



IPO Annual Meeting

Community Patent Review

Addressing the Challenges

Manny Schecter
Associate General Counsel, IBM
schecter@us.ibm.com

September, 2006

Outline

- ❖ **Frequently cited issues**
- ❖ **Participation**
- ❖ **Final thoughts**

Frequently Cited Issues: Summary

- ❖ **Impermissible protest**
- ❖ **Incentive to participate**
- ❖ **Willfulness**
- ❖ **Flooding**
- ❖ **Inequitable conduct**
- ❖ **Pendency**
- ❖ **Gaming**
- ❖ **Estoppel**
- ❖ **Copyright**

Preliminaries

❖ Terminology

- “Submission” of prior art references by the public to the review process
- “Forwarding” of prior art references to the examiner

❖ EPO and JPO

❖ Trial Voluntary Protest Program (TVPP)

❖ Legal research

❖ Code of conduct

Issue: Impermissible Protest

- ❖ **Protest is not permitted after publication of patent application without consent of applicant – why should applicants consent?**

Impermissible Protest

- ❖ **Applicants will consent to protest in the pilot**
- ❖ **Incentives to consent (eg accelerated prosecution)**
- ❖ **Patent reform legislation will permit third party to provide prior art references with commentary to examiner**

Issue: Incentive to Participate

- ❖ **If potential peers will not be compensated, will they lack motivation to participate?**

Incentive to Participate

- ❖ **Once said about open source software developers**
- ❖ **Some open source developers work for companies, develop OSS on own time**
- ❖ **Public impact of wrongly issued patents will result in many potentially interested parties**
- ❖ **Broad array of potential peers (eg excellent university project)**

Issue: Willfulness

- ❖ **Will peers be subject to enhanced damages for willful infringement?**

Willfulness

- ❖ **No legal basis for willfulness of peers**
 - **Cannot willfully infringe until a patent issues**
 - **No evidence of knowledge of issued patent**
 - **Consenting applicants can waive willfulness for peers**
 - **Accommodation of anonymous peers**

- ❖ **Even without above, risk v. reward**

- ❖ **Many peers do not work for companies and are at low risk**

- ❖ **Patent reform legislation would require notice of infringement or deliberate copying**

Issue: Flooding

- ❖ **Will peers forward large numbers of prior art references to examiners and, if so, can it be managed?**

Flooding

- ❖ **Conflicts with fear of lack of participation!**
- ❖ **Not a problem in EPO, JPO, and TVPP**
- ❖ **Checks and balances**
 - **Only most relevant prior art references forwarded**
 - **Rating and reputation**
 - **Sorted and searchable**
 - **Comments required in patent reform legislation**
 - **Active participation is beneficial**
- ❖ **Active review only likely for small number of patent apps**

Issue: Inequitable Conduct

- ❖ **Will applicants fear inequitable conduct and forward additional prior art references identified by peers (beyond those most relevant) to examiners, thereby increasing costs?**

Inequitable Conduct

- ❖ **Applicants no more obligated to forward additional references to examiner than for search results and other known prior art**
- ❖ **No specific knowledge of additional references**
 - **Why impute any more than for well-classified prior art?**
 - **Against spirit to impute to consenting applicant**
 - **If knowledge imputed, why not also to examiner?**
 - **Examiner link to additional prior art references**
 - **Could amend Rule 56 to provide safe harbor**
- ❖ **USPTO has proposed reform of IDS practice**

Issue: Pendency

- ❖ **Will the review process delay patent examination and, possibly, patent issuance?**

Pendency

- ❖ **Policy: unworthy patents impact everyone**
- ❖ **Pilot will test efficiency**
- ❖ **Occurs prior to examiner search and onset of substantive examination**
 - **Time limit for protest**
 - **No examination delay at all**
 - **Examiner search may be improved or unnecessary**
 - **Long pendency art units for pilot**
- ❖ **Increases search efficiency of examiner**
- ❖ **Pendency may improve: examiner will find and apply references more efficiently, eliminating office actions**

Issue: Gaming

- ❖ **Will participants subvert the process for their benefit and, if so, what are the likely abuses?**

Gaming

- ❖ **Gaming already exists (eg prior art flooding)**
- ❖ **Identified gaming can be addressed**
 - **Code of conduct**
 - **Internet addressing**
- ❖ **Discredit strong prior art references?**
 - **Potential for inequitable conduct**
- ❖ **Amend claims so references not dispositive?**
 - **Same issue today with examiner search**
 - **Good result if in response to review process**

Issue: Estoppel

- ❖ **Will issued patents enjoy an enhanced likelihood of validity (“gold-plating”)?**

Estoppel

- ❖ **References treated like any other prior art**
 - **No estoppel from use in litigation**
 - **No change to presumption of validity**
- ❖ **Examiner may not appreciate reference**
- ❖ **Not all references forwarded to examiner**
- ❖ **Estoppel would:**
 - **Prevent combination with later discovered reference**
 - **Dissuade submissions**
 - **Incent gaming by applicants**

Issue: Copyright

- ❖ **Will the submission of prior art references for review violate copyright?**

Copyright

- ❖ **Handling of patents not restricted by copyright**
- ❖ **Forwarding of references to examiner not restricted by copyright**
- ❖ **Warning to peers about handling third party copyrighted references**
 - **Consent**
 - **Preference for link rather than copy**
 - **Fair use**
 - **Some references might have to be excluded**

Participation: Summary

Perspectives on participation

- ❖ Patentees
- ❖ Potential infringers
- ❖ Public

How to participate

- ❖ Help needed
- ❖ Monitoring progress

Perspectives on Participation

❖ Patentees

- Strengthen confidence in truly worthy patents
- Improve marketplace for innovation
- Locate prior art early

❖ Potential infringers

- Improve clarity of patent system
- Reduce threat from unworthy patents
- Lower costs

❖ Public

- Opportunity to participate
- Reduce prices

Help Needed

- ❖ **Funds**
- ❖ **Equipment**
- ❖ **Technical support**
- ❖ **Consent to review of patent apps**
- ❖ **Peers**
- ❖ **Guidance**

Monitoring Progress

❖ **Contact us**

❖ **See:**

<http://dotank.nyls.edu/communitypatent>

❖ **Join listserv at:**

<https://lists.osdl.org/mailman/listinfo/patent-peerreview>

Final Thoughts

- ❖ **The patent system meets open collaboration**
- ❖ **Integrity of the patent system**
- ❖ **Purpose of a pilot**
- ❖ **Participation welcome**

Thank You!

Questions?

Manny Schechter
Associate General Counsel, IBM
schechter@us.ibm.com