March 14, 2014

Michelle Lee  
Deputy Under Secretary of Commerce for Intellectual Property  
and Deputy Director of the U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314


Dear Deputy Under Secretary Lee:

The Coalition for Patent and Trademark Information Dissemination (CPTID) is a group of private sector companies that provide value-added services for patent and trademark information users, including USPTO examiners. These companies have been investing in and building efficient, high quality patent and trademark research services for more than 50 years. For patent research purposes, their services cover U.S. and foreign patents, pre-grant publications, and non-patent literature; and for trademark searches, U.S. pending and registered marks, as well as state, common law, and foreign marks.

We believe that a well-functioning U.S. Patent and Trademark Office (“USPTO”) promotes innovation and job creation and strengthens the U.S. economy. Those who innovate and create patented and trademarked works in this country rely on an efficient USPTO for their financial success and ability to continue innovating. On behalf of our members, we appreciate the opportunity to provide this written submission commenting on the following questions: 1. What specific databases, Web sites, tools and other resources do you find useful in searching for software-related inventions? Please indicate strengths and limitations of each resource. 2. What are your concerns regarding the manner in which USPTO examiners formulate and implement search strategies to identify prior art for software related inventions? How should these concerns be addressed?

Some of the Coalition’s members may be making their own separate filings in response to the USPTO’s Request for Comments. We submit these comments as a Coalition, however, to highlight as a group the important role that private sector publishers play in helping the USPTO strengthen its capacity to identify prior art for software related invention, thus improving the quality of its software related patents.

Coalition for Patent and Trademark Information Dissemination  
Corsearch * Dialog * Reed Elsevier * Thomson Reuters
I. Background

Private Sector Publishers are an Important Part of the Patent Landscape

Issuance of high quality patents and a well-functioning patent legal landscape is dependent on clear and accessible information about what patents actually exist and what other prior art is available. This information is generally provided by commercial publishers, including members of the Coalition, who process raw data coming from the patent and trademark offices and other sources and make it searchable, thus more usable, by patent and trademark searchers, innovators, attorneys, and enforcers.

Commercial providers are an indispensible part of the classic value creation chain for patent information. The first link involves patent offices, which collect basic information from applicants and make it available to the public and commercial service providers. Few in the general public can make optimal use of the raw data that comes out of the offices, and thus it is the second link - the commercial providers - who process the raw data and add value through additional data, features and functionality, improving its searchability and usefulness, to users. The U.S. patent system thus depends on the dissemination of value-added information. Such dissemination can best be achieved by a private-public partnership that takes advantage of the core strengths of the patent offices as well as the private sector publishers. A competitive private sector patent information industry complemented by the USPTO provides the optimal approach for meeting the broad range of user needs – from specialists to the general public – and is just the type of dynamic private public partnership necessary for our nation to lead and thrive in the 21st century.

USPTO Policies Should Encourage a Diversity of Sources for Patent Information

U.S. law embraces the notion that one should not rely on a single source of information, and that the best and most accurate information is best derived from a marketplace of ideas with a multiplicity of sources. Thus, Federal statute provides that Federal government agencies shall ensure public access to an agency’s public information by “encouraging a diversity of public and private sources for information based on government public information.” (44 USC 3506(d)(1)(A)). The statute’s enforcement vehicle, OMB Circular A-130, provides that in determining how and whether to disseminate information, agencies will: “[t]ake advantage of all dissemination channels, Federal and nonfederal, including State governments, libraries, and private sector entities, in discharging agency information dissemination activities.”

The concept of “a diversity of sources” has special applicability to patent information, including prior art searching for software related inventions. Each area of technology benefits from different types of search tools to achieve optimal results for understanding what patents already exist and what prior art is out there. There are many types of uses of patent information, and there are many types of users in addition to those who conduct searches for patentability, infringement, validity, etc. If there is only one source or only few sources, this diversity and its benefits can be lost.
The USPTO Should Recognize That Functionality Is Value, and Functionality Costs

Added functionality--added value--is really at the heart of what private sector patent information services do. It is the second link in the process of dissemination of patent and trademark data, and it represents the results of their investment in both dollar and human capital in a given year. It is a never-ending process. Adding value can add considerable costs to a patent office’s budget, and since applicants and grantees are paying for patent offices, added value can translate into added costs to inventors.

Here is where a solid private-public partnership can provide optimal results for meeting the broad range of user needs. For example, when the USPTO conducted analyses of full-text searching and its costs several years ago, it was generally agreed that the private sector plays an important role in addressing USPTO objectives. Moreover, there was a strong positive correlation between high costs to the USPTO and functions that Coalition member companies provide. As such, the USPTO was sensitive to the negative impact aggressive and expensive enhancements of their public search systems would have on vendors. Considering that the USPTO is funded by users of the agency, decisions on appropriate functionality can sometimes be made based on costs alone.

The USPTO’s Policies Should Create an Environment for Maximizing Competition among Private Sector Patent Information Providers

Maximizing competition requires creating, not destroying, incentives for investment. No rational investor will risk capital where the plans of a patent office is not known, or where there is not reasonable certainty that fair and open competition will prevail. This means open competition among private sector companies in the marketplace and fair competition with a patent or trademark office or its proxy. Fairness implies that a patent office is not overreaching in the added value it is providing free. If a patent office takes steps to directly compete with private sector companies, a market distortion is created and this can lead to destruction of the marketplace. Fairness also means maintaining a practice of opening all work with outside parties – paid or not paid – to an open and transparent contracting process.

II. What specific databases, Web sites, tools and other resources do you find useful in searching for software-related inventions? Please indicate strengths and limitations of each resource.

Many of USPTO’s groups have access to tens of thousands of resources from our Coalition members. For example, Scientific and Technical Information Center (STIC) staff and patent examiners already have access to ProQuest and Reed Elsevier resources that are useful in researching software patents, and the Westlaw and Thomson Innovation Platforms from Thomson Reuters provide support for a number of divisions’ individual missions and goals including STIC, Office of General Counsel (OGC), Trademark Trial and Appeal Board (TTAB), Board of Patent Appeals and Interferences (BPAI), as well as EED. See Attachment 2 for the specific Reed Elsevier resources currently available to the USPTO and the number of publications or databases they contain. See Attachment 3 for a selected list of Thomson Reuters resources relevant to software invention searching.Attachments 4-7 provide additional lists of additional resources.
The strengths of these resources are plentiful with brands that are industry leaders. The depth and breadth of coverage that these resources provide are the best of brand, and customer support for these resources is timely and thorough.

Coalition members provide a wide array of time-saving and efficiency-driving services to assist patent examiners and STIC staff. USPTO staff download millions of documents from Coalition members each year. Coalition member databases provide access to high-quality content, with broad and deep coverage of non-patent literature such as foreign patents and peer-reviewed, technical, and industry and trade journals.

ProQuest Dialog, Reed Elsevier and Thomson Reuters deliver patent offerings in the marketplace with full-text and bibliographic patent authorities. These offerings include PDFs, claims, specifications, forward and backward citations, families, and legal status tables.

Coalition members’ products contain millions of NPL documents and global patents in software related research topics.

The ProQuest ebook platform, Ebrary, provides access to over 100,000 e-book titles and their Serials Solutions tools help USPTO staff access full-text articles as available from within STIC’s e-journal collections; this service not only meets on-demand needs for full-text materials, but further increases the STIC collection ROI.

In addition to its commercial services, ProQuest has assisted the USPTO in creating E2D2, a private database built for and with STIC and examiners, provides access to examiner-submitted “best practice” materials including NPL and patents from across technology centers. Beyond these information services, ProQuest also provides support and customized training to help examiners and STIC staff to increase search competencies and effectiveness.

Given the global diversity and changing environment, the products and services of the Coalition members provide the foundational research to USPTO that fosters the integrity of patent, trademarks and intellectual property and encourages investment and fosters the innovative sprit.

**III. What are your concerns regarding the manner in which USPTO examiners formulate and implement search strategies to identify prior art for software related inventions? How should these concerns be addressed?**

The USPTO has noted that it provides examiners access to Non-Patent Literature (NPL) through multiple electronic resources purchased from various publishers. STIC currently subscribes to 59,000 electronic journals and over 145,000 electronic books in full text.

There are three particular resources that do not appear to be available to STIC that would likely be quite useful, especially for prior art searching for software related inventions:

1) Patent Law Emerging Issues: This is a database of commentaries covering the most important and rapidly emerging issues in patent law today. This collection of articles provides expert guidance written by attorneys practicing in the field. The commentaries examine a wide range of recent cases,
regulations, trends, and developments. These accounts cover national, state and international issues and provide expert insight in important areas and legal developments.

2) IP Law & Strategy Series: The LexisNexis IP Law & Strategy Series offers the expertise and guidance of practitioner authors from AmLaw 100 firms, Fortune 500 companies and U.S. government agencies. This collection of 40+ titles acquired from Oxford University Press, U.S. Law Division, includes checklists, practice pointers and forms.

3) Thomson Reuters WestLaw business is also a provider of best practices texts (non-patent literature) with the WestLaw Analytical Library print resources. A selected list of these resources valid to software invention searching are included in Attachment 4.

The Coalition suggests that all of the above resources should be considered for use by the USPTO for improving prior art searching.

IV. Closing

In closing, we want to reiterate the Coalition’s appreciation for the USPTO’s efforts to solicit and consider stakeholder input on what specific databases, Web sites, tools and other resources our members find useful in searching for software-related inventions; our concerns regarding the manner in which USPTO examiners formulate and implement search strategies to identify prior art for software related inventions; and how these concerns should be addressed. We thank you for this opportunity to emphasize that private sector publishers are a significant part of the patent landscape, including for software related patents. The U.S. patent system depends on the dissemination of value-added information. Such dissemination can best be achieved by a public-private partnership that takes advantage of the core strengths of the patent offices as well as the private sector publishers. A competitive private sector patent information industry complemented by the USPTO provides the optimal approach for meeting the broad range of user needs, including for prior art searching for software related inventions.

Sincerely,

Marla Grossman
Executive Director
Coalition for Patent and Trademark Information Dissemination

See Attachment 1 for Background on Coalition Members
Attachment 1: Background on Members of the Coalition for Patent and Trademark Information Dissemination

Corsearch:

- Corsearch is the result of the merger over 10 years ago of Trademark Research Company (TRC) and Corsearch, Inc. TRC had been formed as the “Trademark Service Corporation” in 1949, and had set the stand in superior data and organization of its intellectual property reports. Corsearch Inc. was formed in 1983, initially focusing on litigation support services, but then concentrating on intellectual property research since 1985. Corsearch has been a leader in innovation when it offered the first comprehensive computerized search in the industry. Corsearch is part of Wolters Kluwer Corporate Legal Services (CLS), a business of Wolters Kluwer, a market-leading global information services company with more than 19,000 employees worldwide.

ProQuest:

- ProQuest provides the USPTO with a wide array of content and services to assist examiners and STIC staff. ProQuest Dialog leads the industry with the largest collection of prior art available in a single, integrated resource – optimizing patent and non-patent literature research with scientific, technical, and medical databases, full-text dissertations, global news, and trade press. Ebrary provides access to over 100,000 e-book titles. Serials Solutions tools help USPTO staff access full-text articles as available from within STIC’s e-journal collections. In addition to our commercial services, ProQuest has assisted USPTO in creating E2D2, a private database built for and with STIC and examiners. ProQuest also provides support and customized training to increase search competencies and effectiveness. ProQuest is headquartered in Ann Arbor, Michigan and has more than 1,800 employees worldwide.

Reed Elsevier:

- Reed Elsevier’s company, LexisNexis, provides the world’s most respected intellectual property treaties: Matthew Bender’s Chisum on Patents, Nimmer on Copyright, and Gilson on Trademarks. LexisNexis also offers a complete collection of federal and state caselaw, statutes, court dockets and filings; a searchable collection of more than 3.8 billion public records, including information on personal assets and business records; and an extensive collection of business news publications. In recent years, LexisNexis added over 1,600 full-text Elsevier Journals in science, medicine and technology; and coverage of IP practice and legislation for over 230 countries from Global IP Law Service.

Thomson Reuters:

- Spanning the innovation lifecycle from discovery to development to delivery, Thomson Reuters Intellectual Property & Science provides category leading content and tools, including the Derwent World Patent Index, Delphion, Aureka, Thomson Innovation, Thomson CompuMark and Serion, and Web of Knowledge. Derwent – a member of the Thomson Reuters family – traces its first U.S. Patent and Trademark Office: Fee Schedule Adjustment and Agency Reform value-added patent service to 1948. Thomson Reuters is headquartered in New York City. It has 60,000 employees in more than 100 countries and operates eight offices in the United States.
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<td>Elsevier E-Books (Referex)</td>
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## Attachment 3: Thomson Reuters Resources Useful in Searching for Software-related Inventions

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Attachment 4: Thomson Reuters WestLaw business and WestLaw Analytical Library Resources

Annotated Patent Digest

Assets & Finance: Audits and Valuation of Intellectual Property

Assets & Finance: Intellectual Property in Mergers and Acquisitions

Assets and Finance: Insurance Coverage for Intellectual Property and Cyber Claims

Calculating Intellectual Property Damages

Code of Federal Regulations Annotated Title 37, Patents, Trademarks and Copyrights

Computer and Information Law Digest, 2d

Computer Software Agreements: Forms and Commentary with Forms on CD-ROM

Computer Software Protection/ Liability/ Law/Forms

Corporate Counsel's Guide to Licensing

Corporate Counsel's Guide to Privacy

Corporate Counsel's Guide to Technology Management and Transactions

Corporate Counsel's Guide to Technology Management and Transactions

Corporate Counsel's Guide to Trademark Law

CyberSpace Lawyer

Designs and Utility Models Throughout the World

Eckstrom's Licensing in Foreign and Domestic Operations

Eckstrom's Licensing in Foreign and Domestic Operations: Joint Ventures

Eckstrom's Licensing in Foreign and Domestic Operations: The Forms and Substance of Licensing

Federal Circuit Patent Case Digests

Federal Intellectual Property Laws and Regulations

Federal Unfair Competition: Lanham Act § 43A

Forms & Agreements on Intellectual Property & International Licensing

Franchise and Distribution Law and Practice
Information Law

Intellectual Property Counselor

Intellectual Property Due Diligence in Corporate Transactions: Investment, Risk Assessment and Management

Intellectual Property in Commerce

Intellectual Property Law for Business Lawyers

Intellectual Property Law Review

Intellectual Property Litigation Guide: Patents and Trade Secrets

Intellectual Property Litigation Reporter (Andrews Litigation Reporter)

Intellectual Property Litigation News (Rutter Group Newsletter)

Inter Partes Reexamination 2d

Internet Law and Practice


Japanese Patent Litigation

Law and Business of Computer Software, 2d

Licensing and the Art of Technology Management

Manual of Patent Examining Procedure, 8th, Rev. 7


Moy's Walker on Patents, 4th

Multimedia and Technology Licensing Agreements

Nanotechnology Law

Patent Application Practice, 2d


Patent Claims, 3d

Patent Damages Law and Practice

Patent Law Practice Forms

Patent Law Review

Patent Law: Legal & Economic Principles, 2d

Patent Office Litigation

Pattern Discovery: Products Liability, 3d

Pre-Litigation Patent Enforcement

Protecting Intellectual Property Rights Across Borders

State Computer Law: Commentary, Cases & Statutes

The Law of Computer Technology - Rights - Licenses - Liabilities

TRADING ARRANGEMENTS IN PACIFIC RIM ASEAN & APEC
Attachment 5: LexisNexis IP Law & Strategy Series

Global IP Law Service for Patents, Trademarks, Utility Models and Domain Names
Associate's Guide to the Practice of Copyright Law
Biotechnology & Nanotechnology Regulation
Business Method & Software Patents
Canadian Intellectual Property Law and Strategy
Clean Tech Intellectual Property
Corporate Insider's Guide to U.S. Patent Practice
Criminal Enforcement of Intellectual Property Rights: U.S. Perspective
Entertainment Litigation
Essentials of Patent Claim Drafting
False Advertising and the Lanham Act
Gray Markets: Prevention, Detection and Litigation
Intellectual Property Culture and Compliance, 2d Edition
Intellectual Property in Eastern Europe & Commonwealth of Independent States
Intellectual Property in Government Contracts, 2d Edition
Internet Crimes, Torts and Scams: Investigation and Remedies, Second Edition
IP Strategy, Valuation, and Damages
License, Royalty & Revenue Agreements: Drafting, Monitoring and Auditing
Music and Copyright
Patent Application Drafting
Patent Ethics: Litigation
Patent Ethics: Prosecution
Patent Related Misconduct Issues in U.S. Litigation
Rules of Patent Drafting
Software Licensing
Technology Licensing and Development Agreements
The Business of Intellectual Property
Thesaurus of Patent Claim Construction
Trade Dress: Evolution, Strategy and Practice
Trade Secret Law and Corporate Strategy
Trade Secrets: Law and Practice
Trademark & Copyright Litigation
Trademark Surveys: A Litigator's Guide
U.S. Patent Opinions & Evaluations, 2d Edition
U.S. Patent Prosecutors Desk Reference
Winning the Patent Damages Case
Attachment 6: LexisNexis Matthew Bender All Intellectual Property Law

Baxter World Patent Law - Index

Business Law Monographs: Intellectual Property

California Intellectual Property Handbook

Chisum on Patents

Chisum on Patents - Index

Computer Law: A Guide to Cyberlaw and Data Privacy Law

Corporate Counsel Solutions: IP Mgm't: Strategies & Tactics

Corporate Counsel Solutions: IP Mgm't: Strategies & Tactics - Index

Court of Appeals for the Federal Circuit Practice & Procedure

Current Legal Forms for Intellectual Property

Entertainment Industry Contracts

European Patent Law and Practice

Gilson on Trademarks

Gilson on Trademarks - Index

Horwitz on Patent Litigation

Intellectual Property Counseling and Litigation

International Computer Law

International Copyright Law and Practice

Manual of Patent Examining Procedure

Matthew Bender Publications, Combined (G)-37 Sources

McGrady on Domain Names

McGrady on Social Media

Milgrim on Licensing

Milgrim on Licensing - Index
Milgrim on Trade Secrets
Milgrim on Trade Secrets - Index
New York Intellectual Property Law
Nimmer on Copyright
Nimmer on Copyright - Index
NY Matthew Bender® Publications, Combined (G)-1 Sources
Patent Case Management Judicial Guide
Patent Law Digest
Patent Law Perspectives
Patent Licensing Transactions
Patent Office Rules and Practice
Patent Office Rules and Practice - Index
Section 337 Patent Investigation Management Guide
Taxation of Intellectual Property and Technology
Trademark Manual of Examining Procedure
Trademark and Unfair Competition Deskbook
World Trademark Law and Practice
Matthew Bender Key Forms & Agreements (22 Sources )
Attachment 7: Reed Elsevier’s TotalPatent
Full Text Authorities

Austria
Australia
Belgium
Brazil
Canada
Switzerland
China
The former German Democratic Republic (East Germany)
Germany
Denmark
Eurasia, including Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan,
Moldova, Russian Federation, Tajikistan, Turkmenistan, Uzbekistan
European Patent Office
Spain
Finland
France
Great Britain
Ireland
India
Italy
Japan-abstract only
Republic of Korea (South Korea)
Luxembourg
Monaco
Mexico
Netherlands
Portugal
Russian Federation
Sweden
USSR
Taiwan, Republic of China (R.O.C.)
United States
World Intellectual Property Organization (WIPO)

Bibliographic Authorities

ARIPO (African Regional Industrial Property Organization). Includes Botswana, Gambia, Ghana, Kenya,
Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Sudan,
Swaziland, Tanzania, Uganda, Zambia, Zimbabwe.
Argentina
Bosnia and Herzegovina
Bulgaria
Brunei Darussalam
Bolivia
Belarus
Chile
Colombia
Costa Rica
Czechoslovakia
Cuba
Cyprus
Czech Republic
Dominican Republic
Algeria
Ecuador
Estonia
Egypt
Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC)
Greece
Guatemala
Hong Kong
Honduras
Croatia
Hungary
Indonesia
Israel
Iceland
Kenya
Kazakhstan
Lebanon
Lithuania
Latvia
Morocco
Republic of Moldova
Mongolia
Malta
Malawi
Malaysia
Nicaragua
Norway
New Zealand
Panama
Peru
Philippines
Poland
Paraguay
Romania
Singapore
Slovenia
Slovakia
San Marino
El Salvador
Thailand
Tajikistan
Turkey
Trinidad and Tobago
Ukraine
Uruguay
Uzbekistan
Venezuela
Vietnam
Yugoslavia
South Africa
Zambia
Zimbabwe