

Taking Advantage of the First Action Interview Pilot Program

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The U.S. Patent and Trademark Office (USPTO) introduced its “First Action Interview Pilot Program” about two years ago. This program enables patent applicants to conduct an interview with the assigned patent examiner, by phone or in person, before the examiner issues a first office action. In the first office action, the patent examiner either allows the application or identifies grounds to reject the application based on the results of the examiner’s search of the prior art and review of the patent application.

Historically, patent applicants could conduct an interview with the patent examiner after the first office action was issued, but not before this time. With this program, the USPTO has attempted to bring the benefits of the interview earlier in the process by focusing the examiner on relevant aspects of the invention at the beginning of examination and helping the applicant understand the examiner’s interpretation of the patent claims that define the invention.

In many cases, this additional interview before a first office action is issued will help the examiner understand the applicant’s invention. Therefore, the first action interview will tend to reduce the length of time necessary to examine the patent application and tend to increase the overall quality of the examination. But the increased pace of examination will also accelerate costs associated with prosecution, including attorney fees and official fees, and the program will not reduce the amount of time until the examiner first reviews the application. Another drawback is that participation in the program requires applicants to comply with additional requirements.

On the balance, the program was considered successful by the USPTO, which last year enhanced it based on feedback from patent applicants and others. The changes to the program expanded the technologies categories of applications that qualify for the program and generally made the program more user friendly. For example, it is now easier to

opt out of the program after requesting the first action interview, and failure to respond to a notice under the program merely withdraws the patent application from the program instead of abandoning the application.

Qualifying patent applicants should have received notices from the USPTO regarding eligibility of their patent applications for the program. However, since these notices did not set any substantive deadlines in the patent applications, they could easily be lost among the plethora of other communications from the USPTO related to a typical patent application. But a possible deadline related to this program may be looming. Earlier this year, the Director of the USPTO extended the pilot program to Oct. 1, 2010, and despite the success of the program there is no guarantee of another extension. Therefore, patent applicants should take a moment to consider whether their applications could benefit from this program, and if so, they should file a request for a first action interview before the October 1 deadline.

To initiate a first action interview for a particular patent application, the applicant must file a request before Oct. 1, 2010, and comply with the requirements. Notably, most pending applications are not eligible for the pilot program, as eligibility is narrowed to applications that have been assigned to a particular “art unit” within the USPTO (a technology classification) and filed before a stated date for each art unit. A listing of the eligible art units and filing dates is provided on the USPTO Web site. (If the pilot program is made permanent, however, it will likely be opened up to all pending applications.) Also, requests previously issued a first office action are barred.

Assuming that these prerequisites are met, a patent applicant may file a request to participate in the program. The applicant must ensure that the patent application contains no more than 20 total claims and three independent claims. This may be unduly limiting for many applications, where more claims are needed to cover the invention adequately. In addition, the applicant must agree to accept any restrictions

requirement issued by the patent examiner. In a restriction requirement, an examiner finds that the claims cover multiple inventions and requires the applicant to choose one of the inventions to pursue in that application. Accordingly, this may expose the applicant to the risk of having to file for multiple applications to obtain solid patent coverage for the invention.

Once an applicant files a proper first action interview request, the application is placed in the examiner's queue until it would normally be examined. As noted, the pilot program does not accelerate the wait time for a first office action. When the application is ready to be examined, the examiner conducts a search of the prior art. If the examiner believes that the application is allowable, the examiner may issue a notice of allowance. More likely, the examiner will issue a "Pre-Interview Communication," which identifies one or more grounds of rejection based on the examiner's prior art search and review of the claims. However, unlike an office action, this does not contain a detailed description of how the references apply to the claims.

The applicant has one month to schedule an interview, which must be conducted within 60 days of the applicant's interview request. Although this one-month deadline is extendable for one additional month, it is still much less time than the three months (extendable to six months) that applicants normally have to respond to an office action. Therefore, if they choose to participate in this pilot program, applicants should be ready to respond quickly when the examiner begins the examination process. Alternatively, the applicant can opt out of the program at this stage by filing a request waiving the first action interview or by treating the pre-interview communication as a first office action and then filing a substantive response to it.

After the applicant and the patent examiner conduct the first action interview, there are generally three possible outcomes. If an agreement is reached for allowance of the claims, the examiner issues an interview summary and a notice of allowance. If no agreement is reached, the examiner will normally issue an office action, which is treated as the first office action. If the applicant chose to treat the pre-

interview communication as the first office action, the applicant may file a response and any following office action by the examiner would be treated as a second office action. This may have significant consequences, since a second office action may be final, forcing the applicant to appeal the rejections or reopen prosecution.

Whether before or after a first office action, interviews are a valuable tool for obtaining patent claims that have a useful scope of the applicant while addressing the examiner's patentability concerns. With written communications, the examiner and the prosecuting attorney are often like two ships passing in the night—each one not quite understanding the other's point of view. Examiners have too little time to review patent applications and search for relevant prior art, and the interview gives the patent applicant an opportunity to teach the invention to the examiner. The interview also gives the patent applicant an opportunity to hear the examiner's concerns about particular claim language. By moving the interview up to before the first substantive office action, these benefits can be realized earlier in the process to improve the quality and efficiency of the examination.

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This article was first published in the SF Daily Journal on Sep. 9, 2010.

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