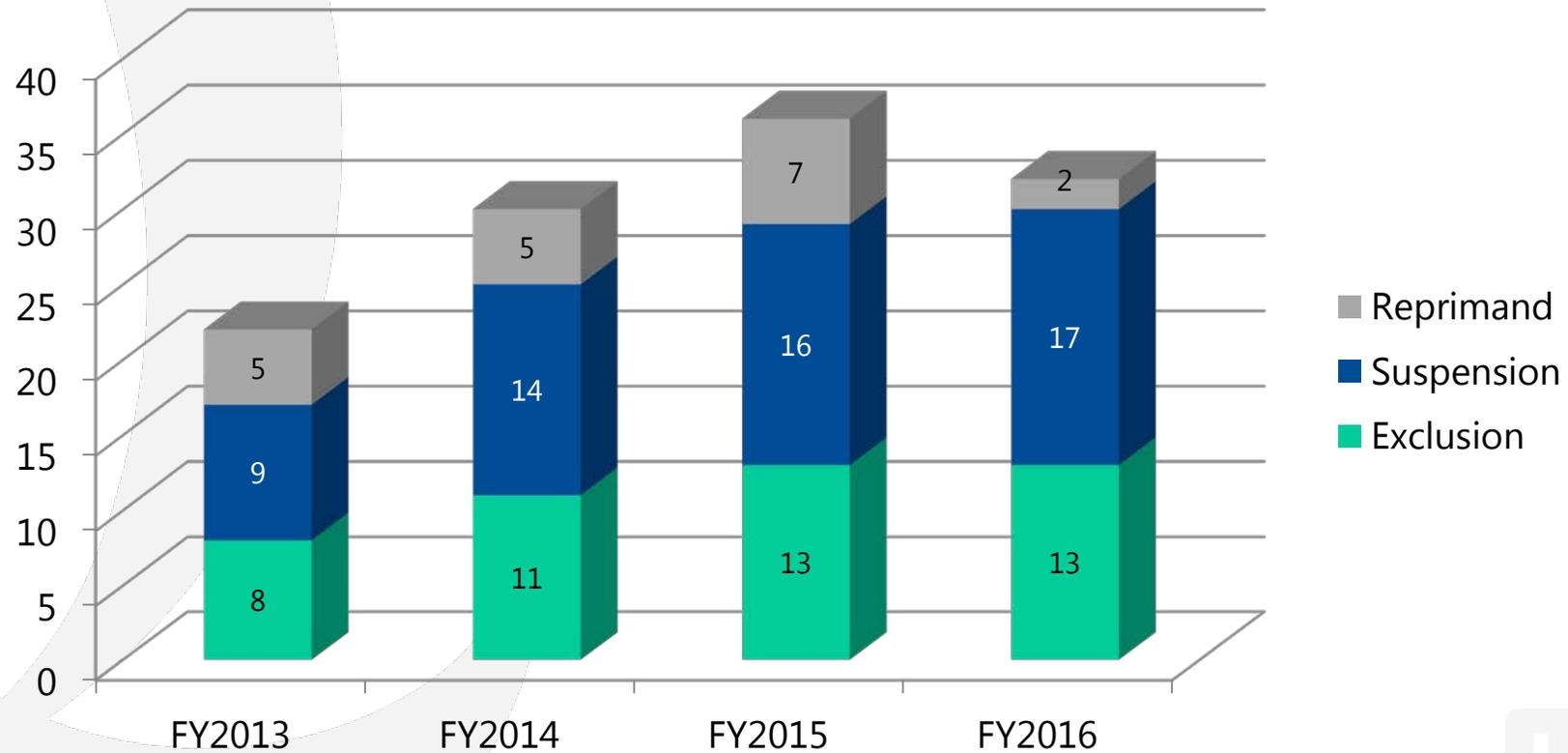
**William R. Covey**

Deputy General Counsel and Director  
Office of Enrollment and Discipline

UNITED STATES  
PATENT AND TRADEMARK OFFICE

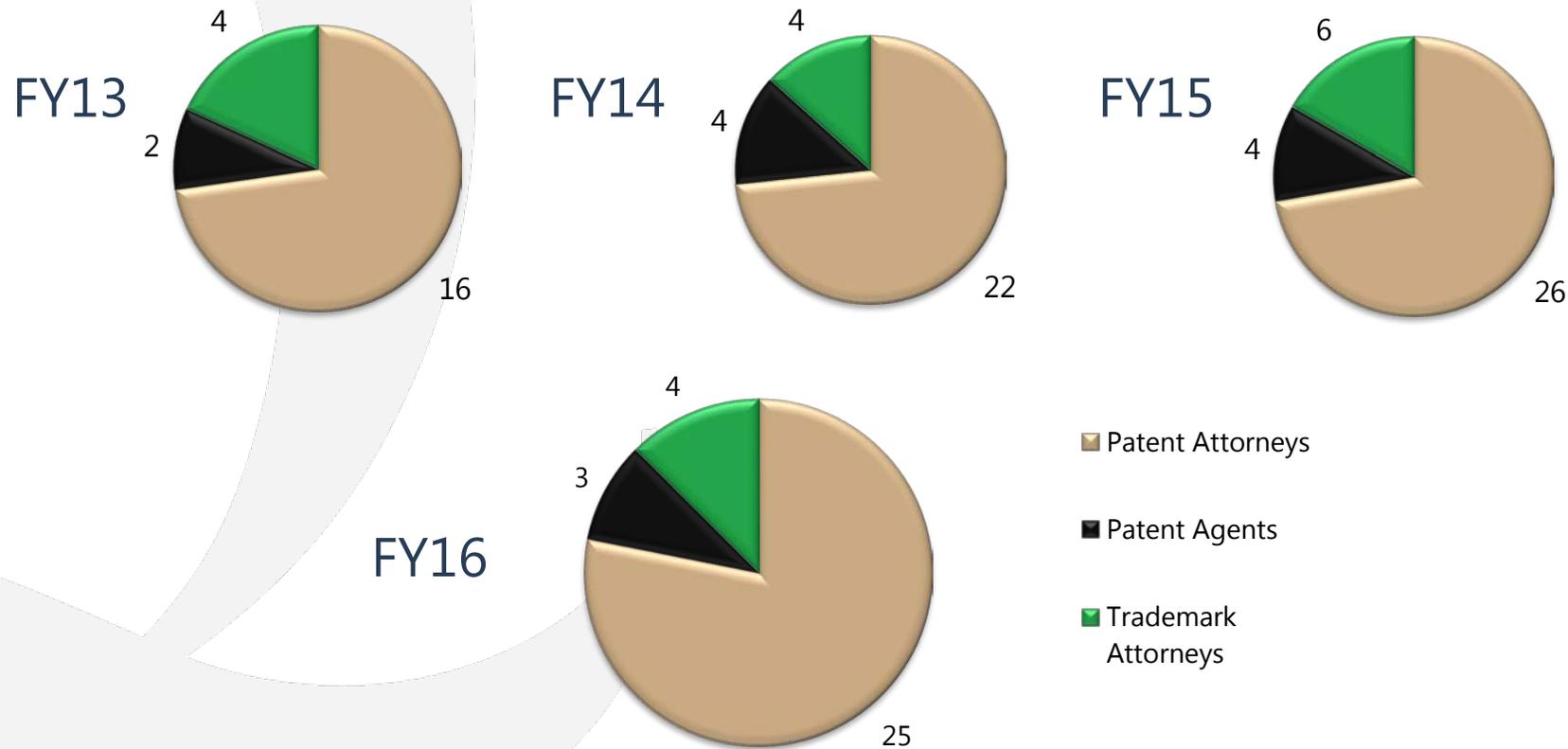
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# USPTO Disciplinary Decisions



# USPTO Disciplinary Decisions

Breakdown of Disciplinary Decisions by Practitioner Type



# OED Discipline: Grievances and Complaints

- An investigation of possible grounds for discipline may be initiated by the receipt of a grievance. *See* 37 C.F.R. § 11.22(a).
- Grievance: “a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner.” 37 C.F.R. § 11.1.
- Common Sources of Information:
  - External to USPTO: Clients, Colleagues, Others.
  - Internally within USPTO: Patent Corps, Trademark Corps, Other.
  - Other: News Articles.
- Duty to report professional misconduct:
  - 37 C.F.R. § 11.803.

# Limited Recognition for Visa Holders

- 37 C.F.R. 11.9(b) provides for the grant of limited recognition to practice before the USPTO in patent matters to nonimmigrant aliens residing in the U.S.
- Limited recognition is based on the visa authorizing employment in the U.S.
  - In many instances, visa must explicitly authorize employment or training involving practice before the USPTO in patent matters.
- Practitioners granted limited recognition are not “registered.”
  - Biographical information must indicate their limited recognition status.
- Limited recognition terminates when visa expires; employment authorized under the visa terminates; or practitioner departs the U.S.
  - New or extended visa requires extension or reinstatement from OED.

# Register of Patent Practitioners

- Register of persons authorized to practice before the USPTO in patent matters is found on USPTO website:  
<https://oedci.uspto.gov/OEDCI/>.
- New web portal enables practitioners to:
  - Indicate whether they are currently accepting new clients;
  - Change official address with OED;
  - Change name;
  - View certain transactions with OED;
  - Add email addresses to receive certain communications and reminders from OED.
- Register now lists persons granted limited recognition.
- More updates to come.

# Duties of Candor, Disclosure, and Good Faith

- 37 C.F.R. § 1.56 - Duty to disclose information material to patentability.
- 37 C.F.R. § 1.555 - Information material to patentability in *ex parte* and *inter partes* reexamination proceedings.
- 37 C.F.R. § 11.18(b) - Signature and certificate for correspondence filed in the Office.
- 37 C.F.R. § 11.106(c) - Confidentiality of information.
- 37 C.F.R. § 11.303(a)-(e) - Candor toward the tribunal.
- 37 C.F.R. § 11.801(a)-(b) - Registration, recognition, and disciplinary matters.
- 37 C.F.R. § 11.804(c) - Misconduct (dishonesty, fraud, deceit, misrepresentation).
- 37 C.F.R. § 42.11 - Duty of candor; signing papers; representations to the Board; sanctions.

# Current 37 C.F.R. § 1.56

- (a) . . . Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section."
- (b) . . . information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or (2) It refutes, or is inconsistent with, a position the applicant takes in: (i) Opposing an argument of unpatentability relied on by the Office, or (ii) Asserting an argument of patentability.
- (b) . . . A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(emphasis added)

# ***Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011)**

- Materiality standard is “but-for” materiality.
  - Prior art is but-for material if the PTO would not have allowed a claim had it been aware of the undisclosed prior art.
- Materiality prong may also be satisfied in cases of affirmative egregious misconduct
- Intent to deceive USPTO must be weighed independent of materiality.
  - Courts previously used sliding scale when weighing intent and materiality.
- Intent to deceive must be single most reasonable inference to be drawn from evidence.

# 2011 Proposed Changes to 37 C.F.R. § 1.56

- Initial NPRM issued on July 21, 2011 (76 FR 43631)
- 2011 Proposed Amendment to 37 C.F.R. § 1.56(b)
  - Information is material to patentability if it is material under the standard set forth in [*Therasense*]. Information is material to patentability under *Therasense* if:  
(1) The Office would not allow a claim if it were aware of the information, applying the preponderance of the evidence standard and giving the claim its broadest reasonable construction; or (2) The applicant engages in affirmative egregious misconduct before the Office as to the information.
- Similar proposed amendment to 37 C.F.R. § 1.555.
- USPTO received feedback from 24 commenters.

# 2016 Notice of Proposed Rulemaking

- NPRM issues October 28, 2016; <https://www.federalregister.gov>.
- Comments due 60 days after publication date.
- 2016 NPRM addresses comments received to 2011 proposed rules.
- Proposed amendment to 37 C.F.R. § 1.56 (emphasis added):
  - (a) . . . Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office **all information known to that individual** to be material to patentability under the **but-for materiality standard** as defined in paragraph (b) of this section. . . . Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. . . . However, no patent will be granted on an application in connection with which **affirmative egregious misconduct** was engaged in, fraud on the Office was practiced or attempted, or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine: (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.
  - (b) Information is but-for material to patentability if the Office would not allow a claim if the Office were aware of the information, applying the preponderance of the evidence standard and giving the claim its broadest reasonable construction consistent with the specification.

# Office of Enrollment and Discipline

## Case Law Review

# Conflict of Interest: *Maling v. Finnegan*

- ***Maling v. Finnegan,***

473 Mass. 336 (2015)

- Plaintiff engaged defendant firm to prosecute patents for screwless eyeglass hinge.
- After patents were obtained, plaintiff learned that firm had simultaneously represented another client in the same industry.
- Plaintiff's work was done in firm's Boston office; 2<sup>nd</sup> party's work was done in D.C. office.
- Plaintiff alleges that firm belatedly commenced preparation of one of his applications and that it inexplicably took a long time to do so.
- Plaintiff alleges he would not have made investment in developing his product if firm had disclosed its conflict and work on 2<sup>nd</sup> party's patents.

# Conflict of Interest: *Maling v. Finnegan (cont.)*

- ***Maling (cont.)***

- Appellate court stated that subject matter conflicts may present a number of potential legal, ethical, and practical problems, but they do not, standing alone, constitute actionable conflict of interest that violates Mass. Rule of Professional Conduct 1.7 (Conflict of Interest).
- Court did not find that competing for patents in the same space placed clients directly adverse to one another.
  - Analogized with two clients attempting to obtain radio broadcast licenses.
- Court discussed likelihood of interference as a barometer for conflict between two clients in same space.
- No evidence or even allegation that Plaintiff's claims were altered because of simultaneous representation.

# Conflict of Interest: *In re Radanovic*

- ***In re Radanovic*** (USPTO D2014-29)
  - Patent attorney:
    - Represented two joint inventors of patent application.
    - No written agreement regarding representation.
    - Attorney became aware of a dispute wherein one inventor alleged that the other did not contribute to allowed claims.
    - Continued to represent both inventors.
    - Expressly abandoned application naming both inventors in favor of continuation naming one.
  - Mitigating factors included clean 50-year disciplinary history.
  - Received public reprimand.

# Conflict of Interest: *Additional Cases*

- ***In re Newman*** (USPTO D2015-14)
- ***In re Blackowicz*** (USPTO D2015-13)
  - Newman asks Blackowicz to represent Client 1 & Client 2, who co-own TM application.
  - Newman and Blackowicz also represent Client 2's father (Client 3), Client 2's uncle (Client 4), and the uncle's company (Client 5).
  - No disclosures to Clients 1 & 2 regarding potential effects of co-representation or in light of representation of Clients 3, 4 & 5.
  - Work on Client 1 & 2's application is billed to Client 5.
    - No disclosures are made regarding possible issues with this arrangement.
  - Clients 3 and 4 were copied on confidential emails with Clients 1& 2.
  - Dispute develops between Client 1 and Client 2.

# Conflict of Interest: *Additional Cases (cont.)*

- ***In re Blackowicz*** (USPTO D2015-13)
- ***In re Newman*** (USPTO D2015-14)
  - Blackowicz and Newman correspond with Client 2 and Client 3 regarding the TM application and the dispute between Client 1 and Client 2.
    - Discussed abandonment of joint application in favor of new applications for the same mark owned by Client 3's company (Client 6).
  - Blackowicz abandoned co-owned application. Did not consult with Client 1.
  - Filed new applications on behalf of Client 3's company (Client 6) for same mark.
  - Client 1 complained and Blackowicz filed petition to reinstate the co-owned application, even though, if granted, the co-owned application would have been directly adverse to Client 6 applications.

# Conflict of Interest: *Additional Cases Decisions*

- ***In re Blackowicz*** (USPTO D2015-13)
  - 30-day suspension.
  - Required to take MPRE & attain score of 85 or better.
  - 13-month probation with practice monitor.
  - Mandatory conflicts CLE attendance.
- ***In re Newman*** (USPTO D2015-14)
  - 30-day suspension.
  - Required to take MPRE and attain score of 85 or better.
  - 18-month probation.
  - Mandatory practice management or conflicts CLE attendance.

# Disreputable or Gross Misconduct

- ***In re Schroeder*** (USPTO D2014-08)
  - Patent Attorney:
    - Submitted unprofessional remarks in two separate Office action responses.
    - Remarks were ultimately stricken from application files pursuant to 37 C.F.R. § 11.18(c)(1).
    - Order noted that behavior was outside of the ordinary standard of professional obligation and client's interests.
    - Aggravating factor: has not accepted responsibility or shown remorse for remarks.
  - Suspended from practice before USPTO for 6 months.

# Legal Fees

- ***In re Neeser*** (USPTO D2015-16)
  - Patent Agent:
    - Formed a partnership w/ non-lawyer practicing patent law.
    - Failed to maintain trust accounts for clients' funds.
    - Neglected applications.
  - Suspended from practice before USPTO for 12 months.
  - Mitigating factors included remorse, cooperation w/ investigation, and no prior discipline.

# Neglect

- ***In re Tachner*** (USPTO D2012-30)
  - Patent attorney; disciplinary complaint alleged:
    - Failed to report Office communications and docket due dates.
    - Apps. became abandoned; patents expired for failure to pay maint. fees.
    - Used handwritten docket book and “white board” for docketing due dates.
    - Staff was undertrained and underequipped.
  - Suspended from practice before USPTO for 5 years.
- ***In re Kubler*** (USPTO D2012-04 and 10-06)
  - Patent attorney:
    - Lacked uniform system of client communication in his office. Caused inconsistent client communications practices and communications delay.
  - Received Public Reprimand:
    - Practitioner also agreed to attend practice-management classes.

# Dishonesty, Fraud, Deceit or Misrepresentation

- ***In re Hicks*, D2013-11 (USPTO 2013)**
  - Attorney sanctioned by EDNY for non-compliance with discovery orders.
  - Federal Circuit affirmed sanction and found appellate brief to contain “misleading or improper” statements.
    - Brief reads, “Both the Magistrate and the District Court Found that RTI's and its Litigation Counsel Hicks' Pre-Filing Investigation Was Sufficient.” However, neither the magistrate judge nor the district court ultimately found that RTI's or Mr. Hicks's pre-filing investigation was “sufficient.”
    - Mr. Hicks also failed to inform the court that a case citation was non-precedential and therefore unavailable to support his legal contentions aside from “claim preclusion, issue preclusion, judicial estoppel, law of the case, and the like.”
    - *Rates Technology, Inc. v Mediatix Telecom, Inc.*, 688 F.3d 742 (Fed. Cir. 2012)
  - Received public reprimand and one-year probation.

# Dishonesty, Fraud, Deceit or Misrepresentation (cont.)

- ***In re Goldstein*** (USPTO D2014-10)
  - Patent attorney; disciplinary complaint alleged:
    - Falsely informed clients he filed patent and TM applications on their behalf and that applications were being examined.
    - Created and sent clients fake filing receipts for patent applications.
    - Created fake cease-and-desist letters allegedly sent to potential infringers.
    - Created phony response to fictitious inquiry from patent examiner.
    - Billed clients for services he did not perform and fees he did not pay.
  - Excluded from practice before the USPTO.

# Fee-Related Issues

- ***In re York*** (USPTO D2013-19)
  - Patent attorney:
    - Contract attorney to law firm, claimed firm owed him money.
    - *Inter alia*, deposited payments from firm client into personal account without informing firm.
    - Used firm's deposit account in violation of firm policy.
  - Received public reprimand and 2 year probation.
- ***In re Lane*** (USPTO D2013-07)
  - Patent agent:
    - Sent notice of charges to client without demand for payment, as parties were working on potential business relationship that would subsume the charges.
    - Later sent an invoice and added an 18% interest charge from first notice.
    - Because client was unaware that interest was accruing, interest charge was excessive fee and disreputable conduct.
  - 18-month suspension added to earlier discipline.

# Unauthorized Practice of Law

- ***In re Pham*** (USPTO D2015-01)
  - Patent Agent (Former Attorney):
    - Represented ex-wife in trademark dispute.
    - Signed emails as “Associate General Counsel”
    - Emails contained legal opinions.
  - Received public reprimand.
- ***In re Campbell*** (USPTO D2014-11)
  - Patent agent:
    - Represented person in Colorado matter involving DUI charges.
    - Attempted to claim he was “attorney in fact” for driver.
    - Sued City of Colorado Springs in civil court on behalf of driver.
    - Appeared on behalf of driver in license revocation hearing.
  - Excluded from practice before the USPTO.

# Unauthorized Practice of Law (cont.)

- ***In re Dao*** (USPTO D2015-23)
  - Attorney:
    - Became administratively suspended in Wisconsin (only state jurisdiction where he was licensed to practice law).
    - Knowingly continued to represent clients in TM matters after administrative suspension.
    - Failed to withdraw from TM cases after administrative suspension.
    - This conduct violated 37 C.F.R. § 11.505 (unauthorized practice of law).
  - For this and other conduct, suspended from practice before the USPTO for 6 months.

# Improper *ex parte* Contact

- ***In re Caracappa*** (USPTO D2014-02).
  - Registered patent attorney was counsel of record in *inter partes* review proceeding.
  - Co-counsel sent an email to PTAB email address, naming a specific judge as the addressee.
  - The email explained a mathematical error in a paper filed by the opposing side.
  - Opposing counsel was not copied on the email.
  - Attorney authorized and had full knowledge of the email, including the fact that opposing counsel was not copied.
  - PTAB held that the email was an improper *ex parte* communication.
- Received public reprimand.

# Duty to Supervise

- ***In re Druce*** (USPTO D2014-13)
  - Non-lawyer assistant fabricated filings and office communications
  - Signed patent attorney's signature to filings.
  - Failure to adequately supervise non-lawyer assistant.
- 2-year stayed suspension and 2-year probation upon reinstatement

# Inequitable Conduct

- ***In re Tendler*** (USPTO D2013-17)
  - Patent attorney filed Rule 131 declaration re: reduction to practice with USPTO.
  - Soon after, attorney learned that the inventor did not review the declaration and that declaration contained inaccurate information.
  - Respondent did not advise the Office in writing of the inaccurate information and did not fully correct the record in writing.
  - District court held resultant patent unenforceable due to inequitable conduct, in part, because of false declaration. *Intellect Wireless v. HTC Corp.*, 910 F. Supp. 1056 (N.D. Ill. 2012). Federal Circuit upheld.
    - 1<sup>st</sup> requirement is to expressly advise PTO of existence of misrepresentation, stating specifically where it resides.
    - 2<sup>nd</sup> requirement is that PTO be advised of misrepresented facts, making it clear that further examination may be required if PTO action may be based on the misrepresentation.
    - It does not suffice to merely supply the Office with accurate facts without calling attention to the misrepresentation.
  - 4 year suspension (eligible for reinstatement after 2 years).

# Decisions Imposing Public Discipline Available In FOIA Reading Room

- ▶ <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>
  - ▶ In the field labeled "Decision Type," select "Discipline" from the drop down menu.
    - To retrieve all discipline cases, click "Get Info" (not the "Retrieve All Decisions" link).
- ▶ Official Gazette for Patents
  - [http://www.uspto.gov/news/og/patent\\_og/index.jsp](http://www.uspto.gov/news/og/patent_og/index.jsp) Select a published issue from the list, and click on the "Notices" link in the menu on the left side of the web page.

# Terminating Representation

- Terry, a registered practitioner, takes over prosecution of a U.S. utility patent application for Company A, who changes the correspondence address to Terry's business address.
- A power of attorney is not filed in the application, but Terry files an Office Action response in a representative capacity pursuant to 37 CFR § 1.34.
- Terry then learns that she must withdraw from representation of Company A due to a conflict with another firm client. Terry is unable to change the correspondence address for the application under 37 C.F.R. § 1.33 because she does not hold power of attorney.
- She requests that Company A change the correspondence address, but Company A is slow to do so.
- The USPTO continues to send correspondence regarding the application to Terry.

# Terminating Representation

- Registered practitioner Trent represents Maria in a U.S. utility application that recently received a Notice of Allowance.
- Trent reported the Notice of Allowance to Maria and requested pre-payment of the issue fee.
- Maria has not yet provided pre-payment of the issue fee to Trent. The payment date for the issue fee is approaching.

# Terminating Representation

- Gail is a patent attorney who works as an associate for Firm W. Gail handles all of the patent prosecution matters for Firm W's clients and is the only practitioner associated with Firm W's USPTO customer number.
- Gail accepts an in-house position at Technology Incorporated and gives 2 weeks notice to Firm W. Firm W wants to continue to represent its patent clients.
- Resources with additional information on withdrawal:
  - 37 C.F.R. § 11.116.
  - MPEP 402.06.
  - USPTO form PTO/AIA/83 (04-13).

# Contacting OED

For Informal Inquiries, Contact OED at  
571-272-4097

THANK YOU

# Stakeholder Training on Examination Practice and Procedure

**Bob Oberleitner**

Assistant Deputy Commissioner for Patent Operations

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# What is STEPP?

A new offering from the Office of Patent Training designed to complement Pillar 3 (Excellence in Customer Service) of the Enhanced Patent Quality Initiative (EPQI) by offering training to external stakeholders on examination practice and procedure

# Why Participate?

- Training materials were derived from training delivered to patent examiners and other USPTO employees
- Training delivered by USPTO trainers

# Current Course Available

3-day training program that focuses on the life of an application from docketing to allowance

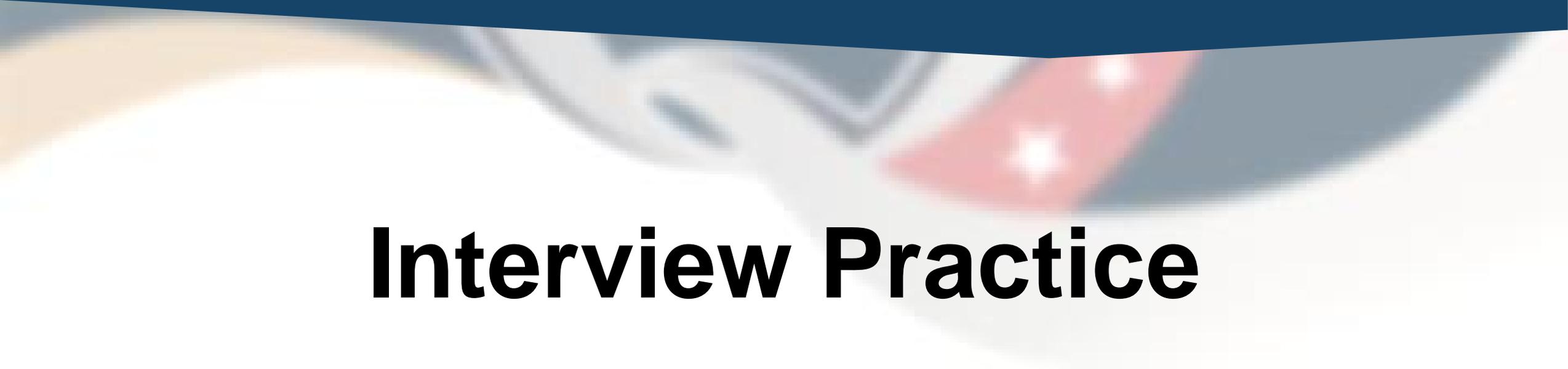
- Day 1: Reading and Understanding an Application
  - Claim interpretation and 112
- Day 2: Planning a Search and Applying Prior Art
  - Searching, identifying, and mapping prior art to claims
- Day 3: Writing an Office Action and Post-Examination Processes
  - Writing an office action, the Patent Trial and Appeal Board, and the Central Reexam Unit (CRU)

# Stakeholder Training on Examination Practice and Procedure Upcoming Sessions

- January 10-12, 2017; Dallas Texas
  - Registration is currently open
- March 14-16, San Jose California
- May 9-11, Denver Colorado
- July 11-13, Alexandria Virginia
- September 19-21, Detroit Michigan

# For Additional Information and to Sign Up

- Website: <https://www.uspto.gov/patent/initiatives/stakeholder-training-examination-practice-and-procedure-stepp>
- Email: [STEPPTraining@uspto.gov](mailto:STEPPTraining@uspto.gov)
- Examiner Training Modules: <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials>



# Interview Practice

**Bob Oberleitner**

Assistant Deputy Commissioner for Patent Operations

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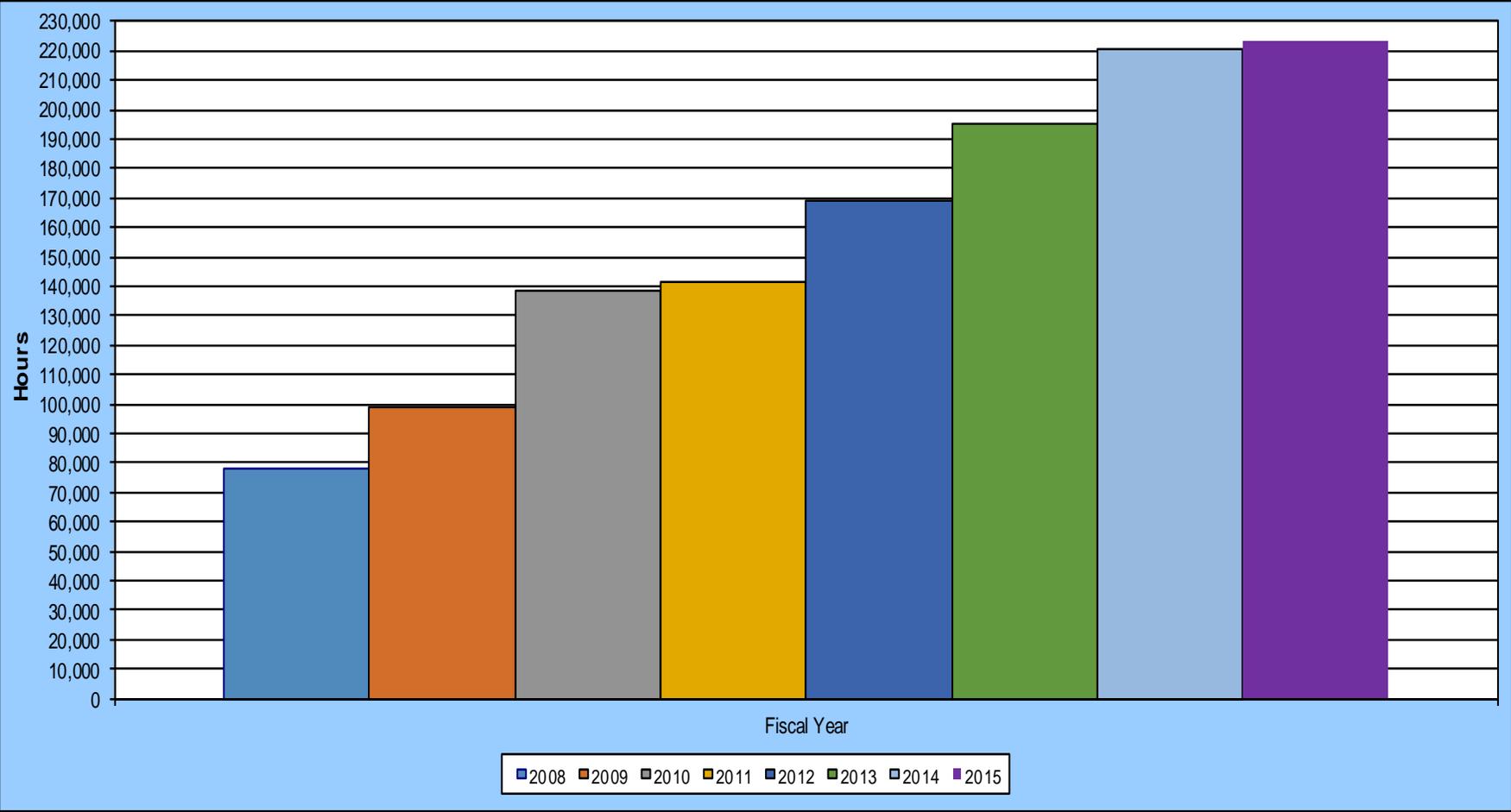


# Interview Practice @ USPTO

- ❖ Overview of Interviews

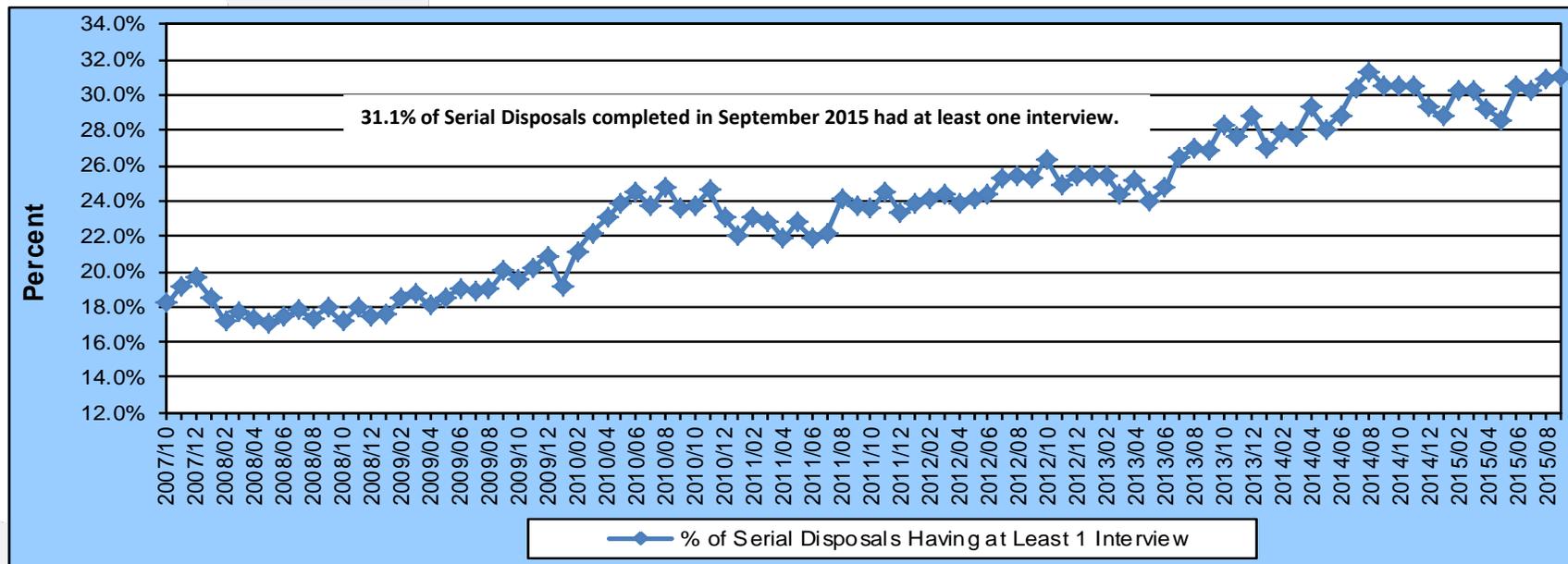
- ❖ Enhancements to Interview Practice

# Interview Time FY 2008 – FY 2015



# Percent of Serial Disposals Having at Least One Interview by Month

FY 2008 – FY2015

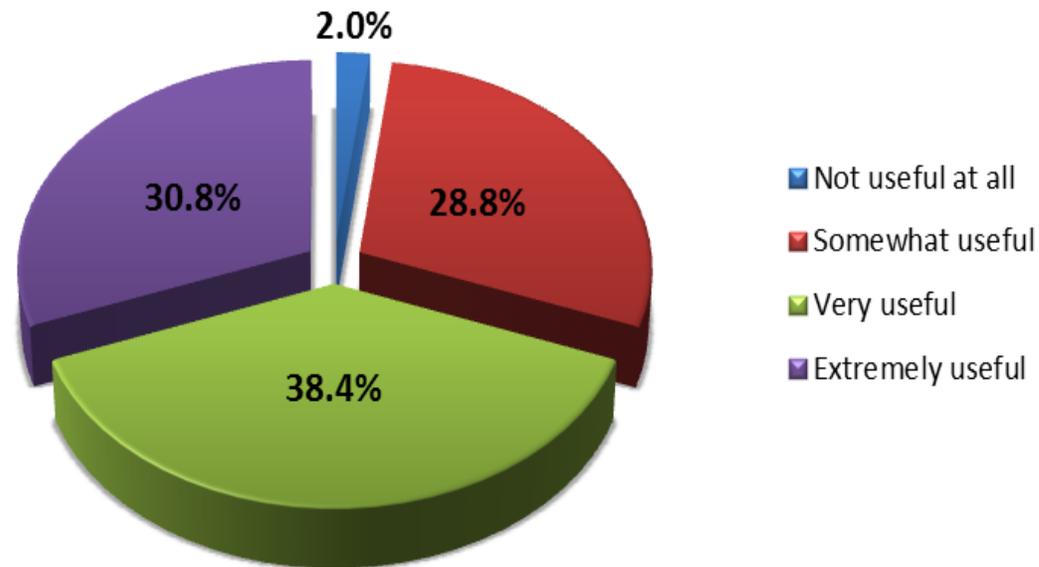


# Interview Survey Results

- For advancing prosecution, Applicants were very positive.

**How effective do you feel an interview is in  
advancing prosecution?**

**Of 1,196 Responses (All Respondents)**



# Automated Interview Requests

## Interview Practice

Interviews enable Applicants and Examiners to discuss and resolve issues and are an effective tool to advance the prosecution of an application. The USPTO encourages Examiners to take a proactive approach to examination by reaching out and engaging our stakeholders in order to shorten prosecution.

1	<b>USPTO AIR</b>
2	<b>Video Conference</b>
3	<b>TC Interview Specialist</b>
4	<b>Policy and Guidance</b>
5	<b>Training and FAQs</b>
6	<b>Survey</b>
7	<b>Federal Register Notice</b>
8	<b>Contact Us</b>

## USPTO AIR



A new web-based tool that allows Applicants to schedule an interview with an Examiner for their pending patent application.

Complete the form.

## Video Conference

Video conferencing with a patent examiner gives you the ability to have face-to-face meetings, no matter the location of the examiner or attorney. Visit [Video Conferencing and Collaboration](#) for instructions on how to join a USPTO-hosted video conference, and information and links on how to use WebEx collaboration tools, including audio/video conferencing and file sharing. In this short video, attorneys share some advantages of video conferencing interviews.

<http://www.uspto.gov/patent/laws-and-regulations/interview-practice>

# AIR Form

- New web-based tool
- Permits Applicants to schedule an interview with an examiner



**1 USPTO AIR**

**USPTO AIR**

A new web-based tool that allows Applicants to schedule an interview with an Examiner for their pending patent application.

**2 Video Conference**

**3 TC Interview Specialist**

**4 Policy and Guidance**

**5 Training and FAQs**

**6 Survey**

**7 Federal Register Notice**

**8 Contact Us**

**Video Conference**

Video conferencing with a patent examiner gives you the ability to have face-to-face meetings, no matter the location of the examiner or attorney. Visit [Video Conferencing and Collaboration](#) for instructions on how to join a USPTO-hosted video conference, and information and links on how to use WebEx collaboration tools, including audio/video conferencing and file sharing. In this short video, attorneys share some advantages of video conferencing interviews.



## TC Interview Specialist

Interview Specialists are subject matter experts in each Technology Center (TC) on interview practice and policy to assist in interviews, including facilitating and assisting with technical issues that may arise (e.g. WebEx, public interview room setup).

If you have questions or comments about interview practice at the USPTO, please contact a [TC Interview Specialist](#), based on the Technology Center that the application is docketed in.

## USPTO Automated Interview Request (AIR) Form

Automated Interview Request Form (SB-15)

Approved for use through 7/31/2016. OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

\* This paper requesting to schedule and/or conduct an interview is appropriate because:

- I have previously submitted an authorization for internet communications in a patent application. See form SB/0439.
- I am concurrently submitting an authorization to communicate via the internet. See form SB/0439.
- This submission is requested to be accepted as an authorization for this interview to communicate via the internet. Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned concerning scheduling of the interview via video conference, instant messaging, or electronic mail, and to conduct the interview in accordance with office practice including video conferencing.

\*  I understand that a copy of this communication will be made of record in the application file.

\*Name(s):

\*S-signature:  (See 37 CFR 1.4(d)(2) (/Name/))

Registration Number:  (5 Digit Numeric Only: 12345)

\*U.S. Application Number:  (8 Digit Numeric Only: 12345678)

\*Confirmation Number:  (4 Digit Numeric Only: 1234)

\*E-mail Address:

\*Phone Number:  (10 Digit Numeric Only: 0123456789)

\*Proposed Date and Time of Requested Interview must be more than one (1) week after today:  
(Note: Confirmation of actual interview date and time will be arranged between examiner and requester)

MM  DD  YYYY  Time  Eastern Time

\*Proposed Type of Interview:  Please select an Interview (Examiners working remotely will offer Video Conference or Telephonic interviews)

\*  I am the applicant or applicant's representative for this application.

\* Indicates fields that are required

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to prosecute (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.111 and 1.14. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

# Verbal Authorization for Video Conferencing

- Internet Usage Policy has been updated to permit oral authorization for video conferencing tools
- MPEP § 502.03 now allows a verbal request to authorize a video conferencing, instead of submitting a written request.
- Examiners set up video conferencing for interview using WebEx, a web-based service that you can use it from any computer (Windows, Mac, Linux, or Solaris) with no software needed.

# Public Interview Rooms

- Video conference rooms on each USPTO campus
- Designated for Applicants to use to connect and collaborate with examiners that are working remotely or at a different USPTO campus

# Public Interview Rooms (cont.)

- Must be reserved by Examiner at least two business days prior to interview.
- Video conference room examples:



**Alexandria**



**Dallas**

# TC Interview Specialists

- Subject matter expert on interview practice and policy in each Technology Center
- To assist Examiners and Applicants in facilitating effective interviews
- The list of TC Specialists can be found here:  
<http://www.uspto.gov/patent/laws-and-regulations/interview-practice/interview-specialist>

# One-On-One Training

- Applicants interested in more detailed WebEx training may request a one-on-one WebEx training session with an interview specialist.
- Email your request to [ExaminerInterviewPractice@USPTO.gov](mailto:ExaminerInterviewPractice@USPTO.gov) with some possible dates and times.
- Please give at least one week notice.

# Interview Practice Website

- **Visit our website to find out more about:**
  - USPTO Air form
  - Video Conferencing
  - TC Interview Specialist
  - Policy and Guidance
  - Training and FAQs

<http://www.uspto.gov/interviewpractice>

# WebEx Basics

- You need a computer and a high-speed Internet connection is recommended.
- WebEx is a web-based service, so you can use it from any computer (Windows, Mac, Linux, or Solaris).
- No software needs to be downloaded or purchased.
- A telephone will be used to join the audio component of the meeting while a video camera may be used as part of the visual component.

# Click Link for Examiner

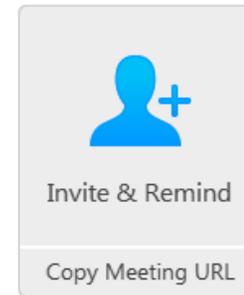
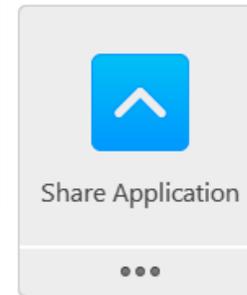
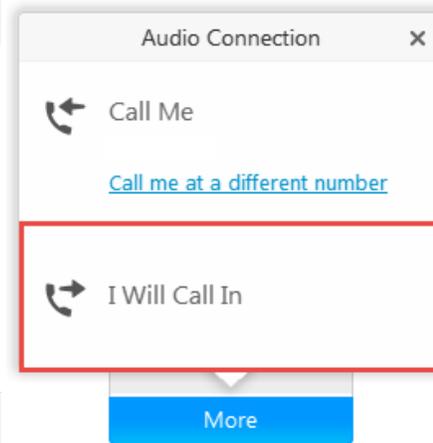
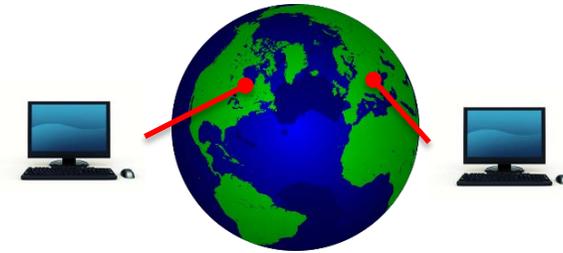
Open the email containing the WebEx online meeting invitation and click on the link to join the visual component of the online meeting.

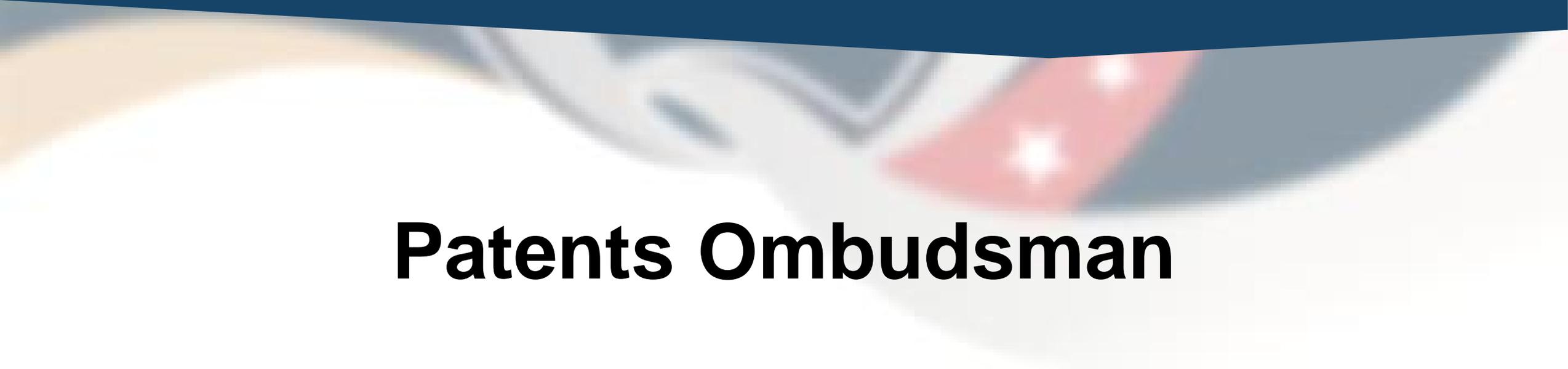
-----  
To join the online meeting (Now from mobile devices!)  
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1. Click the following link: [Join the meeting](#)
2. If requested, enter your name and email address.
3. If a password is required, enter the meeting password:
4. Click "Join".

# WebEx Interview

- Telephone is used for the Audio
- WebEx can be used to host an international WebEx interview.
- An international applicant should dial-in to join the audio component by using the **“I will Call In”** option.





# Patents Ombudsman

**Anthony Knight**

Office of Stakeholder Outreach and Patents Ombudsman

UNITED STATES  
PATENT AND TRADEMARK OFFICE

**uspto**

# Ombudsman Program - Purpose

**Provide feedback regarding training needs based on complaint trends**

**Facilitate complaint handling when applications become stalled in the examination process**

**Track complaints to ensure each is handled within 10 business days  
Currently averaging 3.7 business days**

# Patents Ombudsman Program

- 1-800-786-9199
- 571-272-5555
- <http://www.uspto.gov/patent/ombudsman-program>
- [ombudsmanprogram@uspto.gov](mailto:ombudsmanprogram@uspto.gov)

Thanks to our Regional Offices Service Hours are 8:30 AM-8PM ET.

# Ombudsman Program

- The Program is not pro-Office or pro-customer. The Program is pro-process.
- The Program is not a replacement for the Appeal or Petition process.
- The Program can be of assistance when the application is hung up in the process.

# Ombudsman Program Total Inquiries

Fiscal Year	Inquiries
2010	268
2011	372
2012	951
2013	4292
2014	5469
2015	4859
2016	4119

# Top Inquiries for 2016

- Status Inquiries
- Filing
- Case Prosecution Concerns
- Provisional Applications.
- General Questions

# Filing

- Procedural Guidance
  - How do you?
  - How do I fix this?
  - What's needed?
  - Who do I contact?

# Tips for Application Data Sheets

- Prior to filing an ADS, double check the listing of domestic benefit and/or foreign priority information (priority and benefit information is required to be in an ADS for applications filed on or after September 16, 2012) for:
  - Typos in application numbers
  - Incorrect filing dates
  - Wrong relationship type (*e.g.*, CON vs. CIP, etc.)

# Tips for Application Data Sheets

- A corrected ADS (for applications filed on or after September 16, 2012) must be marked up as set forth in 37 CFR 1.76(c).
- A corrected ADS showing changes relative to the information of record is required regardless of whether an ADS has been previously filed or not.
- The corrected ADS will not be processed unless markings showing the changes are provided.
- For more information on a corrected ADS see MPEP 601.05(a).

# Case Prosecution Concerns

- Clarity and Consistency of Examination Practice
- Try to resolve it with the examiner or SPE first
- Call or e-mail the Patents Ombudsman



# Quality Chat

**Anthony Knight**

Office of Stakeholder Outreach and Patents Ombudsman

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Quality Chat

- Once per month
  - 1 hour in length
- Usually 2<sup>nd</sup> Tuesday
  - start time: 12:00 pm



First time here? Let us help you find your bearings.

Has your invention already been patented at the USPTO?

New to Trademarks?

# First time here? Let us help you find your bearings.

Learn how patents, trademarks, and copyrights differ and other basic information to get started.

Get Going



Patent No. 6234487

## Learn About the Process

### Patents

[? General Information Concerning Patents](#)

### Trademarks

[TM Trademark Basics](#)

Learn about trademarks and find out

### Patents & Trademarks Initiatives Enhanced Patent Quality Initiative

Learn about USPTO efforts to increase patent quality.

## Enhanced Patent Quality Initiative



High-quality patents enable certainty and clarity of rights, which fuels innovation and reduces needless litigation. To ensure we continue issuing high-quality patents well into the future, we established the **Enhanced Patent Quality Initiative (EPQI)**. We are strengthening work products, processes, services, and how we measure patent quality at all stages of the patent process.

### Updates

- Join us for presentations and panel discussions across the country on the latest achievements of the EPQI programs. This November, our Patent Quality Forums will be visiting Washington, DC; Milwaukee, Wisconsin; Baton Rouge, Louisiana; Kansas City, Missouri; and Portland, Oregon. See our [Patent Quality Forum Series](#) page for more information.
- **Post-Prosecution Pilot (P3)**, which launched on July 11<sup>th</sup>, explores a new after final program that combines features of the Pre-Appeal Brief Conference and After Final Consideration 2.0 pilot programs and adds in new features requested by our stakeholders. For more information, please visit the [P3 webpage](#).
- Join **Michelle K. Lee**, Under Secretary of Commerce for Intellectual Property & Director of the United States Patent and Trademark Office, to discuss results from the Enhanced Patent Quality Initiative, how patent quality impacts the U.S. Courts, and next steps the USPTO is taking to advance patent quality. Learn more about the event details on the [Patent Quality Conference event page](#).

### 2016 Patent Quality Chats

NEXT: November 8, 12-1 pm ET

### Patent Quality Forum Series

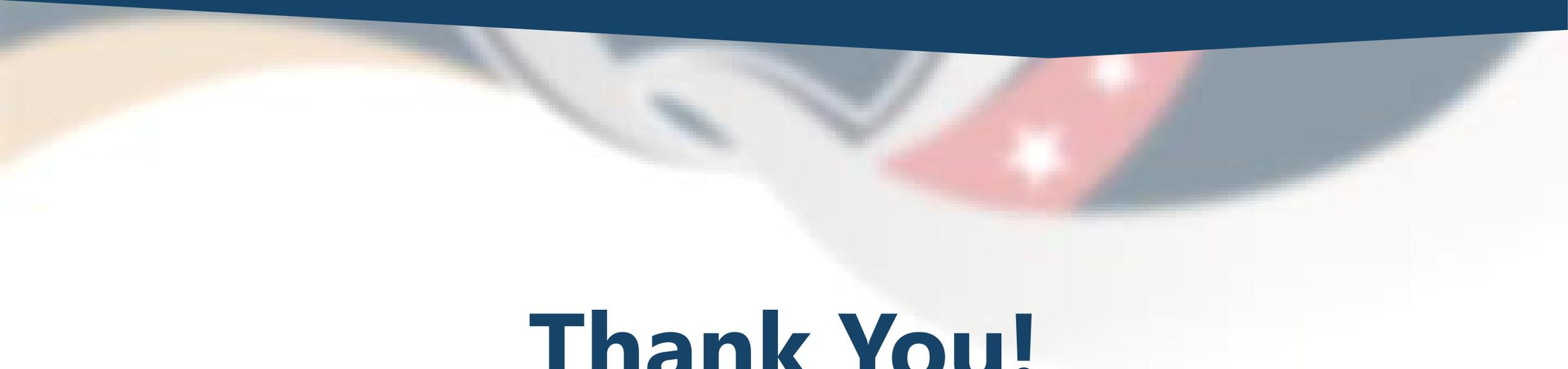
November, 2016 - Visiting cities across the country to discuss patent quality achievements and options for your participation

### Patent Quality Conference

Advancing Patent Quality Across the IP Community  
Keynote Speaker: Michelle K. Lee, Under Secretary of Commerce for Intellectual Property & Director of the United States Patent and Trademark Office

# Next Quality Chat

- Tuesday, November 8<sup>th</sup>, 2016, 12:00pm
- Clarity of Record Pilot: A Discussion of Findings



**Thank You!**

UNITED STATES  
PATENT AND TRADEMARK OFFICE

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