28 October 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property &
Director of the United States Patent and Trademark Office
Mail Stop CFO
P.O. Box 1450
Alexandria, Virginia 22313-1450

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

Re: Comments on Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance

Dear Director Lee:

Intellectual Property Owners Association (IPO) submits the following comments and suggestions in response to the United States Patent and Trademark Office's "Request for Comments and Notice of Roundtable Event on Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance," published in 81 Fed. Reg. 59197 (Aug. 29, 2016) (FRN).

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO's membership includes about 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans 43 countries. IPO advocates for effective and affordable IP ownership rights and provides a wide array of services to members, including supporting member interests relating to legislative and international issues; analyzing current intellectual property issues; information and educational services; and disseminating information to the general public on the importance of intellectual property rights.

IPO appreciates the USPTO's effort to allow stakeholders to provide feedback on these issues. We support the USPTO's effort to expedite and improve patent prosecution, and especially efforts to provide relevant prior art to examiners as early as possible and to reduce the corresponding burden on applicants.

Thank you for considering these comments on the FRN.

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<u>Question 1</u>: 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.)?

The USPTO should monitor other applications besides domestic parent and counterpart foreign applications. IPO proposes that the USPTO implement a hybrid program where some applications are automatically monitored without being identified by the applicant, while other applications are monitored only after a request by the applicant. Information from monitored applications could be imported into the application's file wrapper to ensure that the information is considered and of record, such that submission of the information by the applicant would be unnecessary to satisfy the duty to disclose under 37 C.F.R. § 1.56.

Automatically monitored applications would include those sharing a priority relationship such as a parent, child, sibling, or foreign counterpart. Applicants should have the option to request that the USPTO monitor additional applications. For example, an applicant might have other co-pending domestic or foreign applications that do not share a priority relationship, but are related through applicant's technology, products, or projects. Because the USPTO would be unaware of the potential relevance of such applications, applicants would be required to request monitoring of those types of applications.

Furthermore, applicants should be allowed to request monitoring of any application, regardless of common ownership/assignee. For example, applicants should be allowed to request monitoring of another applicant's application in the same technology space if the applicant believes information material to the given application might be identified during prosecution of the other application.

Monitored applications would include only applications pending in IP5 offices because the USPTO can automatically import all relevant documents and other information from IP5 applications into the record of applications pending before the USPTO through Global Dossier. IPO recommends expanding the Global Dossier tool to include information from other patent offices and to make information about monitored applications available to the USPTO pre-publication to ensure information from monitored unpublished applications is available to the USPTO as soon as possible. Until the Global Dossier tool is expanded, applicants should continue to cite material information not available through Global Dossier using Information Disclosure Statements (IDS).

In some instances, an applicant might not want an application monitored. For example, an applicant might not believe an automatically monitored application with overlapping priority lineage includes information material to patentability. In such cases, applicants should have the option to remove applications from monitoring upon request. The USPTO could consider giving examiners the power to veto requests to remove or add applications.

We suggest that an applicant's duty of disclosure should be satisfied with respect to all information imported from applications monitored through this program. The USPTO could clarify this in various ways, such as modifying 37 C.F.R. § 1.56 to state that information from

monitored applications is deemed cumulative of information already of record or to add another section noting that the duty of disclosure does not extend to information in applications being monitored through this program. The USPTO also could modify the MPEP to expressly state that it is not necessary for applicants to submit an IDS with information from monitored applications, similar to the handling of information from parent applications per MPEP § 609.02.

We suggest that the USPTO use this new monitoring program to expedite examination and reduce the burden on applicants. For example, IPO notes that applicants frequently receive potentially relevant information from foreign counterpart applications pending before IP5 offices after receiving a final office action or notice of allowance and before payment of the issue fee. Instead of requiring applicants to submit an IDS with an appropriate certification and 1.17(p) fee, we suggest that the USPTO automatically provide the information to the examiner for consideration and automatically charge the 1.17(p) fee with applicant pre-approval. This approach would reduce delay in patent issuance and reduce the burden on applicants.

Finally, the USPTO should consider whether additional fees would be necessary to implement this program. For example, the USPTO could consider charging a fee for each application monitoring request beyond those monitored automatically. In addition to providing a revenue source, this approach would reduce the likelihood that applicants would request monitoring of numerous additional applications, burdening the USPTO and the examiner. The USPTO could consider a sliding-fee scale under which fees increase based on the number of applications requested to be monitored.

Question 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 U.S. application (e.g., automated system, applicant notifies the USPTO, etc.)?

Under the hybrid program discussed above, monitoring requests could be made via paper filing or web interface. For a paper filing, the USPTO could introduce a new form or modify form SB08 to include a section for monitoring requests. For web interface requests, the USPTO could consider modifying private PAIR to include this functionality.

The USPTO also should modify the public and private PAIR interfaces to include information on the applications being monitored and a list of information (e.g., patent and non-patent references that have been provided to the examiner and included in the file wrapper) from monitored applications that have been placed in the record of a given application, so applicants can verify that the automatic and requested monitoring is in place, and the public can also be informed as to the applications being monitored. This could be implemented, for example, via a separate tab on the PAIR interface.

Question 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?

All information included in the Global Dossier for a monitored application should be placed in the record and provided to the examiner. Otherwise, applicants still would have to submit information in IDSs, which would eviscerate the value of this program. Providing Global Dossier information (including references and office actions) should not place an undue burden on examiners, because 37 C.F.R. § 1.56 already advises applicants to consider submitting prior art cited in foreign counterpart applications. IPO's proposal merely automates a practice applicants routinely follow.

To ease the burden on examiners, we recommend implementing a technology solution to identify equivalent references through Global Dossier, such as cited references that are different counterparts of the same prior art application. (Such information is typically included in PCT Search Reports, for example). This would enable examiners to review any one equivalent prior art application from a family of cited applications, particularly any English language equivalent, thus avoiding a review of redundant prior art applications cited by different IP5 offices.

We further suggest that the USPTO implement a technology solution that flags for the examiner only information that has been added to the Global Dossier since the last time the examiner checked to streamline the examiner's review.

Question 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 U.S. 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?

With respect to importing information from the applicant's other non-US applications, IPO recommends following the guidelines followed by the USPTO for references cited by an applicant on an IDS submitted under 37 C.F.R. § 1.97. This treatment is consistent with current practice and places no additional burden on the examiner.

For example, the USPTO would document in the image file wrapper the following information for each monitored application in Global Dossier: identification of information imported, source of imported information, date information was imported, and acknowledgement that imported information was considered by the examiner. IPO encourages the use of a technology solution to document this information in the file, such as importing citations from Global Dossier into the image file wrapper.

Information should be imported in a timely manner to ensure applicants are not prejudiced by information in monitored applications being imported after time periods such as those for IDS submissions (under 37 C.F.R. § 1.97) and Patent Term Adjustment (under 37 C.F.R. § 1.704). Additionally, amendment of relevant rules to exclude information imported from monitored applications from such time periods might be appropriate to avoid uncertainty.

<u>Question 5</u>: 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?

IPO generally supports streamlining the information published on the front page of a granted patent while maintaining that information believed to be most critical to the general public. Such information includes: the patent number, date of grant, title, inventors, assignee, priority and related application information, U.S. and international classifications, abstract, and representative figure, all of which is currently included on the front page of a granted patent.

IPO supports omitting information that is less important to the general public, provided that omitted information remains accessible via other means such as PAIR. Information that might be omitted includes: field of classification search, references considered or cited by the examiner, examiner information, and attorney/agent information. If the USPTO decides to omit a list of references considered or cited by the examiner from the patent document, the USPTO should include a list in the file wrapper because it could be unduly burdensome for the public to comb through the entire image file wrapper to identify all information submitted, considered, and cited during examination.

Thank you for considering these comments. We welcome other opportunities to assist your efforts to expedite and improve the patent prosecution.

Sincerely,

Mark Lauroesch
Executive Director