



[3510-16-P]

**DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

[Docket No.: PTO-P-2016-0026]

**Request for Comments and Notice of Roundtable Event on Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice of public meeting; request for comments.

**SUMMARY:** The United States Patent and Trademark Office (USPTO) is continuing its efforts to expedite and improve the overall patent process. Accordingly, the USPTO is exploring how to best utilize available electronic resources to provide examiners with information (e.g., prior art, search reports, etc.) from applicant's other applications as early as possible to increase patent examination quality and efficiency. These other applications, for example, could have the same or substantially the same disclosure (e.g., domestic parent and counterpart foreign applications) as the U.S. application being examined. In addition to improving patent examination quality and

efficiency, providing the examiner with this information from applicant's other applications will reduce applicant's burden to provide this information to the USPTO.

Further, the USPTO is seeking to reduce the issuance time of a patent by eliminating potentially unnecessary information from the front page of the patent. In particular, the USPTO is seeking public comment on what information, beyond a copy of the specification and drawing that is required by statute, should be part of the patent considering that complete information concerning U.S. patents and U.S. patent application publications are accessible to the public via the Patent Application Information Retrieval (PAIR) system.

To assist the USPTO in determining the best way to address these two topics, the USPTO is hosting a roundtable event to obtain public input. The roundtable will be open for any member of the public and will provide a forum for a discussion of the questions identified in this notice. Written comments in response to these questions set forth in this Notice also are requested.

**DATES:** Event Date: The roundtable will be held on September 28, 2016, beginning at 1:00 PM Eastern Daylight Time (EDT), and ending at 4:00 PM EDT.

Roundtable Registration Deadline: Registration to attend the roundtable in person or via webcast is required by September 21, 2016. Additionally, requests to participate in the roundtable as a speaker must be submitted in writing no later than September 14, 2016. See the "Event Registration Information" section of this notice for additional details on how to register and how to request to present as a speaker.

Written Comments: Written comments must be received on or before [Insert date 60 days after publication in the FEDERAL REGISTER].

Written comments should be sent by electronic mail addressed to [PriorArtAccess@uspto.gov](mailto:PriorArtAccess@uspto.gov). Comments also may be submitted by postal mail addressed to: Mail Stop Comments – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Michael Neas, Deputy Director, International Patent Legal Administration. Although comments may be submitted by postal mail, the USPTO prefers to receive comments by electronic mail.

Comments will be available for public inspection via the USPTO's Internet Web site at <http://www.uspto.gov/patent/laws-and-regulations/comments-public-response-specific-requests-uspto>, and at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, VA 22314, upon request. Because comments will be available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

ADDRESSES: Event Address: The roundtable will be held in the USPTO Headquarters, Madison Auditorium, 600 Dulany Street, Alexandria, VA 22314.

Event Registration Information: To register to attend or request to present as a speaker, please send an e-mail message to [PriorArtAccess@uspto.gov](mailto:PriorArtAccess@uspto.gov) and provide the following information:

(1) your name, title, company or organization (if applicable), address, phone number, and e-mail address; (2) whether you wish to attend in person or via webcast; and (3) whether you wish to make an oral presentation at the roundtable and, if so, which question(s) identified in part III of the “Supplementary Information” section of this notice will be addressed and the approximate desired length of your presentation. Each attendee, even if from the same organization, must register separately.

In order to give all speakers a meaningful opportunity to speak, the USPTO may not be able to accommodate all persons who wish to make a presentation. However, the USPTO will attempt to accommodate as many persons as possible who wish to make a presentation. After reviewing the speaker requests and the information regarding the presentations provided in the requests, the USPTO will contact each speaker prior to the event with the amount of time available and the approximate time that the speaker’s presentation is scheduled to begin. The amount of time available for each presentation may be limited to ensure that all persons selected to speak will have a meaningful opportunity to do so. Speakers who opt to employ slides as part of their presentation must send final electronic copies of the slides in Microsoft PowerPoint to [PriorArtAccess@uspto.gov](mailto:PriorArtAccess@uspto.gov) by September 21, 2016, so that the slides can be displayed at the roundtable. Additionally, the USPTO will provide an opportunity for persons in the audience to speak at the roundtable without a formal presentation.

For more information on the roundtable, including webcast access instructions, agenda and a list of speakers, please visit <https://www.uspto.gov/patent/initiatives/patent-application-initiatives/roundtable-discuss-leveraging-electronic-resources>.

If special accommodations due to a disability are needed, please inform the contact person(s) identified below.

**FOR FURTHER INFORMATION CONTACT:** Requests for additional information should be directed to the attention of Jessica Patterson, Program Manager, International Patent Cooperation, by telephone at 571-272-8828, or by e-mail to [PriorArtAccess@uspto.gov](mailto:PriorArtAccess@uspto.gov).

**SUPPLEMENTARY INFORMATION:**

I. Purpose of Notice: This notice announces a roundtable event to solicit stakeholder input concerning the questions identified in part III of this section. In particular, at the roundtable we seek to explore how the USPTO can better leverage applicant's other applications having the same or substantially the same disclosure (e.g., domestic parent and counterpart foreign applications (see MPEP 609.04(b)(V))) as the U.S. application under examination, to provide examiners with relevant information as early as possible. The USPTO believes that providing this information at the earliest possible stage of prosecution of the U.S. application can improve the examination efficiency and quality. The participants at the roundtable also will provide feedback on what information, beyond that of a copy of the specification and drawing set forth in 35 U.S.C. 154(a)(4), should be part of a patent considering that complete information concerning U.S. patents and U.S. patent application publications are accessible to the public via the PAIR system. The USPTO is also seeking written comments on the questions identified in part III of this section. The public is invited to provide comments on these questions or any other issues relevant to the consideration or development of the two topics discussed in this notice.

Any member of the public, whether attending the roundtable or not, may submit written comments for consideration by the USPTO on any of the issues identified in this notice.

II. Background: The USPTO strives to expedite and improve the overall patent application process by (1) increasing patent examination quality and efficiency, and (2) streamlining patent issuance after an application is allowed.

(1) Increasing Patent Examination Quality and Efficiency

Examiners consider information from various sources when making patentability determinations. One such source may be an information disclosure statement filed by the applicant. Another would be information identified by the examiner during his prior art search. For continuing applications, the examiner will also consider the information the USPTO previously considered during the examination of a domestic parent application (other than an international application that designated the U.S.). See section 609.02 of the Manual of Patent Examining Procedure (9th ed. 2015) (Rev. 07.2015, November 2015) (MPEP). The USPTO's work sharing efforts have resulted in the development of additional sources of information from foreign counterpart applications that is likely highly relevant to the U.S. application under examination. For example, Global Dossier, a work sharing initiative developed by the IP5 offices (USPTO, the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), and the State Intellectual Property Office of the People's Republic of China (SIPO)), provides U.S. examiners and the public access to the official file contents (e.g., prior art, search reports, office actions, etc.) of counterpart foreign applications.

The USPTO is exploring how to better leverage the information contained in these counterpart foreign applications and other U.S. applications with the same or substantially the same disclosure to improve examination efficiency and quality. The USPTO seeks, for example, the development of a system that utilizes both Global Dossier and the USPTO's internal databases to provide examiners with the information from counterpart foreign and domestic parent applications automatically at the earliest stage in prosecution of a U.S. application to improve the quality and efficiency of examination.

Global Dossier and the USPTO's databases may contain information from applicant's other applications that are not a domestic parent application or a counterpart foreign application. In fact, the pool of applications available for monitoring for relevant information could be much larger (e.g., the database may contain information on applicant's other child applications or other applications that are indirectly related to the U.S. application through a priority claim).

Numerous concerns, however, arise when determining how to effectively implement a system with a larger scope of applications than domestic parent and counterpart foreign applications. Similarly, numerous concerns arise when considering what information would be provided to an examiner from another of applicant's applications. For example, too many applications, like too many items of information, might present large amounts of information that has no relevance to the application being examined. The examiner's consideration of such information may result in the examiner not having time to fully consider information that is relevant, and possibly material, to the U.S. application under examination. The right balance of the scope of applications and

information therein is critical to ensure examiners are provided with the most relevant information without overburdening them with immaterial and marginally relevant information.

As part of its efforts to seek the right balance, the USPTO is requesting input on the best way it can ascertain the presence of these other applications having the same or substantially the same disclosure as the instant U.S. application under examination and import potentially relevant information contained therein. For instance, some applicants may prefer a fully automated system in which the USPTO monitors a set of applications that have been predefined by the USPTO, such as domestic parent and counterpart foreign applications, for certain information (e.g., prior art) to be imported into the U.S. application under examination. Other applicants may not desire that the USPTO import information from such a USPTO predefined set of applications, but instead, may prefer a set of applications defined by the applicant from which information is imported for consideration by the examiner. Still, other applicants may want to define both the set of applications and the particular information to be imported from these applications. In view of the different possible approaches for importing information, such as those mentioned herein, the USPTO would like stakeholders' input on what approach they believe the USPTO should consider implementing so examiners have the most pertinent information at the earliest stage of prosecution of the U.S. application. Furthermore, if the USPTO were to import information using any approach, the USPTO would like stakeholders' input on what documentation should be included in the record of the U.S. application under examination to accurately reflect that the information was imported and considered by the examiner.

(2) Streamlining patent issuance after an application is allowed

The USPTO is also considering what information, beyond the specification and drawings provided for in 35 U.S.C. 154(a)(4), should be part of a patent. This would include studying the degree to which the USPTO can migrate from the current paper-based process to 21<sup>st</sup> century processes that make greater use of the reality that complete information concerning U.S. patents and U.S. patent application publications is accessible to the public via the PAIR system. For example, the USPTO discontinued printing inventor address information in 2011 as this information is readily accessible via PAIR. See Elimination of an Inventor's Mailing Address on Patents and Application Publications, 1360 Off. Gaz. Pat. Office 197 (Nov. 23, 2010). The USPTO also eliminated the listing of prior art documents accessible in Public PAIR on reexamination certificates to expedite the issuance of reexamination certificates. See Elimination of the Listing of Prior Art Documents on Reexamination Certificates, 1371 Off. Gaz. Pat Office 95 (October 11, 2011). The USPTO is seeking public comment on what information (e.g., prior art references, classification information, etc.) should be retained on the face of the patent now that processing and examination is conducted in an electronic environment.

III. Questions for Written Comments and Discussion at the Roundtable Event:

The USPTO seeks written comments and participant feedback at the roundtable on the following questions related to how the USPTO should efficiently utilize information from applicant's other applications having the same or substantially the same disclosure to automatically provide U.S. examiners with relevant information at the earliest stage of examination and on what information should be part of a patent:

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.)?

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.)?
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?
4. If the USPTO were to import information from applicant's other applications, how should the USPTO document the information 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?
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?

Dated: August 18, 2016.

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Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

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