Patent Quality Chat: Opportunities for Examiner Interviews: First Action Interview Pilot and General Practice

Patent Quality Chat
Webinar Series 2016 (8 of 11)
July 12, 2016
To send in questions or comments during the webinar, please email:

PatentQualityEventParticipationBox@uspto.gov
Enhanced Patent Quality Initiative

High-quality patents enable certainty and clarity of rights, which fuels innovation and reduces needless litigation. To ensure we continue issuing high-quality patents well into the future, we established the Enhanced Patent Quality Initiative (EPQI). We are strengthening work products, processes, services, and how we measure patent quality at all stages of the patent process.

Updates

- **Post-Prosecution Pilot (P3),** which launched on July 11th, evaluates a new after final program that combines features of the Pre-Appeal Brief Conference and After Final Consideration 2.0 pilot programs and adds new features requested by our stakeholders. For more information, please visit the P3 webpage.

  - The **Post Grant Outcomes Program** launched a pilot aimed at putting related AIA trial proceedings, including their prior art, in front of the examiners of pending related applications. More information is on the Pilot webpage.

Patent Quality Chat:
Opportunities for Examiner Interviews:
First Action Interview Pilot and General Practice

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Director, Technology Center 2400
First Action Interview (FAI) Pilot Program

- Promotes personal interviews prior to issuance of a first Office action on the merits
- Advances examination of applications once taken up in turn
- Facilitates resolution of issues for timely disposition of an application
- Gives applicants more options in regards to the amount of notice and procedure needed
FAI Pilot History

Original Pilot
• In two small, computer technology areas

Enhanced Pilot
• In one technology area in each Technology Center

Full Pilot
• 5/15/2011 – present
• All technology areas are eligible

Email questions to PatentQualityEventParticipationBox@uspto.gov

FAI Pilot Program Requirements

An application suitable for the FAI pilot MUST:

➢ be a non-reissue, nonprovisional utility application under 35 U.S.C. 111(a) or national stage application under 35 US.C. 371
➢ contain three or fewer independent claims and twenty or fewer total claims
➢ not contain any multiple dependent claims
➢ claim only a single invention and
➢ not have a first Office action on the merits as of the date Applicant requests participation in program

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FAI Prosecution Begins: Pre-Interview Communication

The examiner will:

1) Follow current restriction policy and practice
2) Conduct a prior art search
3) Follow current policy and practice if a determination of allowability is made
4) Issue a Pre-interview Communication (PTOL-413FP) setting a one month (30 day) time period to request or decline an interview
   - The time period to respond to the Pre-Interview Communication may be extended for one additional month (30 days)

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Pre-Interview Communication (PTOL-413FP)
PTOL-413FP Example

**Notification of Rejection(s) and/or Objection(s)**

<table>
<thead>
<tr>
<th>#</th>
<th>Claim(s)</th>
<th>Reference(s) (if applicable)</th>
<th>Rejection Statutory Basis</th>
<th>Brief Explanation of Rejection</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>1-8</td>
<td></td>
<td>101</td>
<td>Claim 1 recites a binary translator with various components. The binary translator as claimed is software per se and software in not considered patentable subject matter. Claims 2-8 depend on 1 and do not include hardware so as to overcome the rejection.</td>
</tr>
<tr>
<td>2</td>
<td>1-8</td>
<td></td>
<td>112, 1st</td>
<td>Claim 1 recites the limitation “replace disabled legacy binary instructions with native instructions”. However, according to the specification, on page 6, lines 1-3, “…used to disable…insert new instruction without (see continuation below)</td>
</tr>
<tr>
<td>3</td>
<td>1-5, 7-8</td>
<td>U</td>
<td>102(b)</td>
<td>Claim 1 (Figure 1, 1st para, 3rd para, Section 3.1 Components. 4th paragraph—note the claimed “processor means” is interpreted as the CPU in figure 1, 2 (Fig. 1); 3 (section 3.1, 4th para); 4 (section 4.2, para 9-note) (see continuation below)</td>
</tr>
<tr>
<td>4</td>
<td>6</td>
<td>U,V</td>
<td>103(a)</td>
<td>U does not disclose said native instruction processor as claimed. V discloses at section 2.1, 2nd para. As one would want better code for hot spots to improve performance (see V, Section 2.1), it would have been (see continuation below)</td>
</tr>
</tbody>
</table>

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**Response to Pre-Interview Communication**

Applicants properly respond to the Pre-Interview Communication by filing one of the following:

1. Request not to have the interview
   - Acts as removal from the Pilot
   - FAI-FAOM will be mailed (PTOL-413FA); extensions of time are limited

2. Request not to have the interview AND submit a reply in accordance with 37 CFR 1.111
   - Pre-Interview Communication (PTOL-413FP) serves as FAOM

3. “Applicant Initiated Interview Request” form (PTOL-413A) along with a proposed amendment and/or arguments via EFS-Web, and conduct the interview within 60 days from the filing of the Applicant Initiated Interview Request

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FAI Pilot Interview

- Conducted in accordance with current policy and practice (See MPEP 713) for the purpose of:
  - Assisting the examiner in obtaining a better understanding of the claimed invention
  - Establishing the relevant state of the art
  - Discussing all relevant prior art teachings
  - Focusing on what claimed features establish patentability over the prior art
  - Discussing proposed amendments or remarks

- Applicant may request waiver of the First Action Interview-Office Action and enter a proposed amendment that complies with 37 CFR 1.111

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Interview → Agreement on Allowability

The examiner will:
- Document the substance of the interview and reasons for allowance on an Interview Summary form (PTOL-413)
- Note and attach all relevant amendments and/or arguments
- Generate a Notice of Allowability (PTOL-37), if applicant requests an unofficial, courtesy copy
- Attach a copy of a completed copy of the Applicant Initiated Interview Request form
- Make all documents and forms of record
- Perform an updated search and interference review before issuing an official Notice of Allowability

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**Interview ≠ Agreement on Allowability**

The examiner will:

- Document all requirements, objections, and rejections in a FAI Office Action form (PTOL-413FA)
- Document the substance of the interview on an Interview Summary form (PTOL-413)
- Note and attach all relevant amendments and/or arguments
- Attach a copy of a completed copy of the Applicant Initiated Interview Request form
- Make all documents and forms of record
- Upon request, provide unofficial, courtesy copies

Upon request for a waiver of the FAI Office action, enter a proposed amendment that complies with 37 CFR 1.111

Email questions to PatentQualityEventParticipationBox@uspto.gov

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**Post-FAI Interview Process**

- Applicants must timely respond to all outstanding issues in accordance with current policies and practice
- Applicants must make the substance of the interview of record when filing a timely response
- Examiners must proceed in accordance with current examination procedures and also ensure the substance of the interview made of record by applicants is accurate

Email questions to PatentQualityEventParticipationBox@uspto.gov
How Well Does FAI Work?

<table>
<thead>
<tr>
<th></th>
<th>Total</th>
<th>Original</th>
<th>Enhanced</th>
<th>Full Pilot (since 5/16/11)</th>
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<td>Applicants</td>
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<td>502</td>
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<td>First Action Interview Office Actions</td>
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<td>294</td>
<td>1963</td>
<td>1723</td>
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<td>Final Rejection mailed with No FAI Office action</td>
<td>618</td>
<td>23</td>
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<td>345</td>
<td>3832</td>
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<tr>
<td>Allowed after pre-interview communication but before FAI office action</td>
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<td>1835</td>
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<tr>
<td>Allowed without/before pre-interview communication</td>
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<td>26</td>
<td>482</td>
<td>444</td>
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<tr>
<td>First Action On the Merits without a Pre-Interview Comm</td>
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<td>Quayle Actions</td>
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<td>3</td>
<td>22</td>
<td>17</td>
</tr>
</tbody>
</table>

Results as of June 6, 2016

29.6% 18.2% 30.6% 31.2% First Action Allowance rate

More Information about FAI

- For more details about FAI, including eligibility information and TC POCs, visit [http://www.uspto.gov/patent/initiatives/first-action-interview/full-first-action-interview-pilot-program](http://www.uspto.gov/patent/initiatives/first-action-interview/full-first-action-interview-pilot-program)

- For Notice/Legal questions, contact Joseph Weiss in OPLA 571-272-7759 or email first.action.interview@uspto.gov

- For EFS-Web questions contact the Electronic Business Center (EBC) at 866-217-9197
General Interview Practice @ USPTO

- Overview of Interviews
- Enhancements to Interview Practice
- Discussion of USPTO tools
Interview Time: FY 2008 – FY 2015

Fiscal Year

Hours

0 20,000 40,000 60,000 80,000 100,000 120,000 140,000 160,000 180,000 200,000 220,000

Percent of Serial Disposals Having at Least One Interview (FY 2008- FY 2015)

31.1% of Serial Disposals completed in September 2015 had at least one interview.
Interview Survey Results

- For advancing prosecution, Applicants were very positive.

Enhancements to General Interview Practice
Automated Interview Requests (AIR)

http://www.uspto.gov/patent/laws-and-regulations/interview-practice#step1

Email questions to PatentQualityEventParticipationBox@uspto.gov

AIR Form

- New web-based tool that permits Applicants to schedule an interview with an examiner
Video Conferencing and Collaboration

- Internet Usage Policy has been updated to permit oral authorization for video conferencing tools.
- MPEP § 502.03 now allows a verbal request to authorize a video conferencing, instead of submitting a written request.
- Examiners set up video conferencing for interviews using WebEx, a web-based service that you can use it from any computer (Windows, Mac, Linux, or Solaris) with no software needed.

Email questions to PatentQualityEventParticipationBox@uspto.gov

TC Interview Specialists

- Subject matter expert on interview practice and policy in each Technology Center.
- To assist Examiners and Applicants in facilitating effective interviews.
- The list of TC Specialists can be found here: http://www.uspto.gov/patent/laws-and-regulations/interview-practice/interview-specialist

Email questions to PatentQualityEventParticipationBox@uspto.gov
Public Interview Rooms

- Video conference rooms on each USPTO campus
- Designated for Applicants to use to connect and collaborate with examiners that are working remotely or at a different USPTO campus

Public Interview Rooms, cont.

- Must be reserved by Examiner at least two business days prior to interview.

Video conference room examples:

Alexandria  
Dallas

Email questions to PatentQualityEventParticipationBox@uspto.gov
One-On-One Training

- Applicants interested in more detailed WebEx training may request a one-on-one WebEx training session with an interview specialist.
- Email your request to ExaminerInterviewPractice@USPTO.gov with some possible dates and times.
- Please give at least one week notice.

Email questions to PatentQualityEventParticipationBox@uspto.gov

Interview Tools
For Video Conferencing

Email questions to PatentQualityEventParticipationBox@uspto.gov
WebEx Basics

- You need a computer and a high-speed Internet connection is recommended.
- WebEx is a web-based service, so you can use it from any computer (Windows, Mac, Linux, or Solaris).
- No software needs to be downloaded or purchased.
- A telephone will be used to join the audio component of the meeting while a video camera may be used as part of the visual component.

Click on the WebEx Link

1. Examiners set up the WebEx online meeting and send an email invitation to Applicant
2. At the appointed time, Examiners start the meeting
3. Applicants open the email containing the WebEx online meeting invitation and click on the link to join the visual component of the online meeting.

To join the online meeting (Now from mobile devices!)

1. Click the following link: Join the meeting
2. If requested, enter your name and email address.
3. If a password is required, enter the meeting password:
4. Click "Join".
Add Audio to the WebEx Meeting

- Telephone is used for the audio component of the meeting.
- WebEx can be used to host an international WebEx interview.
- An international Applicant should dial-in to join the audio component by using the “I will Call In” option.

Verbal Authorization for Video Conferencing

Change to Internet Usage Policy to Permit Oral Authorization for Video Conferencing Tools

- Policy has been updated to make it easier for Applicants to authorize the use of video conferencing tools to conduct examiner interviews.
- MPEP § 502.03 now allows a verbal request to authorize a WebEx interview, instead of submitting a written request.
- The verbal authorization is limited to the video conference interview and does not extend to other communications regarding the application.

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For More Information

- Visit our website to find out more about:
  - USPTO Air form
  - Video Conferencing
  - TC Interview Specialist
  - Policy and Guidance
  - Training and FAQs
  http://www.uspto.gov/interviewpractice

- Contact us via email at ExaminerInterviewPractice@USPTO.gov

Let’s Chat about Opportunities for Examiner Interviews: First Action Interview Pilot and General Practice

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Next Patent Quality Chat:
Tuesday, August 9th
The Post-Prosecution Pilot:
A New After Final Collaboration Program