

Access to Relevant Prior Art Initiative Update

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Standing Committee on the Law of Patents

December 2018

UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto

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 in June 2016
- Federal Register Notice – August 2016, October 2018
- Public Roundtable – September 28, 2016
- Initial Written Comments – October 28, 2016
- 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 effects of importing prior art on prosecution and on 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 one Art Unit
 - January 1: Release to eight additional Art Units

Access to Relevant Prior Art (RPA): 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)
- Subsequent phases of the project will focus on importing from additional sources, such as counterpart foreign and PCT applications

Citations in the MRL

- All citations in the immediate parent application at the time of importation
- All applicant submitted citations in the instant application at the time of importation
- **Note:** In the initial release, any citations in parent and any applicant submitted citations filed in the instant application after importation will not be in the MRL
 - Importation will occur once, after pre-exam but prior to docketing to the Examiner

Notice of Imported Citations (NIC)

Notice of Imported Citations		Application No. [REDACTED]	Parent Application No. [REDACTED]		
		Date of Importation of Citations [REDACTED]	Art Unit [REDACTED]	Page 1 of 1	
<p><i>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.</i></p>					
U.S. PATENT DOCUMENTS					
	Document Number Country Code-Number-Kind Code	Date	Name	CPC Classification	US Classification
1	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
2	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
3	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
4	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
5	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
6	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
7	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
8	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
9	US-[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
FOREIGN PATENT DOCUMENTS					
	Document Number Country Code-Number-Kind Code	Date	Country	Name	CPC Classification
10	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
11	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
12	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
13	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
14	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
15	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
NON-PATENT DOCUMENTS					
Include as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages					
16	[REDACTED]				
17	[REDACTED]				
18	[REDACTED]				
19	[REDACTED]				

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.

- 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 a NIC in an RPA application indicates that the application is ready to be examined



Examiner Consideration

- In the MRL, examiners must consider all documents imported from the parent unless they were not compliant with U.S. requirements in the parent (e.g. no copy filed)
- Information in the MRL will be considered to the same extent as information submitted by the applicant on an Information Disclosure Statement
- 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 applicant in instant application**
 - Follow normal procedure

Notice of Consideration

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

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	[]

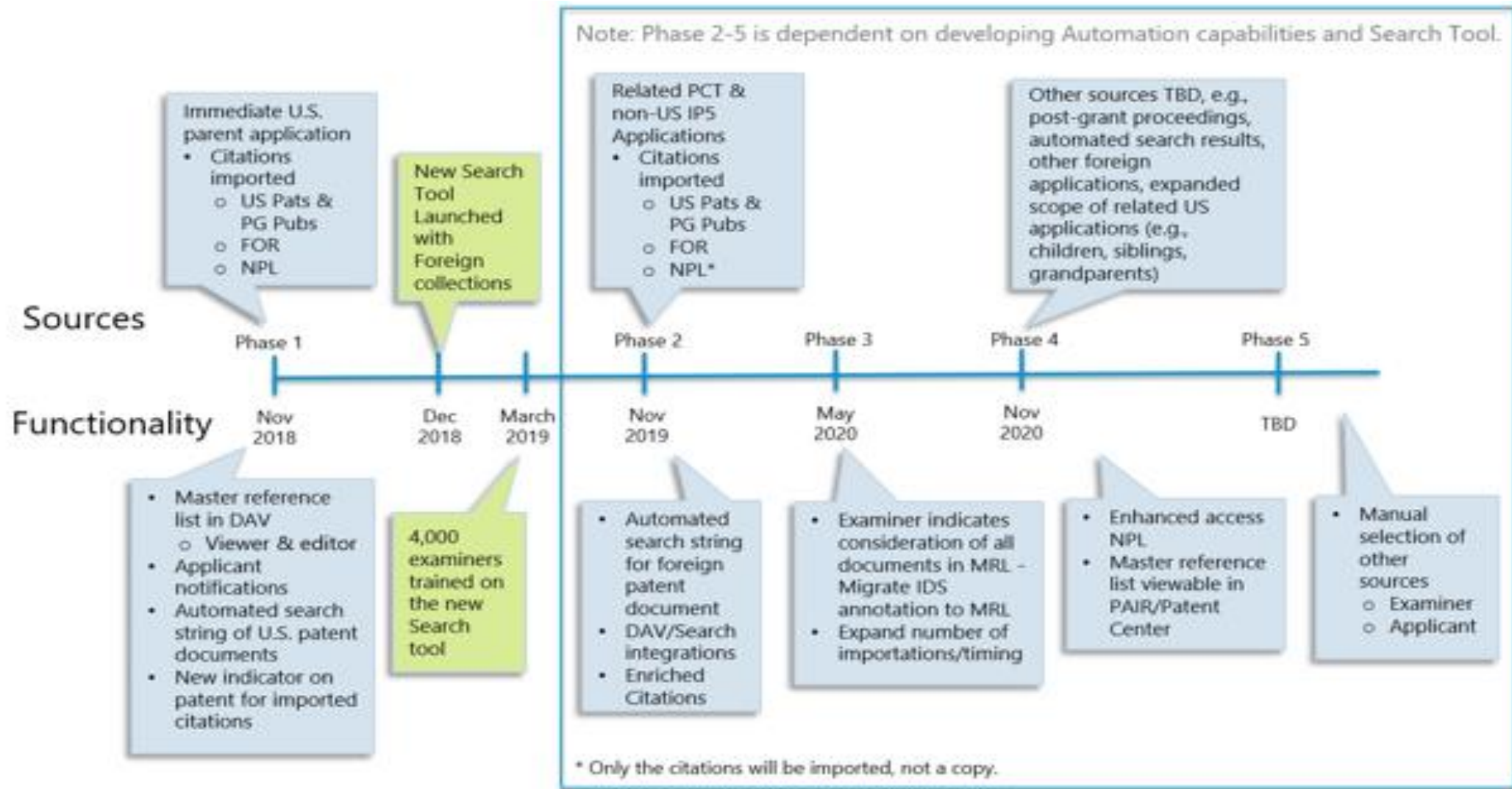
All references considered except where lined through*	
Examiner Signature	Date Considered

*Imported citations that are not in conformance with 37 C.F.R. 1.98 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.

- 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



Tentative Expansion Plan



FY 2019 Next Steps

- Phase 1 Business Solution 2nd Targeted Release – January 2019
- Further engagement of stakeholders
- Gathering and Refining Business Requirements
- Finalize expansion plan to all art units and to additional sources

Thank you!

