

From: [Botos, Richard J.](#)
To: [Prior Art Access](#)
Subject: Comments Regarding Leveraging Electronic Resources To Retrieve Information From Applicant's Other Applications and Streamline Patent Issuance
Date: Wednesday, October 26, 2016 5:22:06 PM

Dear Sirs/Madams:

I have concerns regarding the interplay between automated retrieval of art and prosecution information from related international applications and the duty of disclosure. While it certainly would expedite prosecution if the art, search reports, etc. from foreign counterparts were to flow automatically to the Examiners; will the applicants remain ultimately responsible for ensuring that the Examiner is made aware of such art? For example, if the system is designed for the EP search report to "flow" to the US case, I assume that it will remain applicants duty to ensure that such art is ultimately cited. Will an applicant have to monitor PAIR for art from foreign counterparts and send any art in when it is evident that the art did not "arrive?" How will an applicant determine when it is appropriate/necessary to cite art that should have been downloaded to the application automatically but was not? Will office actions from foreign counterpart applications automatically be cited as well? Will providing such office actions, when the standards for patentability are different in different in countries, color the US Examiner's office actions?

Regarding selection of countries, again the concern is the interplay between any such selection and the duty of disclosure. It will be incumbent on applicant to cite art from prosecutions in related foreign cases in "non-selected" countries. This could become confusing if applicant were allowed to select the countries from which cited art in related applications will flow into the US application.

Regarding information on the face of the patent document, I strongly believe the names of inventors, the priority information and the art should still be on the patent face. When discussing patents we often provide live links to the patent itself to clients and other individuals who are not patent savvy. Explaining how to "extract" the information from PAIR that one might want to discuss with a client or layperson will not be as convenient as having that information presented on the face of the patent document.