

## Enhanced First Action Interview Pilot Program

**I. Summary:** The United States Patent and Trademark Office (USPTO) conducted the First Action Interview Pilot Program in which applicants in certain art areas could participate. *See First Action Interview Pilot Program*, 1329 *Off. Gaz. Pat. Office* 159 (April 22, 2008). Under the program, participants were permitted to conduct an interview with the examiner after reviewing a Pre-Interview Communication providing the result of a prior art search conducted by the examiner. Participants experienced 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. Based upon comments and suggestions from the public, including both participants and non-participants, the Office is expanding the First Action Interview Pilot Program to other art areas and modifying the procedure under the program to enhance efficiency and provide more options to participants.

Currently, granting an interview before first action on the merits of a new application is within the discretion of the examiner and a showing may be required to justify the granting of the interview. *See Manual of Patent Examining Procedure (MPEP) § 713.02*. The First Action Interview Pilot Program, however, provides a procedure which, if followed, makes the granting of an interview non-discretionary.

For those applicants who are eligible and wish to participate in the pilot program, applicants must file a request electronically<sup>1</sup>. When the application is taken up for examination, the examiner will conduct a prior art search and provide applicant a Pre-Interview Communication that includes citations to prior art references from the prior art search (similarly to a search report) and an identification of any rejections and/or objections, if at least one claim is not allowable.

Once the applicant reviews the prior art references, applicant must either file a request to not have a first action interview with the examiner, or schedule the interview and file a proposed amendment or remarks (arguments), within one month or thirty days from the mailing or notification date<sup>2</sup> of the Pre-Interview Communication. If applicant chooses not to have a first action interview, a First Action Interview Office Action will be promptly entered and applicant will have one month or thirty days, whichever is longer, to reply. If an interview is scheduled, applicant must be prepared to discuss issues related to the patentability of the claims. If the applicant and the examiner reach agreement during the interview on all claims at issue in regard to patentability, a Notice of Allowability and Notice of Allowance and Fees Due will be issued promptly after the interview. If agreement is not reached on all claims in regard to patentability,

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<sup>1</sup> *See* the Requirements section of this notice for more information on other requirements for the pilot program.

<sup>2</sup> The mailing or notification date is indicated on the form PTOL-90 accompanying the Office communication. For those applicants that are participating in the Electronic Office Action Program (e-Office Action), the Office communication will not be mailed, rather an e-mail notification will be sent to the applicants who will retrieve the communication through Private Patent Application Information Retrieval (PAIR).

at the conclusion of the interview, applicant may be given a courtesy copy of a First Action Interview Office Action, which will set forth the requirements, objections, and rejections. Applicant will be given one month or thirty days, whichever is longer, from the mailing or notification date of the First Action Interview Office Action to reply, with limited extensions of time.

**II. Effective Date:** The effective date for the Enhanced First Action Interview Pilot Program is October 1, 2009. The pilot program will last for six months, until April 1, 2010. Any request for a First Action Interview filed on or after October 1, 2009, and before April 1, 2010, in an application that is eligible, will be granted if all of the requirements set forth in the Requirements section of this notice are satisfied. *See* section III (Eligibility) and section IV (Requirements) for more information.

**III. Eligibility:** New utility nonprovisional applications that fall within one of the following groups may be eligible for the Enhanced First Action Interview Pilot Program:

1. Applications filed on or before November 1, 2006, and assigned to workgroup 1610 (art units 161X).
2. Applications filed on or before October 1, 2006, and assigned to art unit 1795.
3. Applications filed on or before February 1, 2008, and assigned to workgroups 2150 and 2160 (art units 215X and 216X).
4. Applications filed on or before July 1, 2008, and assigned to workgroups 2440 and 2450 (art units 244X and 245X).
5. Applications filed on or before June 1, 2007, and assigned to art unit 2617.
6. Applications filed on or before May 1, 2008, and assigned to art units 2811-2815, 2818, 2822-23, 2826, 2891-2895.
7. Applications filed on or before December 1, 2007, and assigned to art unit 3671.
8. Applications filed on or before January 1, 2008, and assigned to art unit 3672.
9. Applications filed on or before November 1, 2007, and assigned to art unit 3673.
10. Applications filed on or before February 1, 2008, and assigned to art unit 3676.
11. Applications filed on or before July 1, 2007, and assigned to art units 3677.
12. Applications filed on or before November 1, 2007, and assigned to art units 3679.
13. Applications filed on or before May 1, 2006, and assigned to art unit 3735.
14. Applications filed on or before April 1, 2007, and assigned to art unit 3736.
15. Applications filed on or before December 1, 2006, and assigned to art units 3737.
16. Applications filed on or before August 1, 2006, and assigned to art units 3768.
17. Applications filed on or before December 1, 2006, and assigned to art unit 3739.
18. Applications filed on or before September 1, 2007, and assigned to art units 3762 and 3766.
19. Applications filed on or before September 1, 2006, and assigned to art unit 3769.

Class and art unit assignment data are available via the Patent Application Information Retrieval System (PAIR) at Public PAIR link <http://portal.uspto.gov/external/portal/pair>.

The actual filing date of an application filed under 35 U.S.C. 111(a), and the international filing date of a national stage application, will determine the eligibility. A continuing application may be eligible for participation, if it complies with the requirements and eligibility of this notice.

**IV. Requirements:** A request for a first action interview will be granted in an application that is eligible for the Enhanced First Action Interview Pilot Program (as indicated above) if the following conditions are satisfied:

- (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).
- (2) 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 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.
- (3) 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 an election without traverse or withdraw from the pilot program.
- (4) The request for a first action interview must be filed electronically using the USPTO's electronic filing system, EFS-Web. Applicant should use form PTO/SB/413C, which is available on the USPTO Web site at <http://www.uspto.gov/web/forms/index.html>.
- (5) The request 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). Applicant may check the status of the application using the PAIR system.
- (6) The request for a first action interview must include a statement that 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) and request for a refund of search fee and any excess claim fees filed after the mailing or notification date of a Pre-Interview Communication will not be granted.

The application under the Enhanced First Action Interview Pilot Program will not be advanced out of turn for examination, but most likely will be taken up for examination in the order of its effective United States filing date in accordance with MPEP § 708. Thus, a petition to make special under 37 CFR 1.102(c) is not required for an application to be eligible for the Enhanced First Action Interview Pilot Program. Furthermore, no additional fees are required for participation in the pilot program.

**V. Improper Requests for First Action Interview Pilot Program:** If applicant files a Request for First Action Interview Pilot Program (PTO/SB/413C) that does not comply with the requirements set forth in this notice, the Office will notify the applicant of the deficiency by issuing a Notice of Non-Compliant First Action Interview Request (PTOL-413NC). If applicant still wishes to participate in the Enhanced First Action Interview Pilot Program, applicant must file a proper request and make appropriate corrections within one month or thirty days, whichever is longer. This time period for reply is not extendable under 37 CFR 1.136(a). If applicant fails to correct the deficiency indicated in the Notice of Non-Compliant First Action Interview Request within the time period set forth therein, the application will not be eligible for the Enhanced First Office Action Interview Pilot Program and the examiner will proceed with the preparation of a first Office action on the merits of the application in due course.

**VI. Requirement for Restriction:** If the application contains two or more independent and distinct inventions, the examiner may make a requirement for restriction in accordance with current restriction practice prior to conducting a search. The examiner will contact the applicant and follow the procedure for the telephone restriction practice set forth in MPEP § 812.01. If applicant makes an election during the telephone interview, the election must be made without traverse in order to stay in the pilot program. When an oral election is made, the examiner will provide a complete record of the telephone election, including the restriction requirement and applicant's election, as an attachment to the Pre-Interview Communication on the elected invention.

If applicant cannot make an election over the phone, or the examiner cannot reach the applicant after a reasonable effort (not to exceed three business days), the examiner will issue a restriction requirement in accordance with current policy and practice. *See* MPEP § 814 *et seq.* When applicant makes an election in response to the written restriction, the election must be made without traverse in order to stay in the pilot program. After an appropriate election is made without traverse in an application with a compliant request for a First Action Interview, the examiner will proceed with the preparation of the Pre-Interview Communication.

**VII. Pre-Interview Communication:** If the application contains only one invention or applicant has elected one invention without traverse, the examiner will conduct a prior art search for the claimed invention under consideration. 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 First Action Interview under the pilot program will not be necessary. The examiner may allow the application, or contact the applicant and conduct a regular interview in accordance with MPEP § 713 to discuss any possible amendment or submission to place the application in condition for allowance.

Otherwise, the examiner will prepare a Pre-Interview Communication (PTOL-413FP) and a Notice of References Cited (PTO-892) citing the prior art references and identifying any rejections or objections. The Pre-Interview Communication will set forth a time period of one month or thirty days, whichever is longer. In response to the suggestions from the participants in the initial pilot program, the Office will permit applicant to extend this time period for reply

pursuant to 37 CFR 1.136(a) for one additional month under the enhanced First Action Interview pilot program. See section VIII, subsection B (Applicant's Options and Reply to Pre-Interview Communication) and subsection C (Failure to Respond to Pre-Interview Communication).

The examiner's typical working schedule will also be provided with the Pre-Interview Communication so applicant will be aware of the examiner's availability when scheduling the interview.

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

**A. Amendments Filed After Pre-Interview Communication:** Once a Pre-Interview Communication has been entered in an application, 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 mailed. Therefore, any amendments filed 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 enhanced First Action Interview pilot program in section VIII, subsection B(2), or section IX, 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 Office may enter the amendment if it is clearly limited to: cancellation of claims; adoption of examiner suggestions; placement of the application in *prima facie* condition for allowance; 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 waiving the first action interview;
- (2) File a reply under 37 CFR 1.111 waiving the first action interview and First Action Interview Office Action – applicant is accepting that the Pre-Interview Communication is the first Office action on the merits; or
- (3) Schedule the first action interview – 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 applicant wishes not to have the first action interview, applicant should electronically file a letter requesting to not have a first action interview within the time period set forth in the Pre-Interview Communication. For this situation, a first action interview will not be conducted and the examiner will provide the First Action Interview Office Action to set forth the requirements, objections, and rejections, in due course. 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, 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 a Pre-Interview Communication has been prepared (one day before it appears in PAIR), withdrawal from the program is not permitted. The Office will treat a request for withdrawal from the pilot program filed after the mailing or notification of a Pre-Interview Communication as a request to not conduct an interview, and 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:** Many participants of the initial pilot program thought that the Pre-Interview Communication provided sufficient notice of the rejections, objections, and requirements. These participants wanted to file a reply under 37 CFR 1.111 to the Pre-Interview Communication directly without an interview and the First Action Interview Office Action, to advance prosecution and reduce pendency. Therefore, under the enhanced First Action Interview pilot program, the Office is permitting applicants to file, 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, 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, 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 applicant wants a first action interview with the examiner, 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, applicant should select the document description “First Action Interview – Schedule Interview Request.”

Applicant must also designate a proposed date for the interview to schedule the first action interview. The applicant’s proposed date for the interview must be within two months or sixty days, whichever is longer, from the filing of the Applicant Initiated Interview Request Form. Applicants 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, 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 VIII, subsection C (Failure to Respond to Pre-Interview Communication). The interview may be in person, telephonic or a video-conference. 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 of the proposed amendment or arguments 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 examiner, based upon discussions, feedback and agreement with 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. If the examiner denies entry of the proposed amendment, the proposed amendment will be placed in the application file.

Preparation for the Interview: Applicant must be prepared to fully discuss the prior art of record, any of the relevant interview talking points and any rejections or objections with the intent to clarify and resolve all issues with respect to patentability during the interview. Applicant must also be prepared to discuss any proposed amendment or arguments previously submitted and discuss and resolve any relevant issues that arise. A non-exhaustive listing of potential topics for discussion in a first action interview is available to the public and the patent examining corps to assist and facilitate comprehensive and effective first action interviews. See the Interview Talking Points posted on the USPTO Web site 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).

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:** Under the enhanced First Action Interview pilot program, if 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. During the original pilot program, the failure to timely respond to a Pre-Interview Communication resulted in abandonment of the application. For this enhanced pilot program, the consequence has been reduced to the entry of a First Action Interview Office Action without the benefit of an interview.

## **IX. 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 at the time the invention was made, including the prior art references cited by the applicant and the examiner; and
3. A discussion of the features of the claimed subject matter which make the invention patentable, including any proposed amendments to the claims.

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

**1. An agreement is reached and all claims are in condition for allowance.** At the conclusion of the interview, if 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 proposed amendment (*e.g.*, "OK to enter") on the first page of the proposed amendment. In a personal 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 Allowance and Fees Due (PTOL-85).

**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 the requirements, objections, and rejections in the First Action Interview Office Action. The examiner will also complete an Interview Summary, and attach 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 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, applicant has sufficient notice of the requirements, objections and grounds of rejection. To avoid abandonment of the application, applicant must, within one month or thirty 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 one additional month.

**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.**

Many participants of the initial pilot program wanted the examiner to enter the proposed amendment and/or arguments previously filed as a reply under 37 CFR 1.111 rather than wait for the First Action Interview Office Action and then refile the proposed amendment and/or arguments. Therefore, under the enhanced First Action Interview pilot program, the Office is permitting applicants to request the Office 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 proposed amendment (*e.g.*, “OK to enter”) on the first page of the proposed amendment, 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”). 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 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 responsibility of applicant to make the substance of an interview of record, 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.

## **X. Forms**

### **A. Forms for Applicants to Use:**

Request for First Action Interview Pilot Program (PTO/SB/413C); and  
Applicant Initiated Interview Request Form (PTOL-413A).

### **B. Forms for USPTO Personnel to Use:**

Notice of Non-Compliant First Action Interview Request (PTOL-413NC);  
Pre-Interview Communication (PTOL-413FP);  
Notice of References Cited (PTO-892);  
First Action Interview Office Action (PTOL-413FA);

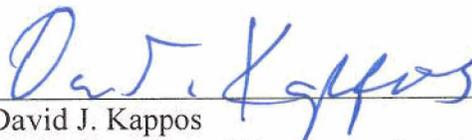
Interview Summary (PTOL-413);  
Notice of Allowability (PTOL-37); and  
Notice of Allowance and Fees Due (PTOL-85).

**XI. Contact Information:** Any inquiries concerning the Office's electronic filing system (EFS-Web) or the Patent Application Information Retrieval (PAIR) system should be directed to the Electronic Business Center at 866-217-9197.

Any inquiries concerning a specific application should be directed to the appropriate Technology Center. Any questions concerning this notice may be directed to Joseph Weiss, Legal Advisor, Office of Patent Legal Administration, by telephone at (571) 272-7759; or e-mailed to [PatentPractice@USPTO.gov](mailto:PatentPractice@USPTO.gov). Any inquiries regarding this pilot program can be e-mailed to [first.action.interview@uspto.gov](mailto:first.action.interview@uspto.gov).

Date:

9/16/09



David J. Kappos

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