

PHEP TOPICS

CITATION OF PRIOR ART

Intellectual Property Owners
Association

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Recommendations From Industry IP5

- Automatic electronic Prior Art Citation Practice so Examiners can obtain prior art and no need for Applicants to cite what is available to Examiners.
- Consider adopting a Common Citation Form like the PCT Search Report and possibly form shared and uploaded among Offices.
- Could be incorporated in Global Dossier
 - Could Common Citation Document (CCD) be available in the passive component of the Global Dossier?
- Offices should clarify parameters for acceptance of machine translations.
- US – modify IDS requirements to minimize burden on Applicants
- EPO – eliminate incorporating prior art before grant
- JPO – KIPO eliminate incorporating prior art in specification.
- References mentioned in specification should be presumed reviewed by Examiner.

Basic Principles Important to Industry

- If it is publically available to examiner, it should satisfy the applicant's duty to cite the art
- Format should be the same in all offices
- Minimize the burden for all via electronic tools like CCD
- Provide maximum transparency to all offices and public

Progress Update

- We understand that the USPTO and KIPO are assigned this topic, and are exploring barriers, e.g.,
- What are the legal and procedural issues for
 - An IT based solution
 - A common form

For More Information:

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