

From: [Andrew McAleavey](#)
To: [Prior Art Access](#)
Subject: Comments on Proposal for Leveraging Electronic Resources
Date: Thursday, October 27, 2016 2:59:58 PM

Dear Sir or Madam:

This is in response to the Notice at 81 FR 59197. As a registered patent agent, I run a small prosecution practice in which I am the only licensed practitioner, although I do have paralegal support.

I applaud the multi-national efforts by the USPTO, including Global Dossier, which have been very helpful. However, because U.S. practice allows any number of continuations and continuations in part, not to mention divisional applications, in my practice, the greater problem is that we often have portfolios with 5-10 related U.S. applications, sometimes more. When possible, we rely on the policy in MPEP § 609.02 that the Office will consider information that has been considered in a parent application in its children without resubmission -- but that policy is often insufficient, because some portfolios have a number of sibling regular applications, each of which claims priority to a common provisional application, but none of which is a continuation of any other.

I estimate that 40-50% of my paralegal's time is spent reviewing prior art, entering new prior art citations into our databases, deciding when an Information Disclosure Statement (IDS) is necessary, and filing IDSes. Mind you, that time estimate includes the use of automated software (AppColl) that tracks the references cited in each case and can cross-cite references and prepare IDS forms automatically. Before we began using this kind of software, such tasks could easily consume 80% of paralegal time.

Yet for all that, most of our time is spent cross-citing references that were cited by different patent examiners in related patent applications, rather than disclosing things that we or the applicant were aware of that the Examiner might not have been. Moreover, when we did submit an IDS, a brief study I did a few months ago showed that only in about 50% of cases were those references actually "picked up" and discussed by the Examiner or used in a rejection. (See <http://patentbest.com/are-patentability-searches-worth-it/>) Clearly, as the Notice implies, something is broken.

In my view, two things would be very helpful. First, the Notice is correct that information on the references cited in any one patent application are available via PAIR, either public or private. However, they are not accessible in a way that is truly and easily useable. If one wants to figure out what was cited in each case, even using the "references" tab, one must sort through images of PTO-892s and IDSes, often looking manually through many pages of documents submitted over many years. Instead of forcing users to do this, PAIR should include, in one place, a comprehensive listing of every patent and publication that is of record in the case, in numerical order, much as the cover of a patent includes such information. If PAIR includes an equivalent listing of ALL references of record in a single place that is updated as prosecution proceeds, I have absolutely no problem with that information being eliminated from the cover of the patent.

Second, the USPTO should do a better job of automatically making references from one case of record in the other cases with less or no input from applicants. Two ways of doing this

come to mind. First, applicants could submit lists of related applications to the USPTO, much as applicants are now required to identify related applications to the Patent Trial and Appeal Board in *ex parte* appeals. References from all of those identified cases would then be automatically placed of record in all of the cases, without further IDS submission from the applicant.

Alternatively, the USPTO has the PLUS system, a linguistic search system, and that system could be used to identify patents from the same inventor/applicant/assignee that use words similarly. Any patents that turn up in a PLUS-like search would have references automatically cross-cited.

37 C.F.R. §§ 1.97 and 1.98 were written when the USPTO was using paper files, and it was physically difficult to copy references from one file to another. With image file wrapper and the other systems now available, that is no longer the case. The burdens should be shifted from the applicant to the Office as much as possible, particularly because doing so would be of great assistance to examiners.

I hope these comments are of use to the Office.

Best regards,
Andrew McAleavey

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