

## First Action Interview Pilot Program

**Summary:** The United States Patent and Trademark Office (USPTO) is initiating a pilot program in which, in certain art areas, applicants who comply with the requirements set forth in this notice will receive the results of a prior art search conducted by the examiner, via a condensed Pre-Interview Communication, and then be permitted to conduct an interview with the examiner to discuss the cited prior art references, before the examiner issues an Office action on the merits that sets forth the rejections. An interview under this pilot program would advance prosecution of the application because it would enhance the interactions between the applicant and the examiner, provide applicant the opportunity to resolve patentability issues one-on-one with the examiner at the beginning of the prosecution process, and facilitate possible early allowance. Currently, granting an interview before first action on the merits of a new application is within the discretion of the examiner, who has not yet searched the case, and a showing may be required to justify the granting of the interview. See MPEP § 713.02. The pilot program 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 potential rejections and/or objections, if any 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 issue 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 issued 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, at the conclusion of the interview, applicant may be given a courtesy copy of a First Action Interview Office Action (before mailing), which will set forth any requirements, objections, and rejections. Once mailed the First Action Interview Office Action, coupled with the interview and accompanying interview summary form, will be considered a first Office action on the merits. Applicant will be given one month or thirty days, whichever is longer, from the issue date of the First Action Interview Office Action to reply, with limited extensions of time.

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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> Use of the phrase "issue date" is in anticipation of the possibility that alternative forms of notification other than postal mailing of an action may become available during this pilot.

**Effective Date:** April 28, 2008

The pilot program will last until November 1, 2008. Any request for a first action interview filed on or after April 28, 2008, and before November 1, 2008, will be granted if all of the requirements set forth in the Requirements section of this notice are satisfied.

**Eligibility:** New utility applications that fall within either Group I or Group II as outlined below may be eligible for the First Office Action Interview Pilot Program:

Group I:

- (1) Filed on or before September 1, 2005, and prior to a first action on the merits;
- (2) Classified in Class 709 (Electrical Computers and Digital Processing Systems: Multi-Computer Data Transferring); and
- (3) Assigned to an art unit in either working group 2140 (group art unit 214x) or 2150 (group art unit 215x).

Group II:

- (1) Filed on or before November 1, 2006, and prior to a first action on the merits;
- (2) Classified in Class 707 (Data Processing: Database and File Management or Data Structures); and
- (3) Assigned to an art unit in working group 2160 (group art unit 216x).

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>.

**Requirements:** A request for a first action interview will be granted in an application that is eligible for the First Office 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.
- (3) 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>.

- (4) 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 (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.
- (5) Applicant must agree not to file a request for a refund of the search fee and any excess claim fees paid in the application after the issue date of the Pre-Interview Communication. Any petition for express abandonment under 37 CFR 1.138(d) to obtain a refund of the search fee and any excess claim fees paid or request for a refund of any excess claim fees will not be granted. No search fee and excess claim fees will be refunded after the issue date of a Pre-Interview Communication. The request 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 issue date of the Pre-Interview Communication. See form PTO/SB/413C.

The application under the 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 First Action Interview Pilot Program.

**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. Applicant is encouraged to make an election without traverse during the telephone interview in order to expedite examination. 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.* After an appropriate election is made in an application with a compliant request for a first action interview, the examiner will proceed with the preparation of the Pre-Interview Communication.

**Improper Requests for First Action Interviews:** If applicant files a request for a first action interview 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 First Action Interview Pilot Program, applicant must file a proper request and make appropriate corrections within one month or 30 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 within the time period set forth therein, the application will not be eligible for the First 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.

**Pre-Interview Communication:** If the application contains only one invention or applicant has elected one invention, 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 potential rejections or objections.

The Pre-Interview Communication (PTOL-413FP) will set forth a time period of one month or 30 days, whichever is longer, within which applicant must file either: (1) a letter requesting to not have a first action interview, or (2) an Applicant Initiated Interview Request Form (PTOL-413A) accompanied by a proposed amendment or arguments, to avoid the abandonment of the application. This time period for reply is not extendable under 37 CFR 1.136(a).

The examiner's typical working schedule will also be provided with the Pre-Interview Communication (PTOL-413FP) so applicant will be aware of the examiner's availability when scheduling the interview.

Once a Pre-Interview Communication (PTOL-413FP) has been issued 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. Any amendment other than a proposed amendment filed after the issue date of the Pre-Interview Communication (PTOL-413FP), but before the interview and/or issue date of a First Action Interview Office Action (PTOL-413FA), will not be entered, unless approved by the examiner. This is because the examiner has devoted a significant amount of time to the preparation of the Pre-Interview Communication before the amendment will be received. 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.

**Request to Not Have a First Action Interview:** If applicant files a letter requesting to not have a first action interview within one month or 30 days, whichever is longer, from the issue date of the Pre-Interview Communication (PTOL-413FP), a first action interview will not be conducted. The examiner will then set forth the requirements, objections, and rejections in the First Action Interview Office Action (PTOL-413FA) in due course.

The First Action Interview Office Action (PTOL-413FA) is the first Office action on the merits because it sets forth all requirements, objections and grounds of rejection including the identification of the prior art references, statutory basis for the rejection, and the claims being objected to or rejected. Because the requirements, objections and grounds of rejection are provided in the Pre-Interview Communication (PTOL-413FP) and the First Action Interview

Office Action (PTOL-413FA), applicant has sufficient notice of the requirements, objections and grounds of rejection. To avoid abandonment of the application, applicant must, within one month or 30 days, whichever is longer, from the issue date of the First Action Interview Office Action (PTOL-413FA), file a reply in compliance with 37 CFR 1.111. This time period for reply is extendable under 37 CFR 1.136(a) for only one additional month.

**Applicant Must Timely Schedule the Interview:** Upon review of the Pre-Interview Communication (PTOL-413FP), if applicant still wants a first action interview with the examiner, applicant must file within one month or 30 days, whichever is longer, an Applicant Initiated Interview Request Form (PTOL-413A), or an equivalent paper. Applicant must designate a proposed date for the interview accompanied by a proposed amendment or remarks (arguments) as an attachment to the request, to schedule the first action interview. The applicant's proposed date for the interview can be no more than two months or 60 days, whichever is longer, from the issue date of the Pre-Interview Communication (PTOL-413FP). Applicants should consult the examiner's work schedule provided in the PTOL-413FP and discuss with the examiner the best date for conducting the interview. The applicant's failure to conduct an interview within two months or 60 days from the issue date will be treated as a failure to respond to the Pre-Interview Communication. The interview may be in person, telephonic or video-conferenced. Applicant must provide written authorization to conduct any Internet e-mail communications with the examiner. See MPEP § 502.03 for more information.

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

**Failure to respond to Pre-Interview Communication:** Failure to timely respond to the Pre-Interview Communication either by not submitting a request not to conduct the first action interview or to schedule the interview will result in abandonment of the application.

**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 potential 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 remarks (arguments) previously submitted and discuss and resolve any relevant issues that arise.

Applicant may file a proposed amendment or remarks (arguments) for discussion during the interview. Multiple proposed amendments or sets of remarks (arguments) are not permitted. The proposed amendment or remarks (arguments) must be clearly labeled as "**PROPOSED**" at the header or footer of each page of the proposed amendment or remarks (arguments) and filed as an attachment to the Applicant Initiated Interview Request Form (PTOL-413A), or an equivalent paper. The proposed amendment or remarks (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 into the record if found sufficient to advance prosecution on the merits. *See* MPEP §§ 713.01 III and 713.04; *see also* MPEP §§ 714 and 1302.04.

A non-exhaustive listing of potential topics for discussion in a first action interview will be made available to the public and the patent examining corps to assist and facilitate comprehensive and effective first action interviews. See the list of topics provided in the Interview Talking Points posted on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/faipp.htm>.

**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.

An agreement is reached: 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 (PTOL-413A). 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 made of record and promptly mailed with a PTOL-85 Notice of Allowance and Fees Due.

An agreement 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 (PTOL-413FA). The examiner will also complete an Interview Summary (PTOL-413), attach a copy of the completed Applicant Initiated Interview Request Form (PTOL-413A) 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 made of record and promptly mailed to the applicant.

The First Action Interview Office Action (PTOL-413FA) is a first Office action on the merits as it sets forth all the requirements, objections and grounds of rejection including the identification of the prior art references, statutory bases for the rejections, and the claims being objected to or rejected. Because the requirements, objections and grounds of rejection are proposed in the Pre-Interview Communication (PTOL-413FP) and provided in the First Action Interview Office Action (PTOL-413FA), coupled with the oral interview and accompanying Interview Summary (PTO-413), applicant has sufficient statutory notice of the requirements, objections and grounds of rejection. To avoid abandonment of the application, applicant must, within one month or 30 days, whichever is longer, from the issue date of the First Action Interview Office Action (PTOL-413FA), file a reply in compliance with 37 CFR 1.111. This time period for reply is extendable under 37 CFR 1.136(a) for only one additional month.

**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.

**Contacts:** 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 (by phone (571) 272-7759), Legal Advisor, Office of Patent Legal Administration, 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: 3/24/08

  
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Under Secretary of Commerce for Intellectual Property and  
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