



# **Topic 3: Best Practices for Communication with the Patent Examiner during the Examination Procedure**

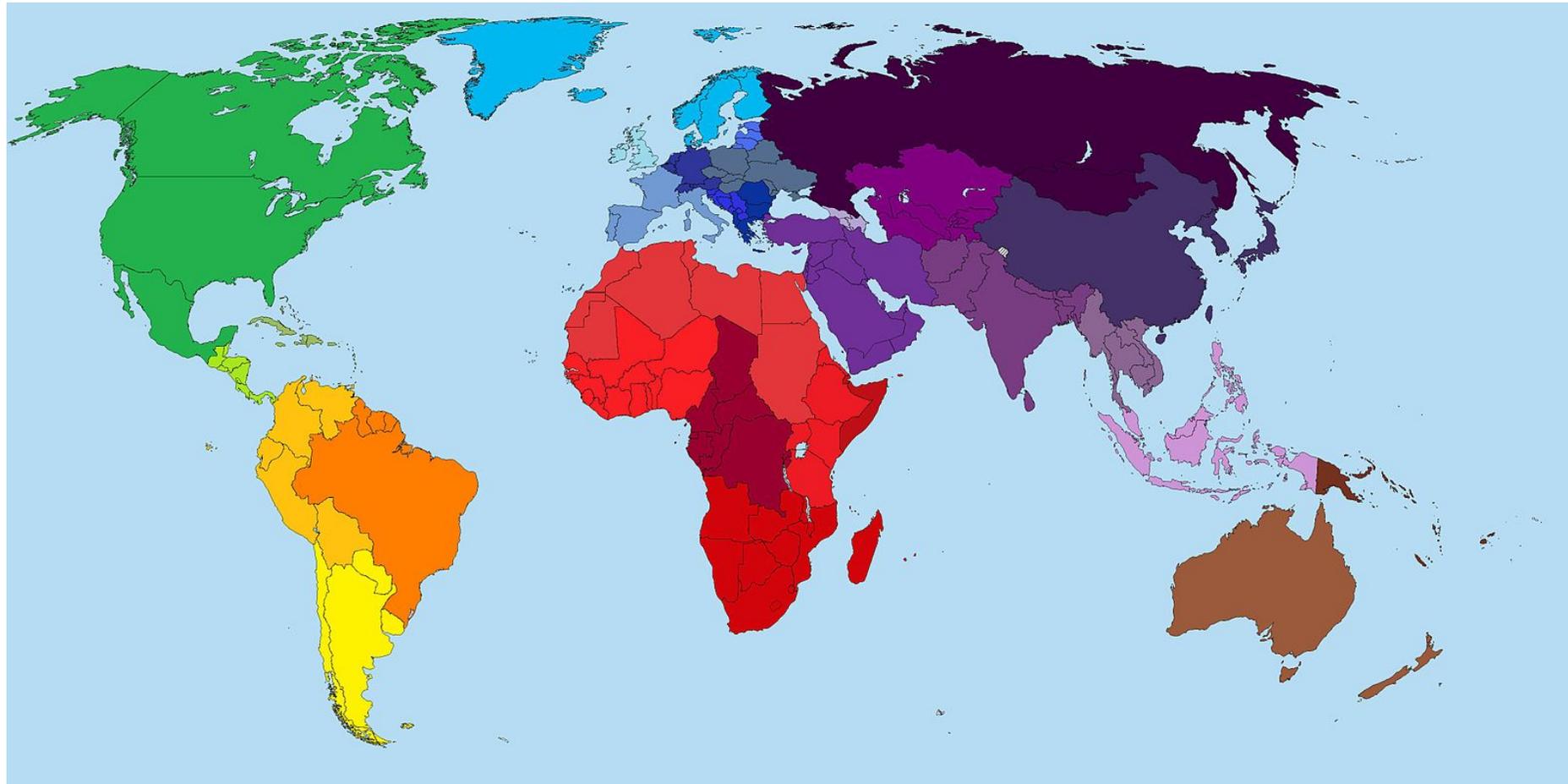
National Intermediate Patent Drafting Course

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The world is different...



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... and times are changing

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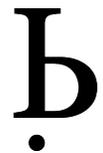


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## The European Patent Office

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# The procedure at the European Patent Office

- Primarily written procedure
- Conducted in one of three languages (EN, DE, FR)
- However, there are many styles of communication:
  - The EPO is an organization of 38 member
  - Cultural differences play a role as well, e.g.
    - German way: rather formal, but very fact-based
    - French way: highly personal way
- Oral proceedings as the “last resort“
  - Conducted between the Applicant and his representative and three Examiners

## Other ways for communication

- Informal telephone calls with the Examiner usually always possible
- Depends very much on the individual Examiner, i.e. his workload, experience, etc. how much you can agree on the call
- Currently, high number of calls by the Examiners, in an attempt to speed up examination

# Best Practices

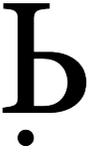


- Be pro-active: Don't wait for the Examiner's objection
- Be detailed: The more technical details you disclose, the better
- Be honest: Consider that part of your success will be your reputation
- Bring the inventor and the invention to the table:
  - If the inventor is interested in coming to oral proceedings, usually that works for the applicant
  - If you have a prototype of your invention, show it in the oral proceedings

# The German Patent and Trademark Office



# Best Practices



- Largely similar to EPO
- But: Less formal, higher degree of individual freedom for both applicant and Examiners
- Hearings are 1-1 battle
- Less strict requirements on formalities, more flexibility for extensions, easier to reschedule hearings, etc.

Australia / New Zealand

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# Best Practices



- Prosecution (examination) procedure is largely done by written correspondence
- It is possible to phone the examiner and discuss your case, noting that:
  - the discussions often go on the written record (and are written by the examiner after the call without opportunity to give input on content);
  - there is no 'formal' procedure to govern this (it is at the examiner's discretion);
  - however, the examiners are generally very open for discussion and to assist in resolving matters.
- There is an appeal process for examination decisions (similar in some ways to EP examination oral proceedings), but it is very rarely used.

The US Patent Office



# Best Practices



- Generally, high legal statements made during prosecution on post-grant litigation proceedings
  - Thus, tendency to only express the “minimum” arguments in writing
- Apart from this, advice received from US practitioners varies a lot
- Good experience with interviews on the phone
  - Particularly in cases where it is evident that the Examiner has misunderstood the invention
- If needed, Examiner’s supervisor may asked to attend the interview



**Thank you very much!**