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Via Electronic Mail
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Attention: Michael Neas, Deputy Director,
International Patent Legal Administration

IBM Corporation Comments in response to "Request for Comments and Notice of Roundtable Event on Leveraging Electronic Resources To Retrieve Information From Applicant's Other Applications and Streamline Patent Issuance," 81 Fed. Reg. 167 (August 29, 2016)

IBM thanks the United States Patent and Trademark Office (the "Office") for the opportunity to comment on how the Office could efficiently utilize information from applicant's other applications to automatically provide U.S. examiners with relevant information at the earliest stage of examination. IBM is also grateful for the opportunity to comment on what information could be eliminated from the front page of the patent to streamline patent issuance in the future.

IBM believes that it is crucial to have the most relevant information in front of the examiner at the earliest stage of examination. IBM is confident that when examiners are aware of the most relevant prior art, they will apply it appropriately. However, IBM recognizes the time constraints that examiners work under to find and consider the most relevant art. Accordingly, sometimes the most relevant art is not uncovered, or may be uncovered only after more than one Office Action, thus extending prosecution and increasing costs to applicants.

IBM applauds the Office for considering innovative ways to ensure the examiner has any and all relevant information at the earliest stage of examination. IBM agrees that this will result in higher quality patents, and will reduce instances of protracted prosecution.

We fully support the Office's proposal to monitor other applications beyond domestic parent and counterpart foreign applications for relevant information. IBM proposes a definition of applications that should be "treated as related" to the instant application. Applications that are identified as "treated as related" applications to the instant application should be monitored by the Office for relevant information such as prior art references and office actions, and any such relevant information should be imported for consideration by the examiner in the instant application. In addition to prior art references and office actions, the examiner of the instant application could review the "treated as related" applications to reveal promising search strategies and/or search classes.

IBM suggests that applications should be "treated as related" by the Office when the instant application and another application claim priority to the same application (i.e. sibling applications), when the instant application has been subjected to a double patenting rejection over the other patent application, or is the basis of a double patenting rejection in the other application. Still further, the instant application and another application should be "treated as related" if they are within the same family. For example, the instant application and another application should be "treated as related" if they have lineage to the same parent application (e.g., uncles, cousins, etc.).

In addition to the above relationships, the applicant may be aware of circumstances in which other applications should be "treated as related" and monitored for relevant information. IBM suggests that the applicant should be able to identify applications to be "treated as related" by the Office in those circumstances. An example of such a circumstance is where the applicant believes that the instant application and the other application have similar subject matter.

IBM recommends that the Office automate the identification of the "treated as related" applications, while allowing the applicant to identify additional applications that should be "treated as related." IBM suggests that the Office has access to the necessary information to identify many of the above relationships. However, as discussed above, the applicant will have insight into additional relationships which may not be readily apparent to the Office.

Further, we recommend that the Office provide a graphical representation of the instant application's relationships to other applications (e.g., a tree structure). While the current PAIR system provides continuing information on one tab, it only shows immediate (i.e. parent and sibling) relationships. The examiner, applicant, and the public must click through to the related application and search for further continuing applications, and if that application has additional continuing applications, click through yet again. In large families of applications it is difficult to untangle these extended relationships and thus, it is challenging to unearth possible relevant prior art. Accordingly, IBM urges the Office to make the relationships of applications more transparent to the examiners, applicants, and to the public to aid in identification of "treated as related" applications and to ensure examiners are provided the relevant information contained within those "treated as related" applications.

IBM recognizes that burdening the examiner with irrelevant or only marginally relevant information is not beneficial to the patent process. Instead, in order for the process to be effective the most relevant information should be highlighted and brought to the examiner's attention. We submit the following approaches to ensure that the Office provides the examiners the most relevant information without overburdening the examiner.

IBM recommends that the Office develop a single repository for the examiner to find all prior art cited in the "treated as related" applications. It is our position that this single act will actually reduce the burden on the examiner over the status quo. Examiners are currently tasked with reviewing all the references cited in parent

applications. In applications that have large families, the examiner may, on their own accord, even look to sibling and uncle applications for relevant prior art. Considerable time and effort is undertaken by the examiner to uncover the application relationships and obtain all of the references cited.

In addition to developing the single repository for all references cited in the "treated as related" applications, IBM recommends that the Office make the repository searchable and filterable. At the very minimum, the Office should include the ability to limit all of the references cited within the "treated as related" applications by keyword. Going further, IBM recommends that the Office use a system that automatically highlights references to the examiner that have specific relevance. For example, references that have been used in rejections in any "treated as related" applications should be highlighted to the examiner for having a high potential for relevance in the instant application. In particular, IBM favors indicating the relevance of each reference, when available, within the repository of reference cited. For example, a notation similar to the category of citations used in international and European search reports (e.g., X, Y, A, etc.) could be used to indicate a reference within the repository is of particular relevance or was used in a rejection in a "treated as related" case. Furthermore, we recommend including a link to the office action or search report in which the reference was cited to assist the examiner in understanding the application of the reference to the claims and the relative relevance of the reference to the instant application.

In addition, IBM suggests that the Office consider utilizing a semantic search system which could present the results to the examiner based on a confidence factor. This could supplement the above suggestions as an additional way to bring to light the most potentially relevant references to the examiner for consideration.

We expect that this single repository that is searchable and filterable and which highlights the most relevant references in "treated as related" applications would have the potential to aid the examiner in finding the most relevant references for the instant application in a shorter amount of time than the current basic keyword and classification search. If indeed the Office's proposal is implemented, IBM suggests that the Office study the effectiveness of providing examiners information from applicant's other applications. For example, the Office could evaluate the frequency in which the examiner applied the art from the "treated as related" application or the frequency of abandonment of an application when the examiner applied art from a "treated as related" application. Moreover, the Office could evaluate the effect of importing information from the "treated as related" applications on pendency and/or the number of office actions per disposal.

IBM strongly encourages the Office to very clearly communicate on the record the applications that were "treated as related" and monitored for information, what information was imported from those "treated as related" applications and considered by the examiner, and what information was not imported from those "treated as related" applications nor considered by the examiner. IBM also requests that the Office clearly articulate how identification of "treated as related" applications relates to the applicant's duty to disclose under 37 CFR 1.56, such as whether an applicant's duty to disclose information in "treated as related"

applications is satisfied by virtue of the applicant or the Office identifying those "treated as related" applications and relying on the Office to monitor those "treated as related" applications for relevant information. This knowledge is critical to an applicant in determining what further steps they must take to fulfill their duty to disclose under 37 CFR 1.56. For example, if an applicant or the Office identifies a "treated as related" application and information from that "treated as related" application is not imported or considered in the instant application, then it is important to notify the applicant that this possibly relevant information has not been considered and provide them the opportunity to submit the information in an information disclosure statement (IDS), and moreover, it is important for the applicant to understand the extent to which they must take these actions to fulfill their duty to disclose under 37 CFR 1.56.

Further, IBM requests clarification on Question 4 of the Federal Register Notice (FRN). The question asks in part, "should the record reflect…whether the examiner considered the imported information?" This seems to imply that the information can be imported into the instant application, but not be considered by the examiner. This interpretation of the question is troubling because one would assume that information that is being imported into the instant application is relevant, and therefore should be considered by the examiner. If indeed this interpretation is correct, then the applicant, aware that this imported information has not been considered, would be obligated to file an IDS and possibly extend prosecution even though the information was previously known to the Office. We urge the Office to clarify this point and encourage the Office to confirm that all information imported into the record of the instant application will be considered by the examiner.

Finally, IBM does not oppose the removal of the listing of prior art references and classification information on the front page of the patent as long as that information is readily available via PAIR. However, in order to make the information more easily accessible to the public, we recommend that the Office provide a notice on the front page of the patent where this information can be found. Going further, IBM recommends that the Office include a pointer or link to a page in PAIR that includes a repository of all references considered by the examiner. Preferably, the list of references considered by the examiner would include hot links to each reference so that the public could very readily access the reference. As indicated above, we recommend indicating the relevance of each reference within this list of the references cited.

Conclusion

IBM appreciates the Office's continued focus on patent quality and its efforts to ensure examiners are provided relevant information as early as possible to increase examination quality and efficiency. We thank the Office for considering our comments on how best to ascertain and provide that information without overburdening the examiner.

Respectfully submitted,

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