



3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-P-2018-0051]

Access to Relevant Prior Art Initiative

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is implementing the first phase of the Access to Relevant Prior Art Initiative (“RPA Initiative”) to import citations (e.g., bibliographic data on forms PTO/SB/08 and PTO-892) from the immediate parent application into the continuing application. The citations corresponding to the documents considered by the examiner in the continuing application will be printed on the face of the patent issuing from the continuing application without the applicant having to resubmit the information on an Information Disclosure Statement. Additionally, an applicant’s duty to disclose information 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 RPA Initiative is being developed in response to

public input following an August 29, 2016, notice and September 28, 2016, roundtable event on leveraging electronic resources to retrieve information from applicant's other applications. The USPTO plans to implement the RPA Initiative in phases to consider and address public and examiner feedback at each phase and determine how to effectively expand the RPA Initiative in future phases.

DATES: *Applicable Date:* November 1, 2018.

ADDRESSES: The RPA Initiative will be implemented in stages without a comment deadline. Comments will be accepted on an ongoing basis. Written suggestions and comments should be sent by electronic mail to PriorArtAccess@uspto.gov or via the IdeaScale tool available at <https://uspto-priorart.ideascale.com>. 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.

FOR FURTHER INFORMATION CONTACT: For questions or comments regarding the RPA Initiative in general, please contact Michael Neas, Deputy Director, International Patent Legal Administration, by telephone at 571-272-3289, or by e-mail to michael.neas@uspto.gov or Matthew Sked, Senior Legal Advisor, Office of Patent Legal Administration, by telephone at 571-272-7627, or by e-mail to matthew.sked@uspto.gov. Questions regarding a specific application should be directed to the Technology Center examining the application.

SUPPLEMENTARY INFORMATION:

I. Background:

On August 29, 2016, the USPTO issued a notice seeking public feedback regarding how to efficiently utilize information from applicant's other applications having the same or substantially the same disclosure to provide examiners with relevant information at the earliest stage of examination. See *Request for Comments and Notice of Roundtable Event on Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance*, 81 FR 59197 (August 29, 2016). The notice announced a Roundtable that was held on September 28, 2016 and requested written comments by October 28, 2016. In response, the Office received twenty-six comments from a diverse group of stakeholders including intellectual property organizations, companies, law firms and individuals. Most of the stakeholders supported a program where the USPTO would automatically monitor related applications for relevant information therein for consideration during the examination of a U.S. application. However, stakeholder views varied on the optimal scope of the program and best method for implementation. Accordingly, the USPTO will implement the RPA Initiative in phases to consider and address public and examiner feedback at each phase. This feedback will be used to determine if the first phase needs adjustment, and how to expand the RPA Initiative effectively in future phases.

Applicants and other individuals substantively involved with the preparation and/or prosecution of a U.S. non-provisional application have a duty to submit to the USPTO information which is material to patentability as defined in 37 CFR 1.56. The provisions of 37 CFR 1.97 and 37 CFR 1.98 provide a mechanism by which patent applicants may comply with the duty of disclosure

provided in 37 CFR 1.56. An information disclosure statement (IDS) filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner assigned to the application. Citations listed in an IDS (e.g., on form PTO/SB/08 and equivalents) and considered by the examiner will be printed on the patent and distinguished from citations that were cited by the examiner and listed on a form PTO-892 (examiner citations will be marked with an asterisk). See *Manual of Patent Examining Procedure*, Rev. 08.2017, Jan. 2018 (referred to herein as “MPEP”) §§ 609 and 609.06.

Under current practice, when filing a continuing application that claims benefit under 35 U.S.C. 120 to a parent application (other than an international application for patent under the Patent Cooperation Treaty (PCT) that designated the United States), a listing of information which has been considered by the examiner in the parent application need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent. Specifically, “(t)he examiner will consider information which has been considered by the Office in a parent application... when examining: (A) a continuation application filed under 37 CFR 1.53(b), (B) a divisional application filed under 37 CFR 1.53(b), or (C) a continuation-in-part application filed under 37 CFR 1.53(b).” MPEP § 609.02(II)(A)(2).

II. RPA Initiative

After careful consideration of the input from the public and examiners on the prior art initiative announced in the August 29, 2016 notice, the USPTO is implementing the RPA Initiative that will leverage electronic resources to improve examiner’s access to relevant information from applicant’s other related applications. As indicated previously, the USPTO will be implementing

the RPA Initiative in phases to evaluate public and examiner feedback at each phase to address concerns and determine the ideal course for future expansion of the RPA Initiative.

In the first phase of the RPA Initiative, the USPTO will import the citations listed on forms PTO/SB/08 (or equivalents) and PTO-892 in the immediate parent application into the continuing application. If compliant with 37 CFR 1.98 in the parent application, the examiner will consider the documents that correspond to these citations and the citations will be printed on the patent. This will eliminate the need for applicant to submit an IDS in the continuing application for the purpose of having these citations printed on the patent. Additionally, 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.

In subsequent phases of the RPA Initiative, the USPTO will consider providing examiners access to citation information from other sources such as other related U.S. applications, international applications under the PCT, and counterpart foreign applications of the same applicant. The selection of these sources and the timetable for expansion will be dictated, at least in part, by evaluating the first phase including feedback on the RPA Initiative from the public and examiners.

This first phase will also begin with a targeted release of a newly developed interface to a subgroup of examiners from a limited number of selected art units. In subsequent phases of the

RPA Initiative, the USPTO plans to provide the interface to more examiners when the RPA Initiative proves scalable.

III. Structure of the First Phase of the RPA Initiative

(1) Overview

In the first phase of the RPA Initiative, applicants of a continuing application included in the RPA Initiative will not need to submit an IDS in a continuing application for information cited in the parent application in order for the corresponding citations to appear on the face of any patent issuing from the continuing application. Instead, IDS citations listed on form PTO/SB/08 (or equivalents) in the parent application, as well as citations listed on form PTO-892 (Notice of References Cited) in the parent application, will be imported into the continuing application. Those citations considered by the examiner in the continuing application will be printed on any patent issuing from the continuing application and distinguished from the other citations of record. This first phase will be targeted to a select group of examiners and limited to continuing applications filed on or after the effective date of November 1, 2018 with a single parent application.

(2) Conditions for Inclusion

An application included in the first phase of the RPA Initiative will meet the following conditions.

- i. Types of Applications.* The application is a non-reissue, non-provisional application filed under 35 U.S.C. 111(a) with a claim for benefit under 35 U.S.C. 120 or 121 of only a single prior U.S. application (i.e., immediate parent

application, referred to herein as “parent application”). The parent application must have been filed under 35 U.S.C. 111(a) or have entered the national stage pursuant to 35 U.S.C. 371. The parent application can claim priority or benefit of other applications only under 35 U.S.C. 119. For example, it cannot include any claims for benefit under 35 U.S.C. 120, 121, 365(c) or 386(c).

ii. Art Unit Requirement. The application is assigned to one of the art units that will be listed on the RPA Initiative website <https://www.uspto.gov/patents-getting-started/PriorArtAccess>.

iii. Timing. The RPA Initiative will initially apply to a small group of continuing applications filed on or after the effective date of November 1, 2018. The RPA Initiative will then expand to a larger group of applications filed on or after January 1, 2019. This information will be listed on the RPA Initiative website <https://www.uspto.gov/patents-getting-started/PriorArtAccess>. The claim for benefit to a parent application must be made in the continuing application and reflected on the filing receipt before the continuing application completes pre-examination processing.

The USPTO cannot accept requests to have an application entered in the first phase of the RPA Initiative.

(3) Art Units in the First Phase

The first phase will begin with a small group of examiners on November 1, 2018, and increase to a larger group on January 1, 2019. The art units will be listed on the RPA Initiative website

<https://www.uspto.gov/patents-getting-started/PriorArtAccess> before the November 1, 2018 effective date.

The art units participating in the first phase of the RPA Initiative will be chosen to ensure that within the first twelve months of the RPA Initiative, data is acquired on approximately 175 applications across the examining corps. Specifically, the USPTO is considering each art unit's current backlog of continuing applications and the projected number of continuing application filings expected in the first year of the RPA Initiative. This targeted selection of art units and the number of applications is designed to provide relevant feedback in a timely manner and allow the RPA Initiative to expand to the next phase in an expeditious manner.

Note, if the application is initially assigned to an art unit within the RPA Initiative and is later transferred to an art unit outside the RPA Initiative, the application will remain in the RPA Initiative and will be treated in accordance with this notice.

(4) Determination of Applications for Inclusion in the RPA Initiative

The USPTO will determine whether an application meets the conditions for inclusion in the first phase of the RPA Initiative after the Office of Patent Application Processing completes pre-examination processing of the continuing application. That is, a filing receipt has been issued, there are no outstanding pre-examination notices (e.g., Notice to File Missing Parts), and the application has completed classification. At this point, the continuing application will be evaluated for inclusion in the RPA Initiative. Once it has been determined that the continuing application meets the conditions for inclusion in the first phase of the RPA Initiative, the

citations from the parent application, as specified herein, will be imported into the continuing application. Concurrent with the importation, a Notice of Imported Citations will be generated and provided to the applicant.

The Notice of Imported Citations will indicate that the continuing application has been entered in the first phase of the RPA Initiative and will list the citations that have been imported into the continuing application under examination. There is no requirement for the applicant to reply to the Notice of Imported Citations. However, applicant may inspect the Notice of Imported Citations to determine what citations have been imported into the continuing application under examination.

Applications included in the RPA Initiative will not be expedited or given special status due to inclusion into this RPA Initiative. The continuing application will be taken up for examination in the order it is filed in accordance with MPEP 708. Once the continuing application is taken up for action, the examiner will consider the imported information in due course, similar to the consideration of other IDSs filed in the application. There is no mechanism for removing an application from the RPA Initiative.

(5) Citations Imported

All citations, both considered and unconsidered in the parent application, will be imported into the continuing application. The citations are those corresponding to U.S. patent documents, foreign patent documents, and non-patent literature (NPL) documents, contained on an IDS listing (e.g., PTO/SB/08 or equivalents) or PTO-892 in the file wrapper record of the parent

application at the time inclusion into the RPA Initiative is determined. If available in the parent application, the examiner will be provided ready access to copies of the foreign patent documents and NPL documents associated with the imported citations as well as any corresponding translations or explanations of relevance. Though copies of documents corresponding to the imported citations will not be available in the electronic file wrapper of the continuing application to applicants and the public, such copies can be accessed in the electronic file wrapper of the parent application by the applicant of the parent application through the USPTO's Private Patent Application Information Retrieval (PAIR) system (<https://ppair.uspto.gov/TruePassWebStart/AuthenticationChooser.html>), or by the public by obtaining a certified copy of file history of the parent application (<http://ebiz1.uspto.gov/oems25p/index.html>). This is consistent with current practice where a copy of a document considered by the examiner in the parent application (except where the parent is an international application) is not required to be filed in the continuing application for consideration, and, therefore, is not available in the electronic file wrapper of the continuing application. See 37 CFR 1.98(d) and MPEP § 609.02. Any citations in the parent application not contained on an IDS listing or PTO-892 form will not be imported, including, for example, citations in a third-party submission under 37 CFR 1.290, Office actions, applicant responses, citations listed in the specification, affidavits/declarations, etc.

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. To have such later-appearing citations printed on a patent issued from the continuing application, applicant must submit an IDS with the later-appearing citations.

(6) Examiner Consideration

Examiners will consider all documents corresponding to the imported citations that are compliant with 37 CFR 1.98 in the parent application. As explained previously, the imported citations will be listed on the Notice of Imported Citations, which will be given to the applicant at the time of importation and will be viewable in the electronic file wrapper record of the continuing application via the USPTO's PAIR system. The examiner will consider the information corresponding to the imported citations to the same extent as information submitted by the applicant in an IDS. See MPEP § 609.05(b).

The examiner will indicate consideration of the imported citations in a Notice of Consideration. Examiners will strike through each citation whose document was not considered in the continuing application. This includes any citation that was not compliant with 37 CFR 1.98 in the parent application (e.g., no copy was submitted) or the examiner was unable to consider the relevance of the imported citation for some other reason. However, citations that were not compliant under 37 CFR 1.97 in the parent application will be considered by the examiner in the continuing application, if compliant with 37 CFR 1.98. The examiner should inform the applicant in the first Office action of the reason(s) a citation was not considered. Applicant may then file an IDS to correct the deficiency in the imported citations. Note that the date the IDS is filed to correct the deficiency in the continuing application is the date for determining compliance with the timing requirements of 37 CFR 1.97. See MPEP § 609.05(a).

The examiner's signature on the Notice of Consideration will indicate that the documents corresponding to all citations that have not been lined through have been considered. The Notice of Consideration should be provided with the first Office action on the merits in the continuing application.

(7) Publication of Imported Citations

All citations that have been imported from the parent application and indicated as considered on the Notice of Consideration will be printed on the patent issuing from the continuing application. These imported citations will be marked with a double-dagger on the patent to distinguish them from the other citations of record. If an item of information is cited more than once on the record (e.g., in a Notice of Consideration and on an IDS), the citation will be listed only once on the patent and will be distinguished as a citation that has been imported from a related application.

IV. Future Phases

As indicated previously, this RPA Initiative seeks to import relevant information for consideration by the examiner at an early time in prosecution while reducing the need for applicants to submit this same information in later-filed applications. The RPA Initiative will begin with the first phase outlined in section III. The USPTO expects to expand this RPA Initiative in subsequent phases to further enhance examination quality and reduce the need for applicants to resubmit citation lists and references.

The USPTO is evaluating how to expand the RPA Initiative in future phases and will use the data acquired in the first phase in making this determination. Currently, the USPTO is considering a first expansion of the RPA Initiative (second phase) to include the importation of U.S. and foreign patent citation information from related PCT and counterpart foreign applications. However, this could change based on the feedback received from examiners and stakeholders in the first phase. Further, the RPA Initiative may be expanded to increase the number of times information is imported from the parent application, as well as encompass more art units within the USPTO so that it will eventually be applicable in all applications regardless of classification.

The timetable for expansion and the chosen sources of expansion will be determined based upon the feedback obtained in the first phase. Applicants are encouraged to provide their feedback on the RPA Initiative to help the USPTO determine how best to expand the RPA Initiative in the next phase and in any future phases. Comments are preferred using the IdeaScale tool which is available at <https://uspto-priorart.ideascale.com>.

Dated: October 19, 2018.

Andrei Iancu,

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

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