AIPLA

American Intellectual Property Law Association

November 8, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Attn: Michael Neas

Via email: PriorArtAccess@uspto.gov

Re: Comments of the AIPLA on Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance, 81 Fed. Reg.59197 (August 29, 2016) Docket No. PTO–P–2016–0026

Dear Under Secretary Lee:

INTRODUCTION

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views on the proposed plans for Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance.

The American Intellectual Property Law Association is a national bar association of approximately 14,000 members who are primarily intellectual property practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

COMMENTS

Specific Questions Asked by the USPTO

Below appear the specific questions asked by the Notice, each followed by AIPLA comments.

Question 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.)?

AIPLA response:
Yes, we believe that the USPTO should monitor other applications, for prior art in addition to domestic parent and counterpart foreign applications, during patent examination.

There are three classes of target applications and several potential methods of identifying such applications. A first class is a broader "extended family" that includes not only U.S. priority and parent applications (including PCT applications) but U.S. child applications and sibling application families as well as foreign counterpart applications. A second class of applications is decoupled from a particular patent family. Applications in this class may include unrelated applications by the same applicant that concern similar subject matter or third party applications concerning similar subject matter. For example, often a search by an applicant turns up a close third party application that has not yet commenced US prosecution or is in mid-prosecution. Information from the third-party application may be relevant to the prosecution of the subject application. Finally, in the third class are other proceedings such as ex parte reexaminations and inter partes proceedings of the applications in the extended patent family that may be sources of information for the examiner.

The Office should be able to automatically identify and obtain references from many of the applications in the first class. The Office should employ sources such as INPADOC to identify related U.S. and foreign applications and Global Dossier and/or Common Citation Document to automatically retrieve the references for at least some of these applications. Applicants should clearly understand which references will be automatically imported and which will not be imported. Applicants should remain responsible for citing any references that are not automatically imported. For example, if foreign office actions and responses are not automatically imported, applicants should still cite at least the responses where they have taken a position contrary to a position taken in U.S. prosecution.

The Office should develop a mechanism to allow applicants and patent examiners to specify applications in the second and third classes. Ideally, the prior art cited in the first class of related applications would be automatically cross-cited within that extended family. Because the second class includes third-party applications, the examiner should decide whether the unrelated applications and/or references contained therein are cross-cited. Note that the record must be clear as to whether a cross-cited patent application is cited per se in contrast to citation of just the references contained therein. Because relationships among applications in the first group may be determined automatically, applicants should be able to rely on the correctness and completeness of the automatic citations; there should be no penalty to applicant if a reference or a related application is missed. Applicants should still be responsible for citation of references that cannot be automatically retrieved, such as references from patent offices that are not covered by the Global Dossier or Common Citation Document. The automatic citation system should ensure that each reference is cited only once in a given application.

Question 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.)?

AIPLA response:
The default identification process should be an automated system that allows identification of relevant applications. One method may be to modify the existing SB08 forms to allow identification of a patent family (regardless of assignee or inventor). The rules for Third Party Submissions should be modified to allow for citation of patent families and their references. Note that since patent application file histories change over time, it is important that forms allow for identification of the service used to access the application and the date on which it was accessed.

The current time limits for submission of prior art should be sufficient to prevent harassment. Because the citation of multiple patent families may cause a large number of references to be added to a file wrapper, however, it may be desirable to take further steps to ensure that only relevant references are cited, such as requiring submitters to provide a declaration stating why the references in these patent families are relevant. Once identified the applications may be cross-linked so that all references and office actions in either application or its extended family members are automatically cited in the other application and its extended family.

Applicants should also be provided with a mechanism to delink patent families to exclude irrelevant references. Alternatively, or in addition, references from related applications may be automatically marked accordingly. The absence of such a marking would identify references cited from an unrelated application. This marking may be useful to examiners as the references from unrelated applications may be less relevant than references from related applications.

Other automated tools for identifying applications to monitor could include artificially intelligent word and field searching. For example, a search starting with common applicant, assignee, and/or inventor could have a relatively broad keyword or other similarity search for applications filed on the same day and a somewhat narrower similarity threshold for other applications.

Automated identification of relevant third party applications is more problematic and might be unjustified. It should be tested in a pilot program before implementation. The USPTO can then judge the merits of including this function in Patents End to End.
To the extent that applicants or third parties are permitted to identify applications, the interface should allow the citing party to flag whether the reference is one that should already have been identified by the Office in an automated search. For example, the information in some databases such as INPADOC may be incomplete. Therefore, it is important to identify the time and date at which related application information was garnered. Identification of a family member that has not been found by the automated search may trigger an updated search to ensure that references from these applications are added to the electronic file wrapper.

Question 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?

AIPLA response:
At a minimum, the examiner should consider references and office actions from applications in the extended family and cited references from foreign counterpart applications. We believe that foreign office actions should not be automatically cited as they may reflect a patentability standard that is not the same as in the U.S. More generally, any automatically cited reference from a member of the extended family of applications must be considered by the examiner.
Foreign-language references, automatically cited from a corresponding foreign application should not need a statement of the relevance, as the relevance of the reference should be apparent from the foreign file wrapper. The USPTO should consider automatically generating a machine translation for any such cited foreign-language reference.

We also have concerns about automatically cited references that do not have a date. The record should clearly and prominently indicate when the examiner has not considered an undated automatically cited reference and applicant should be given an opportunity to provide a date without paying a penalty.

References that are automatically cited after a first action should not require a certification. Generally, automatic citation of references should not penalize the applicant. For example, references that are automatically cited after a final action should not require payment of a fee. The QPIDS program should remain in effect for references that are cited from a corresponding U.S. or foreign application after payment of the Issue

Fee. Finally, the automatic citation of a reference should not affect patent term adjustment.

To reduce the burden to the examiner, it may be possible to implement search tools so that keyword searches may be performed concurrently on multiple documents. This may reduce the burden on the examiner by effectively combining several documents into a single document.

Question 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?

AIPLA response:
The record should indicate – for the information imported into the file wrapper from other applications – the application from which the information was imported, the date on which it was imported and which information from the related application was considered by the examiner. This would allow a person to determine exactly which references and/or office actions were considered. Ideally, in PAIR there would be a hot link to the contents of the other applications. This would be the starting point for such a program. Other improvements could be developed with increased technological capabilities at the Office.

One such improvement could be that prior art references for each application under examination are stored as records in a prior-art database that is unique to the application. Each record in the database would include the bibliographic information about the reference; the text of the reference or, if the reference is not in English, a machine translation of the reference, an indication as to the date on which the reference was cited; a link to the office action or IDS in which it was cited; and, where available, an indication of why the reference was cited (e.g. X, Y or A codes).

The copyright protections for non-patent literature references makes it difficult for the public to determine the relevance of such a reference. One suggestion may be to use software similar to that used by the Google Books Library Project to allow the public to view small excerpts of the references while still preventing them from viewing or downloading the entire reference.

At some time in the future, it may also be possible to algorithmically rank large sets of references by their relevance. This algorithm may be applied to references automatically imported from related applications. This algorithm is a variation on the automated pre-examination search algorithm proposed by the Office in the Federal Register Notice entitled Request for Comments on Enhancing Patent Quality (80 FR 6475). For the automated pre-examination search, the Office proposed scanning the application under examination for keywords and using those keywords to perform an automated search. We suggest a variation on this algorithm as a way to automatically rank the cited references.

According to this variation, the keywords automatically extracted from the application being examined would be used to search the cited references in the application's prior art database. For foreign-language references, the algorithm would search the machine translation. The references in the database may then be ranked, at least in part, by the number of keywords found in each document and their frequency of occurrence. We recognize that this algorithmic ranking may require advances in artificial intelligence to be practical. Nonetheless, we suggest that the Office be open to investigating such artificial intelligence tools to assist examiners.

Question 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?

AIPLA response:
All information currently listed on the first page of the patent should continue to be listed unless equivalent information is readily available in the PAIR database. We have noticed that some publications and issued patents that should be available are not available in the PAIR database. When such an application is discovered, there must be a rapid way for a party to retrieve the relevant information about that published application or patent.

Furthermore, our members find the prior art tools in Private PAIR to be limited and cumbersome. Substantial improvement is needed. Thus, PAIR, in its current form, is not a reliable resource to substitute for listing on the front page of a patent. If a prior art database, described above, is implemented, the public should be able to access the database and make use of any tools available to the examiners. Additionally, we note that there is considerable redundancy among PAIR, the Global Dossier and the Common Citation Document. These systems should be brought together so that all information is easily accessible or, if they remain separate, these three systems should be able to be accessed and searched using common tools.

Information on the prior art cited in a particular application should be in a format that is easily accessible by third-parties who currently aggregate the data to provide commercial patent analysis tools.

CONCLUSION

AIPLA acknowledges the effort by the USPTO to improve prior art citation practices. These comments have been provided in the spirit of making proposed changes in a way that is compatible with the needs of our members. Thank you for allowing AIPLA the opportunity to provide comments on the proposal.

Sincerely,

Mark L. Whitaker
President
American Intellectual Property Law Association