

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Public Advisory Committee Quarterly Meeting

Access to Relevant Prior Art Initiative Update

Michael Neas – Deputy Director, International Patent
Legal Administration

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UNITED STATES
PATENT AND TRADEMARK OFFICE



Initiative objectives

- Leveraging electronic resources to retrieve information (e.g., prior art, search reports, etc.) from relevant sources (e.g., related U.S. applications, counterpart foreign and PCT applications)
- Automatically import information into the file wrapper of a U.S. patent application under examination at the earliest point
 - Potentially reduce applicant's burden under the duty of disclosure.

Outreach efforts to date

- **External:**
 - Focus sessions at regional offices – June 2016
 - Federal Register Notice – August 2016, October 2018
 - Public roundtable – September 28, 2016
 - Initial written comments – October 28, 2016
 - Patent Public Advisory Committee (PPAC) presentations – November 2017, August 2018, November 2019
 - IdeaScale
 - Ongoing various speaking events
- **Internal:**
 - Examiner Focus Sessions – April 2017
 - Expanded Examiner Focus Sessions – June 2017
 - Examiner Survey – September 2017
 - User Center Design Council Sessions – November, December 2017
 - Focus sessions and surveys with examiners in targeted release art units

Project research

- **Evaluation of Data Sources**
 - Global Dossier, Common Citation Document, PatentScope, USPTO Internal IT Systems, etc.
- **Application Case Studies**
 - 400+ cases reviewed to consider the effects of importing prior art on prosecution and examiners

Access to Relevant Prior Art: Phase 1

- Began November 1, 2018
- Initial implementation is a targeted release and will not be a corps-wide release
 - November 1: Released to Art Unit 2131
 - January 1: Released to Art Units 1616, 1731, 2431, 2675, 2879, 2922, 3635, and 3753
- Subsequent phases of the project will consider importing from additional sources, such as counterpart foreign and PCT applications.

Access to Relevant Prior Art: Phase 1

- Automatically imports citations from immediate U.S. parent applications into certain pending continuing U.S. applications for consideration by the examiner.
- Imported citations will be printed on the face of any patent that issues from the continuing application with a new indicator.
- This collection of imported citations is called the Master Reference List (MRL).

Citations in the MRL

- All citations on all Information Disclosure Statements (IDSs) (e.g. SB/08) and PTO-892s in the immediate parent application at the time of importation
- All citations on any IDS in the child application at the time of importation
- Note: IDSs and PTO-892s filed in parent and IDSs filed in the child application after importation will not be in the MRL in the initial release.
- Importation will occur once, after pre-exam but prior to docketing to the Examiner.

Notice of Imported Citations (NIC)

- Informs the applicant that the application has been entered into the RPA Initiative
- Lists all citations that have been imported from the parent application
- Applicant does not need to respond to the NIC
- The presence of an NIC in an RPA application indicates that the application is ready to be examined

Notice of Imported Citations	Application No. []	Parent Application No. []	
	Date of Importation of Citations []	Art Unit []	Page [] of []

The instant application has been entered in the Access to Relevant Prior Art Initiative. This Notice identifies the citations that have been imported from the Information Disclosure Statements and/or PTO-892s of the parent application listed above. The U.S. patent, foreign patent and non-patent documents corresponding to the imported citations, along with any translation or explanation of relevance thereof, will be considered by the Examiner and cited in the Notice of Consideration in due course if the requirements of 37 C.F.R. § 1.98 are met in the parent application on the date of importation. Any additional information Applicant would like considered in this application, including non-compliant citations in the parent application, should be submitted to the USPTO in accordance with 37 C.F.R. §§ 1.97 and 1.98. More information on the Access to Relevant Prior Art Initiative is available on the USPTO web site at <https://www.uspto.gov/patents-getting-started/PriorArtAccess>.

U.S. PATENT DOCUMENTS					
	Document Number Country Code-Number-Kind Code	Date	Name	CPC Classification	US Classification
1	US-[]	[]	[]	[]	[]
2	US-[]	[]	[]	[]	[]
3	US-[]	[]	[]	[]	[]
4	US-[]	[]	[]	[]	[]
5	US-[]	[]	[]	[]	[]
6	US-[]	[]	[]	[]	[]
7	US-[]	[]	[]	[]	[]
8	US-[]	[]	[]	[]	[]
9	US-[]	[]	[]	[]	[]

FOREIGN PATENT DOCUMENTS					
	Document Number Country Code-Number-Kind Code	Date	Country	Name	CPC Classification
10	[]	[]	[]	[]	[]
11	[]	[]	[]	[]	[]
12	[]	[]	[]	[]	[]
13	[]	[]	[]	[]	[]
14	[]	[]	[]	[]	[]
15	[]	[]	[]	[]	[]

NON-PATENT DOCUMENTS	
	Include as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages
16	[]
17	[]
18	[]
19	[]

Note: Copies of patents, publications, applications or other information corresponding to the citations are not being furnished with this Office communication. Dates in MM-YYYY format are publication dates. Classifications may be US or CPC.

Examiner consideration

- In the MRL, examiners must consider all documents imported from the parent unless they were not compliant with 37 CFR 1.98 in the parent (e.g. no copy filed).
- Examiners may use the MRL to consider documents cited on IDSs in the child application.
- Information in the MRL will be considered to the same extent as information submitted by the applicant on an IDS (see MPEP 609.05(b)).
- If a translation or explanation of relevance is not available, the examiner should go to the parent application to view it.

Indication of examiner consideration

- **Citations Imported from Parent**
 - Indicate whether a document is considered or not considered in the RPA viewer.
 - Indicate in the office action the reason(s) a citation was not considered.
 - Generate Notice of Consideration and mail with the next office action.
- **Citations from IDSs in instant application**
 - Follow normal IDS procedure.

Notice of consideration

- Form is auto-generated based upon the consideration indications in the RPA viewer.
- Citations indicated as not considered will be displayed on the form with a strike-through.
- Signature and date are auto-populated.
- Mail with the next office action.

Notice of Consideration		Application No.		Parent Application No.	
		Date of Importation of Citations		Art Unit	Page <input type="text"/> of <input type="text"/>

U.S. PATENT DOCUMENTS					
Document Number	Country Code-Number-Kind	Date	Name	CPC Classification	US Classification
1	US-				
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7	US-				
8	US-				
9	US-				

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16					
17					
18					
19					

All references considered except where lined through*					
Examiner	Date	Considered			

*Imported citations that are not in conformance with 37 C.F.R. 1.68 in the parent application at the date of importation will not be considered by the Office in the instant application, unless separately submitted in an Information Disclosure Statement in compliance with 37 C.F.R. 1.97 and 1.98.

EXAMINER: Include copy of this form with next Office action on the merits to applicant.

Note: Copies of patents, publications, applications or other information corresponding to the citations are not being furnished with this Office communication. Dates in MM-YYYY format are publication dates. Classifications may be US or CPC.

FY 2019 next steps

- **Increased engagement of external stakeholders – 2019**
- **Evaluation of initial implementation - ongoing**
- **Gathering and refining business requirements – ongoing**
- **Development of expansion plan to all art units and to additional sources – ongoing**

Prior Art Access contacts

E-mail: PriorArtAccess@USPTO.gov

Website: www.uspto.gov/patents-getting-started/access-prior-art-project

Michael Neas

Deputy Director, International Patent Legal Administration

571-272-3289

Michael.Neas@USPTO.gov

Jessica Patterson

Director, International Outreach and Administration

571-272-8828

Jessica.Patterson@USPTO.gov



Questions and comments

Michael Neas

Deputy Director, International Patent Legal
Administration

(571) 272-3289

Michael.Neas@USPTO.GOV

