



RECENT PROGRESS ON CITATION OF PRIOR ART

Meeting of IP5 Heads and IP5 Industry

Suzhou, 21 May 2015

Korean Intellectual Property Office
United States Patent and Trademark Office

1

Recent progress on citation of prior art



- **3 topics were endorsed at IP5 Heads meeting in June 2014**
 - Unity of Invention
 - **Citation of Prior Art**
 - Written Description/Sufficiency of Disclosure

- **2 prioritized sub-topics were selected at 3rd PHEP meeting in Oct. 2014**
 - Providing an IT based mechanism for the submission of prior art previously cited by other offices
 - Implementing an IP5 common form for citation of prior art

2

How were the two topics selected?



- **Main differences identified by IP5 comparison table**
 - Citation form of prior art : in the description, separate IDS
 - Result of violating requirement : rejection, unenforceable, deemed to be withdrawn

- **Inputs from IP5 industry**
 - Adopt an automatic, electronic prior art citation practice
 - Consider to adopt a common citation form similar to the PCT search report
 - Minimize burdens by citation of prior art requirement



IP5 agreed to focus on

- 1. IT based solution for citation of prior art**
- 2. Common citation form**



- **STEP 1** : Identifying differences among IP5 offices and user's needs [Completed]
- **STEP 2** : Identifying topics to focus [Completed]
- **STEP 3** : Identifying legal barriers [Completed]
 - ※ The report on practices and legal barriers of IP5 offices will be endorsed by IP5 Heads tomorrow and released to the public next week
- **STEP 4** : Begin to explore solutions [Prior to 4th PHEP Meeting]
- **STEP 5** : Implementation [TBD]



Thank You!

For further questions, please contact Sangheum.Cho@korea.kr and Summer.Kostelnik@uspto.gov