

Navigating The USPTO First Action Interview Pilot Program

By **Robert Curylo** (March 16, 2018, 12:04 PM EDT)

Most options for expediting U.S. patent prosecution require the applicant to incur additional expenses. For instance, the Track One program requires payment of additional fees to the U.S. patent office, and even the Patent Prosecution Highway, which lacks any fee requirement, involves the expense of submitting an application to an office of first filing. By contrast, the First Action Interview pilot program (“FAIPP”) provides a low-cost alternative that often results in faster consideration of applications. And, unlike other options for expediting prosecution, the FAIPP often provides an opportunity to shape the examiner’s opinions early in the examination process, thereby smoothing the path to allowance for certain applications.



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Practitioners who are well versed in the procedures and strategic considerations of the FAIPP can fully leverage its advantages on behalf of clients. To that end, this article guides applicants through each phase of the FAIPP, including enrollment, pre-interview considerations, and various outcomes following the interview.

Program Enrollment

The applicant initiates the FAIPP by submitting an enrollment request. This request is subject to the following requirements:

- Filing enrollment request before first action on the merits: Enrollment requires filing Form PTO/SB/413C at least one day before a first action on the merits appears in the Patent Application Information Retrieval system. The first action on the merits can be an office action, a notice of allowability, or an ex parte Quayle action, but does not include a restriction requirement.
- No more than three independent claims and no more than 20 total claims: Although a preliminary amendment may be filed with an enrollment request to conform the application to the requirement on claim numbers, no refund is available for excess fees paid for claims that are later cancelled via preliminary amendment. Thus, proactively deciding on the FAIPP route and drafting the claim set accordingly will avoid wasting the applicant’s money on excess fees.

- No multiple dependencies: Certain applications, such as Patent Cooperation Treaty applications or applications drafted by non-U.S. practitioners, are more likely to include multiple dependencies. When using the FAIPP with these types of applications, practitioners should ensure that claims are checked for multiple dependencies and amended accordingly.
- No traversal of restriction requirements: Any election in response to a restriction requirement must be made without traverse. If a restriction requirement is issued, then the applicant must choose between a traversal and a first-action interview; the applicant cannot do both.

Getting to the Interview

The Pre-Interview Communication

After enrollment, the examiner issues a pre-interview communication (PTOL-413FP), along with a notice of references cited (PTO-892), that identifies any rejections, accompanying citations to prior art, and any allowable claims. While the FAIPP is sometimes hailed as an opportunity to intercede with the examiner before claims are rejected, the reality is more complicated. The pre-interview communication's level of detail is a strong indicator of whether the applicant should approach the interview with an eye toward overcoming an examiner's entrenched position or shaping the examiner's overall impression of the invention.

For instance, when presented with a well-structured pre-interview communication having levels of detail comparable to an office action, as in the figure below, the applicant should be prepared to address the first-action interview in a manner similar to a non-FAIPP interview.

First Action Interview Pilot Program Pre-Interview Communication				Application No.	Applicant(s)	
				Examiner	Art Unit	AIA (First Inventor to File) Status Yes
Notification of Rejection(s) and/or Objection(s)						
#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection		
6	1,13,18	A	102(a)(1)(a)(2)	A teaches a method and system for determining signing constraints (0032), modifying a document for signing based on those signing constraints (0032, 0050).		
7	10,11,15	A	102(a)(1)(a)(2)	A discloses the signing constraints as specific persons within a company who must be present and must sign the document (0039), and wherein the document must be signed by a certain date (0033).		
8	2,6,12	A, B	103(a)	A fails to disclose but B teaches recording aspects of the electronic signing (B 0088)		

This example of a pre-interview communication clearly articulates the details of the examiner's position by grouping claims according to their features and providing specific mappings between claim limitations and relevant portions of the cited art. This detailed analysis can indicate that the examiner has strong opinions on the claims. Therefore, the applicant should be prepared to present substantive claim amendments, present an in-depth rebuttal to the examiner's arguments, or both.

By contrast, pre-interview communications having more high-level rejections could provide the applicant with an easier route toward agreement with the examiner. In the figure below, a pre-interview communication rejects all claims, but provides little detail about the examiner's rationale for doing so.

First Action Interview Pilot Program Pre-Interview Communication				Application No.	Applicant(s)	
				Examiner	Art Unit	AIA (First Inventor to File) Status No
Notification of Rejection(s) and/or Objection(s)						
#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection		
1	1-10, 12-18, 21-23	G	103(a)	G teaches every limitations recite in claim 1 (col. 5, lines 15-26, col. 6, lines 30-67, col. 9, lines 43-54).		
	1-10, 12-18, 21-23	D	103(a)	G does not explicitly teach steps c) querying...". However, Desell teaches step "querying ..." (para. 0030, 0036).		

In this example, an undifferentiated group containing all claims is summarily rejected with a statement that all limitations are found in a few general citations from the prior art. The applicant is left to guess at how the examiner maps particular claim features to particular teachings of the art. But in some cases, this scenario could work to the applicant's advantage.

In particular, this paucity of detail could indicate that the examiner either does not understand the invention or will be unable to recall, during an interview, why the prior art allegedly reads onto the claims. In either case, the examiner may come to the interview without strongly held opinions on whether the application includes allowable subject matter. The applicant should therefore be prepared, during the first-action interview, to explain the core inventive concept, clarify any misunderstandings on the examiner's part, and demonstrate a detailed knowledge of the prior art and why it does not read onto the claims. This gives the applicant a chance to prevent the examiner's initial impressions from hardening into biases against allowability.

Furthermore, in cases where the applicant-examiner relationship is more adversarial than transactional, the applicant could leverage vaguely worded rejections, in combination with the patent office's count system, to move prosecution in a more favorable direction. For instance, a broadly worded claim rejection, which is common in pre-interview communications, is more likely to gloss over detailed claim features that distinguish the cited art. Traversing such a rejection without amendments changing the scope of that claim should prevent the examiner from issuing a final office action, since any new prior-art rejection would not be "necessitated by applicant's amendment" under Manual of Patent Examining Procedure § 707.07(a). Thus, by failing to sufficiently support all rejections, the examiner has effectively wasted a count on an easily traversed pre-interview communication (or subsequent first action). In this scenario, the examiner may prefer negotiating a path to allowance rather than expending labor on another non-final office action without receiving any accompanying credit for that labor.

Interview Request

Following the pre-interview communication, the applicant must file an interview request to proceed with the FAIPP. In particular:

- An applicant-initiated interview request form (PTOL-413A) must be filed via EFS Web, rather than merely calling the examiner or faxing an interview request form to the patent office. The

filing deadline for the request is one month or 30 days (whichever is longer) from the mailing or notification date of the pre-interview communication, with a one-month extension available.

- The request must designate a proposed interview date that is within two months or 60 days (whichever is longer) from the filing of the interview request. The burden is on the applicant to contact the examiner and confirm the interview date. The failure to conduct the interview within two months or 60 days from the request's filing date will be treated as a failure to respond, triggering a first action on the merits.
- The interview request must be accompanied by proposed amendments, arguments, or both. The proposed amendment or arguments must be clearly labeled as "PROPOSED" at the header or footer of each page of the proposal. No amendment will be entered without the applicant's agreement.

The interview request, along with any proposed amendments or arguments, will be placed in the application file even if no amendments are entered. This fact, in combination with the lack of any required level of detail for proposed arguments, might dissuade practitioners from presenting any argument more detailed than "claim feature X is absent from the references," especially if the practitioner prefers to avoid written remarks and concomitant estoppel risks at all costs.

While such concerns are well taken, the goal of minimizing estoppel risks should not be pursued so ardently or reflexively that the applicant is deprived of the FAIPP's benefits. For instance, although the FAIPP specifically contemplates reaching an agreement on allowability during the interview, an examiner who is hearing the applicant's rationale for the first time during an interview is less likely to feel comfortable with such an agreement, especially in the absence of a clear-cut error in the pre-interview communication. But if the examiner understands the applicant's position because the interview request has explained why a particular claim feature does not encompass the cited disclosure, the limited time during an interview can be focused on convincing a fence-sitting examiner to adopt that position. This is especially true if the pre-interview communication indicates a shallow understanding of the inventive concept on the examiner's part. Therefore, practitioners should carefully weigh the benefit of expediting prosecution against potential estoppel risks, rather than simply hewing to one extreme or the other.

Alternatively, the applicant may simply forgo an interview if, for example, the interview is unlikely to advance prosecution or only minor amendments are required for allowance. To do so, the applicant may either electronically file, within the time period required for requesting an interview, a request to not have a first-action interview or take no action within that period (i.e., the one-month/30-day deadline plus the one-month extension). Either course of action will result in issuance of a first action on the merits. Alternatively, the applicant may simply file a formal reply to the pre-interview communication under Rule 1.111 within the time period required for requesting an interview. In this case, the patent office will consider the pre-interview communication to be the first action on the merits.

The Interview and Subsequent Prosecution

FAIPP interviews proceed similarly to non-FAIPP interviews, with one crucial exception. Unlike non-FAIPP interviews, the examiner, not the applicant, is required to take the next formal action in prosecution. Notably, some examiners are unfamiliar with FAIPP procedure. Accordingly, practitioners should understand and, if necessary, be prepared to diplomatically explain the three possible outcomes of the interview under the FAIPP process.

The first possibility is an agreement on allowability without any action on the merits being issued, which requires the examiner to issue a notice of allowance. The patent office's guidance seems to contemplate a scenario where only the amendments proposed in the interview request result in allowance. However, examiners are often amenable to refining the proposed amendments during the interview and allowing for consultation between a practitioner and the applicant following the interview. If the applicant approves the revised amendment, a notice of allowance is issued upon entry of an applicant-approved examiner's amendment.

A second possibility is that no agreement is reached on allowability, even if agreement is reached on other issues (e.g., distinctions over the currently cited references), and an applicant waives the right to a first action on the merits. Here, the examiner treats the pre-interview communication as the first action on the merits and must convert the interview request, with any amendments or arguments therein, into a reply under Rule 1.111(b). No further applicant action is required until issuance of a subsequent office action (which may be final) or a notice of allowance.

The final possibility is that no agreement is reached on allowability and the applicant does not waive the right to the first action. Here again, no immediate action is required by the applicant. Instead, the examiner must issue a first action on the merits along with an interview summary. Subsequent prosecution of the application is virtually identical to non-FAIPP practice, save for a shortened response deadline for the first action. The applicant must respond to the first action on the merits, or the application will be abandoned.

In the latter two outcomes where no agreement is reached on allowability, an applicant may be well served by waiting for the first action rather than waiving it. For example, if agreement is reached that overcomes any pending rejections and an updated search is not particularly burdensome, examiners may follow up after the interview with proposals for allowance. Alternatively, if no agreement was reached on any issue, awaiting the first action on the merits allows the applicant to develop a more comprehensive response strategy, especially since amendments and arguments presented during the interview request are not binding on the applicant. Therefore, waiving the right to a first action on the merits presents little tactical advantage for the applicant.

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