



August 26, 2019

Andrew Hirshfeld
Commissioner for Patents
Mail Stop Comments—Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration

Via RegulatoryReformGroup@uspto.gov

Dear Commissioner Hirshfeld:

Intellectual Property Owners Association (IPO) submits the following suggestions to improve, revise, and streamline USPTO regulations in support of the USPTO’s efforts in accordance with Executive Order 13777, “Enforcing the Regulatory Reform Agenda.” IPO understands that this is an ongoing process and might submit additional comments in the future.

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO’s membership includes about 200 companies and close to 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans over 30 countries.

IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

I. Information Disclosure Statement Regulations

IPO believes that several of the information disclosure statement (IDS) regulations can be improved, revised, and streamlined because they are unnecessary, ineffective, costly, and/or unduly burdensome to both the USPTO and applicants. Specific suggestions are provided below.

A. § 1.97(e)(1) Statements for Items from Co-Pending Applications

1. patent office communications

Current 37 C.F.R. § 1.97(e)(1) provides for consideration of an IDS filed within certain time periods if accompanied by a statement “[t]hat each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the [IDS]” but does not expressly encompass patent office communications per se.

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To ease the burden on applicants who want to cross-cite patent office communications, we suggest revising 37 C.F.R. § 1.97(e)(1) to expressly include “a communication that was issued by a patent office in a foreign or international application or by the Office,” not just items “first cited in” a patent office communication. This suggested language parallels language used in 37 C.F.R. § 1.704(d)(1)(ii), which provides that filing an IDS will not be considered “a failure to engage in reasonable efforts to conclude prosecution” under certain circumstances if each item of information “[i]s a communication that was issued by a patent office in a counterpart foreign or international application or by the Office.”

It is IPO’s understanding that the USPTO already interprets § 1.97(e)(1) as encompassing patent office communications *per se*, but it would be useful for the rule to state this explicitly, especially because § 1.704(d)(1)(ii) addresses them explicitly.

## 2. *items first cited in co-pending, counterpart U.S. applications*

Current 37 C.F.R. § 1.97(e)(1) does not include a parallel provision for items cited in communications from the USPTO. To ease the burden on applicants who want to cross-cite office actions and references cited therein in co-pending, counterpart U.S. applications, IPO suggests revising 37 C.F.R. § 1.97(e)(1) to encompass items first cited in any communication from “a patent office” not more than three months prior to the filing of the [IDS].” This parallels language used in 37 C.F.R. § 1.704(d)(1)(i), which provides that filing an IDS will not be considered “a failure to engage in reasonable efforts to conclude prosecution” under certain circumstances if each item of information “[w]as first cited in any communication from *a patent office* in a counterpart foreign or international application or from the Office ....” 37 C.F.R. § 1.704(d)(1)(i) (emphasis added).

Although an applicant could submit an office action *per se* with a statement under current 37 C.F.R. § 1.97(e)(2), that provision might not encompass references that were known to an individual designated in § 1.56(c) more than three months prior to filing the IDS. For example, an individual designated in § 1.56(c) might have been aware of a reference but not considered it material to patentability; if an examiner subsequently cited that reference in a co-pending, counterpart U.S. application, the applicant might want to submit an IDS to comply with the duty of disclosure. Under current IDS rules, if such a reference is cited in a communication from a foreign patent office in a foreign counterpart application it can be submitted within certain time periods if accompanied by a statement under § 1.97(e)(1),<sup>1</sup> but a request for continued examination (RCE) is required to obtain consideration of such a reference if cited in a co-pending U.S. application.

Drawing a distinction between references cited by foreign patent offices and references cited in co-pending, counterpart U.S. applications is unduly burdensome on applicants seeking to comply with the duty of disclosure.

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<sup>1</sup> As set forth in MPEP § 609.04(b), for a statement under 37 C.F.R. § 1.97(e)(1), “it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report.”

3. *items first cited in co-pending international applications*

For similar reasons, IPO suggests that 37 C.F.R. § 1.97(e)(1) be revised to clarify that it applies to items first cited in communications issued in international applications, such as items cited in search reports issued in PCT applications. This would be consistent with language used in 37 C.F.R. § 1.704(d)(1)(i), which as noted above encompasses items first cited in international applications.

IPO therefore suggests that 37 CFR § 1.97(e) be amended as follows:

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement is, or was first cited in, any communication from a ~~foreign~~ patent office in a counterpart international, foreign, or U.S. application not more than three months prior to the filing of the information disclosure statement; or

(2) That no item of information contained in the information disclosure statement is, or was cited in, a communication from a ~~foreign~~ patent office in a counterpart international, foreign, or U.S. application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

In regard to possible concerns that these changes would permit applicants to intentionally delay submitting information cited in co-pending foreign, international, or U.S. applications, the “first cited” requirement and three-month time period should provide sufficient safeguards to prevent deliberate misuse of § 1.97(e)(1). Overall, these changes should encourage applicants to submit items of information by expanding the ability to do so without having to file an RCE, which could interfere with the conclusion of substantive prosecution.

B. Requirement for Copies of Documents under § 1.98(a)(2)

Current 37 C.F.R. § 1.98(a)(2) requires applicants to submit copies of all documents cited in the IDS “other than U.S. patents and U.S. patent application publications.” Given the ease with which USPTO personnel can access published PCT applications, foreign patent documents, and unpublished U.S. applications in various USPTO, foreign patent office, and free public databases, IPO believes the cost this requirement imposes on applicants outweighs the benefits to the USPTO. We therefore suggest amending 37 C.F.R. § 1.98(a)(2) as follows:

(2) A legible copy of:

(i) ~~Each foreign patent;~~

(~~ii~~) Each publication or that portion which caused it to be listed, other than U.S. patents, ~~and~~ U.S. patent application publications, WIPO patent application

publications, and foreign patents and published foreign patent applications from other IP5 patent offices or available in the Global Dossier, unless required by the Office<sup>2</sup>;

(iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the application or that portion of the application which caused it to be listed is stored in the USPTO's Image File Wrapper system;<sup>3</sup> and

~~(iii)~~ (iv) All other information or that portion which caused it to be listed.

If the agency prefers to continue requiring documents, we suggest permitting this requirement to be satisfied by referencing another U.S. patent application or Global Dossier application in which the documents already are of record. Current 37 C.F.R. § 1.98(d) exempts from the copy requirement items of record in a parent application. IPO does not believe drawing a distinction between references of record in a parent application and references of record in any other U.S. application or Global Dossier application offers any benefits to the USPTO, but it does impose costly burdens on applicants seeking consideration of the same references in multiple U.S. applications. IPO also does not believe that the ability to rely on the availability of a copy of an item in the file wrapper of another application should depend on an IDS in the other application having complied with 37 C.F.R. § 1.98(a)-(c). We therefore suggest amending 37 C.F.R. § 1.98(d) as follows:

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office ~~in an earlier~~ any other U.S. application, or is available in the Global Dossier for an IP5 application, unless:

(1) The ~~earlier~~ other U.S. application or Global Dossier application is properly identified in the information disclosure statement ~~and is relied on for an earlier effective filing date under 35 U.S.C. 120;~~ and

(2) The information disclosure statement ~~submitted in the earlier application~~ otherwise complies with paragraphs (a) through (c) of this section.

To promote practice consistent with 37 C.F.R. § 1.98(d) and to clarify that an IDS should be considered at least to the extent it satisfies the requirements, IPO suggests the Examiner Note for Form Paragraph 6.49.07 be revised as follows:

<sup>2</sup> In view of this clause, if for some reason an examiner is unable to obtain a copy of a listed patent/application document, he or she could require the applicant to provide a copy in order to have it considered.

<sup>3</sup> MPEP § 609.04(a) already provides that “the requirement ... for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application ... is *sua sponte* waived where the cited pending application is stored in the USPTO's IFW system.” Including this waiver in the regulation itself will clarify the requirements.

## 6.49.07 Information Disclosure Statement Not Considered, No Copy of References

The information disclosure statement filed [1] fails to comply with 37 C.F.R. § 1.98(a)(2), which requires a legible copy of each ~~cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed, other than U.S. patents, U.S. patent application publications, pending unpublished U.S. applications where the application or that portion of the application which caused it to be listed is stored in the USPTO's Image File Wrapper system, WIPO patent application publications, and foreign patents and published foreign patent applications from other IP5 patent offices or available in the Global Dossier~~ and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

## Examiner Note:

Do not use this form paragraph when the missing reference(s) are U.S. patents, U.S. patent application publications, pending unpublished U.S. applications where the application or that portion of the application which caused it to be listed is stored in the USPTO's Image File Wrapper system, WIPO patent application publications, and foreign patents and published foreign patent applications from other IP5 patent offices or U.S. pending applications (limited to the specification, including claims, and drawings) stored in IFW, or when the missing reference(s) were previously submitted to, or cited by, the Office in any other U.S. application properly identified in the information disclosure statement.

Do not use this form paragraph if copies of one or more cited references were provided or if copies of one or more cited references are not required. In that case, line through only the references for which required copies were not provided and notify the applicant accordingly.

To promote compact prosecution, IPO suggests expanding the practice of providing applicants limited time to correct deficiencies in information disclosure statements such as situations where a required copy of a cited reference was not provided, such as by revising Form Paragraph 6.51 so that it is not limited to requirements of 37 C.F.R. § 1.98(b) as follows:

## 6.51 Time for Completing Information Disclosure Statement

The information disclosure statement filed on [1] does not fully comply with the requirements of 37 C.F.R. § 1.98(b) because: [2]. Since the submission appears to be bona fide, applicant is given ONE (1) MONTH from the date of this notice to supply the above-mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 C.F.R. § 1.136(a) OR (b).** Failure to timely comply with this notice will result in the above-mentioned information disclosure statement being placed in the application file with the non-complying information not being considered. See 37 C.F.R. § 1.97(i).

## Examiner Note:

Use this form paragraph if an IDS complies with the timing requirements of 37 C.F.R. § 1.97 but part of the content requirements of 37 C.F.R. § 1.98~~(b)~~ has been inadvertently omitted.

This practice does not apply where there has been a deliberate omission of some necessary part of an Information Disclosure Statement or where the requirements based on the time of filing the statement, as set forth in 37 C.F.R. § 1.97, have not been complied with.

C. Requirements for Concise Explanation of Relevance and Translation under § 1.98(a)(3)

Current 37 C.F.R. § 1.98(a)(3) requires applicants to provide a “concise explanation of the relevance” of information that is not in the English language and to provide a copy of any English-language translation that is “within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).” We believe these requirements should be revised because the Global Dossier enables USPTO personnel to obtain machine translations of foreign patent office communications (that may provide concise explanations of the relevance of foreign-language references)<sup>4</sup> and foreign-language references. IPO therefore suggests amending 37 C.F.R. § 1.98(a)(3) as follows:

(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant’s specification or incorporated therein, or contained in a foreign patent office communication for which an English-language translation is available in the Global Dossier if the Global Dossier application and foreign patent office communication are properly identified in the information disclosure statement.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c), unless a translation is available in the Global Dossier for a Global Dossier application that is properly identified in the information disclosure statement.

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<sup>4</sup> MPEP § 609.04(a) already provides that “[w]here the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report.”

D. Citation Requirements of § 1.98(b)

Current 37 C.F.R. § 1.98(b) imposes detailed citation requirements for the listed information. Although we recognize that accurate citations are required to ensure that examiners consider the intended items of information and to provide an accurate record, an examiner's refusal to consider an item of information due to an obvious error or minor omission imposes a costly burden on applicants—by the time the error is identified, an IDS fee or RCE will be required to obtain consideration of the item in a corrected IDS.

IPO suggests the USPTO provide applicants a limited time period to correct deficiencies in information disclosure statements already reflected in Form Paragraph 6.51. That is, we suggest that examiners not be permitted to refuse to consider an item of information listed in an IDS due to an obvious error or minor omission in the citation, as long as the examiner can identify the intended item of information, particularly if a copy of the item was submitted with the IDS. This practice would be consistent with the instructions in MPEP § 1302.12.<sup>5</sup>

For consistency and simplicity, IPO also suggests revising 37 C.F.R. § 1.98(b) as follows:

- (1) Each U.S. patent listed in an information disclosure statement must be identified by the first named inventor, patent number, and issue date.
- (2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by ~~applicant~~ the first named inventor, patent application publication number, and publication date.
- (3) Each U.S. application listed in an information disclosure statement must be identified by the first named inventor, application number, and filing date.
- (4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.
- (5) Each publication listed in an information disclosure statement must be identified by ~~publisher~~, author (if any), title, relevant pages of the publication, date, and place of publication.<sup>6</sup>
- (6) Each electronic document obtained from an online source must be identified by type of electronic medium, date when the document was retrieved, and identification of the source of the document using words "retrieved from."

<sup>5</sup> MPEP § 1302.12 provides, "In any application, otherwise ready for issue, in which an erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation by an examiner's amendment."

<sup>6</sup> MPEP § 609.04(a) clarifies that the "place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published." Deleting the requirement to list a publisher would be consistent with current PTO/SB/08a.

(7) Each U.S. application or Global Dossier application relied upon for having a copy of a listed item in the electronic file wrapper, must be identified by country code, application number, and filing date.

IPO also suggests deleting from MPEP § 609.04(a) the general requirement for a month of publication. Although not specified in 37 C.F.R. § 1.98(b), MPEP § 609.04(a) states:

The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue.”

Month of publication might be significant in some circumstances, but the requirement to provide a month of publication or statement for every listed item imposes an unnecessary and costly burden on applicants, particularly when the month of publication is not printed on the document. IPO suggests eliminating this requirement but permitting an applicant to establish a more precise date of publication during prosecution if needed to antedate or disqualify the document.

E. Revisions to PTO/SB/08a

IPO suggests revising PTO/SB/08a to parallel the requirements of 37 C.F.R. § 1.98(b). Currently, PTO/SB/08a includes fields for kind codes and patentee or applicant names that are not required by 37 C.F.R. § 1.98(b). Moreover, PTO/SB/08a currently includes a field for county code, but 37 C.F.R. § 1.98(b)(4) permits identification of either a foreign country or foreign patent office. For non-patent literature documents, PTO/SB/08a requires information such as volume and issue number(s) not required by 37 C.F.R. § 1.98(b)(5). Also, PTO/SB/08a includes a field for an author’s name (to be listed in capital letters), while 37 C.F.R. § 1.98(b) recognizes that some non-patent literature documents may not have an author name.

IPO suggests PTO/SB/08a be revised to include sections for information required under 37 C.F.R. § 1.98(b)(3) and a new section for electronic documents as proposed above for new 37 C.F.R. § 1.98(b)(6). We also suggest revising PTO/SB/08a to include a field to identify another U.S. or Global Dossier application in which a copy of a listed item can be found in the electronic file wrapper, as proposed above for new 37 C.F.R. § 1.98(b)(7).

F. Streamlined Confirmation of Consideration of Information from Parent Application

MPEP § 609.02 states that the examiner of a continuing application will consider information that was considered by the USPTO in the parent application. The MPEP further states that an applicant should list the prior art from the parent application if the applicant desires the information to be printed on the patent issuing from the continuing application. IPO considers this requirement potentially burdensome to the applicant and prone to errors by both the applicant and the USPTO.

We appreciate the USPTO’s efforts to address this issue via the Access to Relevant Prior Art initiative, upon which IPO may comment separately after members have had an opportunity to participate. Until the program is expanded to encompass all applications, IPO suggests the USPTO



introduce a mechanism for confirming the examiner's consideration of the parent prior art by a single listing in the IDS. The listing could include, for example, listing "Information Considered in Parent Application 12/123,456" in the "Non-Patent Literature Documents" section of Form PTO/SB/08a. MPEP § 609.02 and/or 37 C.F.R. § 1.98 could be amended as follows to implement this mechanism for confirming the examiner's consideration of parent prior art.

MPEP § 609.02

2. Continuation Applications, Divisional Applications, or Continuation-in-Part Applications Filed under 37 CFR 1.53(b)

The examiner will consider information which has been considered by the Office in a parent application (other than an international application; see subsection I., above) when examining: (A) a continuation application filed under 37 C.F.R. § 1.53(b), (B) a divisional application filed under 37 C.F.R. § 1.53(b), or (C) a continuation-in-part application filed under 37 C.F.R. § 1.53(b). A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

If resubmitting a listing of the information, applicant should submit a new listing that complies with the format requirements in 37 C.F.R. § 1.98(a)(1) and the timing requirements of 37 C.F.R. § 1.97. Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 or PTO-892 forms from other applications. A completed PTO/SB/08 form from another application may already have initials of an examiner and the application number of another application. This information will likely confuse the record. Furthermore, when the spaces provided on the form have initials of an examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide his or her initials, and the previously relevant initials may be erroneously construed as being applied for the current application. A confirmation of the examiner's consideration of the information from the parent application can be requested by listing the parent application in an information disclosure statement.

37 C.F.R. § 1.98 Content of information disclosure statement.

...

(e) The examiner will consider information which has been considered by the Office in a parent application when examining: (A) a continuation application filed under 37 C.F.R. § 1.53(b), (B) a divisional application filed under 37 C.F.R. § 1.53(b), or (C) a continuation-in-part application filed under 37 C.F.R. § 1.53(b). A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent. However, a confirmation of the examiner's

consideration of the information from the parent application can be requested by listing the parent application in an information disclosure statement.

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IPO appreciates the USPTO's consideration of these comments.

Sincerely,

A handwritten signature in black ink, appearing to read "Henry Hadad". The signature is fluid and cursive, with the first name "Henry" being more prominent than the last name "Hadad".

Henry Hadad  
President