

**DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

[Docket No.: PTO-P-2015-0026]

**United States Patent and Trademark Office and Korean Intellectual Property Office**

**Collaborative Search Pilot Program**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice

**SUMMARY:** The United States Patent and Trademark Office (USPTO) is initiating a joint Work Sharing Pilot Program with the Korean Intellectual Patent Office (KIPO) to study whether the exchange of search reports between offices for corresponding counterpart applications improves patent quality and facilitates the examination of patent applications in both offices. In the pilot program, each office will concurrently conduct a prior art search for its corresponding counterpart application. The search report from each office will then be exchanged between offices before either office issues a communication concerning patentability to the applicant. As a result of this exchange of search reports, the examiners in both offices may have a more comprehensive set of references before them when making an initial patentability determination.

Each office will accord special status to its counterpart application to first action. First Action Interview (FAI) pilot program procedures will be applied during the examination of the U.S. application and make the Korean search report of record concurrently with the issuance of a Pre-Interview Communication.

**EFFECTIVE DATE:** September 1, 2015

**DURATION:** Under the United States-Korean Collaboration Pilot (US-KR CSP) program, the USPTO and KIPO will accept petitions to participate for two years from its effective date. During the pilot program, each office will be limited to granting 400 petitions. The offices may extend the pilot program (with or without modification) for an additional amount of time, if necessary. Both offices reserve the right to terminate the pilot program at any time.

**FOR FURTHER INFORMATION CONTACT:** Daniel Hunter, Director of International Work Sharing, Planning, and Implementation, Office of International Patent Cooperation, by telephone at 571-272-8050 regarding the handling of any specific application participating in the pilot. Any questions concerning this notice may be directed to Joseph Weiss, Senior Legal Advisor, Office of Patent Legal Administration, by phone (571) 272-7759. Any inquiries regarding this pilot program can be e-mailed to [csp@uspto.gov](mailto:csp@uspto.gov)

## **SUPPLEMENTARY INFORMATION:**

### **I. Background.**

The USPTO is continually looking for ways to improve the quality of issued patents and to promote work sharing between other Intellectual Property (IP) Offices throughout the world. The USPTO has launched several work sharing pilot programs in recent years (e.g., numerous Patent Prosecution Highway Pilot Programs). In furtherance of promoting interoffice work sharing, the USPTO and KIPO will cooperate in a study to determine whether work sharing between IP offices, in the form of exchanging the results from independently performed concurrent searches, increases the efficiency and quality of patent examination. This exchange of search reports would occur prior to making determinations regarding patentability. Work sharing benefits applicants by promoting compact prosecution, reducing pendency, and supporting patent quality by reducing the likelihood of inconsistencies in patentability determinations (not predicated upon differences in national patent laws) between IP offices when considering corresponding counterpart applications.

Currently, an application filed in the USPTO with a claim of foreign priority may have a search report and art cited by the foreign office in the priority application provided to applicant during the U.S. application's pendency. After review of the search report and cited art, an applicant may submit an Information Disclosure Statement (IDS) in the U.S. application to provide the information to the USPTO. Often this submission occurs after examination on the merits is already underway in the U.S. application. Upon evaluation of the search report and cited art, the U.S. examiner may determine that the art cited by the foreign office is relevant to patentability and merits further examination before making a final determination on patentability. The delay

caused by further examination results in additional costs to an applicant and the USPTO that could have been avoided if the U.S. examiner was in possession of the foreign office's search results before commencing examination of the application. Furthermore, in light of the various expedited examination programs currently in place, the potential exists that a U.S. application may reach final disposition before an applicant is in receipt of a foreign office's search report. Work sharing between intellectual Property (IP) offices in the form of an exchange of search reports may increase efficiency and promote patent examination quality by providing the examiner with both offices' search reports when examination commences. In order to study the benefits of the exchange of search reports between offices, current USPTO examination practice would need to be modified to conduct a search and generate a search report, without issuance of an Office action. The U.S. application also would need to be "made special" pursuant to USPTO procedures to ensure that it could be contemporaneously searched with its corresponding counterpart application.

The USPTO is using the First Action Interview Pilot Program (FAI) in this search report work sharing pilot program because its procedure bifurcates the determination and evaluation of a prior art search from the notice of rejection. See Full First Action Interview Pilot Program, 1367 Off. Gaz. Pat. Office 42 (June 7, 2011). Under the FAI pilot program, participants receive a Pre-Interview Communication providing the results of a prior art search conducted by the examiner. Participants then have three options: (1) file a request not to conduct a first action interview; (2) submit a reply under 37 CFR 1.111 after reviewing the Pre-Interview Communication; or (3) conduct an interview with the examiner. Participants in the FAI pilot program experience many benefits including: (1) the ability to advance prosecution of an application; (2) enhanced

interaction between applicant and the examiner; (3) the opportunity to resolve patentability issues one-on-one with the examiner at the beginning of the prosecution process; and (4) the opportunity to facilitate possible early allowance.

The US-KR CSP program differs from the FAI pilot program procedure by requiring a Petition to Make Special for the participating application, and providing for the exchange of information with KIPO at different stages of prosecution as set forth in this notice.

The USPTO also is initiating a joint Work Sharing Pilot Program with the Japan Patent Office (JPO). The KIPO and JPO pilot programs are different in the way that they operate. Thus, while there may be applications that are eligible for both work sharing pilot programs, such applications will **not** be permitted to participate in both pilot programs due to the differences in work sharing procedures of these two different programs. More information about the US-KR CSP program can be found on the USPTO's Internet Web site at: <http://www.uspto.gov/patents-getting-started/international-protection/collaborative-search-pilot-program-csp>.

## **II. Overview of Pilot Program Structure.**

An application must meet all of the requirements set forth in section III of this notice to be accepted into this pilot program. An applicant must file a Petition to Make Special using form PTO/SB/437KR via EFS-web in a U.S. application. Use of the form will assist an applicant in complying with the pilot program's requirements. Form PTO/SB/437KR is available at: <http://www.uspto.gov/patents-getting-started/international-protection/collaborative-search-pilot-program-csp>. An applicant's use of this form allows the USPTO to quickly identify participating

applications, facilitates timely processing in accordance with this notice, and simplifies petition preparation and submission for an applicant. The collection of information involved in this pilot program has been submitted to OMB. The collection will be available at the OMB's Information Collection Review Web site ([www.reginfo.gov/public/do/PRAMain](http://www.reginfo.gov/public/do/PRAMain)).

No fee is required for submission of petitions using Form PTO/SB/437KR. The fee (currently \$140.00) for a petition under 37 CFR 1.102 (other than those enumerated in 37 CFR 1.102(c)) is hereby sua sponte waived for petitions to make special based upon the procedure specified in this notice.

Each office may reevaluate the workload and resources needed to administer the pilot program at any time. The USPTO will provide notice of any substantive changes to the program (including early termination of the program) at least thirty (30) days prior to implementation of any changes.

New patent applications are normally taken up for examination in the order of their U.S. filing date. Applications accepted into the US-KR CSP program will receive expedited processing by being granted special status and taken out of turn until issuance of a Pre-Interview Communication, or first action allowance, but will not maintain special status thereafter. While KIPO and USPTO will be sharing search reports, the possibility exists that there may be differences in the listing of references made of record by the USPTO versus those made of record in the corresponding KIPO counterpart application. Participants in the US-KR CSP program should review the references cited in each respective office's search reports. If any

KIPO communication to an applicant cites references that are not already of record in the USPTO application and the applicant wants the examiner to consider the references, the applicant should promptly file an Information Disclosure Statement (IDS) that includes a copy of the KIPO communication along with copies of the newly cited references in accordance with 37 CFR 1.98 and MPEP § 609.04(a)-(b). See also MPEP §§ 609 and 2001.06(a).

### **III. Requirements for Participation in the Pilot Program.**

The following requirements must be satisfied for a petition under the US-KR CSP Program to be granted:

(1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371(c), with an effective filing date of no earlier than March 16, 2013. The U.S. application and the corresponding KIPO counterpart application must have a common earliest priority date that is no earlier than March 16, 2013.

(2) A completed petition form PTO/SB/437KR must be filed in the application via EFS-Web. Form PTO/SB/437KR is available at: <http://www.uspto.gov/patents-getting-started/international-protection/collaborative-search-pilot-program-csp>.

(3) The petition submission must include an express written consent under 35 U.S.C. 122(c) for the USPTO to accept and consider prior art references and comments from KIPO, during the examination of the U.S. application participating in the pilot program. The petition

also must provide written authorization for the USPTO to provide KIPO access to the participating U.S. application's bibliographic data and search reports in accordance with 35 U.S.C. 122(a) and 37 CFR 1.14(c). Form PTO/SB/437KR includes language compliant with the consent requirements for this pilot program.

(4) The petition must be filed at least one day before a first Office action on the merits of the application appears in the Patent Application Information Retrieval (PAIR) system (i.e., at least one day prior to the date when a first Office action on the merits, notice of allowability or allowance, or action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935), appears in the PAIR system). An applicant should check the status of the application using the PAIR system prior to submitting the petition to ensure that this requirement is met.

(5) The petition for participation filed in the corresponding KIPO counterpart application for the US-KR CSP Program must be grant or have granted by KIPO. The KIPO and the USPTO petitions should be filed within fifteen days of each other. Both the KIPO and the USPTO petitions must be granted for the applications to be treated under the US-KR CSP program. As the requirements of each office's pilot program may differ, applicants should review the requirements for both pilot programs when considering participation, ensuring that the respective corresponding counterpart applications can comply with each office's requirements.

(6) The petition submission must include a claims correspondence table that notes which claims between the pending U.S. and KIPO applications have a substantially corresponding

scope to each other. Claims are considered to have a “substantially corresponding scope” where, after accounting for differences due to claim format requirements, the scope of the corresponding claims in the corresponding KIPO counterpart application would either anticipate or render obvious the subject matter recited under U.S. law. Additionally, claims in the corresponding U.S. counterpart application that introduce a new/different category of claims than those presented in the corresponding KIPO counterpart application are not considered to substantially correspond. For example, where the corresponding KIPO counterpart application contains only claims relating to a process of manufacturing a product, then any product claims in the corresponding U.S. counterpart application are not considered to substantially correspond, even if the product claims are dependent on process claims which substantially correspond to claims in the corresponding KIPO counterpart application. Applicants may file a preliminary amendment in compliance with 37 CFR 1.121 to amend the claims of the corresponding U.S. counterpart application to satisfy this requirement when attempting to make the U.S. application eligible for the program.

(7) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or any multiple dependent claims, applicants may file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims to make the application eligible for the program.

(8) The claims must be directed to a single invention. If the Office determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), the applicant must make a telephonic election without traverse in accordance with the procedures outlined in section V of this notice. An applicant is responsible for ensuring that the same invention is elected in both the U.S. and KIPO corresponding counterpart applications for concurrent treatment in the US-KR CSP program.

(9) All submissions for the participating application while being treated under the US-KR CSP program's procedure must be filed via EFS-Web.

(10) The petition must include a statement that the applicant agrees not to file a request for a refund of the search fee and any excess claim fees paid in the application after the mailing or notification date of the Pre-Interview Communication. See form PTO/SB/413C. Any petition for express abandonment under 37 CFR 1.138(d) to obtain a refund of the search fee and excess claim fee filed after the mailing or notification date of a Pre-Interview Communication will not be granted.

**IV. Decision on Petition to Make Special Under the US-KR Collaborative Search Pilot Program (Form PTO/SB/437KR):** An applicant must file a Petition to Make Special using Form PTO/SB/437KR in an eligible U.S. application for entry into the US-KR CSP program. Applicant also must file the appropriate petition paper in the corresponding KIPO counterpart application for participation in the US-KR CSP program. Once both petitions are granted, the

U.S. application will receive expedited processing by being placed on the examiner's special docket for examination in accordance with sections V-VIII of this notice.

**A. Petition Decision Making:** An applicant must file appropriate petition papers in both the USPTO and KIPO corresponding counterpart applications within fifteen days of each other. If the petitions are not filed within fifteen days of each other, an applicant runs the risk of one of the pending applications being acted upon by an examiner before entry into the pilot program, which will result in both applications being denied entry into the pilot program. Both offices must grant the respective petitions in order for the applications to participate in the pilot program. Once the USPTO issues a decision granting the petition, an applicant will no longer have a right to file a preliminary amendment that amends the claims. Any preliminary amendment filed after petition grant and before issuance of a Pre-Interview Communication amending the claims will not be entered unless approved by the examiner. After the petition is granted and before issuance of the Pre-Interview Communication, an applicant may still submit preliminary amendments to the specification that do not affect the claims. If either office determines that the petition must be denied, then the other office will be informed of the denial determination, and both offices will issue decisions denying the petition.

**B. Petition Dismissal:** If an applicant files an incomplete Form PTO/SB/437KR, or if an application accompanied by Form PTO/SB/437KR does not comply with the requirements set forth in this notice, the USPTO will notify the applicant of the deficiency by issuing a dismissal decision and the applicant will be given a single opportunity to correct the deficiency. If an applicant still wishes to participate in the pilot program, the applicant must make appropriate

corrections within one month or thirty days of the mailing date of the dismissal decision, whichever is longer. The time period for reply is not extendable under 37 CFR 1.136(a). If the applicant fails to correct all of the noted deficiencies within the time period set forth, the USPTO will render a denial decision and notify KIPO in accordance with this notice, and neither application will be eligible for the pilot program. The U.S. application will then be taken up for examination in accordance with standard examination procedures, unless designated special in accordance with another established procedure (e.g., Prioritized Examination, Special Based on Applicant's Age, etc.). If an applicant timely files a response to the dismissal that corrects all the noted deficiencies and does not introduce new instances of non-compliance, the USPTO will issue a decision granting the petition.

**C. Withdrawal of Petition:** An application can be withdrawn from the pilot program only by filing a withdrawal of the petition to participate in the pilot program prior to issuance of a decision granting the petition. Once the petition for participation in the pilot program has been granted (one day before it appears in PAIR), withdrawal from the pilot program is not permitted. The USPTO will treat any request for withdrawal from the pilot program filed after the mailing or notification of acceptance into the pilot program as a request to not conduct an interview, and subsequent to the mailing of the Pre-Interview Communication, the USPTO will issue a First-Action Interview Office Action, in due course. (See section VII.B.1. of this notice.)

**V. Requirement for Restriction:** If the examiner determines that not all the claims presented are directed to a single invention, the telephone restriction practice set forth in MPEP § 812.01 will be followed. An applicant must make an election without traverse during the telephonic

interview. If the applicant refuses to make an election without traverse, or if the examiner cannot reach the applicant after a reasonable effort (i.e., three business days), the examiner will treat the first claimed invention (the group of claim 1) as constructively elected without traverse for examination. When a telephonic election is made, the examiner will provide a complete record of the telephone interview, including the restriction or lack of unity requirement and the applicant's election, as an attachment to the Pre-Interview Communication. Applicants are strongly encouraged to ensure that applications submitted for the pilot program are written such that they claim a single, independent, and distinct invention. An applicant is responsible to ensure the same invention is elected in both the U.S. and KIPO corresponding counterpart applications for concurrent treatment in this joint office work sharing pilot program.

**VI. Pre-Interview Communication:** If the application contains only one invention or an applicant has elected one invention without traverse, the examiner will conduct a prior art search for the claimed invention under consideration. The examiner may prepare either a Notice of Allowability or a Pre-Interview Communication.

**A. Notice of Allowability:** If the examiner determines that the application is in condition for allowance or the application could be placed in condition for allowance with minor corrections or a possible amendment or submission, a Pre-Interview Communication and all subsequent FAI procedures under this pilot program will not be necessary. The examiner may allow the application, or contact the applicant and conduct an interview in accordance with MPEP § 713 to discuss any possible amendments or submissions to place the application in condition for allowance. If the USPTO has not received the KIPO search report at the time the examiner has

decided the claims are allowable, the USPTO will notify KIPO of the examiner's findings and references identified during the search. The USPTO will wait for up to 90 days from the date of notification for receipt of the KIPO search. Upon receipt of the KIPO search report, the examiner will consider the references cited in the KIPO search report before making a final determination whether to issue a Notice of Allowability. If the KIPO search report is not received within 90 days, the examiner will issue a Notice of Allowability without consideration of the KIPO search report. An applicant will be responsible for determining the appropriateness of any future correspondence with the USPTO for information later obtained from KIPO. If the examiner issues a Notice of Allowability with consideration of the KIPO search report, the examiner will cite references from the KIPO search report in a Notice of References Cited (PTO-892). The Notice of Allowability with a completed form PTO-892 also will be forwarded to KIPO for further consideration by the KIPO examiner of record for the corresponding KIPO counterpart application. If a Notice of Allowability will not issue, then the examiner will prepare and issue a Pre-Interview Communication in accordance with Section VI.B of this notice.

**B. Pre-Interview Communication:** If the examiner determines the application is not in condition for allowance, the examiner will prepare a Pre-Interview Communication and a PTO-892 citing the prior art references, identifying any rejections or objections relevant to the claimed invention, and any designation of allowable subject matter. If the USPTO has not received the KIPO search report at the time the examiner has completed the Pre-Interview Communication, the USPTO will notify KIPO of the examiner's findings and references identified during the search. The USPTO will wait for up to 90 days from the date of notification for receipt of the KIPO search. Upon receipt of the KIPO search report, the examiner will issue a Pre-Interview

Communication and include a copy of the KIPO search report. Thus, the examiner is not required to cite in the Pre-Interview Communication references cited in the KIPO search report, because the KIPO search report is being sent to the applicant with the Pre-Interview Communication. If the KIPO search report is not received within 90 days, the examiner will issue the Pre-Interview Communication to the applicant, and the application will be removed from the pilot program for evaluation purposes only, but will continue to be treated in accordance with this notice. An applicant is responsible for responding to the USPTO Pre-Interview Communication in accordance with the First Action Interview Program procedures discussed in Section VII of this notice.

The Pre-Interview Communication issued to an applicant will set forth a time period of one month or thirty days, whichever is longer, for the applicant to request or decline an interview. An applicant is responsible for responding to the Pre-Interview Communication in accordance with the First Action Interview Program procedures discussed in Section VII of this notice. The USPTO will permit the applicant to extend this time period for reply pursuant to 37 CFR 1.136(a) for one additional month as set forth in section VII, subsection B (Applicant's Options and Reply to Pre-Interview Communication) and subsection C (Failure to Respond to Pre-Interview Communication) of this notice. The examiner's typical working schedule also will be provided with the Pre-Interview Communication to indicate the examiner's availability for scheduling the interview.

## **VII. Post Pre-Interview Communication**

**A. Amendments Filed After Pre-Interview Communication:** Once a Pre-Interview Communication has been entered in an application, an applicant no longer has a right to amend the application until the first action interview is conducted and the First-Action Interview Office Action is sent. Therefore, any amendments filed after the Pre-Interview Communication, but before the interview and the mailing or notification date of a First-Action Interview Office Action (PTOL-413FA), will not be entered unless approved by the examiner or in accordance with the procedure of the Full First Action Interview Pilot Program in section VII, subsection B(2), or section VIII, subsection B(3), of this notice. This is because the examiner has devoted a significant amount of time to the preparation of the Pre-Interview Communication. See 37 CFR 1.115(b) and MPEP § 714.01(e). The USPTO may enter the amendment if it is clearly limited to: cancellation of claims; adoption of examiner suggestions; placement of the application in condition for allowance, including an explanation on how the proposed amendments overcome art cited and/or applied in the KIPO search report, if necessary, in accordance with U.S. patent laws; and/or correction of informalities (similar to the treatment of an after-final amendment). Amendments will be entered solely at the examiner's discretion.

**B. Applicant Options and Reply to Pre-Interview Communication:** Upon receipt of a Pre-Interview Communication, the applicant has three options:

- (1) File a "Request to Not Have a First Action Interview";

(2) File a reply under 37 CFR 1.111 waiving the first action interview and First-Action Interview Office Action – an applicant is accepting that the Pre-Interview Communication is the first Office action on the merits; or

(3) Schedule the first action interview – an applicant must file an Applicant Initiated Interview Request Form (PTOL-413A) electronically via EFS-Web, accompanied by a proposed amendment or arguments, and schedule the interview to be conducted within two months or sixty days, whichever is longer, from the filing of the Applicant Initiated Interview Request.

**1. Request to Not Have a First Action Interview:** If an applicant wishes not to have the first action interview, the applicant should electronically file a letter requesting not to have a first action interview within the time period set forth in the Pre-Interview Communication. In this situation, a first action interview will not be conducted, and the examiner will provide the First-Action Interview Office Action setting forth the requirements, objections, and rejections relevant to the claimed invention. However, such a request will not preclude the examiner from contacting the applicant and conducting a regular interview in accordance with MPEP § 713 to discuss any issues or possible amendment to place the application in condition for allowance. To ensure that the request will be processed and recognized timely, an applicant should file the request electronically via EFS-Web, selecting the document description “Request to Not Have a First Action Interview” on the EFS-Web screen.

Once the petition for entry into the pilot program has been granted (one day before it appears in PAIR), withdrawal from the pilot program is not permitted. Therefore, the USPTO will treat a request for withdrawal from the pilot program filed after the mailing or notification of granting

an applicant's petition to participate in the pilot program as a request to not conduct an interview, issue a Pre-Interview Communication, and subsequently enter a First-Action Interview-Office Action, in due course.

**2. File a Reply under 37 CFR 1.111, Waiving the First Action Interview and First-Action**

**Interview Office Action:** Applicants may file, preferably in conjunction with a request to not conduct the interview, a reply in compliance with 37 CFR 1.111(b)-(c) to address every rejection, objection, and requirement set forth in the Pre-Interview Communication, including any issues of patentability raised by the art cited and/or applied in the KIPO search report, if necessary, in accordance with U.S. patent laws, thereby waiving the first action interview and First Action Interview Office Action. The reply under 37 CFR 1.111 must be filed within the time period for reply set forth in the Pre-Interview Communication. To ensure that the request will be processed and recognized timely, an applicant should file the request electronically via EFS-Web, selecting the document description "Reply under 1.111 to Pre-Interview Communication" on the EFS-Web screen.

In this situation, a first action interview will not be conducted, and a First Action Interview Office Action will not be provided to the applicant. The Pre-Interview Communication will be deemed the first Office action on the merits. The examiner will consider the reply under 37 CFR 1.111 and provide an Office action in response to the reply, in due course. The Office action will be the second Office action on the merits, and thus it could be a final Office action, a notice of allowability, or other appropriate action.

**3. Schedule the First Action Interview:** If an applicant wants a first action interview with the examiner, the applicant must timely file an Applicant Initiated Interview Request Form (PTOL 413A), electronically using EFS-Web, accompanied by a proposed amendment and/or arguments (as an attachment to the request). To ensure that the request will be processed and recognized timely, the applicant should select the document description “First Action Interview – Schedule Interview Request.”

An applicant must designate a proposed date to conduct the interview to facilitate scheduling of the first action interview. The applicant’s proposed date to conduct the interview must be within two months or sixty days, whichever is longer, from the filing of the Applicant Initiated Interview Request Form. An applicant should consult the examiner’s work schedule provided in the Pre-Interview Communication and discuss with the examiner the best date for conducting the interview.

After filing the Applicant Initiated Interview Request Form, the applicant must contact the examiner to confirm the interview date. The applicant’s failure to conduct an interview within two months or sixty days, whichever is longer, from the filing of Applicant Initiated Interview Request Form will be treated as a failure to respond to the Pre-Interview Communication. See section VII; subsection C (Failure to Respond to Pre-Interview Communication) of this notice. The interview may be in person, telephonic, or a video-conference. The applicant must provide written authorization to conduct any Internet e-mail communications with the examiner. See MPEP § 502.03 for more information.

The proposed amendment or arguments must be clearly labeled as “**PROPOSED**” at the header or footer of each page and filed electronically via EFS-Web as an attachment to the Applicant Initiated Interview Request Form. The proposed amendment or arguments will not be entered as a matter of right. The proposed amendment or arguments must address every proposed rejection, objection, and requirement set forth in the Pre-Interview Communication, including any issues of patentability raised by the art cited and/or applied in the KIPO search report, if necessary, in accordance with U.S. patent laws. The examiner, based upon discussions, feedback, and agreement with an applicant during the interview may at his or her discretion enter the amendment if found sufficient to advance prosecution on the merits. See MPEP §§ 713.01 III and 713.04; see also MPEP §§ 714 and 1302.04. Even if the examiner denies entry of the proposed amendment, the proposed amendment will be placed in the application file.

Preparation for the Interview: An applicant must be prepared to fully discuss the prior art of record, any relevant interview talking points from the interview talking points posted at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/fai\\_talking\\_points.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/fai_talking_points.pdf), and any rejections or objections with the intent to clarify and resolve all issues with respect to patentability during the interview, including any issues of patentability raised by the art cited and/or applied in the KIPO search report, if necessary, in accordance with U.S. patent laws. An applicant also must be prepared to discuss any proposed amendment or arguments previously submitted and discuss and resolve any relevant issues that arise. The interview talking points posted at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/fai\\_talking\\_points.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/fai_talking_points.pdf) represent a non-exhaustive list of potential topics for discussion in a first action interview. The

talking points are available to the public and the patent examining corps to assist and facilitate comprehensive and effective first action interviews.

Multiple proposed amendments or sets of arguments are not permitted.

Inventor Participation: Inventor participation in the interview process is encouraged, as it may assist in the resolution of outstanding rejections and/or objections.

**C. Failure to Respond to Pre-Interview Communication:** If an applicant fails to: (1) respond to the Pre-Interview Communication within the time period for reply or (2) conduct the interview within two months or sixty days, whichever is longer, from the filing of the Applicant Initiated Interview Request Form, the Office will enter a First-Action Interview Office Action. Therefore, the consequence for failure to respond to the Pre-Interview Communication is issuance of a First-Action Interview Office Action without the benefit of an interview.

### **VIII. First-Action Interview and First-Action Interview Office Action**

**A. First-Action Interview:** The interview will be conducted in accordance with the procedure provided in MPEP § 713 except as otherwise provided in this notice. The interview should focus on and include:

1. A discussion to assist the examiner in developing a better understanding of the invention;
2. A discussion to establish the state of the art as of the effective filing date of the claimed invention, including the prior art references cited by the applicant and the examiner (as only

applications subject to the First Inventor to File provisions of the Leahy-Smith America Invents Act (AIA) are eligible for this pilot program); and

3. A discussion of the features of the claimed subject matter which make the invention patentable, including any proposed amendments to the claims.

4. A discussion regarding any issues of patentability raised by the art cited and/or applied in the KIPO search report, if necessary, in accordance with U.S. patent laws.

#### **B. Three Possible Outcomes of a First-Action Interview:**

**1. An agreement is reached and all claims are in condition for allowance.** If the applicant and the examiner reach agreement that the application is in condition for allowance, the examiner must complete an Interview Summary (PTOL-413), enter and attach any necessary amendments or arguments (e.g., the proposed amendment and/or an examiner's amendment), generate a notice of allowability (PTOL-37), and attach a copy of the completed Applicant Initiated Interview Request Form. If the examiner agrees to enter the proposed amendment, the examiner must annotate the first page of the proposed amendment (e.g., "OK to enter"). In an in-person interview, a courtesy copy of the completed forms will be given to the applicant at the conclusion of the interview. The completed forms will then be promptly made of record with a Notice of Allowability and a Notice of Allowance and Fees Due (PTOL 85). The Notice of Allowability and the Notice of Allowance, interview summary, and all amendments made of record along with a completed Notice of References Cited form PTO-892 listing any newly cited references will also be forwarded to KIPO for consideration by the KIPO examiner of record for the corresponding KIPO counterpart application.

**2. An agreement as to allowability is not reached.** If the applicant and the examiner do not reach agreement during the interview, the examiner will set forth any unresolved, maintained, or new requirements, objections, and rejections in the First-Action Interview Office Action. The examiner also will complete an Interview Summary, highlighting the basis for any unresolved, maintained, or new requirements, objections, and rejections as well as resolution of any issues that occurred during the interview, attaching a copy of the completed Applicant Initiated Interview Request Form and any proposed amendments or arguments. In a personal interview, a courtesy copy of the completed forms may be given to the applicant at the conclusion of the interview. The completed forms will be promptly made of record.

For this situation, the First-Action Interview Office Action is deemed the first Office action on the merits. Because the requirements, objections, and grounds of rejection are provided in the Pre-Interview Communication and the First-Action Interview Office Action, the applicant has sufficient notice of the requirements, objections, and grounds of rejection. To avoid abandonment of the application, the applicant must, within two months or sixty days, whichever is longer, from the mailing or notification date of the First-Action Interview Office Action, file a reply in compliance with 37 CFR 1.111(b)-(c). This time period for reply is extendable under 37 CFR 1.136(a) for only two additional months. The First-Action Interview Office Action, interview summary and a completed Notice of References Cited form PTO-892 listing any newly cited references also will be forwarded to KIPO for consideration by the KIPO examiner of record for the corresponding KIPO counterpart application.

**3. An agreement as to allowability is not reached, and applicant wishes to convert the previously submitted proposed amendment into a reply under 37 CFR 1.111(b) and waive receipt of a First-Action Interview Office Action.** Applicants may request the USPTO to enter the previously filed proposed amendment and/or arguments as a reply under 37 CFR 1.111 to address every rejection, objection, and requirement set forth in the Pre-Interview Communication, waiving a First-Action Interview Office Action, if the proposed amendment and/or arguments comply with the requirements of 37 CFR 1.121 and 37 CFR 1.111(b)-(c). If the examiner agrees to enter the proposed amendment as the reply under 37 CFR 1.111 to the Pre-Interview Communication, the examiner must annotate the first page of the proposed amendment (e.g., “OK to enter”), and provide a statement in the Interview Summary (e.g., “Applicant requested to enter the proposed amendment as a reply under 37 CFR 1.111 to the Pre-Interview Communication, waiving the First-Action Interview Office Action”). The applicant cannot file any additional amendment and/or arguments until the mailing or notification of the next Office action.

In this situation, a First-Action Interview Office Action will not be provided to the applicant. The Pre-Interview Communication and the interview will be deemed the first Office action on the merits. The interview summary and a completed Notice of References Cited form PTO-892 listing any newly cited references, if any, also will be forwarded to KIPO for consideration by the KIPO examiner of record for the corresponding KIPO counterpart application. The examiner will enter the proposed amendment and/or arguments, consider it as the reply under 37 CFR 1.111, and provide an Office action in response to the reply. The Office action will be the

second Office action on the merits, and thus it could be a final Office action, a notice of allowability, or other appropriate action.

**C. Substance of Interview Must be Made of Record:** A complete written statement as to the substance of the interview with regard to the merits of the application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview. It is the applicant's responsibility to make of record the substance of an interview, and it is the examiner's responsibility to see that such a record is made and to correct inaccuracies, including those which bear directly on the question of patentability. See MPEP § 713.04.

Date: 7/2/15



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Michelle K. Lee

Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office