

Agreement between the
Patent and Trademark Office
And the
Patent Office Professional Association
On
First-action Interview Full Pilot Initiative
April 21, 2011

The U.S. Patent and Trademark Office (USPTO) and the Patent Office Professional Association (POPA) agree to a full pilot program of a First-Action Interview initiative for utility applications. The First-Action Interview initiative is a program whereby the applicant may request and will receive a first-action interview after the search has been conducted, but prior to the first Office action on the merits (FAOM), in a new utility application. Management has determined that the Agency will implement the pilot in accordance with the attached guidelines. The terms of the agreement are as follows:

1. **Duration:** This pilot is to continue for twelve months from the implementation date and may be extended by agreement of the parties.
2. **Participants:** The pilot participants consist of all utility examiners assigned to the Technology Centers (excludes those at the Patent Training Academy):

During the course of the full pilot, examiners will not be charged under the performance appraisal plan for the first instance of a clear error related to the examination procedures changed by the FAI Initiative. The examiner will be informed of the clear error and may be held accountable for second and subsequent errors in accordance with the provisions set forth in the Quality Element of their PAP.

3. **Scheduling the Interview:** Within 60 days, or two months (whichever is longer), of the filing date of the Applicant Initiated Interview Request, the Applicant must schedule and conduct an interview with the examiner (or choose not to have such an interview). The interview must be held within 60 days, or two months (whichever is longer) of the date the Applicant Initiated Interview Request is forwarded to the examiner, except for the rare instance where the examiner's schedule cannot accommodate such a timeframe.

4. Conducting the Interview: The interview may be held either in-person, telephonically, or by video-conference, as agreed by the parties to the interview. If the examiner does not have full signatory authority, an employee with full signatory authority must also be present during the interview.

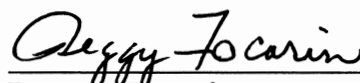
5. Cases transferred from another art area: As soon as an examiner is aware of an application which is outside of his or her regularly assigned docket that includes a First Action Interview Request, he or she should notify his or her SPE who will remove it from his or her docket if the examiner requests.

6. Number of Pilot Cases to be Examined by any one Examiner: Applications in this pilot are treated as regular new applications.

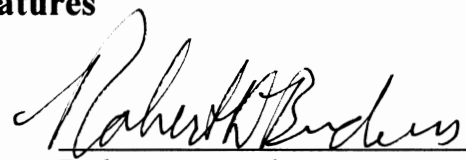
7. Pilot Data: Summary data collected during the full pilot will be shared with POPA. This data may include information such as the number of Requests for First-Action Interview received, the outcome of interviews held under the initiative, the total number of other time hours claimed under the initiative, etc. Upon request, POPA will be provided the full data collected during the full pilot.

8. Opportunity to Bargain: Unless agreement is reached under paragraph 1 or 2 of this agreement, the USPTO will notify POPA of any decision to make this initiative a permanent part of patent practice for all or a portion of the patent examiners. Thereafter, POPA will have the opportunity to bargain, to the extent required by law, in accordance with the ground rules in place between the parties at the time of the notice.


Signatures



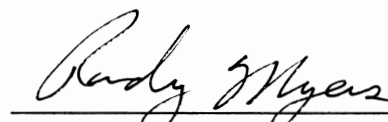
Peggy Focarino 4/21/11
Deputy Commissioner for Patents Date



Robert D. Budens 4/21/2011
President, POPA Date




Wendy R. Garber 4/21/11
Director, TC 2100 Date



Randy Myers 4/21/2011
Treasurer, POPA Date

Date: April 21, 2011

To: Patent Examiners
From: 
Peggy Focarino
Deputy Commissioner for Patents

First Action Interview Full Pilot Initiative Guidelines

On May 1, 2011, the U.S. Patent and Trademark Office (USPTO) will begin a twelve-month full pilot of the First Action Interview Initiative.

The First Action Interview initiative is a program whereby the applicant may request and will receive a first action interview after the search has been completed, but prior to the first Office action on the merits (FAOM), in a new utility application. The examiners are to examine an application in which a First Action Interview Request Form has been received in the ordinary order in which the examiner completes new applications. That is, the filing of the Request does not place the application in any "special" status requiring expedited examination. The First Action Interview Request form will be annotated in eDAN so that an examiner will know when the application is to be treated under this Pilot.

When examining an application under this initiative, the examiner is to search the application and determine which, if any, grounds of rejection should be applied to each claim. Once the grounds of rejection applicable to each claim have been determined, the examiner completes a Pre-Interview Communication, for which Communication the examiner will receive first action production credit. The Pre-Interview Communication is a condensed statement of the examiner's proposed rejections. If completed by a junior examiner, the junior examiner is to initial the Pre-Interview Communication and post for credit like any other first action.

From the mailing or notification date of the Pre-Interview Communication, the applicant has 30 days, or one month (whichever is longer) with a possible additional one month extension, to submit:

- (1) a letter requesting to not have a first action interview;

(2) a reply under 37 CFR 1.111 to the Pre-Interview Communication waiving the first action interview and First Action Interview Office Action; or

(3) an Applicant Initiated Interview Request Form (with accompanying draft amendments and/or arguments).

Any one of these communications will place the application on the examiner's regular amended docket.

If the applicant chooses to forgo the interview under option 1, the examiner should proceed immediately to the mailing of the First Action Interview Office Action. In this instance, the First Action Interview Office Action is a duplicate of the Pre-Interview Communication.

Under option 2, a first action interview will not be conducted and a First Action Interview Office Action will not be provided to the applicant. The Pre-Interview Communication will be considered the first Office action on the merits. The examiner will consider the reply under 37 CFR 1.111 and provide an Office action in response to the reply. The Office action will be the second Office action on the merits, and thus it may be a final rejection, if appropriate.

Under option 3, if an Applicant Initiated Interview Request form is filed, the examiner will be provided timely and actual notice of its filing, for example, the application will be placed in the regular amended category of the examiner's docket. As with other regular amended cases, the workflow clock will start the biweek after the case is forwarded to the examiner (FWDX). If the interview is held and next Office Action completed prior to the expiration of the first 30 days (which could be a replacement Pre-Interview Communication if warranted), the application will count as 0 days in the examiner's Docket Management score. This allows for time for the applicant and examiner to schedule and hold the interview. After the first 30 days, the application will begin accumulating days starting from Day 1. The examiner will be expected to complete the next Office Action in accordance with the examiner's Performance Appraisal Plan. If the new Docket Management element of the PAP is not in place at the time an amendment under the First Action Interview pilot is received by the examiner, the Guidelines dated 9/16/2009 will apply.

The interview may be held either in-person, telephonically or by video-conference, as agreed by the parties to the interview. If the examiner does not have full signatory authority, an employee with full signatory authority must also be present during the interview. In accordance with current practice, other time may be charged for the interview using code

PPEAAM-0000-112021 (Interview conducted as part of the FA Interview Pilot).

At the interview, there are several possible outcomes:

I. The application is in condition for allowance (either with or without an additional amendment). If in condition for allowance, the examiner will so note in an Interview Summary Form, ensure any necessary amendments have been made, and prepare the Notice of Allowability for mailing. At this time, the examiner will get the disposal credit for the application.

II. Agree that the claims are properly rejected as written. This situation may occur if either the claims are unamended, or if the applicant has proposed an amendment that would require further search and/or consideration above that which was done in preparation for the Pre-Interview Communication. In this case, the applicant can select between the following options:

1. To receive a First Action Interview Summary Office Action: the examiner is to summarize the interview in an Interview Summary Form and prepare the First Action Interview Office Action. In this instance, the First Action Interview Office Action will either be a duplicate of the Pre-Interview Communication, or it may include changes resulting from the interview and agreed to by the parties to the interview (for example, changing a dependent claim's rejection from a §102 to a single reference §103 using the same reference). It is the Pre-Interview Communication coupled with the First Action Interview Office Action and Interview Summary that act as the applicant's first notice of rejection under 35 USC 132. The examiner does not receive production credit for this action.
2. To waive the receipt of the First Action Interview Office Action and convert Draft Amendment to a formal amendment: the examiner will note that the applicant has waived the First Action Interview Office Action in the Interview Summary Form along with the summary of the interview. The examiner is to annotate the amendment to note that it is to be entered (as with an after-final amendment). Then, the examiner is to proceed to the second Office action, which may be a Final Rejection, if appropriate, for which the examiner will receive production credit.

III. Disagree as to whether the claims are properly rejected. If agreement cannot be reached after discussion by the parties to the interview, the

examiner is to prepare the Interview Summary and First Action Interview Office Action or the Applicant may waive the First Action Interview Office Action as discussed in II above.

IV. Agree that at least one claim was not properly rejected. In this situation, the examiner is to prepare an Interview Summary noting this fact. The examiner must then complete a replacement Pre-Interview Communication with the claims properly rejected and mail to the applicant to begin the process again in a timeframe consistent with the Performance Appraisal Plan. This is analogous to a second-action non-final under current practice.

The applicant has 30 days, or one month (whichever is longer), to respond to the First Action Interview Office Action, with a possible additional one month extension. When such a response is received, the application will be placed on the examiner's regular amended docket.

With respect to assessing the examiner's performance relative to the Workflow Management element of the Performance Appraisal Plan, there is a possibility that an examiner's amended docket may be affected by this pilot initiative. If this occurs, the examiner must discuss it with their immediate supervisor in a timely manner to determine if any waiver, excuse or extension is appropriate. An examiner shall not be held responsible for a delay which is beyond his or her immediate control. A prescribed time period or special handling instruction will be waived, excused, or extended provided that the examiner has timely informed his or her immediate supervisor of a delay which is beyond his or her immediate control. When there is insufficient time to allow the timely completion of all items of work within their respective prescribed time periods or in accordance with special handling instructions, the immediate supervisor may determine the priority in which those items of work are to be completed by the examiner.

Periodic "just-in-time" training classes will be provided so that examiners who have First Action Interview applications assigned to them can attend.