



**COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION AND
PUBLIC KNOWLEDGE REGARDING LEVERAGING ELECTRONIC RESOURCES
TO RETREIVE INFORMATION FROM APPLICANT’S OTHER APPLICATIONS
AND STREAMLINE PATENT ISSUANCE**

Docket No. PTO–P–2016–0026

The Electronic Frontier Foundation (“EFF”) and Public Knowledge are grateful for this opportunity to respond to the request by the United States Patent and Trademark Office (“USPTO”) for comments regarding leveraging electronic resources and streamlining patent issuance. EFF is a nonprofit civil liberties organization that has worked for more than 25 years to protect consumer interests, innovation, and free expression in the digital world. EFF and its more than 25,000 dues-paying members have a strong interest in helping the courts and policy-makers to ensure intellectual property policy furthers the public interest. Public Knowledge is a non-profit organization that is dedicated to preserving the openness of the Internet and the public’s access to knowledge; promoting creativity through balanced intellectual property rights; and upholding and protecting the rights of consumers to use innovative technology lawfully.

I. Introduction

With respect to questions 1-4, EFF and Public Knowledge broadly support the USPTO’s efforts to leverage electronic resources to make it easier for examiners to locate and review information regarding related applications. We urge that this should be seen as a quality initiative rather than a path to quicker examination. Also, since examiners cannot be expected to review all information available to them, applicants must still be required to identify material information in related applications. Regarding question 5, we submit that the Public PAIR database is not an adequate substitute for clear and accurate information on the face of a patent. We discuss these submissions in more detail below.

II. The USPTO Should Ensure That Improved Access To Related Application Data Improves Patent Quality (questions 1-4)

General observations

Examination will be improved by easier access to potentially material information. However, examiners will always need assistance finding the most relevant information. Thus, the USPTO should not treat easy availability of this information as in any way reducing or abrogating the duty of disclosure under MPEP 2001.06(a)-(c). Information disclosure is required to satisfy the patent attorney's duty of candor, and that requirement must be satisfied whether or not the examiner actually looks at the information and whether or not the information was otherwise available to the examiner. *See, e.g., Bone Care Int'l, LLC v. Pentech Pharm., Inc.*, No. 08-CV-1083, 2010 WL 1655455, at *5 (N.D. Ill. Apr. 23, 2010) (applicant must identify material information even if same examiner had been made aware of the material in related applications).

We also urge the USPTO to treat this initiative as a quality initiative rather than as an efficiency initiative. Any improvements in search time will likely be offset by time taken to adequately review the additional material. There is strong evidence linking patent quality to the amount of time actually spent by examiners reviewing prior art. *See* Michael D. Frakes & Mellissa F. Wasserman, *Is the Time Allocated to Review Patent Applications Inducing Examiners to Grant Invalid Patents?: Evidence from Micro-Level Application*, NBER Working Paper No. 20337 (July 2014), available at <http://www.nber.org/papers/w20337>. We urge the USPTO not to consider search efficiency improvements as a reason to reduce examination time.

Response to question 1.

The USPTO should endeavor to make as much information automatically available as possible. But information from closely related applications, such as domestic parent and counterpart foreign applications, should be the first priority.

Response to question 2 & 3.

As noted above, applicants should still be required to identify material information in related applications. See 37 C.F.R. § 1.56. One urgently needed way to help examiners find the most relevant information would be the use of custom tools that let examiners automatically search and analyze related applications, including IDS references from related application. The USPTO should make building these tools a high priority. The potential importance of these

documents to examination means that efficiency and quality gains from such tools would quickly justify resources spent building them.

Response to question 4.

EFF and Public Knowledge believe that the record should reflect whether or not an examiner actually reviewed material from a related application. The USPTO should, akin to what it does in ex parte reexams, include an express disclaimer noting that references not starred have not been reviewed. Specifically, the principle announced in MPEP 2256, with respect to reexams, should be applied more generally. This states that the requisite degree of consideration to be given to information available to the examiner:

[W]ill be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the document. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary in the record, do not signify that the document has been considered by the examiner any further than to the extent noted above.

Ultimately, a patent owner facing a validity challenge in another forum (such as district court) should not be able to suggest that material was considered unless it was actually reviewed by the examiner. Similarly, the record should be as clear as possible regarding the extent to which references were considered and for what purpose. As MPEP 2256 notes, that will, in large part, be determined by how the information is presented and explained by the applicant. Improved access to electronic resources may improve examination overall, but it will not alter this underlying reality.

III. The USPTO Should Continue to Promote Notice By Including Useful Information on the Face of the Patent (question 5)

Patents should be as clear as possible to the public. This public notice function is best served by having information available on the *patent itself*. EFF is regularly contacted by individuals and small businesses who have received a patent demand letter. In our experience, many targets of such demands are not highly familiar with the patent system and may not even be aware of the Public PAIR database. Moreover, navigating a patent file history, especially on PAIR, is a laborious and time-intensive task compared to reviewing the face of a patent, and imposing that burden on every single demand letter recipient takes time from technology creators

that could otherwise be going to productive activities of innovating. Ultimately, we believe that the information on the face of the patent remains very important to public notice.

Public PAIR is a poor substitute for the face of the patent. While the USPTO has made improvements in recent years, patent information is still only available on its websites via a set of fragmented and user-unfriendly databases. For example, users have to navigate to different databases to find file wrappers or assignment documents. And every visit to Public PAIR requires completing a CAPTCHA challenge. Moreover, users can be locked out for making too many downloads. See Donald Zuhn, PatentDocs, *USPTO Places Limits on PAIR Downloads*, May 7, 2015.¹ Critics have even suggested that PAIR contains numerous omissions and errors. See Kristin Whitman, Intellogist, *Warning: your electronic patent search databases have gaps!*, October 13, 2010.² At the very least, the USPTO should not assume the public can rely on PAIR without significant improvements in the user interface and a thorough accounting of the database's completeness and accuracy.

EFF and Public Knowledge believe that all of the information currently on the face of the patent should be kept. Keeping the current format is beneficial because there are many guides regarding how to read the front page of a patent geared to the current system.³ We especially urge the USPTO to keep all information relevant to patent term and priority date. This includes filing dates, disclaimers, term adjustments, and related application data.

In addition, the information on the face of the patent, such as references cited, is more easily input into third-party electronic databases for search and analysis. Currently, the USPTO exports bulk data sets in XML format of the data on the cover of each patent. See MPEP 1309.⁴ That data has been instrumental in building useful patent data visualization products, conducting

¹ <http://www.patentdocs.org/2015/05/uspto-places-limits-on-pair-downloads.html>

² <https://intellogist.wordpress.com/2010/10/13/1612/>

³ See, e.g., <http://www.bpmlegal.com/howtopat1.html>

⁴ See also <https://www.uspto.gov/learning-and-resources/electronic-data-products/issued-patents-patent-grants-data-products>

large-scale research, and developing better models for patent valuation.⁵ Without the data capture that accompanies a full listing of patent cover information, much of that important research and development could not have been done.

Certainly it is recognized that a substantial effort is required on the USPTO's part to capture and prepare data for inclusion on the patent cover. But to the extent that the burden is excessive, the correct solution is to develop tools for making the necessary data capture more efficient. It would not be difficult to expand the e-IDS system (see MPEP 609.07), for example, so that applicant-cited references may be collected instantaneously from a computerized form. The correct solution to any resource problem is not to reduce the ease of access to patent information, but rather to work with applicants to develop more efficient systems that maintain current levels of information accessibility.

Overall, we recommend that the USPTO be cautious about removing information from the face of the patent and not force the public to rely on Public PAIR until the completeness and usability of that database is significantly improved.

Respectfully submitted,

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⁵ To take just one example, the “innovation cartography” efforts of Patent Lens are built in part on this data. See <https://www.lens.org/about/what/>.