Insights: Publications

First Phase of USPTO Access to Relevant Prior Art Initiative Reduces Applicants' IDS Burden in Continuing Applications

OCTOBER 25, 2018 Written by Roger D. Wylie

The USPTO is implementing the long-awaited[1] Access to Relevant Prior Art Initiative ("RPA Initiative") with a first phase that begins on November 1, 2018[2]. The RPA Initiative will allow the USPTO to leverage its electronic resources to automatically provide examiners with access to relevant information, such as references cited, from a parent application for consideration in a continuing application. As such, it appears that the RPA Initiative will significantly reduce applicants' burden related to preparing and filing Information Disclosure Statements (IDS) in continuing patent applications.

Phase one of the RPA Initiative changes the way the USPTO handles relevant information from a parent (or "priority") application in a child (or "continuing") application and simplifies applicants' responsibilities related to this information, as described below.

1. The USPTO will automatically import reference citations from a parent application into a continuing application for the examiner to consider as part of her examination of the continuing application.

- The citations may have been provided by the examiner or the applicant in the parent case.
- Citations to U.S. patent documents, foreign patent documents, and non-patent literature (NPL) documents will be imported.
- The examiner will have ready access to copies of foreign patent documents and NPL documents associated with the imported citations, as well as any corresponding translations or explanations of relevance, if the copies are available in the parent application.
- Citations in the parent application not included in an IDS listing or cited by the examiner will not be imported, including, for example, citations in a third-party submission and citations listed in the specification.

2. The citations from the parent application considered by the examiner in the continuing application will automatically be printed on the face of the patent issuing from the continuing application.

- Imported citations will be identified on the face of the patent with a "double-dagger" to distinguish them from the other citations of record.

3. The applicant no longer needs to submit an IDS listing the references cited in the parent application to have those citations appear on the face of the patent.

4. The applicant's duty to disclose information in the continuing application is satisfied for information

considered in the parent application.

First Phase

The first phase of the RPA Initiative will begin on November 1, 2018 for applications that meet the following criteria.

Application Type

- Only non-provisional, continuing applications filed directly with the USPTO or having entered the national stage in the U.S. from a PCT application are eligible.
- Reissue applications are not eligible.

Filing Date

- To be eligible, a continuing application must be filed on or after November 1, 2018.

Priority

- The continuing application can only claim priority to a single U.S. parent application.
- The parent application can claim priority to an earlier-filed foreign patent application, but cannot claim priority to any earlier-filed U.S. applications.
- The claim for priority must be made in the continuing application and reflected on the filing receipt before the continuing application completes preexamination processing.

Art Unit

- Only applications being examined in a targeted subset of art units will be eligible for the Initiative in phase one starting on November 1, 2018.
- A larger group of art units will be participating in the Initiative starting on January 1, 2019.
- The targeted art units will be listed on the USPTO's RPA Initiative webpage.
- Examiners in the targeted art units will have access to a newly developed interface that will presumably assist them in considering imported citations under the Initiative.
- If a continuing application is initially assigned to an art unit within the RPA Initiative and is later transferred to an art unit outside the RPA Initiative, the application will remain in the Initiative.

An applicant cannot request inclusion in the RPA Initiative. The USPTO will determine whether an application meets the above criteria after preexamination processing is complete, which means that a filing receipt has been issued, there are no outstanding pre-examination notices, like a Notice to File Missing Parts, and the application has been classified and assigned to an art unit.

If an application is granted inclusion in the RPA Initiative, the USPTO will (1) import relevant information from the parent application into the continuing application, and (2) send the applicant a Notice of Imported Citations, which lists the citations that have been imported. No reply to the Notice is required, but applicants are encouraged to check the Notice carefully to determine which references were imported.

Once the examiner considers the imported citations, the applicant will receive a Notice of Consideration.

The Office will perform only a single importation of citations from the parent application. Only those citations present in the parent application at the time the citations are imported into the continuing application will be imported. Any references cited by the applicant or the examiner in the parent application after this single importation occurs will not be imported. To ensure such references are considered by the examiner in the continuing application and are printed on the face of the patent, the applicant must submit an IDS listing those later-cited references following the usual procedure.

Future Phases

The USPTO plans to consider data and stakeholder comments related to the first phase of the RPA Initiative before expanding the program. The public can provide comments on an ongoing basis by providing written suggestions and comments to PriorArtAccess@uspto.gov or via the IdeaScale.

In subsequent phases, the USPTO is considering growing the RPA Initiative as follows.

- Providing examiners access to citation information from other sources, such as other related U.S. applications, PCT applications, and counterpart foreign applications by the same applicant.
- Increasing the number of times relevant information is imported from a parent application.
- Including more art units so that the RPA Initiative will eventually be applicable in all applications regardless of classification.

Footnotes

[1] More than two years ago on August 29, 2016, the USPTO first requested public input on how the Office could provide examiners with relevant information from related applications by the same applicant at the earliest stage of examination. *Request for Comments and Notice of Roundtable Event on Leveraging Electronic Resources to Retrieve Information from Applicant's Other Applications and Streamline Patent Issuance*, 81 FR 59197 (August 29, 2016). The USPTO held a Roundtable on the topic on September 28, 2016 and received twenty-six comments from stakeholders the next month.
[2] The USPTO announced the RPA Initiative in a Federal Register Notice published October 25, 2018.

Related People



Roger D. Wylie
t 206.516.3092
rwylie@ktslaw.com