

From: [Charles Cohen](#)
To: [Prior Art Access](#)
Subject: Fwd: Comments Regarding Retrieving Information From Applicant's Other Applications and Streamlining Patent Issuance
Date: Thursday, October 06, 2016 11:33:24 AM

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-----Original Message-----

From: Charles Cohen <laccarcec3@aol.com>
To: www.PriorArtAccess <www.PriorArtAccess@uspto.gov>
Cc: laccarcec3 <laccarcec3@aol.com>
Sent: Thu, Oct 6, 2016 11:30 am
Subject: Comments Regarding Retrieving Information From Applicant's Other Applications and Streamlining Patent Issuance

Please see my comments below in red.

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? **This would be ideal, but probably difficult and time consuming to do if extended to applications of other inventors. Also, if the claims in these other applications are not highly similar or the same, this might result in a huge number of references that might not be useful in examination of the instant application, and place a large time burden on the examiner.** If so, which other applications should be monitored (e.g., siblings, applications involving the same or related technology, etc.)? **I think this should be limited to related and counterpart applications of the instant inventor. The examiner's prior art search should identify any other relevant references that may have been cited in applications of others anyway.**
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.)? **Applicants and their attorneys are in the best position to know of applicants' separate, but related, and counterpart, applications. Therefore, applicants should be required to bring these to the attention of the examiner. This burden should be on applicants and their current attorneys because as applications are sometimes transferred to other law firms, the significance of other applications in an applicant's portfolio can get lost in the transition. Once again, the burden should be on the applicant, who should be aware of his/her other separate but related and counterpart applications.**
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? **See comments above in response to point # 1.**
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? **This could be achieved by adding an 892 form to the prosecution file, just like for any other examiner-cited references.**

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? **Yes. Personally, I find the current information printed on the first page of U.S. patents extremely useful for numerous reasons relating to both patent preparation and prosecution within the Office, and activities outside the Office such as conducting freedom-to-operate investigations, due diligence, etc. The currently provided information provides a convenient, "one stop" source of relevant prior art, relevant classes/subclasses, search information, the inventor's prior applications and patents, assignee information, priority and related U.S. application data, patent term information, etc. It would be inconvenient and time consuming if one had to search through the file wrappers of patent applications on the PTO website to find and assemble all this information. In short, I suggest leaving things on the first page of published applications and patents just as they are.**

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