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The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office
600 Dulany Street
P.O. Box 1450
Alexandria, VA 22313

Via e-mail to PriorArtAccess@uspto.gov (4 pages)

Re: Oblon Response to the USPTO “Request for Comments and Notice of Roundtable Event On Leveraging Electronic Resources to Retrieve Information From Applicant’s Other Applications And Streamline Patent Issuance” 81 Fed. Reg. 59197 (Aug. 29, 2016)

Dear Director Lee:

Oblon, McClelland, Maier & Neustadt L.L.P. (“Oblon”) appreciates the opportunity to present comments in response to the USPTO’s “Request for Comments ... On Leveraging Electronic Resources to Retrieve Information From Applicant’s Other Applications And Streamline Patent Issuance” published in the Federal Register on August 29, 2016. 81 Fed. Reg. 59197 (Aug. 29, 2016). The following comments are based on the questions posed in the Federal Register.

- 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.)?**

Oblon supports the monitoring of applications beyond domestic parent and counterpart foreign applications.

The USPTO should begin implementation by first leveraging the information from all applications having exactly the same U.S. or foreign priority or combination of U.S. and foreign priorities. A subsequent phase could expand the scope to include applications directly or indirectly linked to one specific priority document (i.e., extended INPADOC patent family). Applications sharing a common inventor or common ownership within the same classification could also be included depending on the volume of information and burden on the examiners.

- 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.)?

Oblon supports an automated system in which the USPTO sweeps for Office actions and references cited in relevant applications and directly pushes that information to the examiners as this would be the most efficient, cost effective, and accurate process. Moreover, an automated USPTO based system would ensure that the information is in a uniform format for examiners to use and would reduce the likelihood of transcription errors.

Applicants should still be responsible for citation of references that cannot be automatically retrieved, e.g., references from patent offices that are not covered by the Global Dossier, and information that is not as readily available to examiners such as material information from related patent litigation, public uses, or sales that are material to patentability and not readily available to patent examiners.

The least favorable outcome is where the burden to notify the Office of information to monitor is placed on the applicants without further limiting the scope of the duty of disclosure by revising 37 C.F.R. §§ 1.56 and 1.98. To reduce accusations of inequitable conduct, the default for applicants should be an over inclusive approach of Global Dossier access by patent examiners. It would not benefit the applicants to force them to scrape the Global Dossier for material information that patent examiners should be readily able to access within the scope of § 1.56.

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?

At a minimum, examiners should consider the office actions and references cited in domestic parent/sibling and foreign counterpart applications, amendments of substantially similar claims, and applicant provided affidavits or declarations since these are the most likely to result in the treatment of material information that examiners can leverage to improve patent quality and examination efficiency. However, it is vitally important that the all of the information reviewed from these counterpart applications be acknowledged as being considered by the examiner because otherwise the applicant's duty of disclosure burden is not reduced.

Under 37 C.F.R. § 1.56(a), “each individual associated with the filing and prosecution of a patent application has a duty to disclose to the Office all information known to that individual to be material to patentability.” The standard for materiality now being reconsidered by the Office is set forth in § 1.56(b), as follows:

Information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or (2) It refutes, or is inconsistent with, a position the applicant takes in: (i) Opposing an

argument of unpatentability relied on by the Office, or (ii) Asserting an argument of patentability.

37 C.F.R. § 1.56(b). Presently, “[t]he duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent *was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)–(d) and 1.98.*” 37 C.F.R. § 1.56(a) (emphasis added).

In order to fully leverage the information from the domestic parent/sibling and foreign counterpart applications and to reduce applicant's burden to independently provide this information to the USPTO, it is critical that examiners cite and acknowledge consideration of each office action, search report, and prior art reference listed in these applications in accordance with § 1.56(a). Without acknowledging consideration of all of the information monitored in these applications (i.e., cited references and Office actions), applicants are not relieved of their burden under § 1.56 unless all of the information that is material to patentability is independently cited by the applicants. Such a system could increase the applicant's burden since applicants will not be able to rely on the Office's importation and consideration of information from these related applications to comply with § 1.56, and will need to independently monitor the information from the related application as well as any portion considered by the examiner.

Consequently, to avoid the need for applicants to resubmit information from the domestic parent/sibling and foreign counterpart applications that an examiner considered but did not acknowledge on the record or that an examiner only partly considered and acknowledged, all of the office actions, search reports, amendments, affidavits, declarations, and prior art references cited in domestic parent/sibling and foreign counterpart applications should be considered and acknowledged as being considered by the examiner.

As the scope of applications being monitored extends beyond the minimum threshold of the domestic parent/sibling and foreign counterpart applications, there is less of a presumption that the information would be material to patentability. However, once an application is identified by the Office or the applicant as being substantially related, our concern is that applicants will then need to submit all material information from these “other applications” to avoid being accused of inequitable conduct. Harmonizing the materiality standard for the duty of disclosure before the Office with the “but-for” standard of materiality set forth in *Therasense* for establishing inequitable conduct before the courts, alleviates this concern and is consistent with the USPTO's goal of improving patent examination efficiency and quality by ensuring that the examiners are provided with the most relevant information rather than being overburdened with immaterial and marginally relevant information. Oblon commends the Office for revisiting and seeking further public comments on the revision of the duty of disclosure rule to be consistent with *Therasense* as set forth in 81 Fed. Reg. 74987 (Oct. 28, 2016).

- 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?

We support all these actions and any additional actions that are necessary to ensure a complete and accurate file history.

- 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?**

The USPTO should continue to list the same information that is currently listed on the first page of the patent until a character-coded full text searchable file history system is deployed and made readily available to the public.

With best regards,

Very truly yours,

OBLON, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Bradley D. Lytle

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