

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





PHEP: Citation of Prior Art

Summer Kostelnik
February 23, 2016

UNITED STATES
PATENT AND TRADEMARK OFFICE



Background

- **Late 2014: IP5 Industry submits proposals on 3 PHEP topics --**

The IP5 Offices should adopt an automatic, electronic Prior Art practice, whereby prior art that is already cited with respect to the application or a related application in any IP5 Office, and is available to an Office, does not need to be further cited to that Office.

- **Work completed thus far:**
 - Table Comparing Practices of IP5 Offices
 - Legal and Procedural Barriers to an IT based solution
 - Business Requirements (PHEP to WG2)

Current Status

- **Problem:** In some circumstances, applicants are required to submit information to offices which may already be available to the examiner by some other means (i.e. Global Dossier, CCD)
 - PHEP recognizes the benefit of developing a system that enables each office to easily view prior art previously cited by another office with respect to commonly filed applications.
 - Examiners can benefit from having consolidated access to citations of prior art from other offices in related applications, while also having access to associated office actions to see how the cited art was applied.

Increased efficiency + work sharing benefits!

System Requirements

- Develop a system that allows for consolidation of prior art citations in an application file, which should include an investigation of whether there is a format which would allow the data to be easily transformed into the various submission forms or formats required by the IP5 Offices. At an initial stage, this information will be shared among the IP5.
- If possible, the system should distinguish between citations made by the office, those submitted by the applicant, and those submitted by 3rd parties.
- In addition, such system should provide this information in real-time and include an indicator as to when the citation was added so as to know whether or not the timing met national requirements and whether or not the citation should have been considered by the examiner in an office action.
- If possible, the system should provide links back to the document where the citation was used and exclude duplicative citations/family members. The system should also include document relevance when available. Data should also be sortable by any data point.



Current Work

1. IP5 WG2 experts will perform an analysis on the sources of citation data and when this data becomes available (specifically information provided in CCD).
2. KIPO will update its proposal on implementing IT service in response to citation of prior art business requirements.

