



IP&T Group LLP

2018 Semiconductor Partnership Meeting

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Using Webex Interview in Prosecution

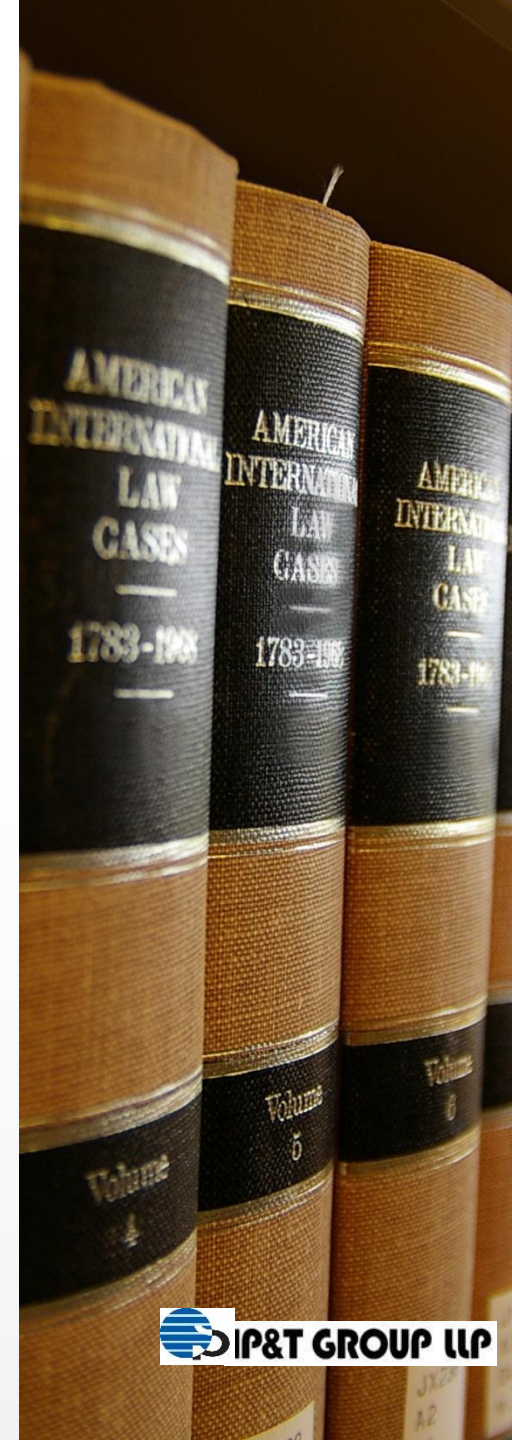
Strategic tool

Case Study: Sample IP&T Case

Different Ways to use Interview

Before the First OA

- Can contact the Examiner to discuss possibility of faster review of the application.
- For complicated or important case, explain background technology to the Examiner.
- Applicant can also utilize First Action Interview Pilot Program for the application with no more than 20 claims in total and 3 independent claims.

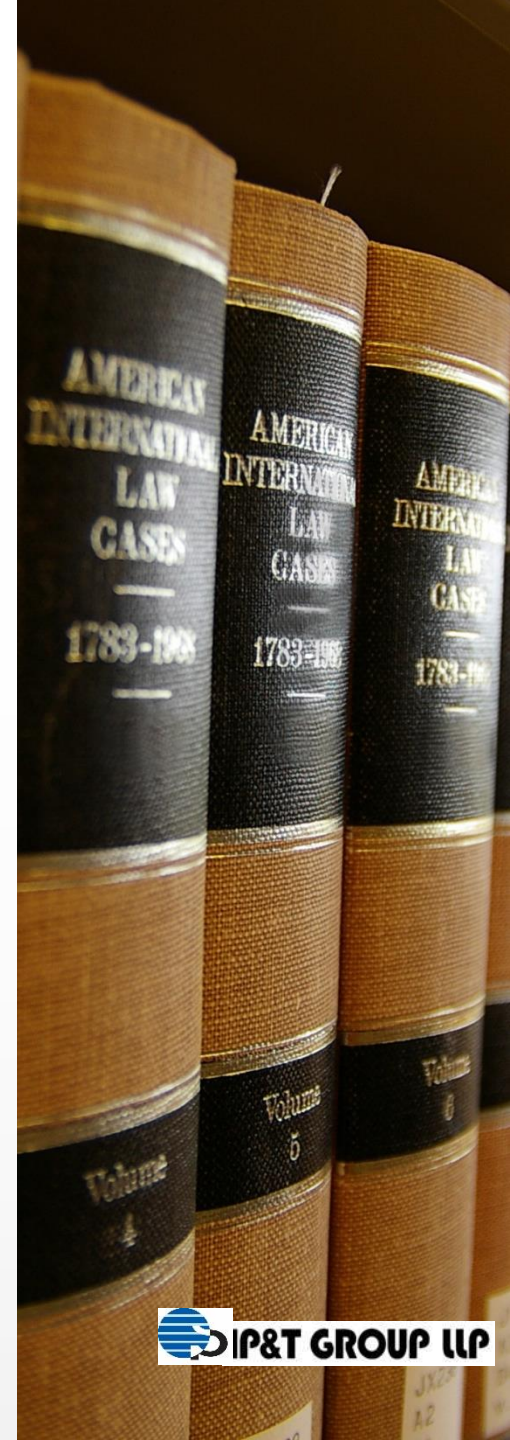


Case Study: Sample IP&T Case

Different Ways to use Interview

General Guideline of First Action Interview Process:

- First Action Interview Request should be filed before the first OA.
- If the filing is compliant, the Examiner will conduct an “all encompassing” prior art search.
 - If the application is in condition for allowance, then the current practice will be followed and the application will be allowed.
 - If the application is NOT in condition for allowance, then a pre-interview communication will be given to the Applicant.
- Applicant has to timely respond within one month:
 - Request not to have an interview
 - Request interview with proposed amendment and/or argument via EFS-Web
 - Request not to have an interview AND submit a reply

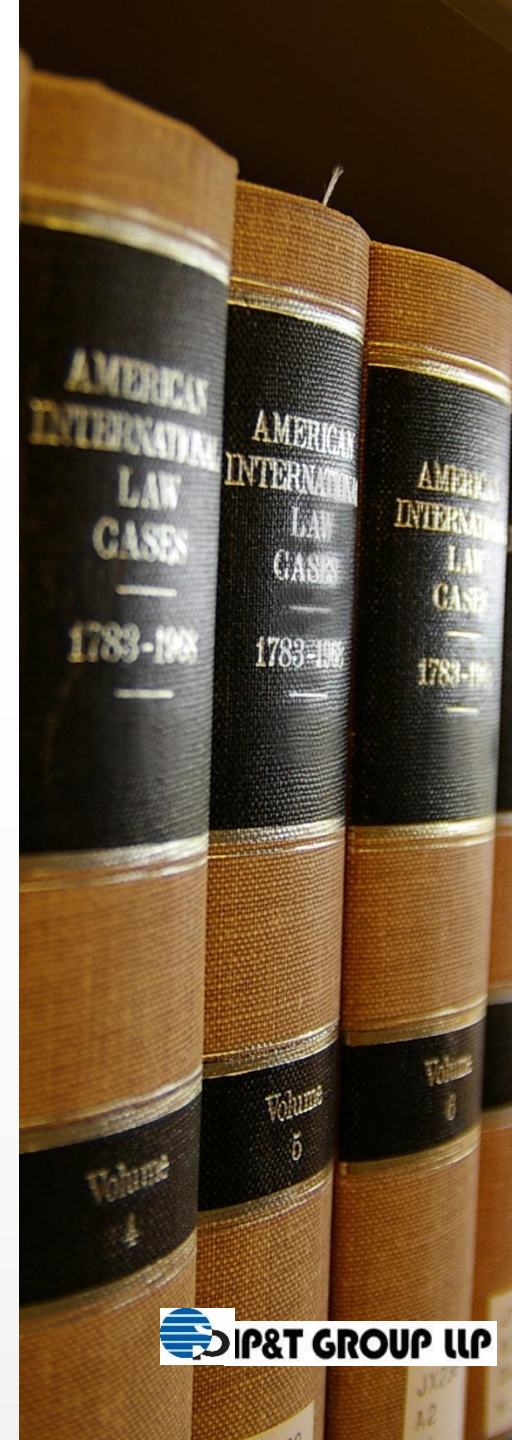


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Different Ways to use Interview

General Guideline of First Action Interview Process:

- If Interview produces **agreement on allowability**:
 - Document reasons for allowance on interview summary.
 - Perform an updated search and interference review before issuing an official NOA.
- If interview produces **NO agreement on allowability**:
 - Interview summary will be completed.
 - First Action Interview OA will be issued, and the applicant must timely respond to all outstanding issues in accordance with the current practice.
 - The applicant is given one month to respond and the due can be extended by one month by paying extension fee.

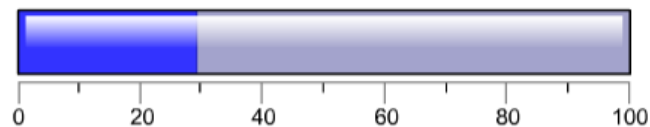


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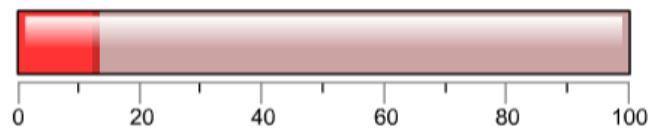
Different Ways to use Interview

Potential Benefit of First Action Interview Program:

- Promote personal interviews prior to first OA.
- Facilitate resolution of potential issues.
- Can assist Examiner in obtaining a better understanding of the claimed invention.
- Applicants can gain more insight as to how the application will be examined/processed.
- Can be especially beneficial for complex invention and applications with focused claims.

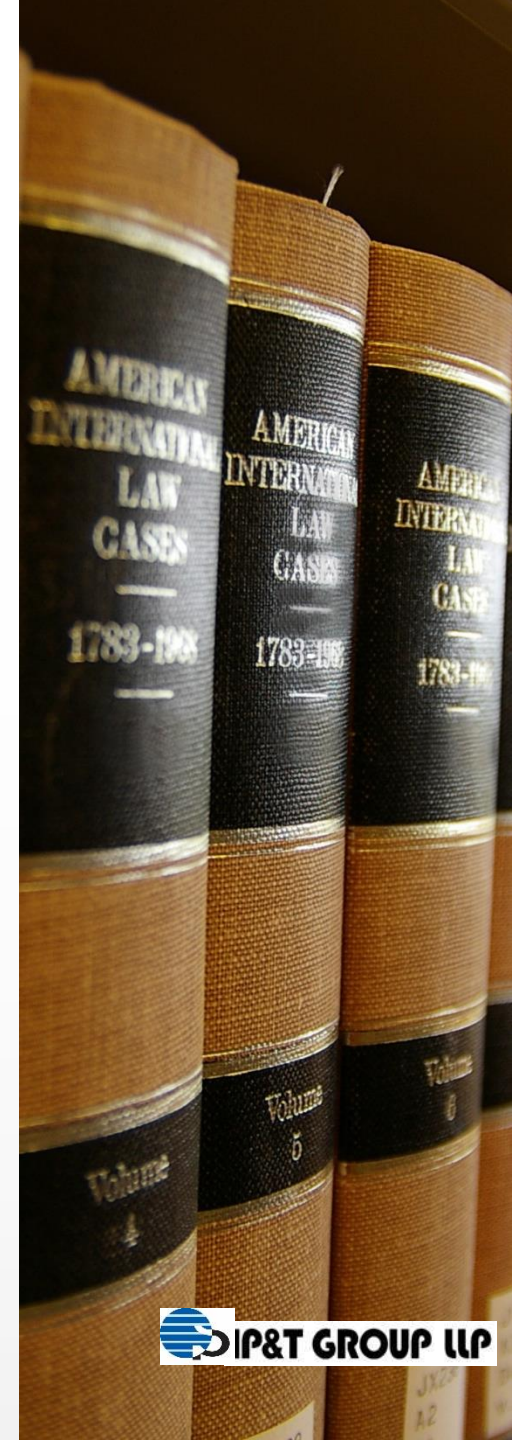


FAIP First Action allowance rate = 29.1%



First Action allowance rate in new, non-continuing applications = 12.2%

May 2018

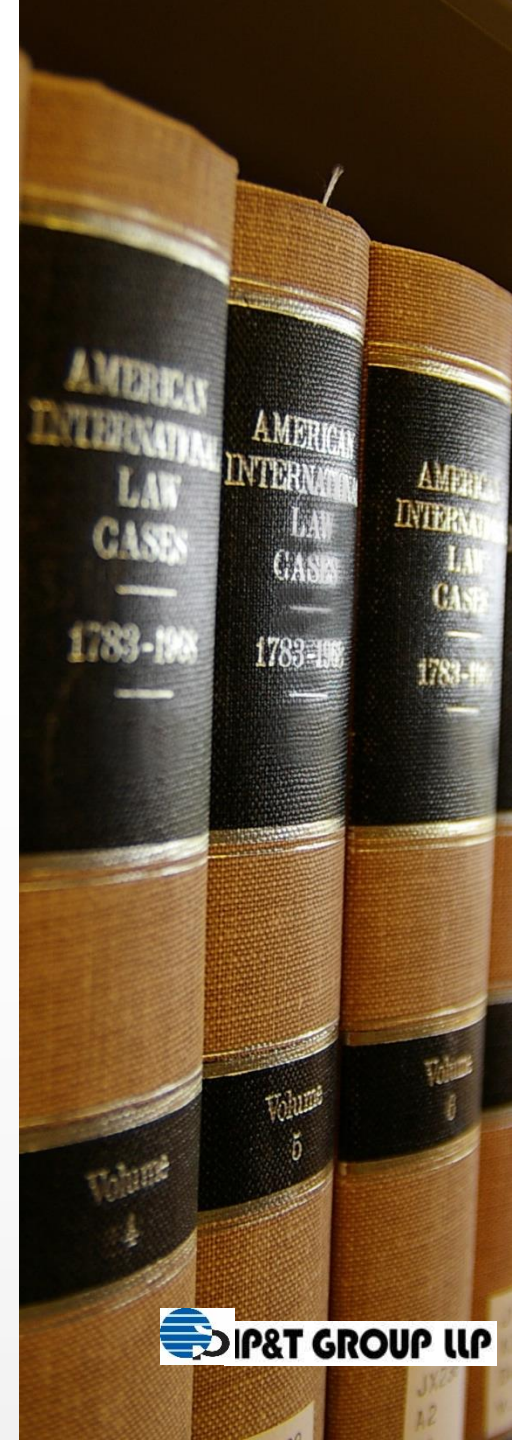


Case Study: Sample IP&T Case

Different Ways to use Interview

During Prosecution

- Avoid unnecessary limitations.
- Persuade Examiner to issue notice of allowance.
- For some Examiners, allowance rate substantially goes up after the interview.
 - Attorneys and Applicants can utilize various patent prosecution analytics.



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Different Ways to use Interview

Different Types of Interviews:

Examiner interviews are available via telephone, in-person, and video

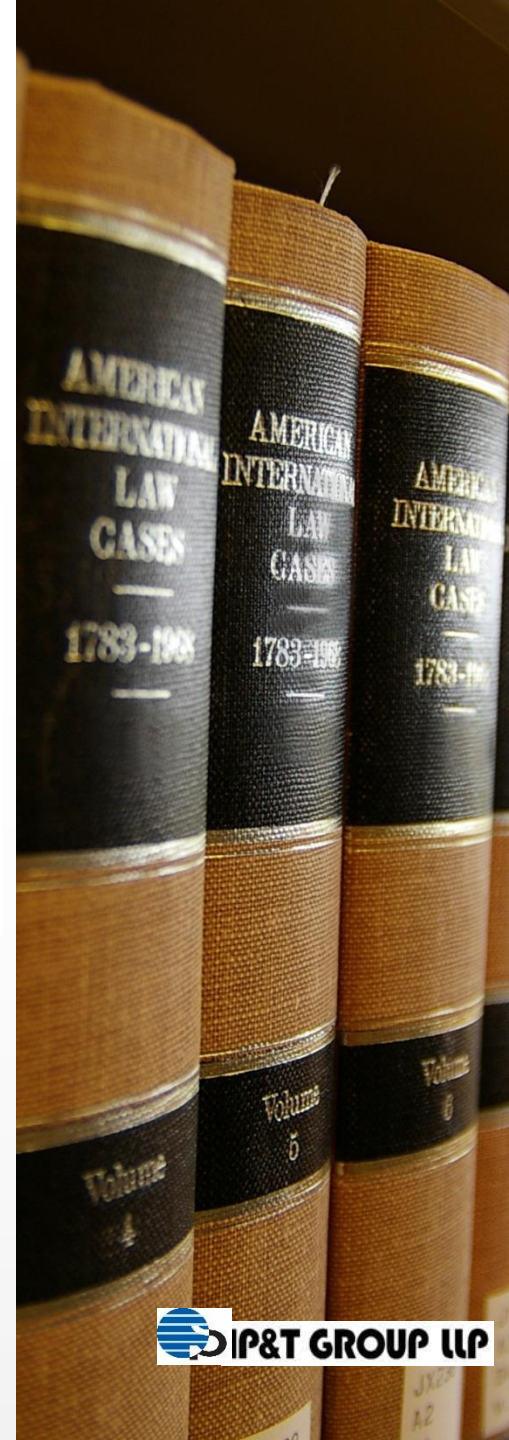
conferencing using a USPTO supplied web-based collaboration tool. To schedule an

interview, applicant is encouraged to use the USPTO Automated Interview Request

(AIR) at <http://www.uspto.gov/interviewpractice>.



“Webex Interview”



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Actual Sample Case

Examiner A

OVERVIEW STRATEGIES HISTORY TIMINGS COMMENTS

Summary

Examiner A Data

203

Total Apps

23

Issued

33

Abandoned

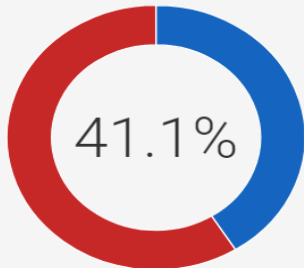
147

Pending

Allowance Rates

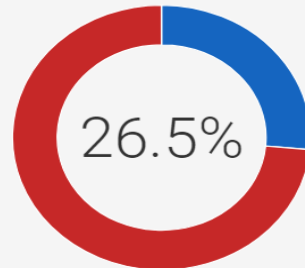
Overall Allowance Rate

Likelihood of Allowance Based on Examiner's Full USPTO Tenure



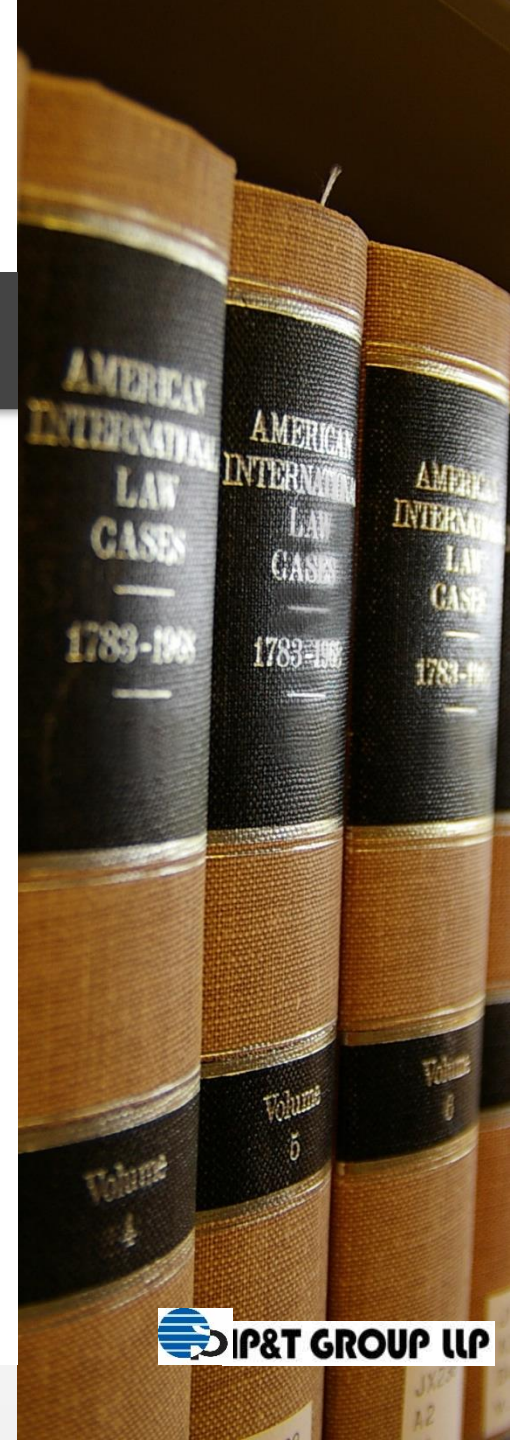
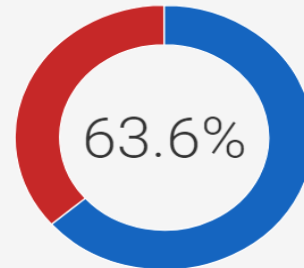
Allowance Rate Before First Final Rejection

Likelihood of Early Allowance



Allowance Rate After First Final Rejection

Likelihood of Allowance After RCE's, etc.

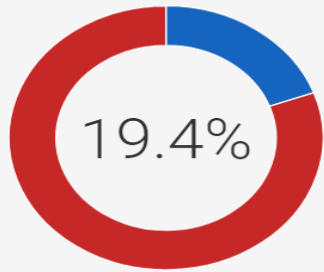


Case Study: Sample IP&T Case

Actual Sample Case

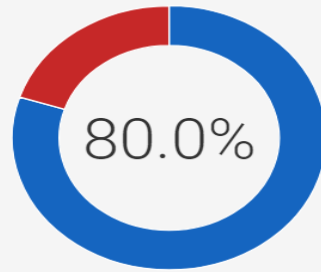
Interviews

Allowance Rate With No Interview



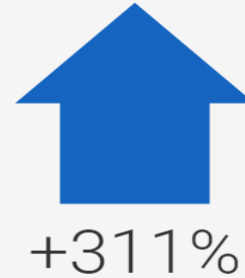
About this graph

Allowance Rate With Interview



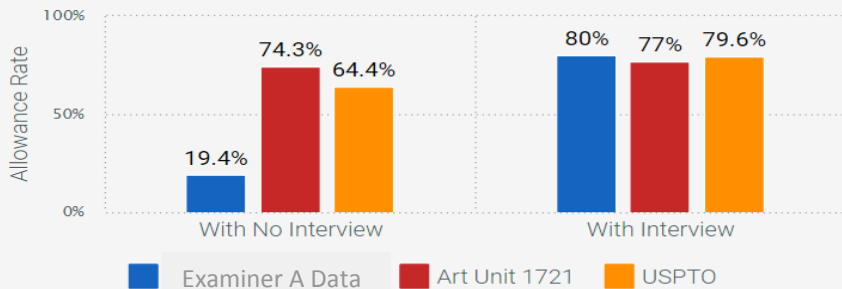
About this graph

Relative Benefit of Interview



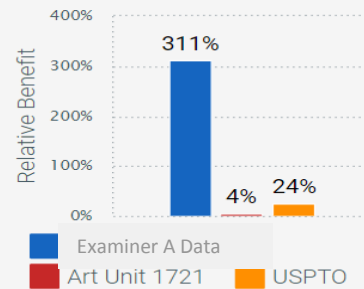
About this graph

Comparative Interview Allowance Rates

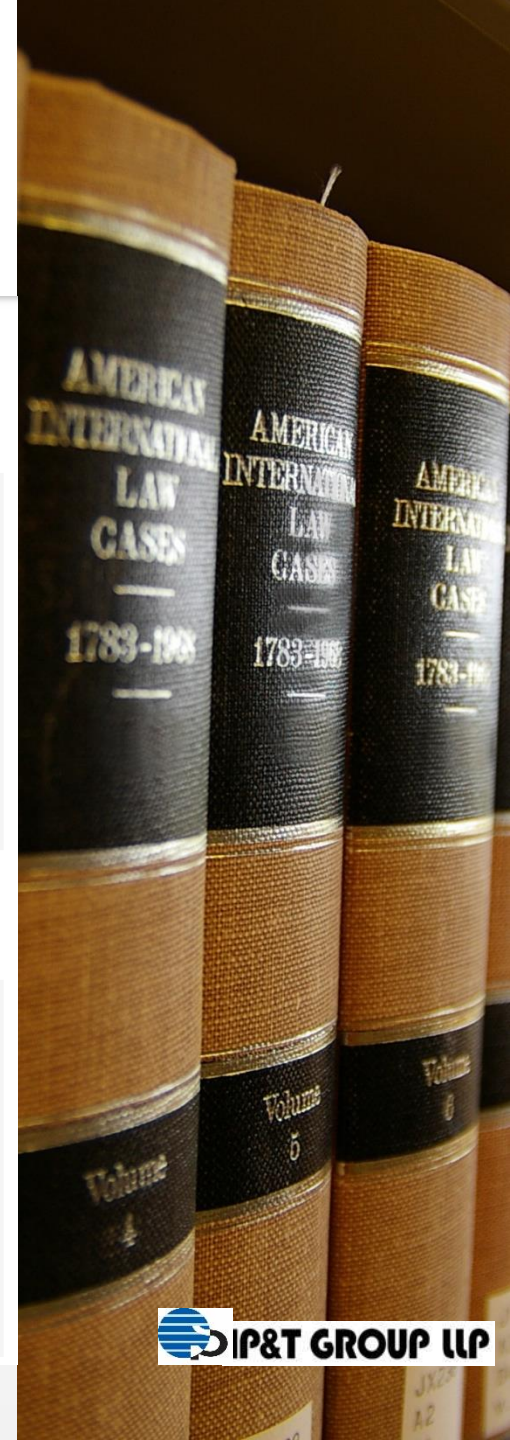


About this graph

Comparative Benefits of Interviews



About this graph

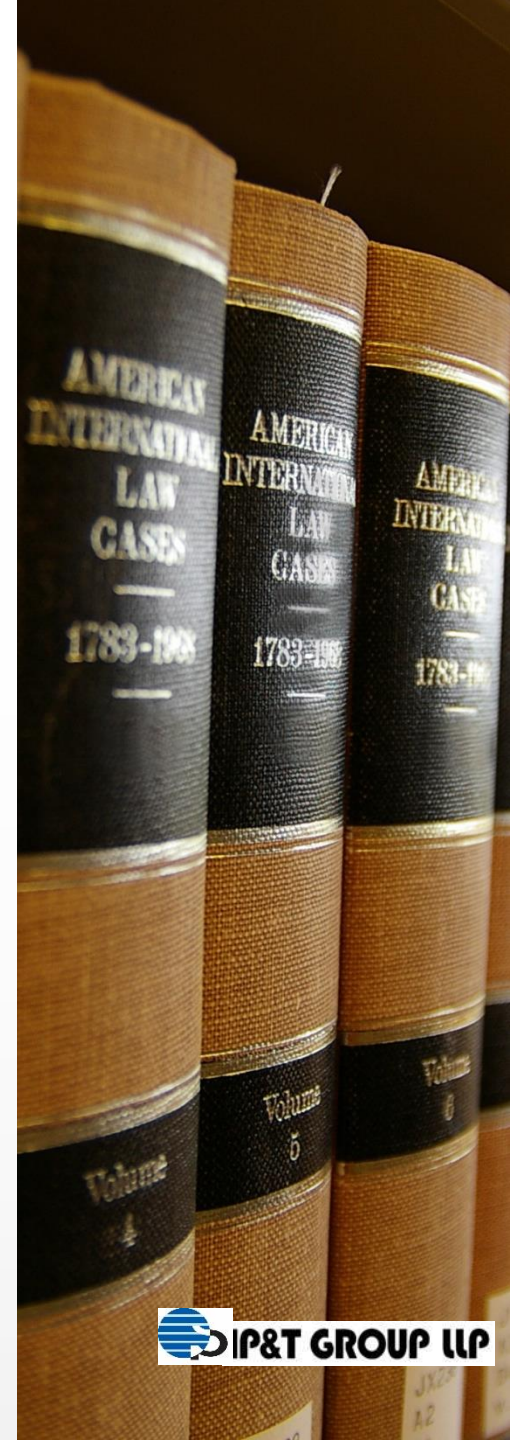
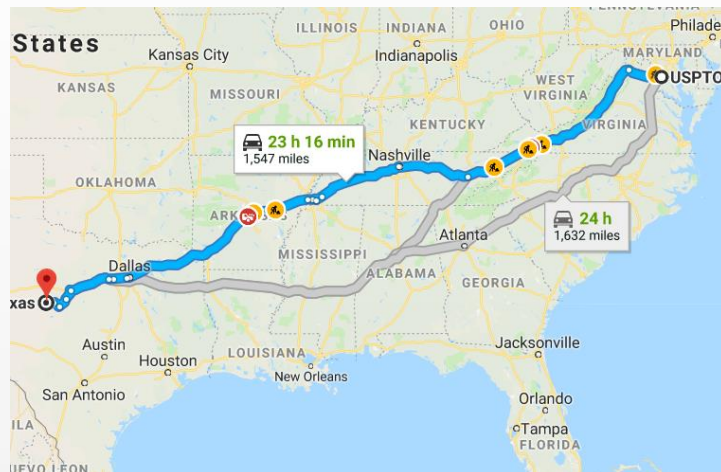


Case Study: Sample IP&T Case

Before First OA

Request for Faster Review of the Case

- Before 1st OA, general interview was held.
- Client wanted faster review of the case and issuance of 1st OA.
- Interview held on 8/2017, 1st OA issued 10/2017.
- After initial informal interview, the Applicant **strongly wanted in-person interview.**
- However, the Examiner was located in **Texas!**

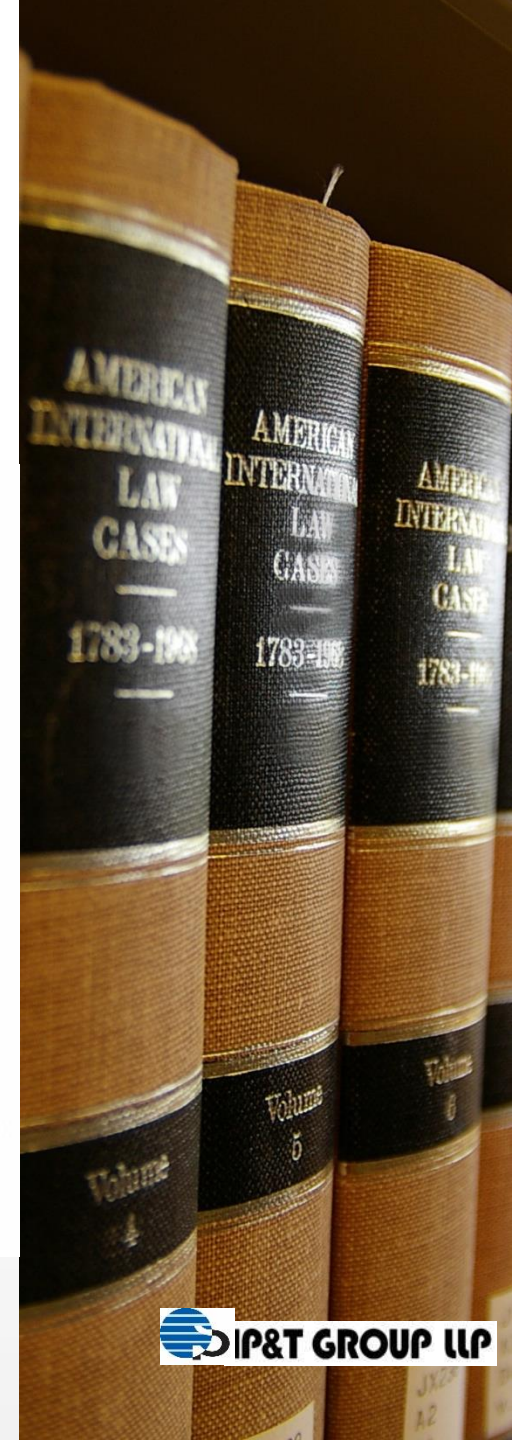


Case Study: Sample IP&T Case

After First OA

Office Action (App# 15/196,703):

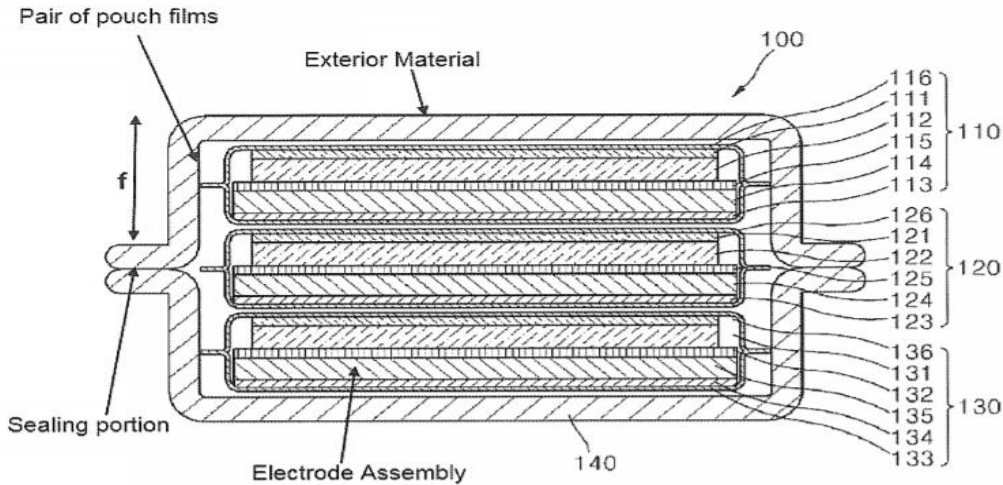
1. Claims 1-37 are rejected under 35 U.S.C. 103 as being unpatentable over *Kwon et al.* (US 2012/0121963).
2. Regarding claims 1-37, Kwon teaches a battery (see Figure) which reads on Figure 2 in instant specification of Applicant.
3. Pictures and drawings may be sufficiently enabling to put the public in the possession of the article pictured. Therefore, such an enabling picture may be used to reject claims to the article. However, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). See also MPEP § 2125 for a discussion of drawings as prior art.



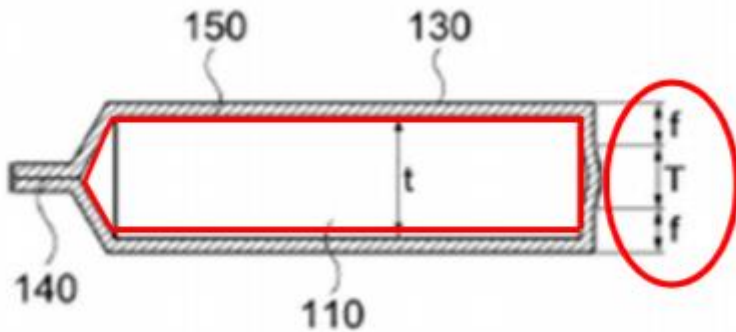
Case Study: Sample IP&T Case

After First OA

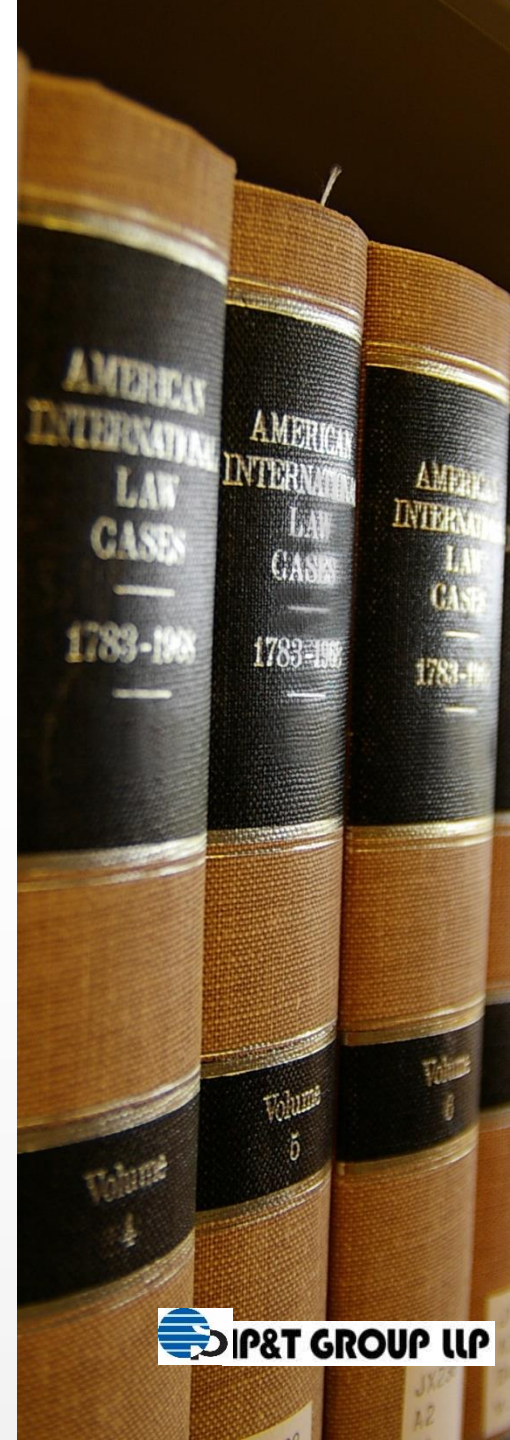
Prior Art and Present Invention:



KWON



Pouch-type
Battery disclosed
in the present
application

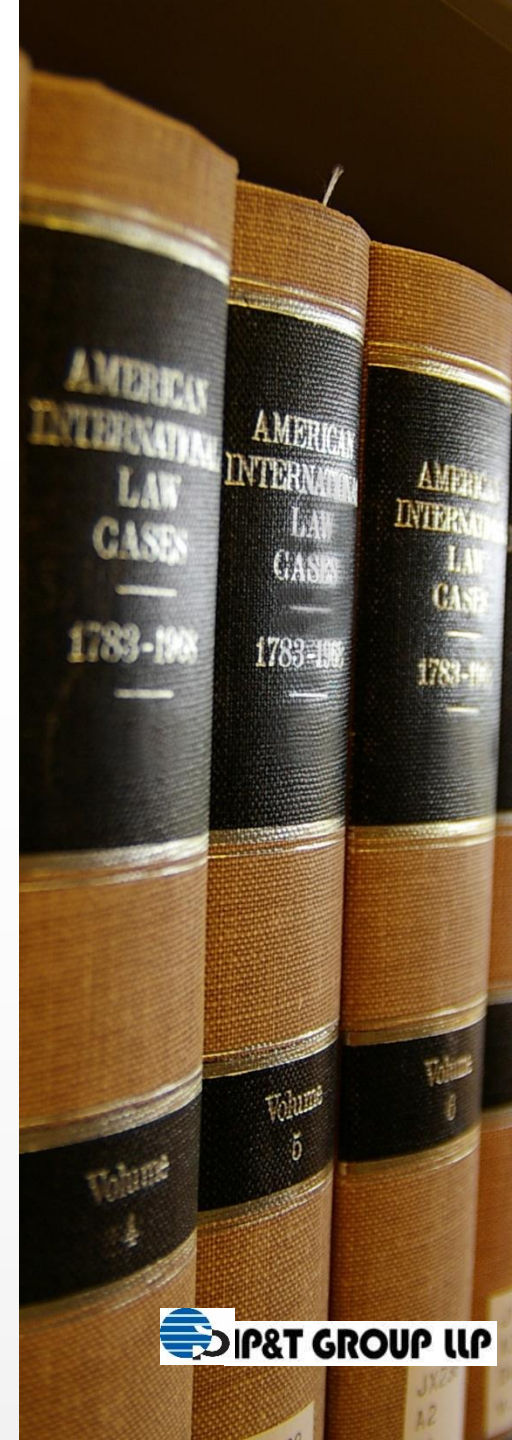


Case Study: Sample IP&T Case

After First OA

Video Conference (“Webex”) was used:

- Examiner was working in Texas.
- Interview agenda was drafted with argument (no claim amendment).
- Kwon discloses a conventional secondary battery including four side sealing surfaces.
- Various advantages:
 - Reduction in sealing portion allows more space for useful part of the battery assembly, results in increased capacity, lower cost.
 - The present invention allows a larger electrode assembly to be packaged within the exterior material.
 - Allows easier cooling of the electrode assembly by attaching a cooling plate at the side of the sidewall of the exterior material which is in contact with the electrode assembly.

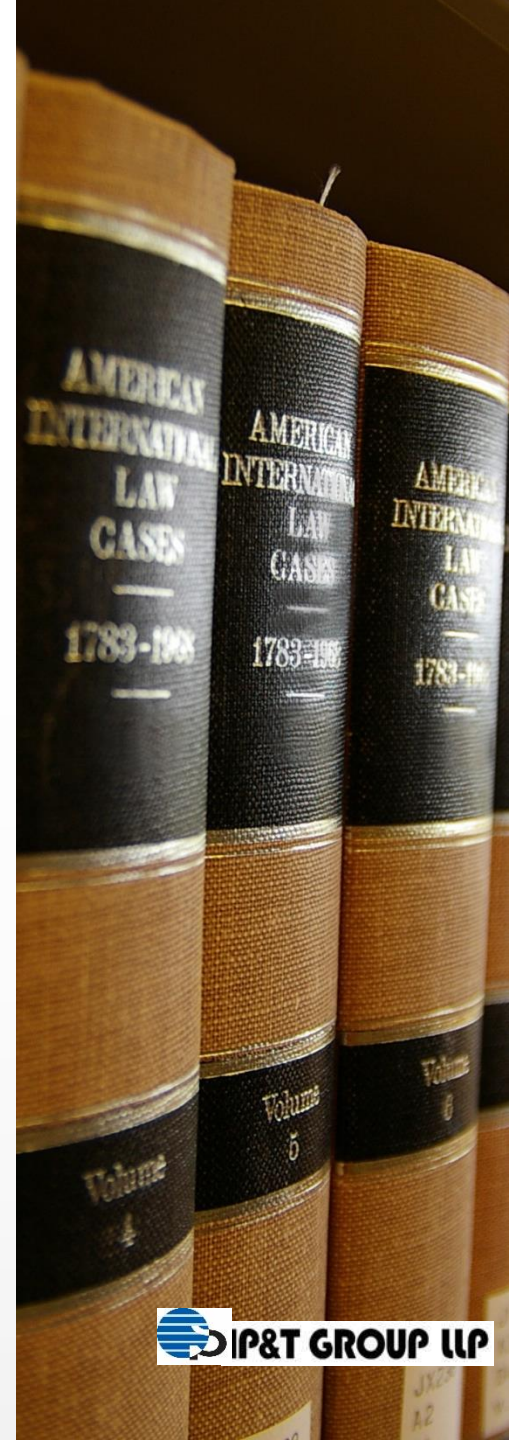


Case Study: Sample IP&T Case

After First OA

Video Conference was used:

- Examiner agreed that even without the amendment, the cited reference will be removed.
- The client wanted the faster Notice of Allowance.
- The Examiner and the client agreed that the amendment emphasizing the reduction in sealing surface will allow the Examiner to issue NOA.



Case Study: Sample IP&T Case

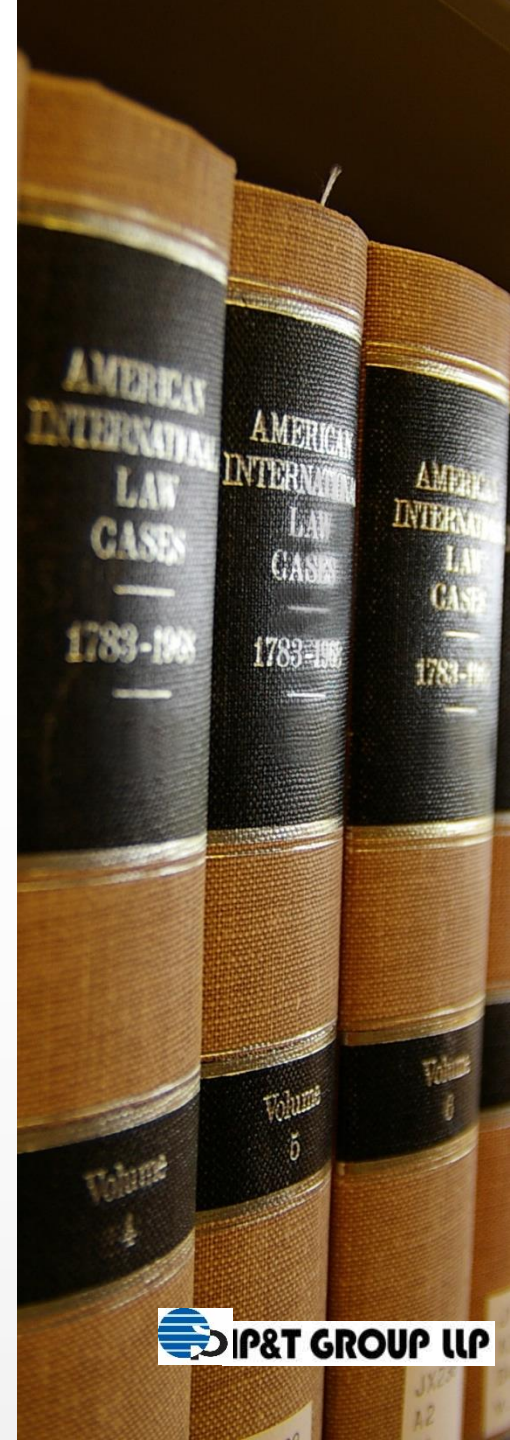
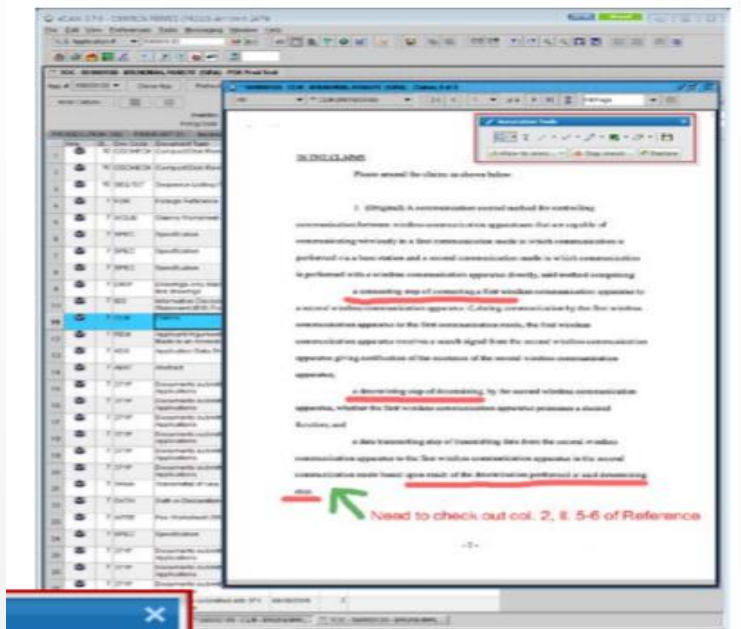
After First OA

Tools within the Webex:

- Applicants and Examiner can utilize tools within the Webex to more efficiently describe/argue their respective positions.



Figure 18. WebEx Sharing Toolbar



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After First OA

NOA Issued:

EXAMINER'S COMMENT/REASONS FOR ALLOWANCE

Allowable Claims

Claims 1-37 are allowed over the prior art of record.

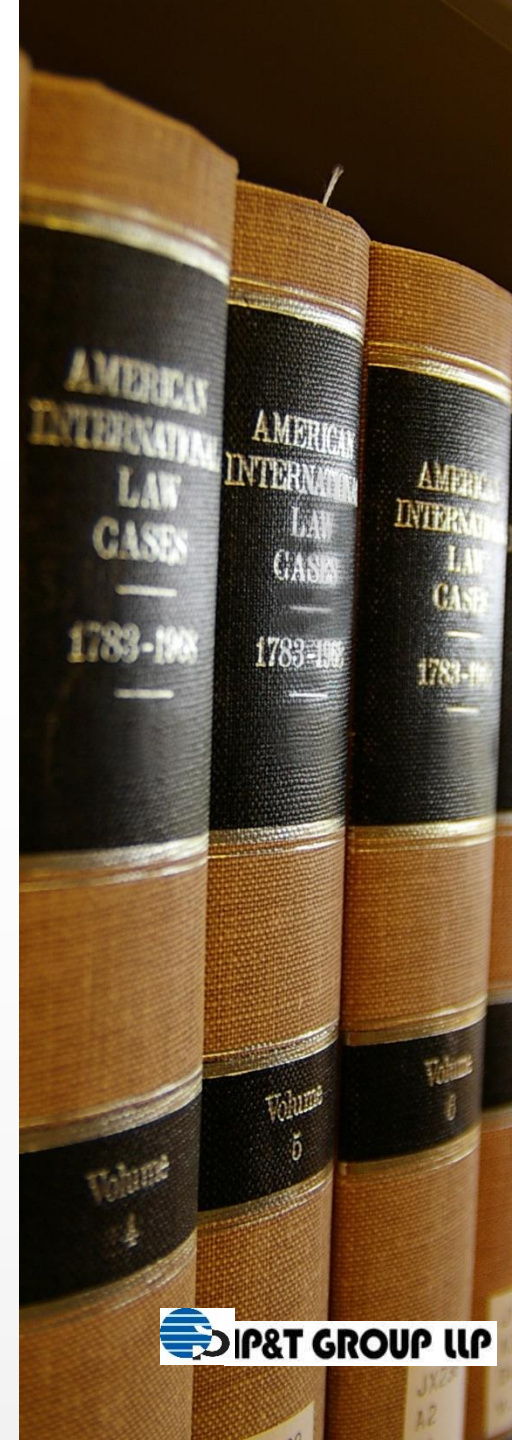
Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The prior art of record fails to disclose or reasonably suggest alone or in combination, the limitations recited in claims 1 and 19

The amendments as filed by the applicant on 3/27/18 taken with the additional limitations already recited in the claims is deemed sufficient to differentiate the instant invention from the inventions of the closest prior art.

The limitations recited in the instant claims are not disclosed or rendered obvious by the prior art of record.

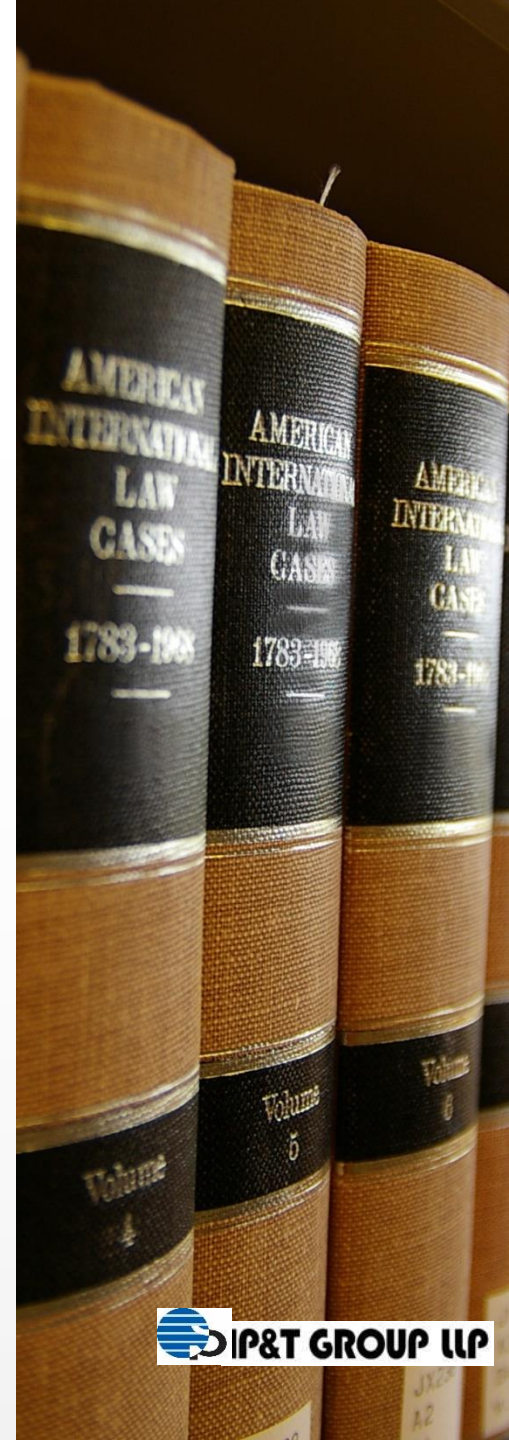


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Webex Interview

Conclusion:

- When dealing with **lots of figures**, Webex interview can be very useful tool.
- If the **Examiner is located far** from USPTO Headquarter, and the applicant insists on in-person interview, Webex is a great tool.
- **Different tools within the Webex** can be utilized to help move forward the prosecution more efficiently.
- We always **appreciate Examiners' patience and effort** to move prosecution forward!





Thank you.

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