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USPTO Request for Comments
Leveraging Electronic Resources To Retrieve Information From
Applicant's Other Applications and Streamline Patent Issuance

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The Chartered Institute of Patent Attorneys (CIPA) is the professional body which represents around 2000 patent attorneys in the United Kingdom. Our members act on behalf of large corporations, small and medium entities, universities, public bodies and individual inventors. CIPA members are very commonly responsible for the parallel prosecution of patent applications in multiple countries, including USA. Ensuring compliance with the duty to disclose prior art cited elsewhere to the USPTO Examiner is a major burden. We therefore strongly welcome USPTO plans to automate the process, which we believe will benefit both applicants and examiners. By reducing the possibility of inadvertent omission of prior art cited elsewhere, it should also improve the quality of patents and reduce litigation about whether such omission amounts to inequitable conduct.

1. In balancing the goals of examination quality and efficiency, should the USPTO monitor other applications, besides domestic parent and counterpart foreign applications, for relevant information located therein for consideration in the instant U.S. application? If so, which other applications should be monitored (e.g., siblings, applications involving the same or related technology, etc.)?

As a precaution against allegations of inequitable conduct in subsequent litigation, we believe that most applicants already cite references automatically if they are cited in either domestic or foreign sibling applications (continuations or divisionals).

It will therefore be a significant benefit to applicants for the USPTO to monitor for such information itself. Moreover, usually it will not result in Examiners being burdened with significant extra information, since it is information which they already receive in IDSs.

On the contrary, if Examiners are provided with tools and training which enable easy access to foreign file wrappers in the Global Dossier, it should assist them to deal with the burden they already experience. It should then be easier for Examiners to understand why a foreign examiner cited a particular document, and for example whether it was seen as particularly relevant or merely as background information.

Please note that the information in the Global Dossier is continually updated by other patent offices. The USPTO must therefore continue to monitor it in order to provide updated information at the time most suited to the US Examiner's needs, e.g. when an office action is in preparation, an applicant's response is being considered, and also before issuance of a Notice of Allowance. Rules 56, 97 and/or 98 should be amended to relieve the applicant of the need to provide this information in a timely fashion.

- 2. What is the most convenient way to bring an application to the USPTO's attention that should be monitored for information during the examination of a U.S. application (e.g., automated system, applicant notifies the USPTO, etc.)?**

For domestic and foreign siblings, it should be straightforward to provide an automated system. For other applications relating to similar technology, we suggest that the applicant should notify the USPTO.

- 3. How should the USPTO determine which information from the monitored applications to provide examiners while ensuring they are not overburdened with immaterial and marginally relevant information?**

As noted above, we believe that most applicants already provide this information, so it should not result in an extra burden on Examiners. In fact, it will reduce the burden if Examiners are provided with tools giving easy access to Global Dossier information which shows why foreign examiners cited it. It should be noted that at present, most applicants feel unable to assist the US Examiner in this way, since that in itself could lead to an allegation of inequitable conduct, questioning whether guidance supplied by the applicant was misleading. It would be counter-productive to attempt to filter the information, providing Examiners with only some of the references cited in the domestic and foreign counterparts. Fearing allegations of inequitable conduct, applicants would likely file the missing information in an IDS, as at present. There would be no benefit to the Examiner, and the need to check and supply missing information would frustrate the major benefit to applicants. Providing US Examiners with the suggested tools to aid their understanding of why the foreign examiner cited a reference is much preferable.

- 4. If the USPTO were to import information from applicant's other applications, how should the USPTO document the information imported into the image file wrapper of the instant U.S. application? For example, should the record reflect which domestic parent or counterpart foreign application the information was imported from, the date that the information was imported, and whether the examiner considered the imported information?**

Most applicants (or their attorneys) currently check that the US Examiner has initialled their IDSs to show that all information has been considered. It is therefore extremely important that there should be a record of what has been considered, and that this should be sent to the applicant. Ideally, this should be a simple statement that all information from the Global Dossier at a specific date has been considered (and the USPTO should automatically check the Global Dossier again at the time of the Notice of Allowance).

5. Taking into consideration the information that is publicly available in PAIR, what information should be part of a patent? For example, should prior art references and classification information still be listed on the front page of a patent?

All information should be available in one place, to make it easy to find. If it is provided in Public PAIR, rather than on the front page of the patent, then PAIR should have a specific tab for the purpose, and the front page of the patent should include a reference to it. We would not wish to have to wade through all the documents in the image file wrapper looking for it (in the way that IDSs are currently interspersed with all the other application documents).