

## **FREQUENTLY ASKED QUESTIONS REGARDINGS THE FIRST ACTION INTERVIEW (FAI) PILOT PROGRAM**

**FAQ#1:** Are there any additional fees associated with the program?

**ANS#1:** No, there are no additional fees required for participation in the FAI pilot program.

**FAQ#2:** Do I have to respond to the marketing flyer notice informing me that a specific case on my docket has been identified by the Office as meeting the eligibility criteria for the program?

**ANS#2:** No, the marketing flyer was for informational purposes only. No action is required on the part of applicant.

**FAQ#3:** As an individual inventor how do I go about using the EFS-WEB filing system to submit my request to participate in the program?

**ANS#3:** You will need to file your request as a registered eFiler ([www.uspto.gov/ebc/index.html](http://www.uspto.gov/ebc/index.html)). To use the registered eFiler you need to obtain a customer number and a digital certificate ([www.uspto.gov/ebc/portal/register.htm](http://www.uspto.gov/ebc/portal/register.htm)). Once you have your customer number and digital certificate, you can enter EFS as a registered eFiler and electronically file your request. Next, select “Existing application/patent” and “Documents/Fees for an existing application” and fill in the Application Number and Confirmation Number and click on “Continue”. The last step is to attach your PDF file, select “First Action Interview Pilot” under Category and “First Action Interview-Enrollment Request” under Document Description.

**FAQ#4:** Can I send a proposed amendment informally to the examiner to avoid making it of record?

**ANS#4:** No, the proposed amendment, if sent, must accompany the Applicant Initiated Interview Request Form (PTOL-413A), or equivalent paper to schedule the interview.

**FAQ#5:** My application exceeds the claim limit for the program. Can I file a preliminary amendment to meet the requirements for the program?

**ANS#5:** Yes, filing a preliminary amendment to conform to the claim requirements is permissible. Applicant is encouraged to file the preliminary amendment concurrent with the Request for First Action Interview noting on line 4 that a preliminary amendment is attached.

**FAQ#6:** If I file a preliminary amendment canceling claims to meet the requirements for the program, can I receive a refund for the now canceled claims?

**ANS#6:** No, currently cancellation of claims via preliminary amendment does not establish a basis for which the Office can grant an excess claims fee refund.

**FAQ#7:** If the result of the interview is that the claims avoid the prior art of record in the Pre-Interview communication, will the claims be considered allowed or could I still receive an Office action rejecting the claims?

**ANS#7:** Any agreement on patentability of the claims produced by the interview would still be subject to current Office practices and procedures, such as a prior art update search and an interference search. If the examiner concludes after the interview that one or more claims are not allowable, then any indication of allowability would be rescinded.

**FAQ#8:** Is the proposed amendment made of record even if the examiner denies entry?

**ANS#8:** If a proposed amendment is denied entry, the proposed amendment will be placed in the application file, but it will not be considered by the Office. If the applicant still wishes to make the changes (e.g., amendments to the claims) set forth in the proposed amendment after the interview, applicant may resubmit the changes in an amendment filed in response to a First-Action Interview Office Action in compliance with 37 CFR 1.121 and 1.111.

**FAQ#9:** How can I determine if my application is eligible for the program in regard to the classification eligibility limitations?

**ANS#9:** An applicant can access public PAIR to see where the Office has classified the application. The Office's classification is controlling.

**FAQ#10:** Does the program take cases out of turn?

**ANS#10:** No, cases are not taken out of turn. However, please note that the eligibility dates of cases for the pilot were chosen because they were likely to come up in turn for examination during the six month window of the pilot program.

**FAQ#11:** Are continuation and continuation in part applications eligible for participation in the program?

**ANS#11:** Yes, as long as the actual filing date of the continuing application meets the date eligibility criteria, the case is eligible for the pilot. A benefit or priority date (i.e. the earliest effective filing date) cannot be used as a basis of establishing eligibility for the pilot program.

**FAQ#12:** How does the PCT filing date of an application affect an application's eligibility for the program?

**ANS#12:** The international filing date of a US national stage application of an international application is the date that determines eligibility for the first action pilot

program. The basis for using the international filing date comes from the Notice on page 2, Requirements section (1) which states, “The application must be a non-reissue non-provisional utility application filed under 35 U.S.C. 111(a) **or an international application that has entered the national stage in compliance with 35 U.S.C. 371(c)**” combined with 35 U.S.C. 363, which accords the effect of a national filing to an international application designating the United States.

**FAQ#13:** Will this program be expanded to include more applications?

**ANS#13:** The Office’s goal is to expand the program to all cases if feedback from the pilot and the patent bar indicates that the first action interview pilot program procedure is a beneficial patent examination tool in the Office’s suite of patent examination products/options.

**FAQ#14:** If cases are only taken up in turn when can I expect my Pre-Interview Communication?

**ANS#14:** The forecasting mechanism in private PAIR that projects the time until issuance of a first Office action on the merits is the best way to estimate when you will get a Pre-Interview Communication.

**FAQ#15:** How much time do I have to file a request to participate in the program?

**ANS#15:** An applicant's request to participate in the first action interview pilot program must be filed during the six month life of the program and at least one day before a first Office action on the merits of the application appears in the Patent Application Information Retrieval (PAIR) system.

**FAQ#16:** If I file during the six months the pilot is in force, but my case is not picked up during the six months, will it be removed from the program?

**ANS#16:** All cases that have a proper request to participate in the first action interview pilot program filed during the pilot’s six month window will be treated under the procedures outlined in the program’s notice, regardless as to when the case is picked up for examination.

**FAQ#17:** The Request for First-Action Interview form (PTO/SB/413C) states “signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required . . . .” Does this mean I have to have all my inventors and assignees sign the request?

**ANS#17:** No, the passage quoted from the PTO/SB/413C further states “or their representatives are required in accordance with 37 CFR 1.33 and 10.18.” Therefore any duly appointed representative for the inventors or assignees may sign the request. See 37 CFR 1.33 and 10.18. See also 37 CFR 1.4(d) for the proper form of the signature.

**FAQ#18:** What procedure governs examination of an application after the first action interview procedure runs its course, when agreement was not reached on patentability and I have responded to the First Office Action on the merits?

**ANS#18:** Once the procedure outlined in the first Office action pilot program is exhausted then current Office policy, practice and procedure for initial patent examination governs. The first Office action pilot program is exhausted after applicant receives a Notice of Allowance or timely responds to the First-Action Interview Office action. The First-Action Interview Office Action follows the interview, should applicant elect to have an interview. All further prosecution is governed by current Office policy, practice and procedure for initial patent examination.

**FAQ#19:** Can an application that is eligible for participation in the first action interview pilot meet the three independent/twenty total claims requirement by designating claims as withdrawn?

**ANS#19:** No, an applicant cannot *sua sponte* withdraw claims in order to comply with the three independent claims and/or twenty total claims requirement in order to participate in the program. If an application that meets the requirements of the program is subject to a restriction requirement, an election of species, or unity of invention, and applicant makes an election, the claims that are drawn to the non-elected invention or species can be carried as withdrawn and not count against the three/twenty threshold. However, if an application was not subject to a restriction requirement, an election of species, or lack of unity of invention, and the application contains more than three independent claims and/or twenty total claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims in order to be eligible for the pilot program.

**FAQ#20:** Can an application be withdrawn from the program after it has submitted a proper request?

**ANS#20:** An application can only be withdrawn from the pilot if a Pre-Interview Communication has NOT been issued by the Office. Once a Pre-Interview Communication has issued, withdrawal from the program is not permitted. Any request for withdrawal from the FAI program received after the Office has issued a Pre-Interview Communication will be treated as a request to not conduct an interview. Accordingly the examiner will, in due course, issue a First-Action Interview Office Action and applicant will then have the shortened thirty (30) day time period, extendable for an additional thirty (30) days, within which to respond.

**FAQ#21:** If I want a one-month extension of time for filing a reply to a Pre-Interview Communication or a First Action Interview Office Action, is there a fee require?

**ANS#21:** Yes, the fee set forth in 37 CFR 1.17(a) is required for the one-month extension of time. See 37 CFR 1.136(a). Therefore, the fee for the one-month extension of time is \$ 60 for a small entity or \$120 for other than small entity.

**FAQ#22:** What happens to my application if I failed to submit a summary of the interview with my reply to the First Action Interview Office Action (FAI-OA)?

**ANS#22:** It is the responsibility of the applicant to make the substance of an interview of record in the application file. If the applicant fails to file a statement of the substance of the interview, the examiner will determine whether the record of the substance of an interview is complete. It depends on whether the examiner previously provided a written summary of the interview and the examiner's summary is sufficient record of the substance of the interview. If the record is not complete, the examiner may give the applicant a 1-month time period to file the statement of the substance of the interview to complete the reply under 37 CFR 1.135(c). See MPEP 713.04.

**FAQ#23:** Can I submit an amendment to add more than three independent claims or twenty total claims in response to a FAI-OA?

**ANS#23:** Yes, applicant may submit an amendment to add more claims in response to a FAI-OA.

**FAQ#24:** Can I submit an amendment to add more claims after a Notice of Allowance has been issued?

**ANS#24:** No, once a Notice of Allowance has issued, prosecution is closed. Amendments filed after allowance are not entered as matter of right. See 37 CFR 1.312 and MPEP §§ 714.16-714.16(e).

**FAQ#25:** Can I submit additional claims if, in the interview, the examiner has designated allowable subject matter and has not yet issued a Notice of Allowance?

**ANS#25:** No, once a Pre-interview communication is entered in an application, applicant no longer has a right to amend the application until the first action interview is conducted AND a FAI-OA is mailed. See EFAI Notice Section VIII (A). An informal designation of allowability, oral or written, provided to an applicant in the interview by an examiner is not an FAI-OA. Therefore an amendment adding claims has no right of entry until the examiner issues the FAI-OA.

**FAQ#26:** Is submission of the Applicant Initiated Interview Request Form (PTOL-413A), with a proposed date and time for the interview, all I need to do for scheduling the interview?

**ANS#26:** No, in addition to timely filing of a proposed date and time for the interview applicant must also contact the examiner to confirm the proposed date and time. See EFAI Notice Section VIII (B)(3), third paragraph. The need for follow-up confirmation is required because applicant's proposed date and time may conflict with an examiner's schedule. By contacting the examiner applicant can confirm the proposed date and time or, if necessary, identify an appropriate alternate date and time.

**FAQ#27:** If I have received a restriction requirement in an application before I have submitted a request to participate in the EFAI pilot program, is the application now ineligible to participate in the program?

**ANS#27:** No, as long as the Office action contains only a restriction requirement. A restriction requirement alone is not considered a first Office action on the merits. See MPEP § 810. However, in order to ensure an application is not delayed from participation, nor rendered ineligible, any response to the restriction should comply with the pilot's requirements regarding restriction, include the request for the EFAI pilot program along with any necessary preliminary amendment to have the application meet all other program requirements.