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**Subject:**

**Inter-Office Document Sharing**

**Project:**

Global Dossier

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**Responsible:**

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## **Inter-Office Document Sharing Background**

The goal of the proof of concept for inter-office document sharing was to expand the functionality of the Passive Component to include the ability to transfer selected documents from an application at one IP5 Office to related applications located at one or more other IP5 Offices. By developing the proof of concept, the feasibility of implementing and perfecting a transport mechanism for delivering application content could be determined.

Through the proof of concept, the IP5 Offices focused on identifying and addressing issues associated with security, machine translation, impact on business, exception processing, cost-benefit, and navigation and operations. The technology and processing developed through the proof of concept would be instrumental in establishing a foundation for cross-filing.

Significant progress on the proof of concept has been made. In 2016, the USPTO developed user interface examples demonstrating the functionality of the inter-office document sharing process and drafted a proposed business solution for utilizing the inter-office document sharing service. The USPTO further evaluated business processes where application forms and documents could potentially be used in the original proof-of-concept, however many business, legal, and IT impediments were identified.

Based on these analyses, the USPTO developed the backend services necessary for inter-office document sharing between IP5 Offices, and has shared the technical documentation and code with participating IP5 Offices. A prototype interface for the inter-office document sharing service has also been developed.

## **Current Status**

After evaluating internal IT and legal analysis, as well as feedback gathered from stakeholders, the USPTO has recognized that the concept for the inter-office document sharing process needs to be achieved in smaller steps, as many complexities exist in the current business practices and in the existing legal and IT framework (see Appendix 1). In order to realize the full vision of the inter-office document sharing process, various business, legal, and IT challenges will need to be addressed among the IP5 Offices. As a result, the USPTO is proposing potential enhancements to Global Dossier that would advance the inter-office document sharing goal and be achievable in the short-term, while also providing additional value to IP5 stakeholders.

An essential criterion for achieving success with the inter-office document sharing goal is in the exchange of relevant application data, whether they be in the exchange of documents and forms between offices, or in the exchange of data between offices for pre-population of Office specific forms and documents that can subsequently be entered into the application file wrapper. While the forms and documents required throughout the prosecution of a patent application can vary between IP Offices, the information contained in the forms is often similar and can be re-used in related applications filed at other Offices.

The USPTO's next step towards achieving the realization of inter-office document sharing involves using data currently available in the Global Dossier to help pre-populate Office-specific forms and documents. To accomplish this, the USPTO plans to pre-populate a USPTO-specific form as an example, which will demonstrate to other IP5 Offices how they can similarly implement pre-population of forms. Functionality would be provided in Global Dossier allowing users to generate USPTO-specific forms and documents, which would be pre-populated with data available in Global Dossier, and could be further modified and submitted by applicants through the typical submission processes (see Appendix 2, Fig. 1). This next phase would further be advanced by integrating the results of the Global Dossier XML document provision project which is being led by the JPO. The USPTO will continue to engage with the JPO to develop a plan to identify opportunities where the XML data provided could be used to pre-populate forms and other application documents.

One example of a Global Dossier-generated form under consideration is the Information Disclosure Statement (IDS). In September 2017, USPTO released a beta version of the Global Dossier Citation List, which lists all the citations from a patent family in one view. Additional functionality would be incorporated into the Citation List to allow citation information, including the publication number, kind code, publication date, and name of patentee/applicant of cited document, to be exported into the fields of a standard IDS form (PTO/SB08a) (see Appendix 2, Fig. 2).

While other IP5 Offices may not require submission of forms similar to the USPTO IDS, the USPTO envisions that other Office-specific forms could be generated and pre-populated using application data accessible in Global Dossier. For example, forms such as a change of address or assignment could be generated that have been partially or entirely completed by an automated method. By allowing the user to generate the pre-populated form and modify the form locally, the amount of time spent completing Office-specific forms and documents would decrease. Furthermore, it is likely that the amount of data-entry errors that could impact the prosecution of an application would be reduced.

The USPTO anticipates that this next phase will lay the groundwork for further progress to be made in inter-office document sharing and towards the ultimate goal of cross-filing among the IP5 Offices, by allowing the IP5 Offices to better understand the application data and documents critical for filing at each Office and to better identify the areas where work sharing and harmonization between IP5 Offices is necessary to advance cross-filing.

### **Next Steps**

The USPTO is developing a business solution to utilize the data currently available in Global Dossier to help pre-populate Office-specific forms and documents, and has been working closely with U.S. Industry Groups to gather feedback on this solution. The USPTO has requested that the U.S. Industry Groups discuss USPTO's next step towards inter-office document sharing among the IP5 Industry Groups in an effort to help identify additional Office-specific forms which could be pre-populated utilizing the information in Global Dossier. Achieving data standardization for pre-populating Office-specific forms would be a significant step in realizing the full vision of inter-office document sharing.

The USPTO will be presenting their progress on this next phase of the Global Dossier inter-office document sharing goal at the Global Dossier Task Force being held in early 2018 in Tokyo, Japan.

## **Appendix 1**

In 2017, the USPTO developed a comprehensive assessment of the full-vision of the inter-office document sharing goal. During the assessment, the USPTO explored the legal, business, and technical challenges to be solved in implementing a solution to an inter-office document sharing business problem. The USPTO selected PPH as a representative business problem that could potentially benefit from the full-vision document sharing goal. The following issues were identified during the assessment, and although PPH was the selected topic to evaluate, the challenges are not uniquely specific to PPH.

### **#1. Authentication**

The USPTO has been in an ongoing process of developing an enterprise-wide authentication service known as Role-Based Access Control (RBAC) for identifying both internal and external users and regulating their access. All services, including Global Dossier, are expected to use this solution for authenticating users. This authentication service, however, is still in development and is not currently ready to be integrated into Global Dossier.

### **#2. Legal Signature**

Currently, the USPTO does not accept the signature of a juristic entity applicant, and thus would require a registered patent practitioner of record to sign the documents being shared.

This would require the documents being shared to be editable by the local agent reviewing the documents at the Offices that receive the shared documents. Further significant IT investment would be required at the USPTO, as an editing service would have to be developed, as well as version controls to identify the original and edited documents. This functionality would also raise substantial cybersecurity concerns, as documents would not only be transmitted between IP5 Offices, but also between the IP5 Office and a third party.

### **#3. Harmonization**

Further harmonization of forms and documents among the Offices would be necessary. While certain documents, such as PPH forms, are similar among the IP5 Offices, they are not identical. Additional analysis is needed to determine what additional steps and modifications are necessary to ensure that the transmitted documents are accepted at all participating IP5 Offices.

### **#4. Translations/Editing**

It is likely that certain shared documents will be in a foreign language or need to be edited prior to submission. This would require the local agent at the USPTO to download the document, translate or make the necessary edits to the document, and upload the modified document.

Significant IT investment would be required at the USPTO to address the translation issue, as both download and upload functionality and version control to identify the original and uploaded documents would need to be developed. This functionality would raise substantial cybersecurity concerns, as

documents would not just be transmitted between IP5 Offices, but also between the IP5 Office and a third party.

Having the IP5 Offices provide machine translations of the shared documents is not be a feasible solution. If there were discrepancies between the original and translated document, this could raise issues in the prosecution of the application. In addition, the shared documents would likely be in image format, which would require OCR software, raising the cost of development and further increasing the likelihood of errors in translation.

#### **#5. Shareable Documents**

The current inter-office document sharing service requires the documents to be publically available in a related application within the patent family filed at another IP5 Office. In many cases, however, the documents may not be present in the related application. For example, in the case of PPH, the PPH request form typically is only filed at the Offices of subsequent examination. While the business process may be modified by creating a new PPH form that is filed at the initial Office for sharing with other Offices, there are other documents where this is not possible, such as non-patent literature (NPL). In these situations, the applicant or the local agent would be responsible for filing the NPL documents separately from the PPH forms.

#### **#6. Communication**

Even though documents can be shared between Offices, the local agent remains required to approve the documents for entry into the application at the receiving Office. This would likely require communication between the applicant and the local agent independently from the document sharing service, such as by email, particularly in scenarios where the local agent is required to submit additional documents, or provide translations of the shared documents.

As a result, it is unclear how much more efficient and beneficial the document sharing service being developed would be to users, particularly when the same documents can be shared, along with instructions or with additional documents, through email.

## Appendix 2

Fig. 1 (Process Flow):

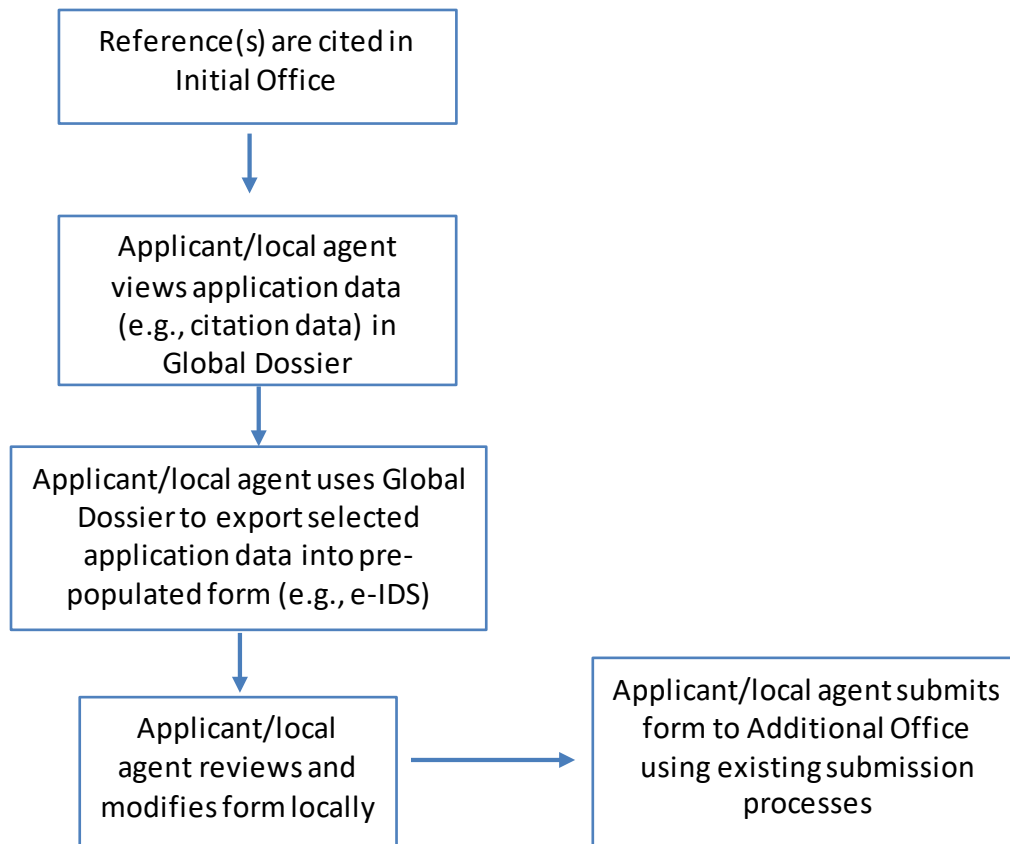


Fig. 2 – Proposed Interface

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6	US 20080086073/A1	MULTI-REGION STAGED INFLATION BALLOON	by MCDANIEL BENJAMIN	04/10/2008
6	US 6640120/B1	Probe assembly for mapping and ablating pulmonary vein tissue and metho...	by SCIMED LIFE SYSTEMS INC	10/28/2003
6	US 6290697/B1	Self-guiding catheter system for tissue ablation	by IRVINE BIOMEDICAL INC	09/18/2001
3	EP 1547537/A1		by TORAY INDUSTRIES	06/29/2005

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Doc code: IDS  
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First Named Inventor	Subramaniam
Art Unit	
Examiner Name	
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### INFORMATION DISCLOSURE STATEMENT BY APPLICANT

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	2	6640120	B1	2003-10-28	Scimed Life Systems Inc		
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	1	1547537	EP	A1	2005-06-29	Toray Industries		

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