



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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FICPI U.S. Section Comments on (1) Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and (2) Streamline Patent Issuance

FICPI, the Fédération Internationale Des Conseils En Propriété Intellectuelle (International Federation of Intellectual Property Attorneys), through its U.S. Section (FICPI-US), would like to provide its comments on the USPTO Request for Comments of Federal Register, Vol. 81, No. 167, August 29, 2016.

Founded over 100 years ago, FICPI represents IP attorneys in private practice internationally with almost 5,500 members in 86 countries, including all major countries. FICPI has strong US and European memberships and has recent and growing sections in India and China. FICPI aims to enhance international cooperation amongst IP attorneys and to promote the training and continuing education of its members and others interested in IP.

FICPI-US strongly supports the efforts of the USPTO to employ work sharing initiatives such as Global Dossier to leverage electronic resources so as to improve examination efficiency and quality among not only the family of counterpart patent applications, but all patent applications disclosing significantly related technology. FICPI has historically supported such efforts as evidenced by the attached past FICPI World Congress Resolutions (both attached). The FICPI 2012 Resolution encouraged a coordination of prior art search strategies among patent offices. The FICPI 2015 Resolution encouraged patent offices to recognize and make use of existing facilities of obtaining relevant patentability information without putting on the Applicant the burden to gather and provide the same information.

FICPI-US comes to this USPTO Request for Comments with a goal of further encouraging coordination of among all patent offices to address all patentability issues. Given that the U.S. case law decisions and USPTO policies include a "duty of disclosure" burden placed in the applicant, FICPI-US supports policies and strategies that increase the efficiency of examination and help reduce, to a reasonable degree, the applicant's burden under this standard.

Responses to Questions for Written Comments

FICPI-US responds to the following USPTO questions as indicated below.

Question 1: Which Other Applications Should Be Monitored?

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.)?

FICPI-US first submits that domestic family applications (i.e. parent, divisional, continuation and continuation-in-part applications), as well as counterpart foreign applications, should be reviewed for relevant information by the Examiner without a need by Applicant to submit Information Disclosure Statements (IDSs) identifying relevant information present in such domestic family and counterpart foreign applications.

With respect to other applications that disclose related technology and potentially raise related patentability issues, FICPI-US supports a coordinated effort by both the Patent Examiner and Applicant to identify such applications. The Examiner can search for related applications that include common inventors, common assignees, and common technological terms. After identifying relevant applications, the Examiner can then periodically review such applications to obtain any new information. The Applicant can inform the Examiner about related applications known to those including the inventors, others working with the inventors, and patent agents/attorneys also working with this group. FICPI-US submits that once a relevant application is identified, the Examiner has the necessary tools, including Global Dossier, to monitor that application going forward, such that Applicant should be relieved of the burden of having to periodically submit IDSs that provide updated information arising in the related application. Also note that past court decisions which appeared to suggest Applicant had some duty to continually update the Examiner about new information arising in a related application (e.g. *McKesson Information Solutions, Inc. v. Bridge Medical Inc.*, 487 F.3d 897 (Fed. Cir. 2007)) were based on patents prosecuted at a time when Examiners had few, if any, of the informational tools they have now.

Question 2: Most Convenient Way to Bring Related Application to USPTO Attention

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, application notifies the USPTO, etc.)?

As noted above with respect to Question 1, FICPI-US supports a coordinated effort by both the Patent Examiner and Applicant to identify relevant applications.

Question 3: How Should the USPTO Determine Which Information is Relevant?

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?

FICPI-US appreciates the issue of “information overload” as it applies to the management of data facing both the Examiner and Applicant. The Examiner can look to terms in significant patent claims together with the context of the patent application as a whole. The Applicant can inform the Examiner about significantly related applications which can help the Examiner focus on the most relevant information.

Question 4: How Should the USPTO Import Information from Other Applications

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 patent or counterpart foreign application the information was imported from, and whether the examiner considered the imported information?

FICPI-US strongly supports the creation by the USPTO of a system which clearly describes both: (1) whether the Examiner has considered information from other applications; and (2) the identity of all other applications as the source of such information. This is consistent with the FICPI-US position that the Examiner and Applicant work together to identify information which is most relevant to the patentability of the application.

Question 5: What Information Should be Part of a Patent?

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?

Given the fact that information, such as cited prior art and classification information, can easily be obtained online at the USPTO PAIR website, FICPI-US tends to support a position which does not require such information on the front page of a U.S. patent. On the other hand, as noted at the Roundtable, there are advantages to listing information such as the cited prior art, since one can simply review the granted patent without having to additionally search online for this information. Perhaps a middle ground can be achieved by eliminating the listing of prior art on the granted patent, while including a listing of all prior art online together with some indication of the relevancy of the prior art, e.g. whether the prior art was specifically relied upon by the Examiner for any rejections during prosecution. The classification information is less important than the prior art and probably does not need to be listed on the front page of a patent.

FICPI-US endeavors to work closely with the USPTO to help improve efficiencies in patent prosecution and improve communication between the Applicant and Examiner.