

Can We Talk? Doing So Significantly Increases Early Allowance of Patent Applications

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Talking to patent examiners often helps advance the examination of a patent application. Now United States Patent Office ("Patent Office") data shows that by talking to a patent examiner prior to a first official action, an applicant is three (3) times more likely to get a first action allowance of a patent application. A newly expanded Patent Office program makes it easier to talk to the Examiner prior to initial examination.¹ The heart of the program is an "Examiner Interview" that takes place before the examiner issues a first official action, which allows the examiner and patent applicant to discuss the application, identify allowable patent claims, and shave months or years off of the time from filing of an application to receipt of an issued patent.

The new program, officially called the *Full First Action Interview Pilot Program*, is not entirely new. The First Action Interview Pilot Program began in April, 2008, and this initial program transitioned into the Enhanced First Action Interview Pilot Program in October, 2009. Those programs were limited to patent applications in specific technologies, or "art units," within the Patent Office.² Under the new full program, patent applications in all art units are eligible, provided that the applications meet other specific requirements. Unlike the previous interview pilot programs, the full program does not limit eligibility to patent applications filed before a specific date.³ The full program, however, still is a pilot program and is scheduled to continue only until May 16, 2012.⁴ The one-year period will give the Patent Office time to collect more data on the benefits of the full program.

A brief summary of the patent prosecution process helps illustrate where the First Action Interview Program can reduce the patent prosecution time. In a conventional patent application cycle, the patent applicant submits an application to the Patent Office, and the application sits in a queue until the examiner evaluates the patentability of the claims. If the examiner considers one or more claims not to be patentable, the examiner issues a first official action. The applicant can respond by arguing the merits of the claims based on how the claims currently exist in the application or by amending the claims in the application to make them patentable. The examiner, in turn, can either allow the claims or issue a subsequent (non-final or final) official action. Under the best of circumstances, it can take months for the Patent Office to issue a

subsequent official action, and the response from the applicant can take weeks or months. These delays associated with subsequent official actions can be reduced or eliminated by the First Action Interview Program.⁵

The heart of the First Action Interview Program is an interview between the applicant and the examiner in which the examiner and the applicant can talk about the application before the examiner issues the first official action. Participants in the earlier First Action Interview Programs have found the program beneficial because it gives the applicant the opportunity to resolve patentability issues one-on-one with the examiner at the beginning of the patent prosecution process.⁶ When the applicant and the examiner communicate, *i.e.*, by talking one-on-one, before the first official action, much of the patent prosecution activity that would normally follow the first official action can be reduced. Statistics published by the Patent Office indicate that resolving issues before the first official action can lead to early allowance of the patent application. Indeed, under the First Action Interview Pilot Programs, approximately 34% of all applications were allowed on the merits on the first action, compared to about 11% of all applications not involved in the program.⁷

Existing Patent Office rules already allow an applicant to request an examiner interview before the first official action. Unfortunately, those interviews are granted at the examiner's discretion, and the examiner may require the applicant to show why such an interview is justified. Under the First Action Interview Program, the interview is granted on a non-discretionary basis, provided the applicant follows specific procedures defined by the program. To qualify for the program, the applicant must file the request for interview before May 16, 2012 and meet each of the following requirements:

1. The application must be a non-reissue, non-provisional utility application or an international application that has entered a national stage;
2. The application must contain three or fewer independent claims and 20 or fewer total claims;
3. The claims must be directed to a single invention;⁸
4. The request for a first action interview must be filed electronically; and
5. The request must be filed before a first official action on the merits.

If the application meets these requirements, the examiner will conduct the usual prior art search and issue a Pre-Interview Communication to the applicant. That communication will include citations to prior art references and an identification of any rejections of or objections to the claims. The applicant then has one month to schedule an interview with the examiner and submit any proposed amendments or remarks, or else file a request not to have the first action interview with the examiner. At the interview, the applicant and the examiner can talk about the prior art and try to identify the broadest allowable patent claims. After the interview, the examiner will (hopefully) issue a Notice of Allowability or a First Action Interview Office Action. There is no additional fee required to participate in the First Action Interview Program. Therefore, it is a cost effective way to reduce the patent prosecution time by potentially reducing the time from the first official action to the issuance of the patent.

Because the *Full First Action Interview Pilot Program* is a pilot program and is scheduled to end on May 16, 2012, those interested in participating in the program should request an interview without delay. Those interested in using the program to advance new and pending patent applications should contact their attorneys at Bracewell & Giuliani LLP or the attorneys listed on this update to discuss the program further.

¹ "Full First Action Interview Pilot Program," Kappos, David J., Director of the United States Patent and Trademark Office, May 6, 2011, available [here](#) .

² Art Units 1610, 1795, 2150, 2160, 2440, 2450, 2617, 2811-2815, 2818, 2822-2823, 2826, 2829, 2891-2895, 3671, 3672, 3673, 3676, 3677, 3679, 3735, 3736, 3737, 3777, 3768, 3739, 3762, 3766, and 3769. Date restrictions further limited eligible applications within these art units. Enhanced First Action Interview Pilot Program, available [here](#).

³ The Enhanced First Action Interview Program, which ended April 1, 2011, was limited to applications filed *before* a specific date. The specific dates were different for each of the 19 eligible art units, and ranged from Aug. 1, 2006 and May 1, 2008. *Id.*

⁴ Applicants that apply and meet all requirements will be able to participate in the program regardless of whether the interview and first official action occur after the May 16, 2012 end-date of the program. See Frequently Asked Questions Regarding The First Action Interview (FAI) Pilot Program, available [here](#) .

⁵ In 2010, Average First Action Pendency, the average time from filing a patent application until the first official action, was 25.7 months. The Average Total Pendency, the average time from filing until the application issued as a patent or abandoned, was 35.3 months.

http://www.uspto.gov/about/stratplan/ar/2010/mda_02_03.html

⁶ "Full First Action Interview Pilot Program," Kappos, David J., Director of the United States Patent and Trademark Office, May 6, 2011, available [here](#) .

⁷ USPTO [Announces](#) Full First Action Interview Pilot Program, May 16, 2011.

⁸ If the Examiner finds patent claims are directed to more than one invention and issues a restriction requirement, the Applicant must elect claims for a single invention without traverse. Failure to elect without traverse disqualifies the application from the First Action Interview Program.