

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property
And Director of the U.S. Patent and Trademark Office

October 28, 2016

Mail Stop Comments – Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Michael Neas
Deputy Director
International Patent Legal Administration

RE: Comments on How the USPTO Should Efficiently Utilize Information From Applicant's Other Applications Having the Same or Substantially the Same Disclosure to Automatically Provide U.S. Examiners with Relevant Information at the Earliest Stage of Examination and on What Information Should be Part of a Patent

Greenblum & Bernstein, P.L.C., the undersigned, is a law firm located in Reston, Virginia, that specializes in all aspects of intellectual property law. The firm currently employs over 30 registered patent attorneys and agents that engage in prosecuting and litigating in various areas of intellectual property. Thus, the firm has an avid interest in the efficient utilization of information in applicant's other applications and in what information should be part of a patent.

We acknowledge and appreciate the interest of the USPTO in expediting and improving the overall patent process and in reducing the issuance time of a patent. In particular, we believe that the efficient utilization of information from applicant's other applications (*e.g.* through the Global Dossier Initiative) provides an important opportunity to reduce the burden on applicants to submit information cited in search reports from related foreign applications to satisfy the duty of disclosure requirements set forth in Rule 56. The undersigned strongly favors processes developed to automatically provide examiners with this information, in so much as such processes provide a clear indication that the duty of disclosure is satisfied with respect to this automatically monitored information.

The following comments are responsive to the USPTO's August 29, 2016 request for written comments and are in line with the undersigned's overarching desire to reduce the burden on applications in satisfying the duty of disclosure requirements under rule 56.

1.) The undersigned is in favor of having the USPTO monitor other applications (*i.e.* in addition to domestic parent and counterpart foreign applications) for relevant information located therein for consideration in the U.S. application. Many applicants already monitor other applications, such as siblings, and could easily provide the USPTO with a list of applications to monitor if doing so would provide a means for automatically considering materials cited in other applications and obviate the need for filing supplemental information disclosure statements.

2.) We believe that an automated system for monitoring information during the examination of a U.S. application would be the most convenient way to bring an application to the USPTO's attention for monitoring. For example, the USPTO could automatically

monitor any applications on the Global Dossier that have at least one common claim of priority. Though an automated system is desirable, we believe that there should also be a pathway to permit applicants, at their discretion, to request that the USPTO monitor particular applications that may not otherwise be known from the USPTO's automation scheme.

3.) We believe that the USPTO should consider all information either disclosed by the applicant or cited by examiners in each of the monitored applications. Examiners at the USPTO routinely and efficiently consider large quantities of information (*e.g.* classification searches often require examiners to search through thousands of items of information) and are more than capable of quickly considering this information. Further, much of the information that is disclosed by the applicant or cited by examiners will be the same across the monitored applications and the examiners would only be required to consider this duplicative information once.

4.) We believe that the USPTO should document the applications that are monitored, the date information is imported, and whether the examiner considered the imported information (in view of comment 3, we believe examiners should always consider this information). In particular, we believe that it is necessary for the USPTO to provide a means for verification that materials have been considered so that an applicant can ensure that his or her duty of disclosure has been satisfied. For example, the USPTO could provide a statement listing the applications that are being monitored and indicating that any materials of record with the monitored applications may be considered to have been disclosed to the USPTO.

Failure to provide such a means of verification may require applicants to monitor whether the USPTO has actually considered the materials in the monitored applications, which will be more of a burden than present practice in which supplemental disclosure statements are routinely filed in response to the issuance of foreign search reports in related applications.

5.) We appreciate the easy reference to, and use of, a list of examiner-considered prior art references printed on the front page of every patent. However, taking into consideration that information is publically available in PAIR, we do not believe that it is critical to continue to list prior art references and classification information on the front page of a patent. But if this information is to be eliminated from the front page of the patent, we recommend adding a feature in PAIR that compiles each of the examiner-considered references and the classification information in one easily printed list to preserve the easy accessibility and use of this listed information while also eliminating the need to print the same on the patent.

The undersigned appreciates the opportunity to submit these comments and would be pleased to work with officials at the U.S. Patent and Trademark Office to achieve the goals of expediting and improving the overall patent process and in reducing the issuance time of a patent.

Sincerely,

Timothy Schwarz, for
the law firm of Greenblum & Bernstein, P.L.C.