



American Intellectual Property Law Association

March 8, 2019

The Honorable Andre Iancu
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, Deputy Director International Patent Legal Administration,

Via email: PriorArtAccess@uspto.gov

Re: Comments on Access to Relevant Prior Art Initiative

Dear Under Secretary Iancu:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views on the Access to Relevant Prior Art Initiative published in the Federal Register Notice dated October 25, 2018, 83 Fed. Reg. §53853 (hereinafter “the Notice”). The Notice requested comments on an ongoing basis.

The American Intellectual Property Law Association is a national bar association of approximately 13,500 members who are 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 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.

AIPLA applauds the Office for working to reduce the burden on applicants filing a continuation application by automatically importing citations from the immediate parent application into continuing application and for creating a mechanism to document references filed in a parent application which have received consideration by the Examiner in the continuing application. While we received many positive comments on this initiative, we have a few suggestions on how it might be improved.

As a preliminary matter, we noticed two statements in the Notice that, while not inconsistent, may be confusing. The first statement is in Section II of the Notice and states that “an applicant’s duty to disclose information under 37 CFR §1.56 in the continuing application will continue to be satisfied for information considered in the parent application and will be satisfied for any additional information made of record by the Office in the continuing

application.” The second statement, in Section III(5) states, “Note that in the first phase of the RPA Initiative, the Office will perform only a single importation of citations from the parent application. Any citations from IDS listings or PTO–892 forms appearing in the parent application after this single importation occurs will not be imported.” While we realize that satisfying the duty to disclose is different from citing the references so that they will be printed on the front page of the patent, we recommend that the Office consider placing a notice on the Notice of Imported Citations indicating that no other references from the parent application will be imported.

Section III(6) states that “Examiners will consider all documents corresponding to the imported citations that are compliant with 37 CFR 1.98” and “Examiners will strike through any citation that was not compliant with 37 CFR 1.98 in the parent application.” To facilitate implementation of this initiative, AIPLA requests that the Office standardize reference citation formats specified on the PTO-892 form, the PTO/SB/08a form, the Examiner’s checklist for reviewing IDSs in MPEP § 609.01, the new Notice of Imported Citation and the new Notice of Consideration in a manner consistent with 37 CFR 1.98. Examples of non-standardized citation forms are listed below:

For U.S. patents and patent applications, the PTO-892 form permits Examiners to enter only the month and year in MM-YYYY format. Citations imported from the PTO-892 form which lack the entire date in DD-MM-YYYY format may be crossed off as not complying with Rule 1.98(b)(1).

Rule 1.98(b)(3) requires that each U.S. application must be identified by filing date. Citations imported from the PTO/SB/08a IDS form or the PTO-892 form which lack a filing date, may be crossed off as not complying with Rule 1.98(b)(3).

For non-patent literature (NPL) citations, the PTO-892 form permits inclusion of the publisher “as applicable” and does not require place of publication as required by Rule 1.98(b)(5). NPL Citations imported from the PTO-892 form which lack a publisher or a place of publication may be crossed off as not complying with Rule 1.98(b)(5).

Further, MPEP § 707.05(e)(IV) provides guidance for citing electronic documents and other information, which is not covered by either PTO-892 or PT/SB/08a form. AIPLA expects that revising and updating the prior art forms and the corresponding Examiner’s checklist will simplify the process of citing and reviewing prior art for both Examiners and applicants. Standardized citation formats will reduce the number of references unnecessarily crossed off as not complying with Rule 1.98.

It is our understanding that, although the Office is automatically importing the citations from the parent into the child application and printing the citations of references considered by the Examiner on the issued patent, the ultimate responsibility for the accuracy and completeness of those citation remains with the applicant. When the applicant notices an error in a citation or a missing citation in the Notice of Imported Citations or the Notice of Consideration which the Office has not corrected, the applicant should be able to have the error corrected without penalty. In particular, any such correction should not require a fee and should not affect the patent term. Furthermore, for errors in a Notice of Imported Citation or a Notice of Consideration identified at time of allowance, we understand that MPEP § 1203.12 should apply, whereby the citation error is corrected by the Examiner in an Examiner’s Amendment.

CONCLUSION

Thank you again for the opportunity to make these comments. AIPLA supports the continuing efforts on improving the patent system, welcomes the opportunity to answer any questions these comments may raise, and looks forward to a continuing dialogue on this very important subject.

Sincerely,

A handwritten signature in blue ink, appearing to read "Sheldon H. Klein", with a stylized flourish at the end.

Sheldon H. Klein
President
American Intellectual Property Law Association