

International Business Machines Corporation
Washington Intellectual Property Law Dept.
1735 Jefferson Davis Highway, #605
Arlington, VA 22202

April 24, 2003

Mr. Robert A. Clarke
Box Comments—Patents
Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Subject: IBM Corporation Comment in Response to Notice of Proposed Rule Making
“Changes to Implement Electronic Maintenance of Official Patent Application Records”

IBM appreciates the opportunity to comment on the USPTO’s electronic file wrapper initiatives described in the Federal Register Notice of March 25, 2003. The measured steps the USPTO is taking to transition to an electronic application file are commendable.

In particular, IBM commends the Office for the proposed addition of new paragraph (e) to Section 1.14, which will provide for sharing of electronic application files with other intellectual property offices. As suggested in the Notice, this would facilitate the exchange of electronic priority documents among participating IP Offices in place of the present process of providing certified copies of applications as filed. As noted, this will result in significant cost savings to applicants and the participating IP Offices. It will also help to streamline the global patenting process by relieving applicants of the burden of having to place and track orders for certified copies and then ship them around the world, all with a watchful eye on deadlines which, if missed, could prove fatal to their priority claim. Because of these very significant potential benefits to applicants, the USPTO and other IP Offices, IBM urges the USPTO:

- To take immediate steps to enter bilateral agreements with its Trilateral Partners, the World Intellectual Property Organization and other major IP offices for the electronic exchange of priority documents.
- To consider relieving applicants who consent to sharing the electronic file of their applications of the need to request that the USPTO transmit their application to other IP Offices in which they are claiming priority, by deeming a priority claim made in an IP Office with which the USPTO has a bilateral agreement as authorization for the USPTO to transmit the file to that IP

Office or provide that Office with access to the file.

- To make the process by which the applicant provides express written consent to the sharing of its electronic application with other IP Offices as simple as possible by allowing it to be incorporated into the Application Transmittal as well as being submitted as a separate paper either at the time the application is filed or subsequent thereto.

While this proposed rule making does not specifically address the sharing of search results and other information with other IP Offices, IBM notes with approval the USPTO's statement that by facilitating the sharing of such information, the transition to electronic application files could improve quality of examination.

IBM commends the USPTO for the proposed addition of paragraph (e) to Section 1.98 which eliminates the requirement for the applicant to submit reference copies for U.S. patents and published applications cited in an e-IDS. However, applicants may not use the e-IDS to cite non-U.S. patent publications or non-patent literature documents. Since the USPTO now has access to extensive image files of non-U.S. patent publications as well as to some sources of non-patent literature, IBM urges the USPTO to move quickly to extend the e-IDS capability to these areas. The USPTO could pilot this by informing applicants of a limited set of frequently cited non-U.S. patent publications (e.g., PCT and EPO publications) and non-patent literature sources (e.g., articles from IEEE and ACM journals and ip.com) that could be cited in an e-IDS without furnishing reference copies. By starting with a small number of sources, the USPTO could also focus on developing edits to help applicants make sure that they are formatting their citations properly for retrieving the correct documents from these sources. IBM believes that by extending e-IDS capability in this way, the USPTO will attain greater utilization of the e-IDS process by applicants and at the same time reduce the volume of documents it needs to scan into its electronic application files.

Sincerely,

Jeffrey L. Forman
Program Manager, Patent Office Liaison
International Business Machines Corp.