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Via E-Mail

Mr. Michael Cygan
Senior Legal Advisor
Mail Stop Comments Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Topic Submission for Case Studies: Proprietary Information Disclosure Statement
Procedures

Dear Mr. Cygan:

Proposal for study: Procedures for Proprietary Information Disclosure Statement notification and consideration by Examiners.

Specific Trend or Correlation for Study: We propose analyzing file wrappers containing an Artifact Sheet corresponding to submission of a Proprietary Information Disclosure Statements (“PIDS”), and determining in such cases whether the PIDS were considered by the Examiner prior to Notice of Allowance.

Explanation: Proprietary Information Disclosure Statements (“PIDS”) have, in our experience, often not been considered by the time of a Notice of Allowance under the USPTO’s current PIDS procedures.

According to those current procedures, receipt of a PIDS results in creation of an Artifact Sheet in PALM/PAIR. Often, Examiners do not notice this Artifact Sheet, are unaware that the Artifact Sheet indicates the existence of a PIDS, or are unaware of the steps that should be taken upon noticing the Artifact Sheet in order to acquire a copy of the PIDS. As a result, on many occasions we have reviewed an application after Notice of Allowance and before the Issue Fee payment, and realized that some references which we have cited to the Office in a PIDS have not yet been considered.

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The problem this generates is exacerbated when the Examiner is hotelling. In that case, it can be difficult for an Examiner to acquire any copy of that PIDS. Current USPTO practices do not involve scanning a PIDS for electronic review, which we believe is a worthwhile precaution against proprietary information becoming available on PAIR. For hotelling Examiners, however, difficulties arise in cases where a non-considered PIDS is discovered by the Applicant but the Examiner is not scheduled to be physically present at the USPTO's headquarters by the time the Issue Fee payment is due.

Typically, our firm files a PIDS to cite documents such as yet-unpublished applications by the same applicant or inventor. Thus, in many cases, we expect that the Examiner has already seen these references in the course of his or her search. Nonetheless, the Examiners who failed to consider a PIDS have often requested that we submit a supplemental IDS to cite formerly proprietary applications or file wrappers, so that they will be accessible electronically. In such cases, attorney time must be spent preparing an additional IDS, as well as preparing remarks explaining why no IDS and/or RCE fee should be required from the Applicant. This can result in significant cost to an Applicant who properly and timely filed a PIDS, solely to have that PIDS considered and the references therein appear on the face of the issued patent.

Because of the detrimental effects of a PIDS that is not considered in a timely fashion by the Examiner, we respectfully request that the USPTO implement a case study to determine whether PIDS procedures could be implemented that would more clearly indicate to Examiners early on in prosecution that there are proprietary references that must be considered.

Sincerely,

/Daniel L. Bruzzone/

Daniel L. Bruzzone

/Amy M. Salmela/

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