Latest News

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Importing Prior Art Automatically & Streamlining Patent Issuance

The United States Patent and Trademark Office (USPTO) is continuing its efforts to expedite and improve the overall patent process. Accordingly, the USPTO is exploring how to best utilize available electronic resources to provide examiners with information (e.g., prior art, search reports, etc.) from applicant's other applications as early as possible to increase patent examination quality and efficiency. These other applications, for example, could have the same or substantially the same disclosure (e.g., domestic parent and counterpart foreign applications) as the U.S. application being examined. In addition to improving patent examination quality and efficiency, providing the examiner with this information from applicant's other applications will reduce applicant's burden to provide this information to the USPTO.

Further, the USPTO is seeking to reduce the issuance time of a patent by eliminating potentially unnecessary information from the front page of the patent. In particular, the USPTO is seeking public comment on what information, beyond a copy of the specification and drawing that is required by statute, should be part of the patent considering that complete information concerning U.S. patents and U.S. patent application publications are accessible to the public via the Patent Application Information Retrieval (PAIR) system.

On September 28, 2016, the USPTO sought participant feedback at a Roundtable on Importing Prior Art Automatically & Streamlining Patent Issuance. During the event, the USPTO sought participant feedback on the following questions related to how the USPTO should efficiently utilize information from an 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:

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.)?

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.)?

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?

4. 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?

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?

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