

October 28, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Attn: Michael Neas

Via email: PriorArtAccess@uspto.gov

Re: Comments of InterDigital on Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance, 81 Fed. Reg. 59197 (August 29, 2016) Docket No. PTO-P-2016-0026

Dear Under Secretary Lee:

InterDigital, Inc. (“InterDigital”) appreciates the opportunity to offer comments regarding the U.S. Patent and Trademark Office’s (“USPTO’s”) proposed plans for Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance, which were published at 81 Fed. Reg. 59197 (August 29, 2016) Docket No. PTO-P-2016-0026 (hereinafter “the Notice”).

InterDigital

InterDigital is a U.S.-based company that develops mobile technologies that are at the core of devices, networks, and services worldwide. We solve many of the industry's most critical and complex technical challenges, inventing solutions for more efficient broadband networks and a richer multimedia experience years ahead of market deployment. InterDigital has licenses and strategic relationships with many of the world's leading wireless companies. InterDigital is one of the most active R&D companies in the wireless industry and has approximately 20,000 patents and patent applications worldwide.

InterDigital Comments

InterDigital lauds this effort to monitor and import information from related patent applications in the U.S. and other countries as a very significant step in (a) improving the quality of patent examination and issued U.S. patents, (b) increasing Examiner efficiency in identifying material prior art and other information, and (c) reducing the substantial burden on applicants, USPTO administrative staff, and Examiners relating to the provision of material prior art via the Information Disclosure Statement (IDS) process pursuant to 37 CFR §§ 1.97 and 1.98.

In response to the questions set forth in the Notice, InterDigital provides the following comments.

QUESTION 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.)?

In addition to U.S. parent and foreign counterpart applications, the USPTO should automatically monitor all U.S. applications that share priority with the subject application (e.g., siblings, children, grandchildren, grandparents, etc.). As is the case with a domestic parent, such applications often contain information material to the instant U.S. application. Additionally, the monitoring of “foreign counterpart applications” would presumably include foreign applications that are siblings, children, grandchildren, etc. of the original foreign application. There appears to be no reason to exclude corresponding types of domestic applications.

We do not recommend that the USPTO automatically monitor an applicant’s other applications involving the same or related technology that do not share any priority with the subject application. Doing so would implicate large volumes of irrelevant information in most cases and therefore be unduly burdensome for Examiners. Also, the public is not served by unnecessarily enlarging the prior art of record with immaterial information. The likelihood of producing large amounts of irrelevant information is particularly high for companies with large patent portfolios. Often, such companies have many hundreds (if not thousands) of co-pending applications in the same or related technical areas, but the specific aspects of many of these applications have little or no relevance to those other pending applications in the same or related technical area. Consequently, monitoring these types of technically related applications would likely yield significant amounts of irrelevant information. Furthermore, it would be very difficult to define “related technologies” in an effective manner, i.e., one that would chiefly capture applications with a high percentage of relevant information and a low percentage of irrelevant information.

Another potential problem with automatically monitoring applications outside of the priority family is that the applications from which information would be automatically imported would not be predictable *a priori* by applicants. This would make it more difficult for applicants to comply with the duty of disclosure in a timely manner and also would likely lead to the filing of many unnecessary IDSs that the USPTO would have to process. However, if such applications were included in the program, the USPTO would need to modify the timeline rules for IDSs to prevent applicants from incurring late IDS fees through no fault of their own and to minimize the likelihood of applicants inadvertently failing to comply with the duty of disclosure. For instance, the rules might be modified to provide applicants an unconditional 3 month grace period to file an IDS after the USPTO informs the applicant which related applications will be monitored.

Regardless of the types of applications that are monitored and the types of information that are imported into the records of subject applications, the USPTO should modify the duty of disclosure rules to establish that an applicant's duty of disclosure pursuant to 37 CFR §1.56 is satisfied with respect to all such information from those applications regardless of whether the information was, in fact, correctly imported. Failure in the process to import information should not operate to the disadvantage of the applicant.

Any other approach would create a process that is more burdensome than the current regime, thereby largely defeating the intended efficiencies of the program for both the USPTO and applicants. Specifically, applicants would still feel compelled to perform all of the usual steps related to complying with the duty of disclosure in connection with prior art cited in monitored applications, but with the additional step of checking that data against the USPTO's monitoring records. As a result, many applicants would find it preferable to simply continue to cite all such prior art via IDS without bothering to determine if it has already been automatically imported. It might also lead to an enhanced risk of meritless inequitable conduct charges being levied during litigation against those applicants that do not follow such a practice.

Finally, the USPTO should automatically monitor applications from any country that it has the capability to automatically and reliably monitor. Presumably, this includes at least the IP5 countries in the Global Dossier. As the necessary capabilities become available with respect to any additional countries, the program should be expanded to include those additional countries at the earliest possible time.

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.)?

As this program will result in significant changes to current practice, it should initially be limited to an automated system in which information from only U.S. priority-related applications (e.g., parents, grandparents, siblings, children, grandchildren) and foreign counterparts is monitored and imported.

After the success of a pilot program is evaluated, the program could potentially be expanded to allow applicants to designate additional applications for monitoring. However, caution must be exercised to minimize the risk of applicants over-designating other applications, thereby creating an unnecessary burden on Examiners. Therefore, the USPTO might consider limiting the number of applications that an applicant may designate, or granting discretion to the Examiner to accept or refuse an applicant's designation.

In addition, since the applications meeting the requirements for monitoring as well as the information in those applications will likely continuously evolve, the process for monitoring must provide for (a) frequently updating imported information and (b) clearly indicating to the Examiner, the applicant, and the public when information was imported.

Furthermore, since new relevant prior art is often identified in foreign counterpart and priority-related U.S. applications after a final office action or notice of allowance, the

program should provide a way to allow such prior art to become part of the record without undue effort by the USPTO or applicants in order to reduce both delay in issuing patents and the burden on applicants and Examiners. Such information should be made part of the record as would any such information imported prior to allowance or final office action.

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?

The USPTO should make all information from monitored applications available to Examiners. Though this process has the potential to present immaterial and marginally relevant information, Examiners are probably best positioned to identify the material information. In addition to the prior art references provided to Examiners from monitored applications, other information would be available that could aid in efficiently reviewing those references and focusing on a more limited number during examination. For example, search reports, office actions, and applicant responses could all be considered by Examiners in their determination of material information. Of course, Examiners must exercise caution in their reliance on such information, particularly from foreign applications, as it is their responsibility to independently examine each application and determine whether the requirements for patentability under U.S. patent law have been satisfied.

Importantly, and as noted above in connection with Question 1, under this new process an applicant's duty of disclosure under 37 CFR §1.56 should be deemed satisfied as to all information from monitored applications and not just information that an Examiner deems to be material. As previously discussed, doing otherwise would create great inefficiency for the USPTO and applicants, as well as undue risk for applicants since they could not be certain that an Examiner would always identify all material information.

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?

There is little reason to withhold from the public any readily available information. However, the USPTO should record at least the following data about each imported document in the image file wrapper:

1. all bibliographic information of the document;
2. a copy of the document to the extent permitted by copyright laws;
3. the source of the document (i.e., the other application from which it was imported); and
4. the date the document was imported.

In addition, at least the following data about the other applications that are being monitored should be recorded: (a) the country/jurisdiction and application number and (b) the most recent date that the application was checked for importable information.

Consideration should be given to notifying the Examiner and/or the applicant (*e.g.*, via email) each time information is imported into an application file history.

QUESTION 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?

All information currently listed on the cover page of the patent should continue to be listed. Although PAIR provides a significant amount of information to the public in electronic form, the information that is currently physically printed on the front page of a patent provides the public with a convenient snapshot of important information. Separating this information would unnecessarily require the public to reassemble the patent by joining the information from PAIR with the other substantive portions of the patent.

Conclusion

We appreciate the opportunity to provide these comments and are available to assist the USPTO in further developing patent practice and procedures.

Sincerely,

INTERDIGITAL, INC.

By:



Jannie K. Lau
Executive Vice President,
General Counsel and Secretary