



SLW INSTITUTE
GLOBAL IP CONFERENCE
with Advanced PCT Training | 2018

Track III: Strategic IP Management

IMPROVING PATENT FILING PROCEDURES & SYSTEMS

Presenters



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What is the IP5?

- The Five IP Offices (IP5) is the name given to a forum of the five largest intellectual property offices in the world that is being set up to improve the efficiency of the examination process for patents worldwide. The members of IP5 are:
 - the European Patent Office (EPO)
 - the Japan Patent Office (JPO)
 - the Korean Intellectual Property Office (KIPO)
 - the State Intellectual Property Office of the People's Republic of China (SIPO)
 - the United States Patent and Trademark Office (USPTO)
- The IP5 Offices account for 90% of all patent applications filed worldwide
- 93% of all work carried out under the Patent Cooperation Treaty (PCT).
- The vision of the IP5 Offices is global co-operation, which has been defined as "the elimination of unnecessary duplication of work among the IP5 Offices, the enhancement of patent examination efficiency and quality and guarantee of the stability of patent right".
- The objective is to address the ever-increasing backlog at the world's five biggest intellectual property offices. As the world sees economic barriers between nations fade away, innovators want their intellectual creations protected concurrently in multiple major markets. Hence, applications for the same technology are filed at more than one patent office. The solution to the backlog problem is to reduce, to the maximum extent possible, the duplication of work which takes place at each office for a family of patent applications.





Common Projects in IP5 Working Group

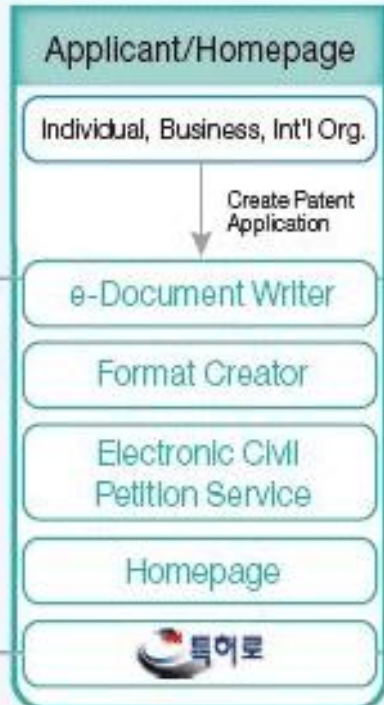
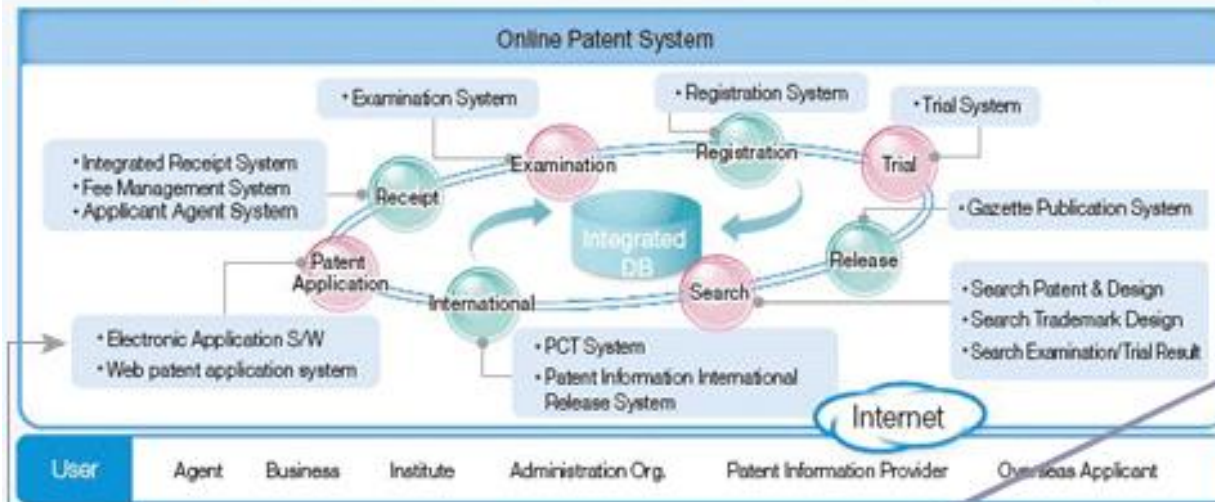
- **Inter-Office Document Sharing:** The next stage to the Inter-Office Document Sharing involves utilizing the data currently available in the Global Dossier to help complete Office specific forms and documents.
- **XMLization:** All the IP5 offices will try to develop their own system towards the full XMLization with sets of common or corresponding XML tags for major outgoing and incoming documents will be agreed among the IP5 offices.
- **Legal Status:** The IP5 offices will engage in providing standardized legal status.
- **Alert Functionality:** Each IP5 Office will continue to strive towards developing its own Alerting service based on RSS pending further analysis and according to the requirements of its users.
- **Standardized Applicant Name:** The IP5 offices are considering approaches that no changes on applicants name would be made without applicants' approval.



ELECTRONIC FILING



KIPOnet System Structure



Global Dossier

uspto

About Us Careers Contact Us

Global Dossier

Home Public Pair Common Citation Document Citation list **BETA**

Service Availability Help Email us

Office US Type Application Ex: XXnnnnnn

★ Collections 0 History 0

→ JPO Supplementary Service is down for maintenance
→ JPO Dossier Access Service is down for maintenance

Welcome to Global Dossier

Global Dossier Initiative

The Global Dossier Initiative is a set of business services being developed by the [IP5 Offices](#) (USPTO, EPO, JPO, KIPO, and SIPO) aimed at modernizing the global patent system and delivering benefits to all stakeholders through a single portal/user interface. Global Dossier will provide a single, secure point of access for the management of dossier and examination information, enabling and encouraging streamlining of office procedures among different IP Offices. This will lead to improved efficiency and predictability of global patent family prosecution with increased cost savings provided to patent applicants.

For more information, on the please visit the [Global Dossier Initiative](#) page.

Global Dossier Public Access

The first service being provided by the Global Dossier Initiative is a secure, online access to the file histories of related applications from participating IP Offices, which currently include the IP5 Offices.

By using this service, users can see the patent family for a specific application, containing all related applications filed at participating IP Offices, along with the dossier, classification, and citation data for these applications. This service also provides Office Action Indicators to help users identify applications that contain office actions, a Collections View for saving documents and applications for review later on in the session, and the ability to download the documents in an application.

Citation List **BETA**

As part of the Global Dossier Initiative, the USPTO is pleased to announce the beta release of the Citation List. The Citation List is part of the USPTO's ongoing efforts to provide a more comprehensive listing of relevant citations that are available in related applications that share a common priority claim.

During the beta, the USPTO hopes to receive feedback from users on future enhancements and functionality to be included in subsequent releases of the Citation List. Users may submit their feedback to GlobalDossier@uspto.gov or through the [Ideascale website](#).

View: [Citation List](#)

<https://globaldossier.uspto.gov/#/>

Patent Examination Data System (PEDS)

- PEDS is part of the USPTO's effort to make open and machine-readable data the new default for government information.
- PEDS lets customers retrieve and download multiple records of USPTO patent application or patent filing status at no cost.
- PEDS contains the bibliographic, published document and patent term extension data tabs in Public PAIR from 1981 to present. There is also some data dating back to 1935.



Patent Examination Data - PEDs

Patent Examination Data System

Use Patent Examination Data System to search and download large sets of data

- Using the fields on the left, narrow down the results to your desired dataset
- Request the results as a download
- The requested files will be packaged and you will receive a notification in the application when it is ready to download

[Send Feedback](#)

Download the entire dataset

Entire dataset (4.3 GB/.zip)
Updated Fri 06 Oct 2017 08:21:19-0400

JSON **XML**

Sample Result

APPLICATION DATA		
Application Number:	09/813,611	Correspondence Address Customer Number: 34477
Filing or 371 (c) Date:	03-21-2001	Status: Patented Case
Application Type:	Utility	Status Date: 11-14-2002
Examiner Name:	BEACH, THOMAS A	Location: FILE REPOSITORY (FRANCONIA)
Group Art Unit:	3671	Location Date: 05-03-2016
Confirmation Number:	3018	Earliest Publication No (PGPUB): US20020134552A1
Attorney Docket Number:	2000.036	Earliest Publication Date: 09-26-2002
Class / Subclass:	166/339000	Patent Number: 6488093
First Named Inventor:	Jeff H. Moss All inventors	Issue Date of Patent: 12-03-2002
First Named Applicant:	-	AIA (First Inventor to File): No
International Registration Number (Hague):	-	Entity Status: UNDISCOUNTED
International Registration Publication Date:	-	
09815351	> TUBING HANGER SYSTEM	Patented Case
09815436	> INTERNAL GATE VALVE FOR FLOW COMPLETION SYSTEMS	Patented Case

PALM Transaction Data

DATE	CODE	DESCRIPTION
05-02-2016	LFFOUND	File Marked Found
04-18-2016	LFFOUND	File Marked Found
10-15-2007	C.ADB	Correspondence Address Change
12-03-2002	PGM/	Recordation of Patent Grant Mailed
12-03-2002	PTAC	Patent Issue Date Used in PTA Calculation
11-14-2002	WPTR	Issue Notification Mailed
11-04-2002	R1021	Receipt Into Pubs
10-31-2002	PILS	Application Is Considered Ready for Issue
10-29-2002	R1021	Receipt Into Pubs
10-18-2002	MM327	Mail Miscellaneous Communication to Applicant
10-18-2002	M327	Miscellaneous Communication to Applicant - No Action Count
09-25-2002	N084	Issue Fee Payment Verified
09-25-2002	IFEE	Issue Fee Payment Received
09-18-2002	R1021	Receipt Into Pubs
08-26-2002	SENT	Workflow - File Sent to Contractor
08-26-2002	R1021	Receipt Into Pubs
08-12-2002	R1021	Receipt into Pubs
08-09-2002	D1220	Dispatch to Publications
08-08-2002	MN/-	Mail Notice of Allowance
07-29-2002	N/-	Notice of Allowance Data Verification Completed
07-22-2002	FWDX	Date Forwarded to Examiner
07-09-2002	A...	Response after Non-Final Action
06-12-2002	WIDS	Information Disclosure Statement (IDS) Filed
06-12-2002	M844	Information Disclosure Statement (IDS) Filed
04-12-2002	WIDS	Information Disclosure Statement (IDS) Filed
04-12-2002	M844	Information Disclosure Statement (IDS) Filed
04-02-2002	HCTNF	Mail Non-Final Rejection
03-22-2002	CTNF	Non-Final Rejection
03-08-2002	DOCK	Case Docketed to Examiner in GAU

Developer Hub for Patent Filing Data

Open Data @USPTO. Become innovative.

Data can be beautiful. Our growing library of visualization >

Share with us. An Open Data community >

Explore our data. A catalog of our data products >

Make something. Our library of APIs >

Application Programming Interfaces

PatentsView	BDSS	Unified Event API
Version: 1.0.0	Version: 1.1.0	Version: 1.0.0
The PatentsView API is intended to inspire the exploration and enhanced understanding of US intellectual property L...	Bulk Data Storage System (BDSS) API allows the public to discover, search by date, and download patent and trademark...	USPTO sponsors/hosts a wide variety of public facing events daily. USPTO publishes information about these events on...

Open Data Portal (beta)

Utility Patent Application & Grant Count (2 visuals)

Combination of Patent Application Counts & Grant Counts Foreign vs. U.S. Origin

View Story

Explore. Discover. Create.

Data tells you what's happening. A good story is not only engaging but gives you insight as to why the data matters. The Patent and Trademark Office wants to make information more transparent and useful to its users, so we are providing you with new ways to explore our data through interactive visualizations. Now you can custom adjust USPTO data in real time to discover new insights and ask questions about why the data matters. Create new visualizations of your own and share your discoveries with others in the community.

Created something with our data?

Let US KNOW

Share your work with the USPTO Open Data Community - use the button below to submit your work.

Share your work

Want to make a visualization?

Explore

Open Data Portal (beta)

USPTO APIs

See what new APIs the US Patent and Trademark Office have come out with.

What is an API?

An API is an application programming interface. It is a set of routines, protocols, and tools for building software and applications. A good API makes it easier to develop a program by providing all the building blocks, which are then put together by the programmer.

For each of the APIs links are provided to the associated syntax or Swagger documentation, Swagger is used to define a standard, language-agnostic interface to REST APIs which allows both humans and computers to discover and understand the capabilities of the service without access to source code, documentation, or through network traffic inspection. Other documentation and a client interface that demonstrates the associated API is also provided.

Created something with our data?

Let US KNOW

Share your work with the USPTO Open Data Community - use the button below to submit your work.

Share your work

PatentsView	BDSS	Unified Event API
Version: 1.0.0	Version: 1.1.0	Version: 1.0.0
The PatentsView API is intended to inspire the exploration and enhanced understanding of US intellectual property L...	Bulk Data Storage System (BDSS) API allows the public to discover, search by date, and download patent and trademark...	USPTO sponsors/hosts a wide variety of public facing events daily. USPTO publishes information about these events on...
API Syntax View on Client Application API documentation	API Syntax View on Client Application API documentation	API Syntax View on Client Application API documentation
Patents	Patents, Trademark	Events
View API details	View API details	View API details

Open Data Portal (beta)

Our community

Our open data community is an aggregate of open data developer community contributions and provides a place to showcase your ideas, talents, and innovative uses of USPTO data.

Search by tags: Sign typing to add tag, separate with a comma.

Filter: Reset

Filter by: All Developer communities Our community Social media

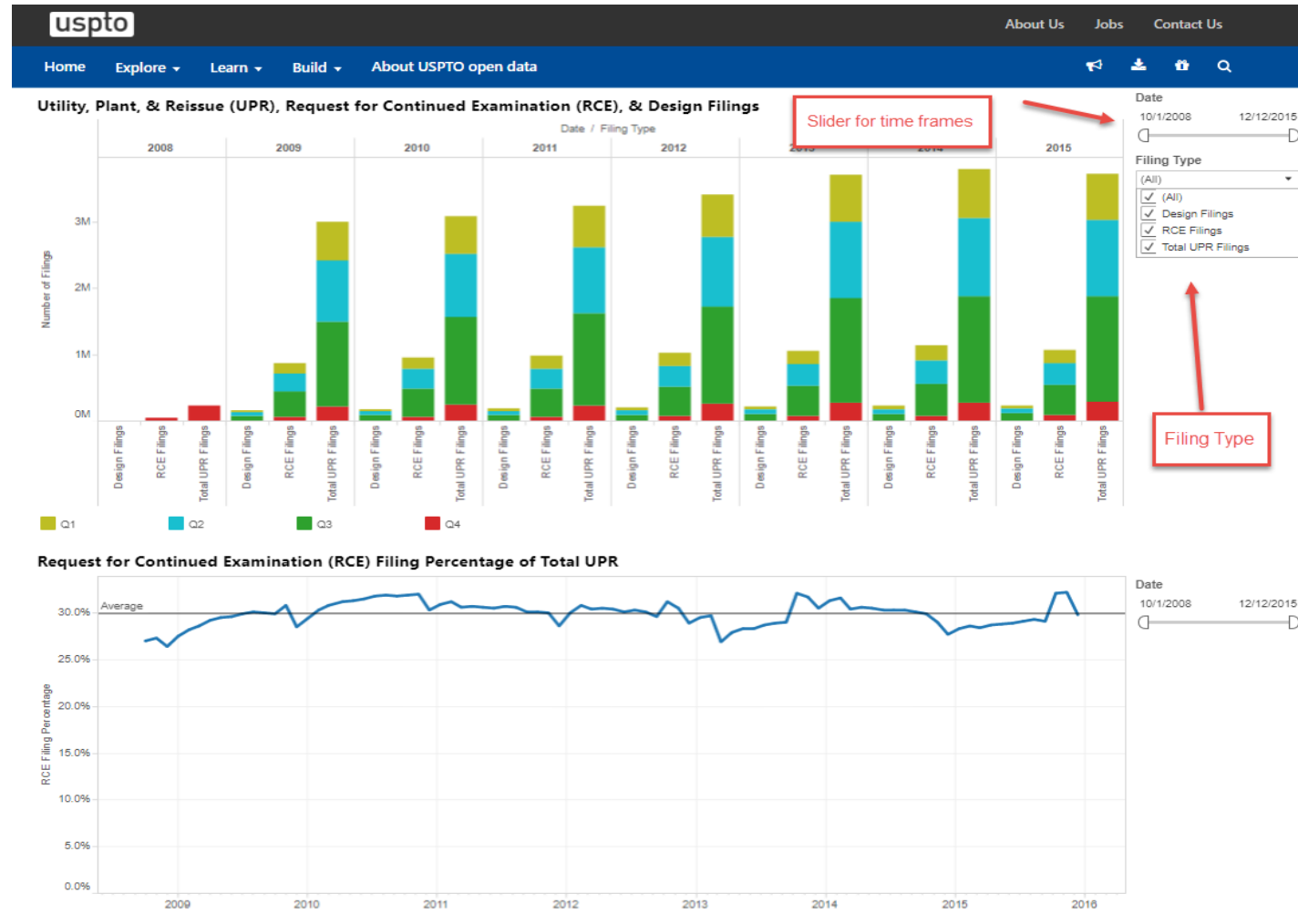
Mobile App for 200 Government Services	Using Data to Drive Your Decisionmaking	Models to Help Business Manage Change	Consumer Finance Protection Board Updates Site	The Normal Entrepreneurs
By USPTO Monday, April 25, 2016 - 15:02	Other Subsector Weekly Sales	By USPTO Monday, April 25, 2016 - 14:04	By USPTO Monday, April 25, 2016 - 13:55	By USPTO Monday, April 25, 2016 - 13:55
Our community Report this post	Our community Report this post	Our community Report this post	Our community Report this post	Our community Report this post
Successful Launch	By USPTO	By USPTO	By USPTO	API: Need Enterprise Support

<https://developer.uspto.gov/>

SLW INSTITUTE
GLOBAL IP CONFERENCE
with Advanced PCT Training | 2018



Interactive Patent Filing Data Site



Law Firms/IP Departments

- Electronic patent office databases, e-filing, document sharing, and electronic reporting improvements have allowed law firms to increase overall transparency, efficiency and overall productivity
 - Online patent office databases improve file intake and review, and streamlined docketing procedures
 - Electronic filing systems allow for high volume filing with near 24/7 availability
 - Global Dossier can be utilized foreign file wrapper intake/review and reference citation, including obtaining translations of foreign prosecution documents
 - Access to patent analytics, including filing and examiner data, along with a proliferation of file sharing methods means that law firms/client counsel can more easily make strategic filing and prosecution decisions



Improved Online Patent Office Access

- Advancements in PAIR, WIPO, EPO and other patent office databases have impacted how law firms:
 - Receive correspondence/notifications from patent offices
 - Open files received as part of a file transfer or intake
 - Populate firm/client databases and set docketing rules
 - Search patent and application data and image databases



Example 1: Electronic PTO Correspondence

- Customer correspondence scraped and OCR'd to identify document type and deadlines
 - Set rules for automatically adding correspondence templates and due dates in case management system
 - Automatically upload copies of documents
 - Identify inconsistent or unspecified document and flag for review
 - Immediately notify internal/external personnel



Electronic Filing Systems

- EFS, ePCT, other electronic filing systems have greatly expanded the available filing period for firms (24 hour availability in many cases)
- Require internal systems and applications for creating, naming, storing, retrieving, and uploading to electronic databases
- Demands attorneys/staff/inventor filers have new and evolving skills processing documents and troubleshooting issues with interfaces or applicable programs
- Proliferation of applications and licenses for managing documents at every stage of the document lifecycle



Example 2: Electronic Citation of References

- Volume and size of IDS references necessitated special tools to be able to cite timely and efficiently. Possible needs include tools for:
 - Bulk downloading from reference database;
 - Bulk renaming of documents to USPTO requirements (remove spaces, special characters) and ordering documents in order indicated on 1449/SB08 form;
 - Flattening/removing embedded fonts (Acrobat, PDF 995, other); and
 - Bulk uploading multiple documents and types (foreign patent, non patent literature) to patent database (AutoHotkey, custom scripting language)
 - By employing all of the above, we've been able to keep up with our duty of disclosure (>8000 IDS's citing >600,000 references over the last two years)



Global Dossier / Inter-Office Document Sharing

- Single portal for locating file wrappers, documents, global patent family information and translations
- Lessens the need to request documents from foreign agents or separate machine or human translations of foreign language documents
- Requires training and procedures for attorneys/staff for utilizing and downloading documents.
- Law firms still have to act as the conduit in many cases between the patent offices
- Promising new features (Citation List) to streamline identification of common citations across patent families with a shared priority claim



Sharing Analytics / Documents with Clients

- Filing and Examiner data publicly available for compiling into databases or client reports
- However, the size and volume of data being shared across firms to client has led to the need for secure file sharing and collaboration platforms (Box, OneDrive, DropBox, Google Drive, SugarSync, etc.)
- Law firms/In-house attorneys have to be able to make sense of the data (analysis/recommendations) and also keep up with client-driven data or reporting requirements
- Increasing demands on law firms/IT departments regarding data access, security, navigation, and storage of documents across multiple platforms
- Need for processes for incorporating all the available data into standardized, useable reports for internal dissemination or to supplement client report outs



Example 3: Samples of patent analytics/data to make prosecution decisions

Examiner Name: ZHOU, QINGZHANG

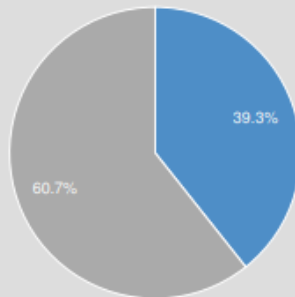
Group Art Unit: 3752 | Class: 239

Allowance vs Abandonment Rates

This examiner has 160 matters allowed, and 247 matters abandoned. That's a 39.31 % allowance rate. The patent office average allowance rate in the class is 58%. The patent office average allowance rate in the art unit is 56%.

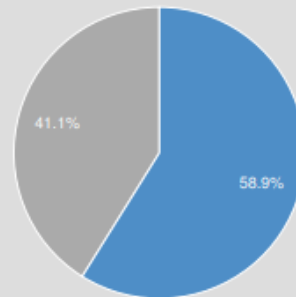
Examiner Allowance vs Abandonment

● Allowed ● Abandoned



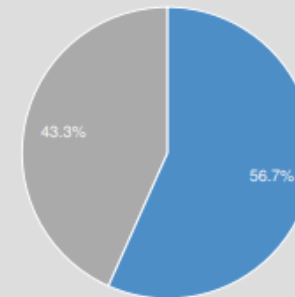
Class Allowance vs Abandonment

● Allowed ● Abandoned



Art Unit Allowance vs Abandonment

● Allowed ● Abandoned

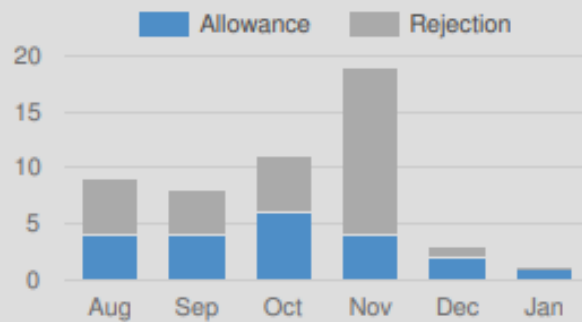


Example 3: Samples of patent analytics/data to make prosecution decisions

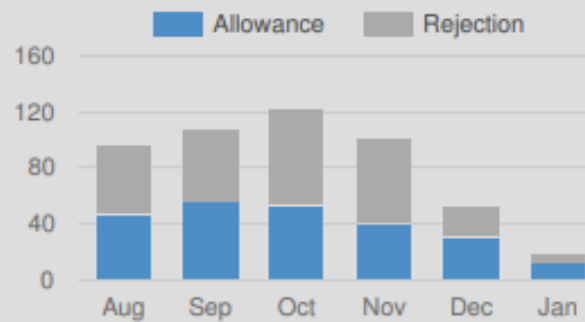
Allowances vs Rejections in the Past 6 months

This examiner has had a total of 52 positive dispositions, and 35 negative dispositions. That's a 59.77 % allowance rate. The patent office average allowance rate for this class is 76.91%. The patent office average allowance rate for this art unit is 76.45%.

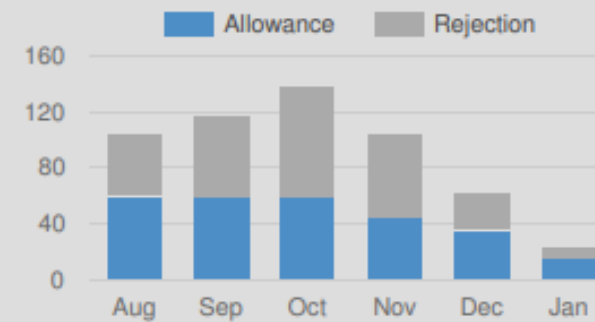
Examiner Allowance vs Rejections



Class Allowance vs Rejections



Art Unit Allowance vs Rejections



Example 3: Samples of patent analytics/data to make prosecution decisions

Activity	Mailing Date	101 Rejection	Art Unit #	Examiner
Non-Final Office Action	12/23/14	<p>Claims 1, 3-13, 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claim(s) as a whole, considering all claim elements both individually and in combination, do not amount to significantly more than an abstract idea.</p> <p>Claims 1, 15, 18 are directed to the abstract idea of data gathering, calculating, determining, comparing and generating an output. Viewed as a whole, these claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself. The additional elements or combination of elements in the claims 15,18 other than the abstract idea per se amount(s) to no more than mere instructions to implement the idea on a computer and by recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the industry. Viewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself. Therefore, the claims 1, 15, 18 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.</p> <p>Dependent claims 3-13, 16, 17, 19, 20 merely contains additional abstract instructions, and like claims 1, 15,18, the claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself.</p>	3748	DIEM TRAN



Some Tips for Success

- Identify champions within your organization for monitoring changes and identifying opportunities occurring across patent offices
- Look within your organization for the most repetitive items/tasks and then work to identify tools/efficiencies to automate those tasks
- Hire employees that can keep up with an increasingly data-driven electronic landscape
- Wherever possible, try to integrate and replicate successful client-drive processes with other clients



Corporate Patent Departments

- Corporate patent departments have clients too!
- We must be able to track our invention disclosures and patent applications from inception to expiration
- Expectations are high
 - We must be able to provide timely, relevant, and comprehensive reports to our executive teams and internal business partners
- We require immediate access to documents and current data in our portfolio
- Clean and current data from reliable sources is critical
- None of this is possible without a variety of electronic systems in place



Sources of Data

- Corporations rely on a variety of sources for patent data
 - Our internal docketing system
 - FoundationIP, Anaqua, CPI, Memotech etc.
 - Our law firms
 - Electronic report outs of work done on our behalf within 24 hours of completion
 - Access to our data in firm databases
 - Patent offices
 - Use of Customer Numbers specific to our company for access to our data via Private Pair
 - Subscription sources like Innography, Thomson Innovation etc.
 - Annuity services like CPA, CPI, Dennemeyer
 - Free web sites like Google Patents



Aggregating and Sharing Data

- All of this data must be aggregated into a central location for easy access and use
- Through the use of propriety internal tools, APIs, web services etc. we can aggregate the data from these multiple sources into one database
- This allows us to track and share comprehensive data quickly and efficiently
- We can eliminate or reduce tasks that are time consuming and inefficient
 - Automation of reports and dockets that are distributed electronically
 - Online submissions of new ideas electronically by inventors/technologists
 - Automated distribution of the ideas to patent committees, OC, tech teams
 - Automated email responses at various stages of the patent process
- We can provide company-wide access to pending applications and issued patents which are updated automatically and always current
 - Providing “self-service” access reduces demands on patent team for information/email responses
 - Ability for managers to see ideas and patent applications filed by their direct reports
 - Pretty charts and graphs that are predefined and can be copied/pasted into presentations on demand



Some Tips for Success

- Embrace technology and new tools and invest in training
- Automate workflows in the corporation to track deadlines and identify potential problems
- Working closely with your patent firms is critical
 - You need each other to be successful!
 - Expectations should be consistent and clearly communicated
 - Written procedures and guidelines are essential and should be enforced uniformly across all firms to insure consistent work product and timely data
- Communication is vital!
 - Are firms getting all of the information they need from you?
 - If possible, grant access to each others tools
 - Do they understand the work flows on the corporate side?
 - Is there a point of contact that will respond quickly if they have questions?
 - Are there clear escalation procedures in place when problems arise?
- Are there systems in place to audit your data?



Questions?



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