PHEP TOPICS
CITATION OF PRIOR ART

Intellectual Property Owners Association

Lawrence T. Welch

Industry IP5
May 21, 2015
Suzhou, China
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:

Intellectual Property Owners Association (IPO)
1501 M Street, NW
Suite 1150
Washington, DC 20005

Phone: 202-507-4500 Fax: 202-507-4501
Web: www.ipo.org