

SPECIAL**REPORT****NEW INTERVIEW PROGRAM FOR PATENT APPLICANTS****June 2, 2008**

The U.S. Patent and Trademark Office (USPTO) recently announced a new "First Action Interview Pilot Program" (the Program) for qualifying patent applications in which a Request to participate in the Program has been filed. Under the Program, an examiner will perform a prior art search and send the applicant a "Pre-Interview Communication" that includes a search report, as well as a brief summary of any proposed objections and/or rejections the examiner may have. The applicant is then provided with the opportunity to file a proposed amendment and conduct an examiner interview prior to issuance of a first full Office Action on the merits.¹

I. Overview

The Program is a six-month pilot program that is currently set to end on November 1, 2008. The stated goal of the Program is to expedite prosecution of qualifying patent applications by enhancing interaction between the examiner and the applicant, thereby facilitating the resolution of patentability issues at the beginning of the examination process. The Program is intended to reduce pendency of patent applications as well as to improve the quality of patents.

Enrollment in the Program provides the applicant with the opportunity to conduct an interview with the examiner prior to issuance of the first full Office Action on the merits, referred to by the Program as a "First Action Interview Office Action." As such, there is a chance that

the applicant may influence the substance of the first full Office Action on the merits. The opportunity to meet and discuss the subject matter of the application and how the application overcomes proposed rejections provides the applicant an opportunity to avoid inclusion of baseless rejections in the first full Office Action on the merits.

The USPTO has made it clear that an application enrolled in the Program will not be advanced in the queue of applications for examination ahead of applications that are not enrolled in the Program. Thus, the Program does not expedite initial examination of applications. However, conducting an interview prior to issuance of the first full Office Action on the merits may result in better focused examination of enrolled applications.

Because the Program is still in its early stages, many questions remain regarding how the Program will be implemented and whether the Program will be effective in meeting the USPTO's goals to reduce pendency of patent applications and improve the quality of patents. For example, it is unclear whether, by conducting an interview prior to issuance of the first full Office Action on the merits, applicants will truly have an opportunity to influence the subject matter of the first full Office Action on the merits. In addition, the Program reduces the time for responding to a first full Office Action on the merits.

Mainly because of the uncertainty and time constraints, we recommend that an applicant interested in enrolling in the Program do so cautiously and with lower priority applications, until a time when we can determine whether the Program is effective and suitable for the applicant.

II. Program Procedures

To enroll in the Program, an applicant must file a Request before November 1, 2008, in a qualifying application. A sample "Request for First-Action Interview (Pilot Program)" form is attached as Appendix I. When the

¹ Currently, granting an interview before a first Office Action on the merits of a new application is within the discretion of an examiner. If granted, such interviews generally occur before the examiner has performed a search, and a showing may be required to justify the granting of such an interview. See MPEP §713.02. However, under the Program, granting of an interview would become non-discretionary.

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application is subsequently taken up for examination, the examiner will conduct a prior art search and issue a Pre-Interview Communication. The Pre-Interview Communication will include a prior art search report and identify any potential rejections and/or objections. Sample Pre-Interview Communications are attached as Appendix II.

Within one month after the mailing date of the Pre-Interview Communication, the applicant must decide whether to schedule a first action interview with the examiner and file a response to the Pre-Interview Communication. The application will become abandoned if the applicant fails to reply to the Pre-Interview Communication within one month or thirty days, whichever is longer, as to whether the applicant wishes to conduct an interview. The time period for responding to the Pre-Interview Communication is not extendible.

If the applicant elects to conduct an interview before receiving the first full Office Action on the merits, then the applicant must schedule the interview with the examiner and also file a proposed amendment and/or arguments together with an "Applicant Initiated Interview Request Form." A sample "Applicant Initiated Interview Request Form" is attached as Appendix III. The interview must be conducted within two months or sixty days, whichever is longer, from the issue date of the Pre-Interview Communication. Failure to conduct the interview within that non-extendible time period will be treated as failure to respond to the Pre-Interview Communication, which results in abandonment of the application.

If the applicant elects not to conduct an interview before receiving the first full Office Action on the merits, the applicant must file a request not to have a first action interview. In that case, the examiner will proceed to issue a first full Office Action on the merits, as discussed below.

At the interview, the applicant should be prepared to discuss issues related to the patentability of the claims. At the conclusion of the interview, if the applicant and the examiner reach an agreement as to the patentability of all the pending claims, then the examiner will issue a Notice of Allowance. Otherwise, if an agreement is not reached, the examiner may provide the applicant with a courtesy copy of a first full Office Action on the merits. The Office Action will be subsequently mailed to the applicant to set the time period for response.²

² Regardless of whether or not the applicant and the examiner reach an agreement during the first action

After issuance of the Pre-Interview Communication, the examiner has discretion to decide whether any amendments will be entered prior to issuance of the first full Office Action on the merits. For example, after the interview, the examiner may enter into the record any proposed amendments filed with the "Applicant Initiated Interview Request Form" if the examiner deems the amendment sufficient to advance prosecution on the merits. The USPTO guidelines indicate that an amendment, filed after the issuance of the Pre-Interview Communication and before the issuance of the first full Office Action on the merits, may only be entered if it merely cancels a claim, adopts an examiner's suggestion, corrects an informality, or otherwise places the application in *prima facie* condition for allowance. In this regard, the decision as to whether an amendment will be entered appears to be similar to after Final Rejection practice. Accordingly, the Program provides no certainty that the examiner will enter, or even consider, any proposed arguments and/or amendments prior to the issuance of the first full Office Action on the merits.

If an Office Action is issued, it will set forth all remaining requirements, objections and/or rejections to the application. The Office Action, in conjunction with any interview summary form, will be considered a first Office Action on the merits.³

Under the Program, the applicant will be given only one month or thirty days, whichever is longer, from the mailing date of the first full Office Action on the merits to respond. This shortened time period applies whether or not the applicant elected to conduct an interview. The time

interview, a complete written statement as to the substance of the interview with regard to the merits of the application must be made of record by the applicant. Although we believe the statement as to the substance of the interview may be included in the formal written response to the first full Office Action on the merits, it appears that an applicant must also submit a complete written statement as to the substance of the interview if a Notice of Allowance rather than an Office Action is issued.

³ The USPTO indicates that the First Action Interview Office Action, in conjunction with any interview summary form, will be considered a first Office Action on the merits. The applicant is given two months to conduct an interview. Thus, it appears that applications enrolled in the Program may be more likely to qualify for patent term extension because these time frames make it more likely that the USPTO will not issue a "first Office Action on the merits" within fourteen months after the U.S. filing date.

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period for responding to the first full Office Action on the merits may only be extended by one month, rather than the usual three months, and the application will become abandoned if the applicant fails to timely reply to the first full Office Action on the merits.

III. Requirements for an Application to Participate in the First Action Interview Pilot Program

Enrollment in the Program is currently limited to patent applications in two technology areas, with filing date and other limitations. Please see Appendix IV for a detailed list of requirements to participate in the Program.

IV. Advantages and Disadvantages of Participation in the Program

Like most new programs offered by the USPTO, this Program has both advantages and disadvantages the applicant will want to consider before deciding to participate. Also, as may have been apparent from the above, the Program still has some unknown aspects that we expect will be resolved over time. We describe some of the more relevant considerations below:

A. Advantages

1. The Program provides the applicant with an opportunity to increase the likelihood that an examiner understands the subject matter of the application and the features of the application that distinguish the claims from any applied reference(s) early in the examination process. This can be especially helpful for more complex applications or applied reference(s), where providing the examiner with guidance at an early stage in prosecution may resolve confusion that would otherwise exist after a first full Office Action on the merits was issued. Thus, by resolving an examiner's misunderstandings early in the process, the applicant may receive a more streamlined subsequent examination that is devoid of examiner confusion that too often prolongs the examination of complex applications.

2. As opposed to the previously available interviews before a first full Office Action on the merits, the Program outlines a procedure through which grant of an early interview is non-discretionary, occurs after the examiner has conducted a search, and does not require any showing to justify grant of the interview. Thus, under the Program, the applicant can now conduct a non-discretionary

interview before a first full Office Action on the merits with the benefit of knowing both the search results and the examiner's positions on patentability in view of the search results.

3. Although not entirely clear from the USPTO's announcement, the Program presumably provides applicants with an opportunity to influence the first full Office Action on the merits. Specifically, by having the opportunity to respond to the Pre-Interview Communication with a proposed amendment and/or arguments, as well as to conduct an interview, the applicant is given the opportunity to influence the first full Office Action on the merits. Accordingly, the applicant may limit the number of improper or baseless objections and/or rejections prior to receiving a first full Office Action on the merits.

4. At a minimum, the interview provides the applicant and the examiner with an early opportunity to agree on amendments that may place the application in condition for allowance or otherwise further prosecution. Presumably, if the applicant presents persuasive arguments in response to the Pre-Interview Communication, the examiner will issue a Notice of Allowance or issue a first full Office Action on the merits that takes into account the applicant's position. Thus, if the examiner considers the proposed arguments and/or amendments, the applicant's influence on the first full Office Action on the merits is similar to having received and responded to an Office Action, and thus can benefit the applicant by providing an additional Office Action before the examiner may issue a Final Rejection.

B. Disadvantages

1. Because the Program is fast paced, it can significantly limit the time available for applicants to respond. For example, the limitation of a one-month period for response to the first full Office Action on the merits with only a single one-month extension available will require applicants to respond rapidly to USPTO communications that are issued under the Program.

2. It is unclear how examiners will implement some aspects of the Program. For example, it is possible that an examiner will not enter proposed amendments or adapt the first full Office Action on the merits in response to an applicant's proposed amendments and/or remarks. Further, it is possible that the first full Office Action on the merits will not be affected by an interview. In either of these events, the extra steps may not be cost-effective.

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3. From our experience, we believe that the possibility of receiving a Notice of Allowance at the conclusion of an interview may be an illusory benefit of the Program. Specifically, examiners are already very reluctant to issue a Notice of Allowance at the conclusion of a personal interview even after issuance of a first full Office Action on the merits. More likely, when an examiner does indicate agreement with an applicant's position at the end of an interview, the examiner will refrain from agreeing to allowance until after conducting a further search.

4. The short period for response to the first full Office Action on the merits may be unduly burdensome for applications that require submission of evidence (e.g., an expert's declaration or other showings of nonobviousness). For example, a total time for responding to an Office Action of two months may not be sufficient to coordinate with clients and/or experts, conduct any necessary literature searches, experiments or tests, and draft a declaration.

5. Having to prepare an additional response to an Office Action can increase costs for an applicant. For example, upon receipt of the Pre-Interview Communication, the applicant must provide proposed arguments and/or amendments. In addition, because the Pre-Interview Communication is merely a summary of the proposed rejections and/or objections, the applicant risks misinterpreting the proposed rejections and/or objections and thus placing unnecessary arguments on the record. Therefore, if an applicant chooses to enroll in the Program, we suggest briefly, but carefully, responding to the Pre-Interview Communication. Even such a course of action might result in additional cost. However, if the Program is effective in expediting prosecution by resolving patentability issues early in prosecution, then there remains a chance that an applicant would file fewer responses and thus incur less total cost if the patent application is enrolled in the Program.

C. Unknowns

1. At this time, it is unclear whether examiners will be willing to consider an applicant's proposed amendments and/or remarks before drafting the first full Office Action on the merits. Further, it is unclear whether examiners will be willing to issue a Notice of Allowance in place of a first full Office Action on the merits if they are persuaded by applicant's amendments and/or remarks, or alternatively, whether examiners will maintain the status quo by rarely issuing a Notice of Allowance following an interview because they wish to take applicant's amendments and/or remarks under advisement and to perform another search.

The USPTO's announcement indicates that a courtesy copy of the first full Office Action on the merits may be provided at the conclusion of the interview. This presupposes that the first full Office Action on the merits was prepared prior to the interview. If so, any such first full Office Action on the merits will not address any comments or arguments presented at the interview. However, the USPTO's announcement leaves open the possibility that the examiner will amend the first full Office Action on the merits based on the results of the interview.

2. If an applicant decides to conduct an interview in response to a Pre-Interview Communication, it is currently unclear whether the applicant will be granted another interview after issuance of the first full Office Action on the merits. At the very least, we believe that such a second interview would only be granted at the examiner's discretion, as opposed to as a matter of right.

3. It is unclear how detailed an applicant's proposed amendments and/or responses must be to be considered responsive to the Pre-Interview Communication. For example, there is a tension between providing a thorough response that analyzes the proposed rejections and relevant art, and creating unnecessary estoppels.

4. As discussed with respect to the potential disadvantages to the Program, it is unclear whether the Program will reduce or add to the costs associated with prosecution of any given patent application. For example, it is currently unclear whether the Program will require an applicant to respond to a greater number of USPTO communications – this depends on whether the interview before issuance of a first full Office Action on the merits is helpful in shortening prosecution. Beyond the monetary costs associated with legal services in responding to USPTO communications, applicants may find that the shortened timelines impose additional internal cost by creating burdens on their internal systems.

V. Recommendations

Because of the limited advantages, potential disadvantages, and many unknowns, we do not recommend the Program for all eligible applicants or all eligible applications. While we expect that some of the unknowns will be resolved either favorably or unfavorably over time, some of the disadvantages, such as limited response times, will most likely not change. Thus, we believe applicants should approach the Program with caution.

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Until the effectiveness of the Program is determined, we recommend enrolling, if at all, only a limited number of applications. Further, we initially recommend only enrolling applications of lower importance. Any initial applications enrolled in the Program should be closely monitored to gauge the effectiveness of the Program and to determine whether the accelerated prosecution schedule is feasible.

The accelerated prosecution schedule limits effective use of the Program to those applicants that are able to commit to rapid correspondence with our firm and the USPTO. For example, a response to a first full Office Action on the merits has a one-month period for response that is only extendible by an additional single month. Thus, depending on individual preferences, the applicant would have to either review and approve a proposed response or provide comments for preparing a response within a much shorter turn-around time than under standard practice. Such shortened timelines may not be feasible for some applicants. However, for clients that provide our firm with full discretion to respond to USPTO communications, we believe these shortened timelines generally will not pose a problem unless the applications require more complex than usual action, such as submission of evidence. In those instances, communicating about and coordinating such evidence may be difficult to complete within the shortened timelines. Therefore, we recommend selecting applications for the Program where the applicant is able to communicate rapidly and there is a low probability that prosecution would be unusually complex.

Additionally, because every communication with the USPTO carries with it the risk of creating prosecution history estoppels, we recommend using caution when filing any proposed amendments and/or remarks in response to the Pre-Interview Communication. As evident from the sample Pre-Interview Communications provided in Appendix II, the Pre-Interview Communication appears to

be very broad and provides very little detail with respect to the proposed objections and/or rejections. Such broad assertions put forth by the USPTO may create misunderstandings between the USPTO and an applicant. As a result, applicants may feel compelled to provide more explanation in a response than the applicant would otherwise include. Therefore, we recommend that applicants remain mindful that any communication under the Program will become part of the permanent prosecution record, and thus that applicants should continue to be cautious when responding to any broad USPTO assertions.

Please let us know if you desire any additional information on the First Action Interview Pilot Program, or if you have any questions about other aspects of U.S. patent practice.

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Appendix I – Request for First-Action Interview (Pilot Program)

Doc Code: FAI.REQ

Document Description: Request first action interview

PTO/SB413C (08-07)

Approved for use through 04/30/2008. OMB 0651-0031

U. S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR FIRST-ACTION INTERVIEW (PILOT PROGRAM)		
Attorney Docket Number:	Application Number (if known):	Filing date:
First Named Inventor:	Title:	
<p>APPLICANT HEREBY REQUESTS A FIRST-ACTION INTERVIEW IN THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.</p> <p>1. The application must contain three (3) or fewer independent claims and twenty (20) or fewer total claims.</p> <p>2. The application must not contain any multiple dependent claims.</p> <p>3. By filing this request:</p> <p style="padding-left: 40px;">Applicant is agreeing not to request for a refund of the search fee and any excess claims fee paid in the application after the mailing of the preliminary first action prepared by the examiner.</p> <p>4. Other attachments: _____</p>		
Signature		Date
Name (Print/Typed)		Registration Number
<small>Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.</small>		
<input type="checkbox"/> *Total of _____ forms are submitted.		

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Appendix I – Request for First-Action Interview (Pilot Program) *continued*

PTO/SB413C (08-07)
Approved for use through 04/30/2008. OMB 0651-0031
U. S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Instruction Sheet for Request for First-Action Interview (Pilot Program) (Not to be Submitted to the USPTO)

A grantable request must meet the following conditions:

1. The application must be a non-reissue utility 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).
2. The application must contain three (3) or fewer independent claims and twenty (20) or fewer total claims. The application may not contain any multiple dependent claims.
3. The request must be filed electronically using the Office's electronic filing system, EFS-Web.
4. The request must be filed before an examination on the merits has been made of the application (prior to the date when a first Office action on the merits, notice of allowability or allowance, or action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935) is issued). Applicant may check the status of the application using the Patent Application Information Retrieval (PAIR) system.
5. Applicant must agree not to request a refund of the search fee and any excess claims fees paid in the application after the mailing of the preliminary first action. Any petition for express abandonment under 37 CFR 1.138(d) to obtain a refund of the search fee and any excess claims fees paid will not be granted and the Office will not refund the search fee and any excess claims fees after the mailing of a preliminary first action.

For more information, see notice "First-Action Interview Pilot Program" available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>

Appendix I – Request for First-Action Interview (Pilot Program) *continued*

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Appendix II – Pre-Interview Communication (Sample 1)

<p style="text-align: center;">Pre-Interview Communication (For use in the First Action Interview Pilot Program) Example 1</p>	<p>Application No. XXXXXXXXXX</p> <p>Examiner XXXXXXX</p>	<p>Applicant(s) XXXXXX</p> <p>Art Unit XXXX</p>	<p>Page 1 of 2</p>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **ONE MONTH OR THIRTY (30) DAYS**, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

This time period for reply is NOT extendable under 37 CFR 1.136(a). This communication constitutes notice under 37 CFR 1.136(a)(1)(i).

To avoid abandonment of the application, applicant must, within this time period for reply, file:

- (1) A letter requesting not to have a first-action interview, or
- (2) A completed Applicant Initiated Interview Request Form (PTOL-413A) accompanied by a proposed amendment or arguments.

Inventor participation in the Pre-First Action Interview is encouraged if it would expedite resolution of the application.

Disposition of Claims

- 3) ☒ Claim(s) 1-8 is/are pending in the application.
 3a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 4) ☐ Claim(s) _____ appear to be allowable.
- 5) ☒ Claim(s) 1-8 appear to be rejectable.
- 6) ☐ Claim(s) _____ may be subject to an objection.
- 7) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 8) ☐ The specification may be subject to an objection by the Examiner.
- 9) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ may be subject to an objection by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 10) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 11) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

Contact Information

Examiner's Telephone Number: (571)272-XXXX
 Examiner's Typical Work Schedule: Monday-Friday, 8 a.m. - 4:30 p.m.
 Supervisor's Name: Supervisor XXXX
 Supervisor's Telephone Number: (571) 272-XXXX

Attachment(s)

<ol style="list-style-type: none"> 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____. 	<ol style="list-style-type: none"> 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application 6) <input type="checkbox"/> Other: _____.
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Appendix II – Pre-Interview Communication (Sample 1) *continued*

Pre-Interview Communication Example 1				Application No. XXXXXXXXXX	Applicant(s) XXXXXX
				Examiner XXXXXX	Art Unit XXXXXX
Page 2 of 2					
Notification of Potential Rejection(s) and/or Objection(s)					
#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Potential Rejection	
1	1-8		101	Claim 1 recites a binary translator with various components. The binary translator as claimed is software per se and software is not considered patentable subject matter. Claims 2-8 depend on 1 and do not include hardware so as to overcome the rejection.	
2	1-8		112, 1st	Claim 1 recites the limitation of "replace disabled legacy binary instructions with native instructions". However, according to the specification, on page 6, lines 1-3, "...used to disable... insert new native instructions without (see continuation below)	
3	1-5, 7-8	U	102(b)	Claim 1 (Figure 1, 1st para, 3rd para, Section "3.1 Components", 4th & 5th paragraph - note the claimed "processor means" is interpreted as the CPU in fig. 1); 2 (Fig. 1); 3 (Section 3.1, 4th para); 4 (section 4.2, para 9 - note this) (see continuation below)	
4	6	U,V	103(a)	U does not disclose said native instruction processor as claimed. V discloses this at section 2.1, 2nd paragraph. As one would want to have better code for hot spots in order to improve performance (see V, section 2.1), it would have (see continuation)	
Expanded Discussion/Commentary					
2		altering the original legacy instructions." Thus, the specification does not disclose replacing disabled legacy binary instructions. On the contrary, the specification specifically discloses not altering the original legacy binary instructions. The claim limitation of claim 1 contradicts with what the disclosure describes. Thus, this subject matter was not described in the specification in such a way to enable one skilled in the art to make and use the invention without undue experimentation.			
3		section states that "any kind of memory can be used"; 5 (Section 3.1 5th para); Claim 7 (Section 3, Resourceable and Retargetable Binary Translation); 8 (Section 3.1, 4th para).			
4		been obvious to include the native instruction processor in the system described in V.			
DATE:		Examiner Signature:		Primary Examiner Signature:	

U.S. Patent and Trademark Office
PTOL-413FP (Rev. 04-08)

Pre-Interview Communication

Part of Paper No./Mail Date

Appendix II – Pre-Interview Communication (Sample 1) *continued*

Notice of References Cited Example 1	Application/Control No. XXXXXX	Applicant(s)/Patent Under Reexamination XXXXXX
	Examiner XXXXX	Art Unit XXXX
		Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-			
B	US-			
C	US-			
D	US-			
E	US-			
F	US-			
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
P					
Q					
R					
S					
T					

NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	Smith, A Universal Compiler. IEEE. 2001. pp. 100-150.
V	Brown, Code management. IEEE. 2000. pp. 30-50.
W	
X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Appendix II – Pre-Interview Communication (Sample 2)

Pre-Interview Communication (For use in the First Action Interview Pilot Program) Example 2	Application No. XXXXXXX	Applicant(s) XXXXXXXX	
	Examiner XXXXXXXX	Art Unit XXXX	Page 1 of 3

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **ONE MONTH OR THIRTY (30) DAYS**, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

This time period for reply is NOT extendable under 37 CFR 1.136(a). This communication constitutes notice under 37 CFR 1.136(a)(1)(i).

To avoid abandonment of the application, applicant must, within this time period for reply, file:

- (1) A letter requesting not to have a first-action interview, or
- (2) A completed Applicant Initiated Interview Request Form (PTOL-413A) accompanied by a proposed amendment or arguments.

Inventor participation in the Pre-First Action Interview is encouraged if it would expedite resolution of the application.

Disposition of Claims

- 3) ☒ Claim(s) 1-15 is/are pending in the application.
3a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 4) ☒ Claim(s) 15 appear to be allowable.
- 5) ☒ Claim(s) 1-14 appear to be rejectable.
- 6) ☐ Claim(s) _____ may be subject to an objection.
- 7) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 8) ☐ The specification may be subject to an objection by the Examiner.
- 9) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ may be subject to an objection by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 10) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 11) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.

Contact Information

Examiner's Telephone Number: (571)272-XXXX
Examiner's Typical Work Schedule: Monday-Friday, 8 a.m. - 4:30 p.m.
Supervisor's Name: Supervisory XXXX
Supervisor's Telephone Number: (571) 272-XXXX

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application 6) <input type="checkbox"/> Other: _____.
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Appendix II – Pre-Interview Communication (Sample 2) *continued*

Pre-Interview Communication Example 2				Application No. XXXXXXXXXX	Applicant(s) XXXXXXXXXX
				Examiner XXXXXXX	Art Unit XXXXXX
Page 2 of 3					
Notification of Potential Rejection(s) and/or Objection(s)					
#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Potential Rejection	
1	1	U,V	103(a)	Reference U discloses claim 1 (see p. 2 lines 35-46 for the grid network, see p.4 lines 11-21 for the grid manager) except for "in response to determining that there are no available (see continuation below)	
2	2, 4-7, 9-13	U,V	103(a)	Building on the rejection of claim 1, U discloses : claim 2 (see p. 7, section 5.2); claim 4 (see p. 3 lines 15-18); claim 5 (see p. 4, section 3.2), claims 6, 7 and 9-13 (see p. 4, section 5.4 (see cont.)	
3	3	U,V,W	103(a)	U and V do not disclose the plurality of computing devices...is a blade management system. W discloses this at p. 2. It would have been obvious to use W's blade mgt. system with the combined system of U and V in order to adapt easily. (see cont.)	
4	8	U,V	103(a)	U does not disclose the network is the world wide web. V discloses this limitation at p. 3. It would have been obvious to use V's world wide web in U's network to facilitate information exchange between users efficiently and quickly.	
5	14	U,V,W	103(a)	Reference U and V disclose the limitations of claim 14 (see p. 2 lines 35-46 for the grid network, see p.4 lines 11-21 for the grid manager) except the limitations of using JAVA. (see continuation)	
Expanded Discussion/Commentary					
1		computing devices having the specific operating system". Reference V discloses this limitation at p. 3 lines 25-30. It would have been obvious to use reference V's algorithm with reference U's Cluster in order to find a suitable Collection of Resources that meet a user's needs (reference V, p. 2 lines 33-37).			
2		- note that 5.4 teaches that a RAM or any other known memory may be used, thus covering claims 10-13).			
3		operate efficiently, and manage seamlessly (see reference W, p. 2).			
5		W discloses this limitation at p. 3 lines 20-39. One would want to utilize the platform-independent characteristic of JAVA programming language in the network of U as it allows for system compatibility across a wide range of systems, giving greater flexibility to the network designer.			
		Note - claim 11 is objected to under Rule 75 for failing to have proper antecedence for "said computing systems".			
DATE:		Examiner Signature:		Primary Examiner Signature:	

U.S. Patent and Trademark Office
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Pre-Interview Communication

Part of Paper No./Mail Date

Appendix II – Pre-Interview Communication (Sample 2) *continued*

Pre-Interview Communication (continued) Example 2				Application No. XXXXXX		Applicant(s) XXXXXXXX	
				Examiner XXXXXX		Art Unit XXXXXX	
Page 3 of 3							
Notification of Potential Rejection(s) and/or Objection(s)							
#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Potential Rejection			
6	15	None	None	Claim 15 is allowable over the cited prior art. The references neither disclose nor render obvious the claimed feature of modifying the data storage based on whether the asset is selected or non-selected.			
Expanded Discussion/Commentary							
DATE:			Examiner Signature:			Primary Examiner Signature:	

Appendix III – Applicant Initiated Interview Request Form

Applicant Initiated Interview Request Form					
Application No.: xxxxxxxx		First Named Applicant: xxxxxxxx			
Examiner: xxxxxxxx		Art Unit: xxxxxxxx		Status of Application: _____	
Tentative Participants:					
(1) _____		(2) _____			
(3) _____		(4) _____			
Proposed Date of Interview: _____			Proposed Time: _____ (AM/PM)		
Type of Interview Requested:					
(1) <input type="checkbox"/> Telephonic (2) <input type="checkbox"/> Personal (3) <input type="checkbox"/> Video Conference					
Exhibit To Be Shown or Demonstrated: <input type="checkbox"/> YES <input type="checkbox"/> NO					
If yes, provide brief description: _____					
Issues To Be Discussed					
Issues (Rej., Obj., etc)	Claims/ Fig. #s	Applied Reference(s)	Discussed	Agreed	Not Agreed
(1) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/> Continuation Sheet Attached					
Brief Description of Arguments to be Presented:					

An interview was conducted on the above-identified application on _____					
NOTE:					
This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).					
This application will not be delayed from issue because of applicant's failure to submit a written record of this interview.					
Therefore, applicant is advised to file a statement of substance of this interview (37 CFR 1.133(b)) as soon as possible.					
_____			_____		
(Applicant/Applicant's Representative Signature)			(Examiner/SPE Signature)		

Appendix IV – Program Eligibility Requirements

Currently, only utility patent applications that fall within one of the groups defined below are eligible for the Program:

Group I:

- (i) the application was filed on or before September 1, 2005;
- (ii) a first action on the merits has not been issued;
- (iii) the application was classified in Class 709 (Electrical Computers and Digital Processing Systems: Multi-Computer Data Transferring);
- (iv) the application was assigned to one of the following working groups:
 - (a) working group 2140 (i.e., one of art units 2140-2149); or
 - (b) working group 2150 (i.e., one of art units 2150-2159);
- (v) the application is a non-reissue and non-provisional utility patent 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);
- (vi) the application has three or fewer independent claims;
- (vii) the application has twenty or fewer total claims;
- (viii) the application does not have any multiple dependent claims;
- (ix) the request for a first action interview is filed electronically;
- (x) the request for a first action interview is filed at least one day prior to a first Office Action on the merits appearing on the Patent Application Information Retrieval (PAIR) system; and
- (xi) the applicant agrees not to file a request for a refund of the search fee and any excess claim fees paid in the application after the issue date of the Pre-Interview Communication.⁴

Group II:

- (i) the application was filed on or before November 1, 2006;
- (ii) a first action on the merits has not been issued;
- (iii) the application was classified in Class 707 (Data Processing: Database and File Management or Data Structures);
- (iv) the application was assigned to working group 2160 (i.e., one of art units 2160-2169);
- (v) the application is a non-reissue and non-provisional utility patent 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);
- (vi) the application has three or fewer independent claims;
- (vii) the application has twenty or fewer total claims;
- (viii) the application does not have any multiple dependent claims;
- (ix) the request for a first action interview is filed electronically;
- (x) the request for a first action interview is filed at least one day prior to a first Office Action on the merits appearing on the Patent Application Information Retrieval (PAIR) system; and
- (xi) the applicant agrees not to file a request for a refund of the search fee and any excess claim fees paid in the application after the issue date of the Pre-Interview Communication.⁴

⁴ The USPTO will not refund the search fee or any excess claim fees after the Pre-Interview Communication is issued.