August 9, 2012

Via Electronic Mail
first.action.interview@USPTO.gov

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments-Patents
P.O. Box 1450
Alexandria, VA 22313–1450

Attn: Joseph F. Weiss, Jr.


Dear Under Secretary Kappos:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) to provide comments in response to the request the United States Patent and Trademark Office (the “Office” or the “USPTO”) published in the Federal Register on July 9, 2012 (PTO-P–2012–0025). These comments have not been approved by the ABA House of Delegates or Board of Governors, and should not be considered to be views of the American Bar Association.

The Section applauds the USPTO’s efforts to efficiently advance patent prosecution using the first office action interview pilot program (“the program”). The Section Committee on Ex Parte Patent Office Matters requested feedback from members regarding their experiences with the First Action Interview pilot. The responses from the request were overwhelmingly positive and support permanent implementation of the first office action interview program. Responses from members of the Section form the basis for our responses to the Office’s request for information.

Most of the Section’s members who provided feedback on the program felt that the Pre-Interview Communication was adequate and sufficient information to conduct an effective interview. One member noted that they received no advance notice or pre-interview communication. However, the member noted that despite the lack of notice, the interview was productive and resulted in a first office action allowance. Substantially all of
the members who responded to our request for feedback were satisfied with the pre-
interview communication.

All of the Section’s members who provided feedback on the program indicated that the interview before the first action greatly enhanced the advancement of prosecution. Members who received a rejection as the first office action after the interview felt that the issues had been advanced by the interview. Members also felt that the interview provided an opportunity to clarify easily resolved matters, enabling the prosecution record to focus on the most important issues. All responding members who participated in the program believed that the interview advanced patent prosecution more effectively as compared with traditional practice.

Most responding members felt that the pre-interview communications were appropriate and commensurate with the issues discussed. One member was satisfied with the outcome; however, received no pre-interview communication. The Section encourages the Office to continue to provide appropriate pre-interview communications, and consider scheduling all interviews, including telephone interviews, in advance.

All responding members considered the First Action Interview program to be more efficient compared with traditional prosecution and encourage the Office to make the program permanent. The Section suggests that the Office consider scheduling the interview in advance, with an option for the applicant to decline the interview in favor of traditional patent prosecution. Prompt, efficient advancement of patent prosecution is important for many small and large entity applicants. One member expressed a belief that the First Action Program helped to optimize applicant’s prosecution costs. The first office action interview program is a valuable tool that may help to decrease the patent backlog and may improve patent quality through enhanced communication with the examiner.

In closing, the Section appreciates the opportunity to comment on the pilot program and strongly encourages the Office to consider making the program a permanent option for patent applicants.

If you have any questions on our comments or would wish for us to further explain any of our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,

Joseph M. Potenza
Section Chair
American Bar Association
Section of Intellectual Property Law