October 28, 2016

Via Electronic Mail
PriorArtAccess@uspto.gov

Attention: Michael Neas, Deputy Director, International Patent Legal Administration

NXP Semiconductors Comments in response to "Request for Comments and Notice of Roundtable Event on Leveraging Electronic Resources to Retrieve Information From Applicant's Other Applications and Streamline Patent Issuance (81 Fed. Reg. 59197 (August 29, 2016))

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NXP thanks the United States Patent and Trademark Office (USPTO) for the opportunity to comment on its plans to more effectively utilize electronic resources to provide examiners with information from an applicant's other applications early in the prosecution process. We appreciate the USPTO's commitment to improve patent prosecution quality and efficiency, and to reduce the burden of producing potential prior art references that the USPTO may already have at its disposal.

With regard to the questions presented in the Federal Register notice, NXP provides the following responses.

1) In balancing the goals of examination quality and efficiency, should the USPTO monitor other applications, besides domestic parent (through PAIR) and counterpart foreign applications (through Global Dossier), for relevant information located therein for consideration in the instant US application? If so, which other applications should be monitored (e.g., siblings, applications involving the same or related technology, etc.)?

NXP suggests that monitoring all genealogically-related applications that are in active prosecution before the USPTO should be a default. Genealogically-related applications include all family members, regardless of whether the applications are in the same branch of the genealogy.

In addition, NXP suggests that other related applications, as designated by the applicant, should be monitored, regardless of whether those designated applications are in the same genealogical family. This is in recognition that there may be patent applications that include substantially similar specifications, but are not in the same

genealogy for a variety of reasons. In the interest of efficiency for the USPTO, those designated related applications can be limited, for example, by number (e.g., four maximum), common inventor(s), and the like.

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 US application (e.g., automated system, applicant notifies the USPTO, etc.)?

NXP suggests that a system that automatically monitors a default set of applications, along with allowing for designation of additional related applications is desirable. The default set of applications can include those U.S. applications in the same genealogy (e.g., parents and siblings).

With regard to designation of related applications, NXP suggests an EFS-type input form that permits such designation at any time during the prosecution lifetime of an application. It would be desirable to provide this in the format of an EFS input form, in order to further the desired result of less paperwork before the USPTO.

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?

As a baseline, NXP suggests that the USPTO should include all information that current case law has determined to be important in satisfying 37 CFR 1.56 obligations.

In addition, NXP suggests that the monitored information include not only the art cited in domestic office actions from related cases but also the office action itself. This will avoid uploading and submission of paperwork that the USPTO already is in possession of or has access to (e.g., through Global Dossier). Further, the system should include some method of loading and storing cited non-patent literature from related domestic and counterpart foreign applications. In addition, the system should include some method of requesting any unavailable NPL from the applicant.

4) If the USPTO were to import information from applicant's other applications, how should the USPTO document the information imported into the image file wrapper of the instant US 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?

The concern here is whether there is a presumption that the examiner considered all the art in the linked applications. If there is no presumption that the examiner considered all art cited in the linked applications, then the record should reflect whether the examiner considered the imported information. Otherwise it will not be clear that any issued patent is entitled to a presumption over that art.

Conclusion

NXP thanks the USPTO for considering an automated process for providing information between related applications that are both before the USPTO and foreign patent offices. It is hoped that this will indeed improve both efficiency and reliable exchange of information, and will also help to avoid needless after-allowance actions due to such information not having been provided. We thank the USPTO for considering our comments on the implementation of such a system.

Respectfully submitted,

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