

August 8, 2012

The Honorable David J. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

Via email: [first.action.interview@USPTO.gov](mailto:first.action.interview@USPTO.gov)

**RE: Extension of the Full First Action Interview  
Pilot Program and Request for Comments  
77 Fed. Reg. 40342 (July 9, 2012)**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the Request for Comments on “Extension of the Full First Action Interview Pilot Program” as published in the Federal Register (77 F.R. 40342) on July 9, 2012 (the “Notice”). AIPLA supports the decision to extend the First Action Interview (“FAI”) Pilot Program while completing a comprehensive review of the program, and also urges the Office to make it a permanent part of the application process upon consideration of the comments below.

AIPLA is a national bar association whose approximately 14,000 members are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property.

AIPLA members have reported more efficient and effective patent prosecution under the FAI program, including resolution of prosecution and patentability issues prior to the issuance of an Office action. In addition, some members have stated that the program has: (1) enhanced interaction between the applicant and the examiner before issuance of an Office action; (2) enhanced one-on-one communication; and (3) expedited allowance of the application, relative to standard examination. Even where the FAI did not result in identification of allowable subject matter, some members reported that rejections in first Office actions and any subsequent Office actions tended to reflect a better understanding of the claims than when an FAI was not conducted.

Some members reported that the Pre-Interview Communication provided them with sufficient, meaningful information to conduct an effective interview, while others thought they would have benefited from further elaboration and clarification of the objections and/or rejections set forth in the Communication.

We received suggestions that the Office provide the examining corps with more information, training and reminders about the program. They reported occasions where the examiner was not sufficiently familiar with the program for the applicant to benefit optimally from the FAI.

Members also have reported that participation in the FAI program typically speeded prosecution, many times resulting in a First Action Notice of Allowance. On the other hand, some members reported cases in which they believed that agreement had been reached at the interview on allowable subject matter, and yet they subsequently received a first Office action citing new art that had not been discussed at the FAI. An applicant would not normally expect additional prior art to be identified after the FAI, especially since the Federal Register Notice indicates that the FAI program is intended to permit an interview after the applicant receives the examiner's search results. Rather, the expectation would be that the prior art search was complete prior to the FAI, except perhaps when the applicant makes an amendment that necessitates a new search.

In this regard it would be helpful to obtain, during the interview, a more complete clarification of any indication of allowable subject matter and of the status of the search. In addition, the presence at the interview of an examiner with signatory authority could provide greater certainty and assurance that that all issues are raised and discussed at the interview.

Several members suggested that it would be helpful if examiners would, in the Pre-Interview Communication, identify any subject matter deemed to be allowable in their initial analysis, and to reiterate that at the interview. They said it would also be helpful if examiners would suggest amendments to overcome potential objections and rejections in order to put the claims in a potentially allowable form. There were also some concerns expressed by members on the relatively short time period (one month) to review and formulate a response to the Pre-Interview Communication. They noted that this one month time period may deter participation in the program, and suggested that a longer time period (e.g., two months) might be considered.

Finally, members reiterated the overall benefits of in-person interviews in facilitating communication between the applicant and the examiner, as compared to limited exchanges of written communications or even telephonic communication. In particular, members who conduct traditional interviews as part of their normal prosecution practice have reported that conducting FAIs enhances communication, and in fact has often led to even more efficient prosecution exchanges on other cases, even unrelated cases, before the same examiners.

Because of these substantial benefits of in-person interviews, there is some concern that the availability of in-person interviews may decrease as a result of the dispersal of examiners

through “hoteling” or through the establishment of satellite offices. The Office should assure that the dispersal of examiners does not make it more difficult to interview with the individual examiner working on a specific case, or to establish multiple in-person interviews in an efficient and timely way.

AIPLA believes that alternatives to in-person interviews should be considered, especially as satellite offices start participating in the FAI program. Implementation of video conferencing capabilities in particular would allow the applicant and examiner to conduct interviews from their respective desks, as is currently done with telephonic interviews, and could avoid any negative consequences of examiner dispersal.

Thank you for allowing AIPLA the opportunity to provide comments on this Notice. AIPLA looks forward to further dialogue with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO’s mission.

Sincerely,

A handwritten signature in black ink that reads "William G. Barber". The signature is written in a cursive style with a long, sweeping underline that extends to the right.

William G. Barber  
President  
American Intellectual Property Law Association