

*Before the*  
United States Patent and Trademark Office  
Alexandria, VA

*In re*

Docket No.: PTO-P-2016-0026

Comments on Leveraging Electronic  
Resources To Retrieve Information From  
Applicant's Other Applications and  
Streamline Patent Issuance

**COMMENTS OF  
COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION**

Pursuant to the request for comments issued by the United States Patent and Trademark Office (“USPTO”) and published in the Federal Register at 81 Fed. Reg. 59,197 (Aug. 29, 2016), the Computer & Communications Industry Association (“CCIA”)<sup>1</sup> submits the following comments regarding leveraging electronic resources to retrieve information from applicant's other applications and streamline patent issuance.

**I. Introduction**

CCIA applauds the USPTO’s efforts to leverage electronic resources in order to streamline patent examination while improving patent quality. The current Global Dossier has provided an excellent starting point, and CCIA supports the USPTO in its desire to build upon Global Dossier. CCIA believes that automatically providing references and office actions from relevant applications both inside and outside the United States will provide large efficiencies and improve the quality of patent examination.

It is common for patent applicants to file applications worldwide; applicants also frequently file continuing applications, including continuations, divisionals, and

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<sup>1</sup> CCIA is an international nonprofit membership organization representing companies in the computer, Internet, information technology, and telecommunications industries. Together, CCIA’s members employ nearly half a million workers and generate approximately a quarter of a trillion dollars in annual revenue. CCIA promotes open markets, open systems, open networks, and full, fair, and open competition in the computer, telecommunications, and Internet industries. A list of CCIA members is available at <http://www.ccianet.org/members>.

continuations-in-part. These prosecutions are spread over a number of years and can involve many different examiners. It makes no sense for a new examiner to have to start over when there is already a volume of work that exists for an application family.

Moreover, some applicants engage in examiner-shopping, filing essentially the same specification multiple times without relating the applications. These applicants hope to find one examiner who will allow the application. This, unfortunately legal, practice has been difficult to prevent.

Accordingly, CCIA strongly supports the USPTO's efforts to leverage that work. This will result in better, more thorough examination, which will produce better quality patents. At the same time, sharing information will discourage examiner-shopping.

CCIA offers the following comments:

## **II. Comments on Question 1**

*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.)?*

CCIA believes that, essentially, the Global Dossier program should be expanded to include monitoring other applications, both domestic and foreign. At a minimum, all applications with a common ancestor should monitor each other, including that common ancestor. In addition, patent examiners and applicants should have the ability to identify applications that should be monitored. These could include, for example, competitors' applications, applications with overlapping inventorship, applications from the same assignee regarding the same technology, or applications that involve the same or related technology.

CCIA suggests that the monitoring relationship be reflexive where possible. That is, if application A monitors application B and B is a domestic application, then application B should monitor application A as well. As further explained below, CCIA does not believe that information should be imported directly into the record; rather, the examiner should act as curator and determine which information is appropriate to add to the record.

CCIA also recommends that the system use some sort of algorithm similar to plagiarism-detection in order to identify identical or nearly identical specifications that are filed in unrelated applications. Some applicants file unrelated applications with identical specifications in an attempt to game the system. The idea is try a number of different examiners in order to find a sympathetic examiner to allow the application. Automatically adding such applications to the monitored group will help prevent these

applicants from gaining any advantage, because all the involved examiners will share the same information regarding the applications.

CCIA does not recommend using more complicated artificial intelligence to identify applications, at least not initially. Artificial intelligence algorithms for doing such identification automatically would add a large amount of complexity and uncertainty to a new system. The project will be more likely to succeed if it is simpler and robust.

### **III. Comments on Question 3**

*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?*

CCIA recommends that information not be imported into the record automatically. Imported art should be placed in a special storage area that the examiner can access. The examiner then reviews this art and determines which references should be made of record. The system should also be able to identify duplicate references so that the examiner is not presented with a list containing the same references more than once.

That is, the examiner should be a curator for information from monitored applications, rather than simply putting everything from a monitor application into the record. The examiner should also be provided effective tools for quickly and efficiently reviewing this imported art. For example, visual indicators could be used to identify references with a publication date earlier than the current application date, references with common inventors, references with common CPC codes, and so on.

CCIA believes that the total volume of information in the storage area is unlikely to be too large to curate effectively. The USPTO, however, should perform studies to determine the likely size of such a storage area. This will involve creating various proposed rules for automatic inclusion of applications, such as:

1. All U.S. ancestor applications and foreign counterparts;
2. Group 1 plus U.S. sibling applications;
3. Group 1 plus all U.S. family applications;
4. Group 3 plus applications with identical (or near-identical) specifications
5. Monitoring as a one-way relationship (i.e., application A monitoring application B does not imply that application B monitors application A)
6. Monitoring as a reflexive relationship (i.e., application A monitoring application B implies that application B monitors application A)

These studies should be done across technology centers, by art unit if practical.

In order to determine a reasonable average size for the “curation” set of information (i.e., the set of information an examiner must review provided by the automatic importation process), the USPTO should consult with examiners and POPA, as well as with supervisory patent examiners. There will be at least two counter-balancing

pressures. On the one hand, reviewing this additional information will take additional time for examiners. On the other hand, providing better-targeted information automatically should save examiners time in searching and drafting actions. It may even reduce the number of requests for continuing examination that are filed.

CCIA believes that, if properly done, this project will provide a net savings of time for examiners.

#### **IV. Conclusion**

CCIA strongly supports the USPTO's efforts to leverage electronic resources in order to streamline patent examination while improving patent quality. CCIA believes that this project has the potential to provide substantial time savings to both examiners and applicants, while at the same time improving patent quality.

Respectfully submitted,

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