

Proposed Rules Change to Benefit from the Global Dossier Initiative

The Global Dossier Initiative is now up and running! It provides the American (or other counterpart) Examiner with the full prior art citations from parallel prosecution files.

Elimination of Redundant Citations of Prior Art: Given that the U.S. Examiner should study the parallel prior art citations, now is the time to modify 37 CFR § 1.56(a) to **exclude** from the duty to disclose any prior art that is included in the Global Dossier Initiative.

A PTO summary of the Global Dossier Initiative and the proposed change to modify 37 CFR § 1.56(a) are attached as part of the PDF version of this note.

Regards,

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37 CFR § 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98 **or made available to the Office by its inclusion in the Global Dossier Initiative.** However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application **unless included in the Global Dossier Initiative,** and
- (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office **or included in the Global Dossier Initiative.**

Global Dossier Initiative

Global Dossier is a set of business services aimed at modernizing the global patent system and delivering benefits to all stakeholders through a single portal/user interface. These business services of Global Dossier are being delivered incrementally.

In Spring 2015, the USPTO examiners were given access to the dossier information of the related IP5 applications. In June 2015, the USPTO became a providing Office, allowing access to US dossiers through IP5 Global Dossier User Interfaces. On November 20, 2015, the USPTO-hosted User Interface for Global Dossier was released, giving public stakeholders Dossier Access, which will make it easier for patent applicants to quickly and easily view, monitor, and manage intellectual property (IP) protection around the world by providing access to the dossiers of related applications filed at participating offices.

Global Dossier is a project being delivered by the **IP5 Offices** (<http://www.fiveipoffices.org/>). The IP5 is made up of: The European Patent Office (EPO), Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of China (SIPO), and the USPTO.

A **Global Dossier Task Force** (<http://www.fiveipoffices.org/industry-consultation/gdtf2015.html>) was created to ensure that the services developed align with the needs of all stakeholders. It is made up of the IP5 Offices, the **World Intellectual Property Organization** (<http://www.wipo.int/>) (WIPO), and IP5 Industry Groups: American Intellectual Property Law Association (AIPLA), Intellectual Property Owners Association (IPO), Business Europe (BE), Japan Intellectual Property Association (JIPA), Korea Intellectual Property Association (KINPA), and Patent Protection Association of China (PPAC).

In January 2015, the **Global Dossier Task Force** (<http://www.fiveipoffices.org/industry-consultation/gdtf2015.html>) meeting took place in Suzhou, China, where IP5 Industry identified five short-term goals for the Offices to explore. There was an agreement among the IP5 that each Office would define the scope of a particular topic identified by Industry Groups as short-term goals:

- Proof-of-Concept for Inter-Office Exchange – sharing documents between offices, e.g. prior art exchanges, supporting documents, bibliographic data updates, etc.
- Alerting Functionality – an automated mechanism that alerts other offices, applicants, and/or representatives when there is a change in the status of an application
- XML Document Provision – enabling the ability to download application content in XML format
- Applicant Name Standardization – an automated mechanism that will assign a single, unique name to entities with applications pending in multiple offices
- Legal Status – a mechanism to allow users to view the legal status of an application in another Office

The IP5 Offices are continuing to evaluate these short-term goals to determine which of these will be the next service to deliver.

Global Dossier will provide benefits to all stakeholders around the world.

KEY ADVANTAGES:

- Provides a single, secure point of access for the management of dossier and examination information
- Increases efficiency and predictability of global patent family prosecution
- Time and cost savings for patent applicants by reducing applicant burden
- Enables and encourages streamlining of Office procedures among different IP Offices
- Improves worldwide patent quality, resulting in higher value patents

The business services of Global Dossier are being designed with stakeholders in mind. Therefore, we are looking for stakeholder input, feedback, and suggestions and will be hosting focus session and information sessions throughout the entire development process. Stakeholders can also provide input, feedback, and suggestions on these five short-term goals through our [Global Dossier Ideascale](http://uspto-globaldossier.ideascale.com/) (<http://uspto-globaldossier.ideascale.com/>).

If you would like more information about Global Dossier or on how you can become involved with Global Dossier, please email GlobalDossier@USPTO.gov (<mailto:GlobalDossier@USPTO.gov>).

Global Dossier

Global Dossier - modernizing the global...

