



# Citation of Prior Art: USPTO

Summer Kostelnik  
Attorney, Office of Policy and International Affairs  
June 1, 2016

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# PHEP Topics – Citation of Prior Art

Track 1: IP5

IT Tool to consolidate citation data

Track 2: Individual Office

Internal considerations to lessen applicant burden

# Background

- USPTO is studying how to increase examination efficiency and patent quality through providing examiners with access to relevant prior art and supplemental information at the earliest point in examinations.
- Additionally, exploring whether or not automatically importing relevant prior art into the US application file at the earliest point in examination would improve prosecution efficiency and quality and reduce the burden of duty of disclosure for applicants.

# Current Issues: Examiner Perspective

- Awareness/availability:
  - How do examiners know that relevant prior art is available and how do they access it?
- Efficiently obtained:
  - How does the relevant prior art get to the examiner in a manner and time that will increase search and examination efficiency and quality?
- Value Recognition :
  - What supplemental information is available to assist the examiner in determining the relevance of prior art?

# Current Issues: Applicant Perspective

## – Acquiring Information:

- How do applicants efficiently obtaining the information necessary to meet their duty of disclosure and assist the examiner in making a proper patentability decision?

## – Efficiently obtained:

- How do applicants avoid cumbersome, costly, and time consuming efforts to monitor prosecution in related or counterpart applications or external sources so as to obtain relevant prior art?

## – Compliant presentation:

- How do applicants efficiently submit relevant prior art to the examiner in a time and manner such that it complies with relevant regulations?

# Anticipated Benefits

- Increase in patent quality
- Efficiency of examination is increased
- Examiner access to relevant prior art and supplemental information in a conveniently searchable manner
- Decreased applicant expense of submitting prior art documents and information disclosure statements
- Reduced burden for applicant compliance with duty to disclose information material to patentability

# Proposed Timeline

- Stage 1: Three track parallel information gathering
  - Track 1 – IT & Data Source Gathering
  - Track 2 – Application Studies Data Gathering
  - Track 3 – Data gathering from internal and external stakeholders
- Stage 2: Information Review
- Stage 2.5: Business Solution Development
- Stage 3: IT Development and Implementation

UNITED STATES  
PATENT AND TRADEMARK OFFICE



[summer.kostelnik@uspto.gov](mailto:summer.kostelnik@uspto.gov)