

# Your Patent Application Is About To Get A First Office Action: Now What?

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The U.S. Patent and Trademark Office (USPTO) recently launched an online [First Office Action Estimator](#), which provides an estimate when a patent application will receive a first Office action. Having an idea of when a patent application will be first subject to examination can help applicants make a variety of strategic decisions to manage costs and/or proceed faster to allowance. This article explores these decisions.

The First Office Action Estimator provides an easy and quick method for applicants to learn when a first Office action may be mailed by entering an application number into the form. The USPTO offers two other options to receive an estimate, but they both require a login. [Private PAIR](#) provides a “First Action Prediction” tab for patent applications awaiting a first Office action. [Patent Center](#) displays a shaded notice of “estimated time to first action” at the top of the screen when relevant for a patent application. The [USPTO states](#) that “[a] first Office action estimation will not be available for an application if a first Office action has already been issued for the application, or if the application has not yet been classified.”

## **Manage Costs**

Being able to check online when a patent application is predicted to receive a first Office action from the USPTO can help an applicant know when costs are likely to be incurred to respond to the Office action. Regularly checking the USPTO’s estimated time is easy and free and can yield positive results for cost management.

## **Proceed Faster to Allowance**

Receiving a first Office action estimate may help an applicant decide when or if to take certain beneficial actions that can only be taken before the mailing of a first Office action. These actions include:

## **Patent Prosecution Highway**

The [Patent Prosecution Highway](#) (PPH) is a program that the USPTO provides in cooperation with various foreign patent offices. An applicant is eligible to file a free petition for acceptance into the

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PPH program only before a first Office action is mailed. A U.S. patent application is only eligible for the program if a participating foreign patent office has indicated that at least one claim in a corresponding patent application is allowable. The USPTO's first Office action estimate may help an applicant properly time PPH filing as well as receive an Office action faster than estimated since the application will be moved up in the examination queue upon acceptance into the PPH program.

## **Collaborative Search Pilot Program**

The [Collaborative Search Pilot Program](#) (CSP) expedites prosecution of related applications at the USPTO and the Japanese Patent Office (JPO) or Korean Intellectual Property Office (KIPO) by allowing the offices to conduct and share prior art searches before issuing a first action. Since the CSP is only available before a first Office action is mailed, the USPTO's action estimator may help ensure that the free petition for acceptance into the CSP is submitted before an application becomes ineligible. The CSP is scheduled to expire on October 31, 2022. Further details about the CSP can be found in [Mintz's prior article about the CSP](#).

## **Petition to Make Special**

Special status jumps a patent application ahead in the examination queue so a first Office action is mailed faster. [37 CFR 1.102\(c\)](#) explains: "A petition to make an application special may be filed without a fee if the basis for the petition is: (1) The applicant's age or health; or (2) That the invention will materially: (i) Enhance the quality of the environment; (ii) Contribute to the development or conservation of energy resources; or (iii) Contribute to countering terrorism."

## **Preliminary Amendment**

A preliminary amendment can only be filed before a first Office Action is mailed and allows amendment of pending claims, cancellation of pending claims, and addition of new claims. Knowing estimated timing of a first Office action may help ensure that the most desirable claims are on file for initial examination without the applicant having to incur the expense and delay of filing a continuation application. Claim amendments may be made via preliminary amendment that would otherwise not be entered after a first Office action is mailed, i.e., because of [election by original presentation](#).

## **Conclusion**

The USPTO caveats that "[t]he estimates provided by the First Office Action Estimator are not guaranteed by the USPTO." In other words, the estimate is only a best guess. The estimate should not be relied on as an absolute. Any number of factors can change when the USPTO mails a first Office action, such as a patent application being reassigned to a different examiner or an examiner using discretion to take a patent application out of order from its ordinary place in the examination queue. The first Office action estimate still can, however, helpfully prompt evaluation of a patent application's status and how to best manage prosecution to secure desired claims.

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