From:	Bradley, Lesae
To:	Prior Art Access
Cc:	Sahr, Robert N.; Buteau, Kristen C.; Patent US Paralegal Team
Subject:	Written Comments re: Roundtable on Importing Prior Art Automatically & Streamlining Patent Issuance
Date:	Wednesday, October 26, 2016 12:52:14 PM

Dear Deputy Director Michael Neas,

Thank you for requesting feedback regarding Importing Prior Art Automatically & Streamlining Patent Issuance. Below are our responses to the questions posed.

Q1: 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.)?
R2: Yes, the USPTO should be monitoring sister applications as well as those with related technology filed by the applicant. We often list such applications in an Information Disclosure Statement and expect that the USPTO will review the files (which is why we don't provide Office Actions and responses, etc. with our Information Disclosure Statements).

One way to accomplish this might be to create a new tab or program for the Examiner's review that contains a flow of office actions and responses, including references, previously cited from the parent and sister related applications. However, the tab should not be available to the public until the actual applications are published, and before that only available to the Examiner and somebody with Power of Attorney for any related applications.

We use IPDAS in a similar way and find the system to be helpful in organizing prior art across families. You might want to contact AutoDocs to evaluate their system for ideas.

Q2: 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.)?
R2: It would be convenient for the USPTO to have an automated system. Many applicants also already notify the USPTO, but not all and not always.

Q3: 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?
R3: Limit the information to applications within the priority chain as well as those by the same applicant involving similar subject matter.

Q4: If the USPTO were to implement a fully automated system to import information from applicant's other applications, how should the USPTO document the information automatically 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?
R4: Not necessary to make all of that information part of the record. When a counterpart application is identified to the Examiner, it is expected that the Examiner will monitor it at relevant times to the application being examined, e.g. prior to issuing an Office Action or Notice of Allowance. If relevant to the case being examined, information will be cited by the Examiner at that time and become part of the record. There is no need to require dates and sign offs from Examiners merely to evidence steps of that process when the result of the process does not impact examination.

Q5: 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?
R5: It's not necessary because that information is now readily obtainable from PAIR. While it is convenient for readers with only the patent in hand to instantly be able to discern if a potential prior art reference was possibly assessed by the Examiner, if it remains a considerable burden for the USPTO to produce the lists in each patent then the benefit may not be outweighed by the cost.

Please let us know if you have any questions or would like to discuss further.

Best regards,

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