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Sent: Wednesday, November 25, 2009 2:53 PM
To: Ombudsman Program
Subject: IBM Corporation Comments - Patents Ombudsman Pilot Program

Attached are IBM Corporation's comments with respect to the Patents Ombudsman Pilot Program.

Respectfully submitted,

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PREPARED BY IBM ATTORNEY - PRIVILEGED AND CONFIDENTIAL

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Via Electronic Mail

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Mail Stop Comments

Attention: Patents Ombudsman Pilot Program

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

IBM Corporation Comments in response to "Request for Comments on Patents Ombudsman Pilot Program" 74 Fed. Reg. 55212 (October 27, 2009)

IBM thanks the United States Patent and Trademark Office (USPTO) for taking steps to enhance USPTO customer service through development of a Patents Ombudsman Pilot Program. This type of program can provide an excellent mechanism for efficiently resolving specific patent application issues that may arise outside of the course of regular patent application prosecution before the USPTO. Also, while fostering better USPTO customer relations, this Program may improve patent quality and accomplish reduction in patent application pendency in certain cases.

Therefore, to fully achieve the objectives set by the USPTO for the Patents Ombudsman Pilot Program, IBM respectfully requests that certain aspects of the Program be clarified and that implementation details be provided. In that regard, IBM offers the following suggestions:

1. To limit the scope of the Program and ensure it is manageable, a clearer statement that only a pro se applicant or an attorney or registered agent of record for an applicant can initiate use of the Patents Ombudsman Pilot Program. For example, the Program should not be available to inventors not acting as pro se on a patent application.
2. Only issues involving a patent application filed by a pro se applicant or those which are being prosecuted by an attorney or registered agent for an applicant who has raised the issue should be eligible for consideration in the Patents Ombudsman Pilot Program; i.e., the USPTO should not allow third parties to raise issues relative to patent applications owned or prosecuted by others.
3. There should be an explicit statement of the types of issues the Ombudsman has authority to address and those issues which will be referred to others for resolution. Also, it should be clarified whether there is any avenue for further pursuing an issue if an applicant is not satisfied with the Ombudsman's proposed

issue resolution or the resolution proposed by others to whom the issue was referred.

4. To promote transparency, the USPTO database for tracking issues handled through the Ombudsman Program should be open to the public.

5. The Program details should indicate whether there will be any limitations such as being limited to specific USPTO Technology Centers, or the like. Also, it should be clarified as to how the Program will differ from the Technology Center Customer Service Representative role, which was eliminated by the USPTO.

6. A contingency should be provided for what happens if the USPTO is flooded with requests for dealing with inappropriate issues in the Program, or should the USPTO receive more issues than can be resolved in the committed time periods due to lack of sufficient USPTO resources.

Conclusion

IBM commends the USPTO for fostering more open lines of communication between patent applicants and practitioners and the USPTO through the Patents Ombudsman Pilot Program. The above suggestions are provided in order to assist the USPTO in further defining and working out implementation details of the Program. IBM looks forward to continuing to work with the USPTO on this Pilot Program and future USPTO patent quality and patent community outreach endeavors.

Respectfully submitted,

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