



Innovative Leveraging of Private PAIR in Your Patent Practice

Improve Efficiency, Effectiveness and Mitigate Risk Using XML Data from the USPTO

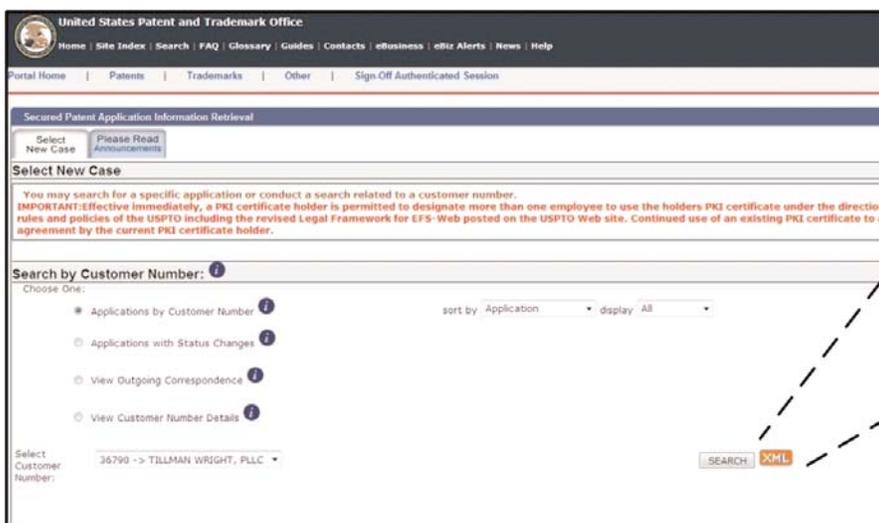
by Chad D. Tillman

Most patent practitioners are aware that the U.S. Patent & Trademark Office (USPTO) provides an online interface – commonly referred to as "Private PAIR" – for viewing information regarding their patent cases. "Private" refers to the fact that the information that is available includes both publicly available information as well as information that is not available to the general public. "PAIR" is an acronym that stands for "patent application information retrieval."

Practitioners gain access to the Private PAIR system by logging in using a digital certificate known as a "PKI" certificate.

The practitioner's PKI certificate is typically associated with one or more customer numbers, and each patent case is typically associated with one of those cus-

each patent case linked to that customer number, while a second file includes information regarding outgoing correspondence from the USPTO for each patent case linked to that customer number. In addition to these two files, the XML data includes, for each patent case, a file that includes very detailed information for that patent case. The detailed information



tomers. A patent practitioner can thereby gain access to each patent case that is linked to any customer number associated with that practitioner's PKI certificate.

Few patent practitioners are aware, however, that the USPTO also provides, via Private PAIR, the ability to download XML data for all patent cases that are associated with a practitioner's PKI certificate.

The XML data available via Private PAIR includes two files, each associated with the customer number. One file includes very high level information for

generally includes the types of information that may be viewed online in Private PAIR, such as inventor information, file history information, and continuity information.

With the XML data, a practitioner can view the most recent updates available in all of his or her cases. The updates provided by the XML data include indications of upcoming allowances as well as forewarning of upcoming Office Actions. This information may be quite useful to the practitioner.

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For example, merely knowing that a case is under first examination and that an Office Action is shortly forthcoming can provide the practitioner a short window of time in which to determine if any prior art references should be cited. If it is determined that references do need to be cited, an information disclosure statement (IDS) can be filed without needing to pay the IDS fee (currently \$180) that would be required if the same filing is made after the first Office Action on the merits has been mailed.

Importantly, the XML data represents the most current information available to patent practitioners. Indeed, the XML data often predates the information that can be seen online in Private PAIR itself. For example, the XML data for one of the cases that I am prosecuting had an indication of allowance back in June 2009; however, it was not until January 2010 that any indication of allowance appeared online in Private PAIR itself. Knowing of the allowance back in June allowed me to make strategic decisions during the prosecution of related applications, thereby providing better service to my client and making me a more effective practitioner.

The XML data is useful for client status reports, too, as the data does not require the manual edits that may be necessary for reports generated from a firm's docket system. Other than excerpting the XML data for a particular client, no "scrubbing" or updating of the data is required by the practitioner. The information comes straight from the USPTO, and is current as of that day.

And, if a practitioner is willing to reformat the XML data, it is likely that the XML data can be directly imported into a firm's docket system, avoiding a lot of manual data entry.

Unfortunately, accessing and utilizing the XML data is impractical for most patent practitioners, and the foregoing theoretical benefits are not enjoyed in practice.

One of the obstacles to practical use of the XML data is the lack of any guidance by the USPTO regarding how a practitioner might make use of such data. The techniques presented above have been

developed by the author only after extended investigation and experimentation.

Nor are the actual steps to acquiring the XML data particularly straightforward. Indeed, merely acquiring just the high level information for all of one's cases requires the separate steps of manually selecting and downloading the pair of XML files for each customer number. The author's firm owns three customer numbers, thus requiring six separate manual downloads. Furthermore, once acquired, the XML data in each downloaded file needs to be merged into a single file, which can be time consuming.

Consequently, the USPTO has done a great job of making critical information available to practitioners, but has failed to enable practitioners to make practical use of that data, leaving the theoretical benefits unrealized. In practice, few practitioners actually acquire and make use of the XML data provided by the USPTO.

Fortunately, a recent commercial offering by Nimvia, LLC—a sponsor of the recent NC IP Section annual meeting—includes innovative software tools that automate the acquisition of the XML data. Using Nimvia's software, available at www.nimvia.com, the XML data can be automatically acquired and processed on a daily basis, with reports being made available to the practitioner that show all recent updates, including both status and transaction changes.

The reports further include case listings, which can be efficiently used as an effective means for generating status reports for clients. An examiner listing shows all cases before a particular examiner, which can be helpful for a practitioner planning to conduct interviews, and a status report shows all of a practitioner's cases grouped by status, whereby the practitioner can quickly review, for example, all cases under final rejection, or can quickly review all cases in which notices of allowances are outstanding. The reports also enable filtering out of cases so that only those cases of particular interest to the practitioner are reported. The information is more current than what can be expected from firm dockets, and does not require any data entry by the user.

Nimvia's software also can be configured to send out an email alert showing that day's recent updates. This email capability exceeds that of the eOffice Action program currently offered by the USPTO, which requires that a practitioner forego actual paper mailings and which only alerts the practitioner to issuance of Office Actions.

Another offering in the works at Nimvia is a personal docketing program that can be instantiated on demand using the XML data. By leveraging the XML data in this way, the labor-intensive steps

of receiving both physical and electronic USPTO mail and making corresponding docket entries can be omitted entirely. Using the UPSTO as the primary source for a docket further enables a practitioner to avoid missed deadlines for USPTO mail that for some reason fails to reach the practitioner or is subsequently lost. The proverbial Office Action "lost in the mail" no longer presents a risk of a missed deadline, as the docket program will have a record of-and alert the practitioner to-the Office Action, even though it was never received.

Using the innovative software now being offered, the potential benefits of the XML data provided by the USPTO can be readily unlocked and realized by practitioners in their daily practice. ■

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When is Art Not Art?

Why Scientific Disclosures May Not Bar Patentability

by Robert A. Schwartzman, Ph.D.

It is customary for scientists to share their research results with fellow scientists, both for recognition and to further their careers. This desire, however, often conflicts with the need to keep results "under wraps" so that public disclosures do not prevent the scientists from obtaining patent protection for inventions developed through their research. This conflict arises frequently in academic settings. Faculty members, postdoctoral fellows and graduate students need to give seminars and present posters on their work in order to further their research and careers. Meanwhile, university technology transfer personnel are continually trying to educate scientists to not disclose their work until patent applications are on file. The result frequently is that public disclosures are made, and the technology transfer officer wrestles with the decision of whether it is worth filing a patent application at all.

There is a general impression that any kind of public disclosure results in (a) an immediate automatic bar to patentability in absolute novelty jurisdictions (such as Europe and Japan), and (b) starts the "one year clock" towards a statutory bar in the United States. This, however, is not neces-

sarily true. While this article will focus on U.S. law, the general impression is not always correct in foreign jurisdictions either. *See, e.g., Macor Marine Systems/Secrecy Agreement*, T830/90, [1995] EPOR 21 (23 July 1993) (circumstances may indicate confidentiality of a document even in the absence of a written confidentiality agreement).

In the United States, 35 U.S.C. § 102 states that a person shall be entitled to a patent unless:

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

The printed publication provision was intended to prevent withdrawal by an inventor of subject matter that was already in the possession of the public. *In re Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981). There is a long history of jurisprudence on the issue of what is considered to be a "printed publication." As publication techniques and the ability to search for

documents have evolved, the definition of "printed publication" has also changed. What we are left with today is a very fact-specific analysis that must be applied on a case-by-case basis. Thus, any given public disclosure should be evaluated before it is deemed a "printed publication" within the meaning of the statute and therefore a bar to patentability.

The touchstone for a finding of a "printed publication" is public accessibility. In determining whether a public disclosure is a printed publication, two separate factors must be considered: (1) whether the disclosure is publically available; and (2) whether one interested in the subject would be able to learn of the disclosure's existence and potential relevance. There is a long history of case law in this area, with a surprising number of relevant cases decided in the last two years. The cases tend to fall along two different lines. The first line includes the "library cases," which typically involve the question of whether a single copy of a publication (often a student thesis) sitting on a shelf in a library counts as a publically accessible document. The second line includes the "dissemination cases," which

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