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From: Francisco Corella

Sent: Monday, April 21, 2014 5:32 PM

To: CrowdsourcingRoundtable2014

Cc:

Subject: Pomcor comments on crowdsourcing and preissuance submissions

The following comments are submitted on behalf of Pomcor in response to the request for written comments on the use of crowdsourcing and third-party preissuance submissions of prior art, issued by the Patent and Trademark Office on 03/19/2014.

1. We believe that crowdsourcing is the best hope for avoiding the issuance of inappropriate software patents, and commend the Office for using it to improve the quality of patent examination. However, current laws and regulations provide loopholes for avoiding third-party scrutiny of applications.

One loophole is provided by Prioritized Examination, a.k.a. Track I.

Since patents on Track I are often issued before they are published, third parties cannot inspect them and submit prior art to the examiner before they issue. Before AIA, prioritized examination was already a profoundly undemocratic regulation, that discriminated against freelance and open-source software developers who cannot afford the prioritized examination fee. Now it is also a tool that allows law firms to shield inappropriate patents from third-party scrutiny. We recommend that prioritized examination be reconsidered and eliminated.

Another loophole is simply for the applicant to request non-publication, in cases where the applicant does not intend to file in foreign countries.

More generally, preissuance submission cannot take place without pre-grant publication. The above loopholes prevent preissuance submission by eliminating pre-grant publication; but pre-grant publication may also fail to take place in the normal course of business. By default, it takes place no earlier than 18 months after the earliest benefit date. If the application does not claim the benefit of any earlier application, in an ideal world the USPTO should be able to examine it in less than 18 months, in which case there would be no pre-grant publication, and hence no possibility of preissuance submission.

Since the 18 months delay in publication and the non-publication request provision are statutory, allowing preissuance submission for all applications requires a change in the law. Since preissuance submission is essential for improving the quality of software patents, such a change is badly needed. We would suggest introducing a minimum 3-month time period between publication and allowance. A request for non-publication would hold publication in abeyance until the examiner thinks the claims are allowable; but then the application would be published and open to preissuance submission of prior art and comments for three months before actual allowance.

While waiting for legislation to be enacted, the Post-Grant Review fees should be drastically reduced, and the onerous requirements on Post-Grant Review petitions should be simplified so that it is not necessary to hire a patent lawyer to file a petition. We would suggest a Post Grant Review request fee no greater than the Appeal Forwarding fee for a small entity (\$1,000). There should be no post-

institution fee and no per-claim fee, and a refund of 50% of the request fee should be given if the request is found to have merit and the review is granted.

2. The Office should use crowdsourcing not only for identifying prior art, but also for assessing whether the specification contains a "full, clear, concise and exact" description that enables a "person skilled in the art" to make and use the invention, as required by 35 USC 112(a). Software developers often complain that software patents are incomprehensible. Sometimes they do not even understand their own patents as written up by patent attorneys; see:

<http://www.wired.com/2012/03/opinion-baio-yahoo-patent-lie/>

Software developers are the persons skilled in the art in the case of software patents, hence they are by definition best qualified to assess compliance with 35 USC 112(a). Third parties making preissuance submissions should be allowed and encouraged to include comments on any lack of compliance with 35 USC 112(a), in addition to prior art.

3. To facilitate the assessment, by third parties as well as by examiners, of whether functional claims are supported by the specification, the specification of every patent application containing one or more means-or-step-plus-function claims should be required to contain a separate section explaining in detail how each claimed functionality is provided.

Conclusion. For a concrete illustration of some of the issues addressed by the above comments, and further comments on other issues related to software patents, please see the blog post at:

<http://pomcor.com/2014/04/21/patent-illustrates-five-different-problems-with-software-patents/>

Respectfully submitted,

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