

From: [Steven M. Hoffberg](#)
To: [Prior Art Access](#)
Subject: Docket No.: PTO-P-2016-0026; Written Comments of Steven M. Hoffberg
Date: Wednesday, October 26, 2016 11:23:40 PM

Dear Sir:

I am a patent attorney with almost 27 years of experience, and daily user of PAIR, and the publically available USPTO databases.

I believe that the front page of a patent (and corresponding information in the PatFT database) provides useful information, and is a critical resource. Given that the constitutional mandate for the USPTO is to disseminate patent information, it would seem antithetical to the USPTO mission to reduce the amount and usability of the of information it publishes. Further, the front page information should be a valuable resource for examiners, and elimination of that information may lead to a reduction in patent quality.

In the form currently available to the public, use of PAIR is not a substitute for complete front page information of an issued patent. For example, non-patent references and US and foreign patent numbers are not readily accessible, and are not properly searchable, while non-patent literature is completely inaccessible on public PAIR. Making this information searchable within PAIR is perhaps the same difficulty as properly listing these on the front page of the patent. If the information is not indexed and made readily searchable, it is essentially useless.

Therefore, I believe that a reduction in available information (e.g., prior art, classification) on issued patents and the PatFT database is not in the public interest.

One alternate would be to facilitate patent applicant self-entry of this information, for example by providing automated linkage of form-fillable SB-08 forms to the publication database. Indeed, a portal should be provided by the USPTO to enter a set of patent numbers, which would then populate all required fields of the information disclosure statement with information already in possession of the USPTO. Perhaps use of alternates to the USPTO supplied forms could be diminished by relaxing various restrictions imposed by these forms, and I encourage a review by the USPTO of the IDS forms, and a survey of the users.

It might also be useful for the USPTO relax its requirement(s) for providing in each case copies of cited foreign patents, especially where the USPTO provides for access to these documents electronically. By facilitating applicant entry of this type of information for all prior art, the burden on the USPTO will be diminished and efficiency increased, cross reference of prior art information improved, and the public interest served.

Indeed, I encourage to the USPTO to revisit its analysis of whether making available non-patent ("NPL") references cited during patent prosecution is a "fair use" under copyright law, and consider standardizing reference names and hyperlinking NPL references as well. Since many references are available on-line as PDFs, the USPTO appears to be protecting rights that the copyright holders are not, and in many cases, protecting public domain materials. Of course, the legitimate rights of

copyright holders are to be respected, but not overprotected.

Finally, I believe that the USPTO is overprotective of its “public domain” data, and as a result limits innovation in general and within the patent information services field. By making full information available to service providers without favoritism, a competitive ecosystem can develop to lessen the burdens on the USPTO itself. Likewise, by opening access to the massive prior art and examination history collections within the USPTO, which are subject to various manual and automated tags, the discovery of material prior art and analysis may be facilitated, progress of the sciences and useful arts promoted, and patent quality improved.

With respect to identification of patent applications having corresponding disclosure, I recommend that the USPTO use automated “big data” techniques to identify patent applications that have substantial similarities. These technologies are readily available, and can exploit databases already in existence. While identifying applications prior to their publication raises logistical issues, these could be resolved by simply OCRing IFW files *en masse*, or accepting patent applications in text form (or cease stripping ASCII information from PDF files uploaded by applicants to yield TIFF-only files), and applying these technologies to “dirty”/uncurated data sets. Once a “similar” application is identified (automatically or manually), there should be an automated update system to provide hyperlinked messages to an Examiner to facilitate review of further proceedings in these other identified cases, without requiring applicant to submit an additional IDS, which itself increases the very burden that the USPTO seeks to diminish. Wholesale copying of the information from one file wrapper to the other does not increase quality, efficiency or usefulness, and therefore an administrative effort to deduplicate the USPTO databases should be given high priority.

In fact, if MPEP 609.02 I were amended as follows, a significant burden on the USPTO could be relieved: “When filing a continuing application that claims benefit under 35 U.S.C. 120 to a parent application (other than an international application that designated the U.S.), it will not be necessary for the applicant to submit an information disclosure statement in the continuing application that lists the prior art cited by the examiner in the parent application [[unless the applicant desires the]] and that information [[to]] will be printed on the patent issuing from the continuing application...” Similar for MPEP 609.02 II: “A listing of the information need not be resubmitted in the continuing application [[unless the applicant desires]] in order for the information to be printed on the patent.”

The foregoing does not represent the opinion of Ostrolenk Faber LLP or its clients, and represent my personal observations.

Very truly yours,

Steven M. Hoffberg, Esq.

Ostrolenk Faber LLP - 1180 Avenue of the Americas - New York, New York 10036

(212) 596-0500

SHoffberg@ostrolenk.com