



# Patent Prosecution Update



## Expansion of the Enhanced First Action Interview Pilot Program

The U.S. Patent and Trademark Office (PTO) has expanded its Enhanced First Action Interview Pilot Program to include all areas of technology. The *Full First Action Interview Pilot Program* (the “Program”) began in May 2011 and will continue until May 16, 2012. While the Program has obvious benefits, participation in the Program may result in increased patent prosecution costs. The following is a summary of key aspects of the Program.

### The Program

As a general rule, the granting of an interview before a first Office Action on the merits is within the discretion of the examiner. Under the Program, participants are entitled to conduct an interview with the examiner prior to receiving a first Office Action on the merits. In advance of the interview, the examiner will perform a prior art search and prepare a Pre-Interview Communication, raising any objections or rejections to the pending application.

After receiving the Pre-Interview Communication, the participant may: (i) file a request waiving the first action interview; (ii) accept the Pre-Interview Communication as the first Office Action on the merits; or (iii) schedule the first action interview. If the participant files a request to waive the first action interview, the first action interview will not be conducted and the examiner will prepare a first Office Action on the merits. Alternatively, the participant may accept the Pre-Interview Communication as the first Office Action on the merits and file a response (under 37 C.F.R. 1.111).

If the participant elects to schedule the first action interview, an Applicant-Initiated Interview Request Form (the “Form”) must be timely filed, electronically via the Web, accompanied by proposed claim amendments and/or arguments. The Form and proposed claim amendments and/or arguments must be filed within one month or thirty days, whichever is longer, of the mailing date of the Pre-Interview Communication. The participant is allowed to extend the time period to file the Form for an additional month. The proposed claim amendments and/or arguments must accompany the Form; the communication containing the proposed claim amendments and/or arguments may not be sent directly to the examiner to avoid making them a communication of record. In addition, the participant must schedule and conduct the first action interview within two months or 60 days, whichever is longer, from the filing date of the Applicant-Initiated Interview Request Form.

During the first action interview, the participant must be prepared to fully discuss the prior art of record, and any relevant objections or rejections raised in the Pre-Interview Communication. In addition, the participant must be prepared to discuss any proposed claim amendments and/or arguments filed with the Form.

As a result of the first action interview, there are three possible outcomes. First, an agreement is reached that the application is in condition for allowance. Second, an agreement is not reached during the interview, in which case the examiner will prepare and issue a First Action Interview Office Action. In this situation, the First Action Interview Office Action is considered the first Office Action on the merits. Third, an agreement is not reached during the interview, and the participant elects to convert the previously submitted proposed arguments and/or claims amendments into a response. In this case, the Pre-Interview Communication is considered the first Office Action on the merits. Following the filing of a response, prosecution of the application will proceed according to conventional PTO procedures.

### Requirements

To participate in the Program, the applicant must electronically file a request at least one day before a first Office Action on the merits appears in the PTO's Patent Application Information Retrieval System. Also, the application must meet the following conditions to be accepted into the Program: (i) the application is a non-reissue, non-provisional utility application, (ii) the application contains three or fewer independent claims, and twenty or fewer total claims, and (iii) the claims of the application are directed to a single invention.

### Cost/Benefits

Although applications accepted into the Program will not be advanced out of turn for examination, applicants may benefit from an early interaction with the examiner. The first action interview provides an opportunity to open a dialog with the examiner prior to receiving a first Office Action on the merits, and may facilitate an early allowance of the application. Currently, no additional Patent Office fees are required to participate in the Full First Action Interview Pilot Program. However, the early interaction with the examiner and accelerated examination pace may lead to increased patent prosecution costs.

### Our Patent Law Group

As patent laws and the rights of patent holders and applicants continue to evolve as a result of court decisions and legislative initiatives, the protection and exploitation of this valuable intellectual property remains more important than ever to companies of all types. Our Patent Law Group represents clients in all of their patent needs, from litigation and dispute resolution to patent applications and contested patent office proceedings to transactions and strategic counseling, allowing them to maximize revenue, market position and shareholder value while retaining and growing their core assets.

If you have any questions about the Program, or would like to consider participating in the Program for certain matters, please contact:

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