

Global Patent Prosecution

November 2020



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Two Pilot Programs for Compact Prosecution – First Action Interview and After Final Consideration Pilot Programs

Streamlining and accelerating patent prosecution are goals of both the USPTO and stakeholders. The USPTO has implemented two pilot programs, one at the outset of examination and the other after final rejection, to help do just that.

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THE USPTO'S FIRST ACTION INTERVIEW PILOT PROGRAM

By: [Paul A. Calvo, Ph.D.](#)

Time to grant is vitally important when generating a robust patent portfolio. While speed is critical for many start-ups, it often comes with a price.

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AFTER FINAL CONSIDERATION PILOT PROGRAM 2.0 – STILL GOING STRONG

By: [Paul A. Calvo, Ph.D.](#)

Once a final rejection has been entered in an application, there is no right to unrestricted further prosecution. However, to advance the goal of compact prosecution, the USPTO introduced a program in 2012 that outlined when entry of an Amendment After Final Rejection under 37 CFR 1.116(b) may lead to earlier allowance of the application and enhanced collaboration between the examiner and stakeholders. This USPTO program is currently the After Final Consideration Pilot Program 2.0 (AFCP 2.0).

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THE USPTO'S FIRST ACTION INTERVIEW PILOT PROGRAM

By: [Paul A. Calvo, Ph.D.](#)

Time to grant is vitally important when generating a robust patent portfolio. While speed is critical for many start-ups, it often comes with a price. Track One examination requires payment of fees. And even the patent prosecution highway, which does not have a requirement of a directed fee, still requires the additional cost of multiple applications. The USPTO First Action Interview Pilot Program (FAIPP), however, offers a low cost alternative to a faster allowance.

Under the FAIPP, an applicant is entitled to an interview prior to a first action on the merits. The program requires that the application must not contain more than 20 claims in total, only 3 or fewer independent claims, and no multiple dependencies. Importantly, a preliminary amendment may be filed with an enrollment request to conform the application to the proper claim number. The only other requirement is that an enrollment request be made before issuance of a first action on the merits. The first action can be an Office action, a notice of allowability, or an ex-parte Quayle action, but does not include a restriction requirement. An enrollment request can only be filed after issuance of a restriction requirement if the restriction response was made without traversal.

Once a request for enrollment into the program is made, the examiner will conduct a prior art search and provide the application with a pre-interview communication citing relevant prior art and identifying all proposed rejections. Within 30 days of receiving the pre-interview communication, the applicant must request an interview to proceed in the FAIPP. The request must be filed via EFS Web (PTOL-413A). A one month extension of time is available.

Similar to non-FAIPP interviews, proposed rejections, amendments, and arguments are discussed. Unlike non-FAIPP interviews however, following the interview, the examiner must take the next formal action. These actions can be one of three: (1) allowance without any action on the merits issued; (2) no agreement on allowability and the applicant waives the right to a first action on the merits; or (3) no agreement on allowability and the applicant does not waive the right to a first action on the merits. In the case of (2), the pre-interview communication is converted into first Office action on the merits and the applicant converts the interview request, along with proposed amendments/arguments, into a reply under 37 CFR 1.111. In the case of (3), the examiner must issue a first Office action on the merits, with an interview summary. Prosecution of the application from that point proceeds as would a non-FAIPP application.

The USPTO has received over 2,000 requests for participation in FAIPP and the allowance rate is approximately 35% on the first action. Therefore, the program provides an attractive vehicle to advance prosecution quickly, while having the ability to resolve patentability issues one-on-

one with the examiner at the beginning of the prosecution process, rather than after a first Office action.

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To be eligible for consideration under AFCP 2.0, an applicant must file a response under 37 CFR §1.116, which includes a request for consideration under the pilot (Form PTO/SB/434) and an amendment to at least one independent claim that does not broaden the scope of the independent claim in any aspect. As was the case with the AFCP, examiners will continue to use their professional judgment to decide whether the response can be fully considered under AFCP 2.0. This will include determining whether any additional search is required and can be completed within the allotted time in order to determine whether the application can be allowed. Interestingly, examiners are given extra time to consider the application under AFCP 2.0 – three hours for utility and plant applications and one hour for design applications, including a patent search. If the examiner's review of the response does not result in a determination that all pending claims are in condition for allowance, the examiner will request an interview with the applicant to discuss the response.

Judging by the consistency of the allowance rate and the number of AFCP 2.0 requests, it appears that the program is functioning as the USPTO intended, namely to streamline and shorten the patent prosecution process. According to Juristat statistics:

In 2017, examiners issued allowances in response to 25.4% of AFCP 2.0 requests, relieving those applicants of the time and expense involved with RCEs and appeals. And in 2019, the AFCP 2.0's popularity skyrocketed from just over 10,000 applications in 2013 to almost 70,000 in 2017 – all while maintaining a consistent number of allowances.^[i]

Overall, there is not much discrepancy among AFCP 2.0 use in technology centers.^[ii] The only tech center with a noticeable lack thereof is TC 1600, which handles applications in the life sciences technology sector, including microbiology, immunology, cosmetics, and drugs. The most popular tech centers for AFCP requests have been TC 2100 and TC 2400. TC 2100 provides examination for patent applications including Computer Architecture Software and

Information Security. TC 2400 provides examination for patent application including Computer Networks, Multiplex, Cable and Cryptography/Security.

[i] <https://blog.juristat.com/afcp-extended-2020>

[ii] <https://blog.juristat.com/afcp-2019>

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