

From: [al](#)
To: [Prior Art Access](#)
Subject: Written Comments Regarding Federal Register Notice, "Importing Prior Art Automatically & Streamlining Patent Issuance," 81 FR 59197
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Written Comments Regarding Federal Register Notice, "Importing Prior Art Automatically & Streamlining Patent Issuance," 81 FR 59197

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From the Notice, question #5 asks:
"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?"

My Comment:
If another openly and freely disseminated data source and search system is provided by the USPTO that is easily accessed, specifically above and beyond public PAIR, then I do not believe this information needs to be listed on the front page of the patent.

However, Public PAIR WILL NOT suffice.

I strongly request that the classification and cited patents continue to be provided in some text-based form (XML or comparable) such as through the current Bulk Data Storage System (BDSS) and preferably similar in format to the current XML bibliographic data already disseminated as Patent Grant Bibliographic (Front Page) Text Data or the Patent Grant Full Text Data available through the USPTO BDSS, even if no longer printed on the front page(s).

In order to afford individuals access to this same information, I also strongly encourage the USPTO to continue to provide this classification and reference information through the existing or similar search system such as currently provided within the existing USPTO Patent Full-Text and Image Database.

Full Discussion:
As an introduction, my name is Al Watkins. I am a registered patent agent who had the good fortune to begin my career at the USPTO as a Patent Examiner. Following that, I spent time in private practice, and then spent seven years managing the intellectual property of a multinational corporation. I have since spent slightly more than twenty years in private practice working for clients of all size.

I would particularly like to thank the USPTO, and in particular Messr's Powell and Bahr, for sponsoring this roundtable discussion, and making a recorded copy available on the web. This stakeholder involvement is both very refreshing, and serves to illuminate the many challenges that

the USPTO faces in making these decisions.

I would like to affirm that I also believe this is a very worthwhile project, and strongly encourage the USPTO to continue devoting funds and efforts to implementing appropriate systems and programs.

In the Notice, there were five "Questions for Written Comments and Discussion at the Roundtable Event" raised. During the roundtable, there were many innovative thoughts and comments, and I do not wish to rehash those. I am comfortable that the Office is very familiar with and working to address the many complex issues facing all of the stakeholders. Once again, thank you.

My comments are very specifically directed to the last question raised in the Notice, for which there was much less discussion during the roundtable. I anticipate that the Office has already considered my comments, and if so, you have my apologies for any duplication.

From the Notice, question #5 asks:

"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?"

In considering this question, the uses of the information must be carefully considered. I understand both from Ms. Leslie Fischer of Novartis' comments and from my own experience that there are many diverse uses for the information, but that they break down into two distinct purposes that I regularly associate with.

One of these is the clear identification that a particular document has been more particularly reviewed and considered. For this purpose from my limited experience, and as I understood from the roundtable discussion as well, the PAIR database as proposed by the question is sufficient. In the event of a question arising as to whether a patent was more carefully considered by an Examiner from the sea of millions of patents, the PAIR information provides this confirmation through the PTOL 892 "Notice of References Cited" and PTOL/SB/08 "Information Disclosure Statement by Applicant". Maintaining this ability, by both the applicant and the Examiner, to explicitly acknowledge the specific consideration of specific individual patents, is invaluable but easily confirmed in PAIR.

However, as Ms. Fischer of Novartis also noted in passing, and as I am also keenly aware, a second critical use for this information comes in more thorough and exhaustive patent searches. While Ms. Fischer did not elaborate at the public roundtable, I would like to take this opportunity to do so.

In some searches, checking the references cited in a patent or later issued patents that cite a document is invaluable. This capability is invaluable both to those members of the public conducting searches, and, speaking only from my own experience, also invaluable to patent examiners.

Unfortunately, I note that there is a large chasm between the information available from the public PAIR database, and the information that is available as a part of the full text or bibliographic XML data.

In order to review the references and technology classifications considered by a patent examiner in a close prior art reference, such as is commonly done when someone is conducting a preliminary patentability search or during a USPTO patent application examination, this information must be easily retrieved. When the information is provided through the front page bibliographic data, as it is presently, the information may easily be accessed either by an individual manual retyping or through direct use of the EAST and WEST search systems and through many commercial third party databases. Consequently, the current bibliographic classification and references cited in both printed and electronic form greatly facilitates more thorough and accurate searches.

However, the current public PAIR system only provides retrieval of the image copy of the PTOL 892 and PTOL/SB/08 (and equivalent) forms. Retrieval of the cited documents this way requires extraction of the forms, OCR conversion or manual retyping, and then assembly and removal of duplicates. While achievable, the amount of time and expertise required to conduct such a process would effectively eliminate this extra and sometimes invaluable step of checking references. Consequently, I believe it is critical that the data continue to be provided in electronic form by the USPTO.

Having represented many individual (independent) inventors over the years, I can also comfortably represent that these individuals generally do not have access to the data systems and third-party provider sources that many professional searchers and patent practitioners rely upon. Consequently, in order to afford individuals access to this same information, should the USPTO remove this information from the front page(s), I also strongly encourage the USPTO to continue to provide this information through the existing or similar search system such as currently provided within the existing USPTO Patent Full-Text and Image Database. Without this, individual inventors will be severely disadvantaged.

Thank you once again for affording me this opportunity to offer comments at this early stage in the process.

/Albert W. Watkins/