

RECIPROCAL ACCESS TO AND USAGE OF DOCUMENTS IN APPLICATION FILES OF TRILATERAL OFFICES

SUMMARY

The United States Patent and Trademark Office (USPTO) is currently considering whether and to what extent documents contained in the files of published foreign patent applications may be entered (imported) into and become a part of the Official record in U.S. patent application files.

BACKGROUND

Applicants often seek world-wide protection for their inventions, and it is common for applications for the same invention to be filed in many different countries. These multiple filings often result in the respective patent offices performing substantially similar prior art searches on corresponding applications. To help reduce the amount of duplication of searching and thereby reduce examining workloads, national patent offices may seek to build upon the search results from a published corresponding application in another office.

For a number of years, the USPTO, European Patent Office and Japan Patent Office (Trilateral Offices) have been considering ways to maximize the mutual exploitation of search results. Together, the Trilateral Offices represent nearly 90% of all patent applications filed in the world, illustrating the dramatic potential for workload reduction in the USPTO through effective work sharing. As part of this ongoing cooperation, the Trilateral Offices have established a Trilateral Document Access (TDA) standard by which any one office may access electronic files of published applications in the other two offices. One of the main benefits of TDA over currently available published application sources (e.g. Public PAIR) is a common interface standard, by which examiners in each office can view the file contents of a published application in one of the other two offices in the examiner's own native viewing format, increasing efficiency and effectiveness. Thus, while examiners in the Trilateral Offices have been searching and reviewing the published applications of the other two offices, the TDA will improve the efficiency and such searches.

PLANNED IMPLEMENTATION

Examiner usage of TDA is limited to viewing and printing application documents from the published files of the other Trilateral Offices. This practice is consistent with current usage by examiners of documents contained in publicly accessible published application and patent databases maintained by various patent offices around the world. It is proposed, however, to expand TDA usage to permit examiners to import certain published documents from the files of a "donor" office into the application file of the "recipient" office, becoming part of that file. For example, a USPTO examiner could

import a reference cited as prior art in the file of a published foreign application into the USPTO file. Unlike viewing and printing of foreign application documents, such imported documents would become part of the official prosecution history of the recipient office's file. Likewise, examiners from the other Trilateral Offices similarly will be able to import documents from the USPTO file of published applications.

It is proposed that TDA importation be limited to the following documents:

- Application As Filed (Request, Claims, Description, Drawings, etc)
- List of cited references
- Available reference copies in the file
- Search reports (without examiner comments or arguments)

Appropriate translations, when available, would also be importable.

If implemented, administrative instructions will be developed to direct Trilateral Office personnel to follow these guidelines and only import documents in accordance with them.

In order to appreciate issues concerned with document importation via TDA, public comment is requested. Comments regarding this matter may be directed to Mark Powell, Technology Center Director, at Mark.Powell@uspto.gov or Jay Lucas, Sr. Legal Advisor- Automation, at Jay.Lucas@uspto.gov.



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