From: McBean, Paul A.
To: Prior Art Access
Subject: Comments related to possible Importation of Prior Art Automatically & Streamlining Patent Issuance
Date: Wednesday, October 19, 2016 4:32:49 PM

Please find my comments below:

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.)?

- Absolutely, the USPTO should monitor other applications for relevant information for consideration in an instant US application. Ideally monitoring should include applications in related technologies. It would involve significant effort on the part of examiners, yes, but for the sake of ensuring complete disclosure of the relevant art it would be worth it. The applicant could then be requested to supplement, if necessary, the list of references cited by the examiner. If such a path is taken, one wonders if there would need to amend the Duty of Disclosure requirements under 37 CFR 1.56.

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.)?

- An automated system that makes use of the various programs and databases (Global Dossier, Espacenet, PATENTSCOPE etc.) that monitor and link patent applications seems to be the best method. Perhaps periodically a report of potentially related applications could be sent to the applicant for review and comment.

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?

- Relevant information should include bibliographic data about the application as well as one or two possible connections/relevant information to the instant application. The use of keyword searches might prove helpful in this instance.

4. If the USPTO were to implement a fully automated system to import information from applicant's other applications, how should the USPTO document the information automatically 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?

- The documented information should include indications about which US parent or foreign counterpart the information was imported from, the date and whether the US examiners considers such information relevant. Perhaps such information can also include (especially in the case of foreign counterparts) whether the information was provided by the applicant, foreign examiner or a third party (opposer).

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?

- In the digital age a list of prior art references on the front page of the patent seems an antiquated notion. Especially is this the case when many prior art references have been cited (over 100 to pick a number). Perhaps it would be better for the USPTO to have both a digital and hard copy of the US patent, both indicating a link where the cited prior art references and classification information can be found (maybe with a link on that page to each individual non-NPL reference).

Please accept my thanks for both the forum and opportunity to express my thoughts on this worthwhile endeavor.

Respectfully,

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