

# Earlier Feedback Mechanisms for Efficient Patent Prosecution

## First Action Interview Pilot Program

In an effort to reduce the wait time for obtaining a new patent, and the costs associated with doing so, the USPTO initiated a First Action Interview (FAI) pilot program in 2008. This program has been continuously renewed since 2008, and remains in effect today.

Like the Accelerated Examination Program, the FAI program provides an opportunity for faster patent prosecution, but requires less information up front. The program offers the applicant the ability to teach the Examiner about the art earlier, avoiding citations to irrelevant prior art in the Examiner's Office Action. This is especially effective when prosecuting a complicated matter. Best of all, there are no additional fees required to participate in the FAI program.

### Eligibility

There are a few simple requirements for a patent application to be eligible for the FAI program:

- Must be a utility patent (non-provisional)
- Must have no more than 3 independent and 20 dependent claims
- Must have no multiple-dependent claims
- Must claim only a single invention

- Program participation must be requested before receiving the first Office Action on the merits

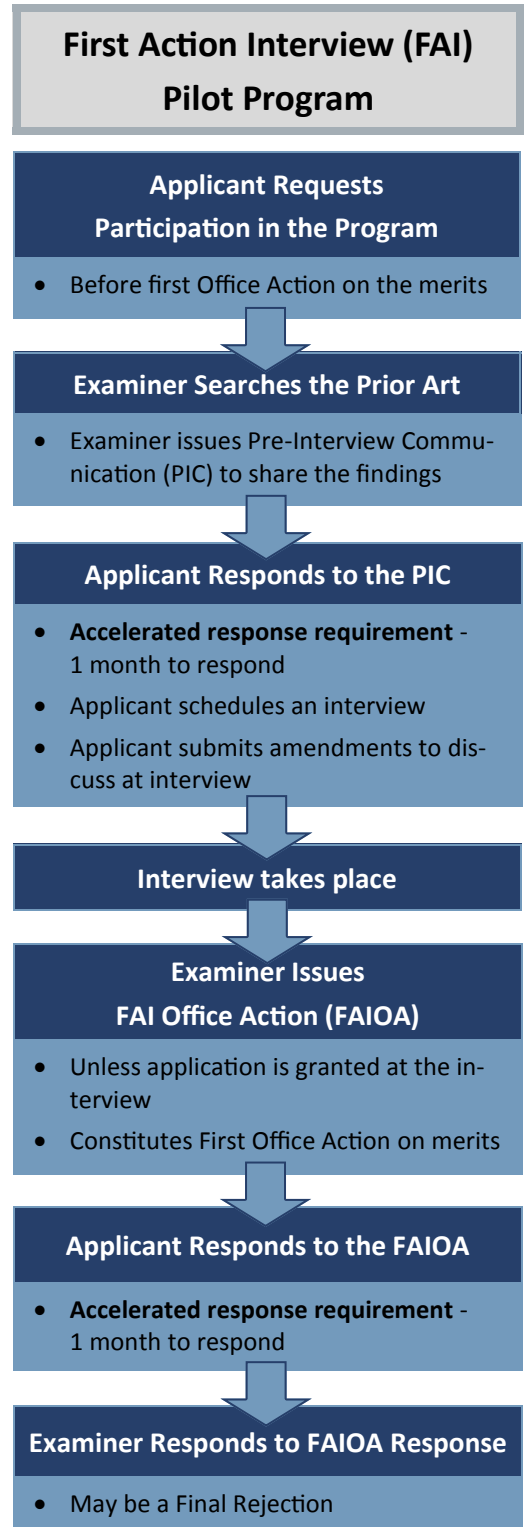
### The FAI Prosecution Process

The FAI process is intended largely to follow the traditional prosecution process, however it is geared to provide faster response times and overall efficiency. This process is relatively straightforward, and can be aborted in favor of the traditional process so long as the Office has not issued a Pre-Interview Communication.

In effect, the FAI process closely mirrors the traditional process; however, it includes earlier communication through an interview with the Examiner.

For patent applications that could benefit from expedient prosecution, the FAI process may be a useful alternative to traditional prosecution. The program facilitates efficient communication for complex art, or where history has already been established, as with continuations or divisional applications. Teaching the Examiner the art earlier can help reduce rejections based upon irrelevant prior art, speeding the overall process. The effects are demonstrated by higher initial allowance rates than traditional prosecution, which increase from 25% to 41% under the FAI program.

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## Pre-Appeal Conference

Similar efficiencies can be realized through earlier communication during the later stages of prosecution, prior to undergoing an appeal. Here, an Applicant may request a Pre-Appeal Conference at the same time the Notice of Appeal is filed, which initiates a targeted discussion by key USPTO personnel. Following this discussion, an application may either be re-opened for prosecution or the case will continue on for a formal appeal.

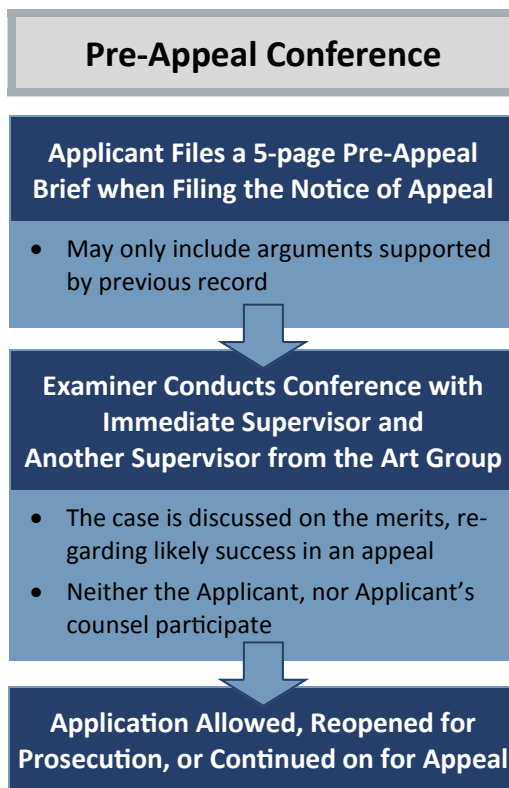
### The Pre-Appeal Conference Process

The requirements for a pre-appeal conference are effectively the same as preparation for an actual appeal, and therefore the process is an efficient means for attempting a re-start of an application without an appeal.

The Office suggests that a pre-appeal conference will be most successful if the rejections of record are (1) clearly improper and without basis or (2) clearly based on factual or legal error.

### Conclusion

This program offers a final consideration of the merits by the Examiner, as well as



two Supervisors, prior to proceeding with a costly appeals process. In the event the application remains rejected, the five page pre-appeal brief merely provides a head-start for a full appeal brief. As such, the Pre-Appeal Conference is another example of an efficient tool for patent prosecution, saving time the Applicant both time and money.

## FIRM NEWS

### U.S. News and World Report Names Four Andrus Attorneys as Best Lawyers -

We are pleased to announce that four Andrus attorneys, Aaron T. Olejniczak, George H. Solveson, Daniel D. Fetterley, and Gary A. Essmann were recently selected by their peers for inclusion in *The Best Lawyers in America*® 2014. (Copyright 2013 by Woodward/White, Inc., Aiken, SC.) For a complete listing of our rankings, please visit our [Firm Profile](#) on the Best Law Firms website. *Best Lawyers* is based on an exhaustive peer-review survey in which almost 50,000 leading attorneys cast nearly five million votes on the legal abilities of other lawyers in their practice areas.

## Patent Law Treaty of 2012

As a follow-on to the America Invents Act of 2012, the Patent Law Treaties Implementation Act of 2012 (PLTIA) was enacted to implement two international treaties of industrial design. This adoption of the Geneva Act and the Patent Law Treaty better aligns the United States to the international community. One of the most significant updates from the PLTIA is the ability to file international design applications (IDAs) directly through the USPTO. These IDAs are then published by the World Intellectual Property Organization to establish priority dates much like a provisional utility patent

filing. IDAs remain valid for five years, but can be renewed in five year increments up to a country's designated maximum.

The PLTIA also extends the term for U.S. design patents from 14 years to 15 years after the date granted. This applies prospectively to any design patent filed on or after 1 year after enactment, or December 18, 2013, excluding those patents involved in litigation prior to enactment. Therefore, as the effective date approaches, applicants should consider the merits of applying for design protection immediately, or delaying until December to capture this additional year of protection under the PLTIA.