

From: [Orange, David B.](#)
To: [Prior Art Access](#)
Subject: Proposal: stop requiring copies of foreign patents
Date: Friday, October 28, 2016 1:35:39 PM

Dear Prior Art Access team,

Not requiring copies of foreign patents for the record would reduce paperwork, save time and improve compliance, both internally and externally, at virtually no cost. The rules requiring copies for the record were written long before tools like Espacenet's database of 90 million foreign patents with machine translations were available. In 2004, US patents could simply be cited by number (and no copy provided) because they were available online:

<https://www.uspto.gov/web/offices/com/sol/og/2004/week42/patwaiv.htm> (applicants don't need to send copies to the PTO)

<https://www.uspto.gov/web/offices/com/sol/og/2004/week20/pataces.htm> (PTO doesn't need to send applicants copies)

The 2004 rule change has been very successful, and foreign patents are now more accessible than US patents were in 2004.

If we could remove the requirement to send copies back and forth, not only would we reduce the paperwork for both examiners and applicants, but we could improve compliance as well. Presently, applicants citing foreign patents often provide a machine translation of the abstract (possibly because for many years, this was the only document that was readily available for certain countries, most notably Japan). However, MPEP 609.04(a)(III) explains that where the inventor knows the language, and the partial translation (e.g., the abstract) does not provide the most complete combination of the claimed elements, there could be inequitable conduct concerns. Under this proposal, the patent office would consider the entire reference so the applicant can't get into trouble for only submitting a partial translation. Internally, if examiners forget to attach a foreign reference to an office action, the case must be returned to the examiner and then re-reviewed, leading to increased pendency.

If we were to make this change, 37 C.F.R. 1.98 would need to be amended because the current language requires providing copies. At the October 26th Partnering in Patents event, Mike Neas suggested that this CFR section may be in the process of being amended as part of implementing other suggestions from this program. The foreign references covered by this program should be limited to those that we have a machine translation of (my personal experience is that it is very rare for a foreign patent to not be available on Espacenet). It appears that the global dossier has already put in place a partnership with the EPO that would allow the patent office to rely on Espacenet for copies of these references.

Lastly, I would recommend that the machine translations insert paragraph numbers, as is done for U.S. pre-grant publications to make it easier to provide pinpoint citations. If desired, a pilot program can be launched where cases from select examiners are treated under the proposed rule. To help this process along, I am willing to volunteer my time to gather data and build a business case.

I look forward to your feedback.

The views expressed are solely my own, and not necessarily those of my employer.

Best regards,

David