

From: [David Vance](#)
To: [Prior Art Access](#)
Subject: Importing Prior Art...Comments
Date: Wednesday, September 28, 2016 5:24:06 PM

Dear Jessica and Michael:

Thank you for today's excellent Roundtable. I thoroughly enjoyed the session.

My comments regarding the 5 questions are as follows.

General:

I think the main issue that was both directly discussed (e.g., by the VEDEKOS representatives) and indirectly discussed is the concern that automatically importing information will, at least initially, expand the burden on the USPTO. There will be more references, not fewer to consider.

At this initial stage, it would be helpful if the prior art imported for an application were able to be searched by the examiner. Perhaps this could be the patent application "database" (or prior art bucket). The examiner could then review those references that were found relevant by the search. The remaining should be marked as "considered" for applicant's purposes.

Final general comment, I would like to see us transition away from using PDF fillable IDS's. It would be much more efficient to be able to populate an online IDS with all references considered in a parent filing (or any filing for that matter) by identifying the earlier filed application. An applicant would not need to submit any of these references as they already would be available to the USPTO. New references could then be added to the online IDS and submitted if necessary.

Questions 1-2:

Yes, other applications should be monitored. Right now some practitioners submit related case statements to inform examiners of "related" patent families. Being able to electronically submit a "related case" statement would be more efficient for both parties. The examiner would hopefully have the ability to look at the related case statement and then either include the prior art of the related case or dismiss the case for not being relevant.

Sibling applications should be monitored by all examiners handling the related applications. It might be effective if the patent office were able to compare art cited in one family member to another to see if there were references in one that have not been considered in the other.

I do not think other applications (besides foreign counterparts and siblings) should be monitored unless the applicant specifically identifies them.

Question 3:

This is the most difficult question. Applicants will want all information "considered." Currently, if the information is not considered, it is likely to be submitted on an IDS.

How to consider it? Until we have computer software that can automatically search and rank (VEDEKOS?) all information, there needs to be a way that the USPTO can at least search the collected or identified information. In this way, the USPTO will know that it has specifically searched art that has been automatically imported.

Question 4:

As I mentioned in the Roundtable, there needs to be some type of acknowledgement that information has been "considered." This acknowledgement needs to satisfy an applicant's burden of submitting "relevant" references. This could easily be accomplished by adding a tab to PAIR that is titled "Art Considered". An applicant would only need to compare this list (helpful if downloaded in a usable format) to their internal list.

It also would be helpful to have a column in the "Art Considered" tab that identifies the source of the information (e.g., IDS, search, Global Dossier, etc.). I don't think this identification is critical, but it would be helpful.

Question 5:

If there were an easy way to find a list of references considered for an issued patent (Art Considered tab in PAIR?), then I think patent practitioners could handle not having prior art listed on the face of the patent.

Information that I would find useful on patent includes:

- Applicant
- Inventor
- Assignee (if recorded at time of patent issuance)
- Examiner
- Priority Data
- Publication Data
- Terminal Disclaimer Data
- PTA data.

Thank you again for starting this process.

Best regards,

David

David H Vance, Ph.D., J.D.
Vance Intellectual Property, PC
PO Box 1224
Crozet, VA 22932

434-531-5976 (voice/mobile)
208-979-0707 (fax)

<http://www.vanceip.biz/>
<http://www.linkedin.com/pub/david-vance/5/18b/116>

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