



**Brooklyn Law Incubator & Policy Clinic**

**Professor Jonathan Askin**  
Founder/ Director

March 14, 2014

Attn: Seema Rao,  
Director, Technology Center 2100  
Mail Stop Comments – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Via email: [SoftwareRoundtable2013@uspto.gov](mailto:SoftwareRoundtable2013@uspto.gov)

**RE: Response to “Request for Comments  
Regarding Prior Art Resources for Use  
in the Examination of Software-Related  
Patent Applications”**

Dear Ms. Rao

The Brooklyn Law School Incubator & Policy (“BLIP”) Clinic is pleased to have this opportunity to present its views with respect to the “Request for Comments Regarding Prior Art Resources for Use in the Examination of Software-Related Patent Applications,” (the “Request”). The Request seeks comments on specific databases, web sites, tools and other resources found to be useful in searching for software-related inventions.

BLIP functions as a modern, technology-oriented law firm. Since its inception in 2008, BLIP has been training a new generation of lawyers who are well-versed across the spectrum of skills needed to represent emerging tech, Internet, communications, and new media companies. To

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date, BLIP has helped more than 500 clients presenting diverse legal, business, and policy challenges. BLIP accepts clients who require creative legal representation and arguably advance the Internet or digital economy, and for whom expensive legal services would act as a barrier to entry in their respective industries.

The United States' patent system is based on the promotion of progress of science and useful arts. Today however, software patents are often used to hinder progress. This crowded and ever-changing area of technology often leads to patents that are improperly broad. Entities that use software often encounter three problems surrounding software patents. Aside for Non-Practicing Entities, they are as follows: (1) lack of notice surrounding products and what is patented and (2) uncertainty of patent validity.

Lack of notice comes from the rate at which software developers are innovating as compared to the speed of the examination process and publication for a software patent. The gap in time between innovation and publication leads to uncertainty in the field, often ending in lawsuits. The crowded nature of software patents often leads to claims that overlap disclosures that were neither cited nor considered during the examination of the patent applications. The sheer mass of disclosures and information available to Examiners inevitably leaves important/relevant prior art from being considered.

With the help of new legislation, the Supreme Court of the United States, and the United States Patent & Trademark office, these problems can be neutralized. An effective way to limit these problems now is centralizing defensive publications. A central database for defensive disclosures brings back a feeling of certainty to a field that has lost it over the past few years. This database, while useful to developers and innovators in the field, more importantly is extremely useful for Examiners. Examiners are the first line of defense against overly broad and murky patents. A centralized database for defensive publications allows developers and innovators to show Examiners what is going on in the respective art unit. This allows for Examiners to get more useful, on-point prior art quicker.

**QUESTION 1:       WHAT SPECIFIC DATABASES, WEB SITES, TOOLS AND  
OTHER RESOURCES DO YOU FIND USEFUL IN SEARCHING  
FOR SOFTWARE-RELATED INVENTIONS?**

Using FirstToDisclose.org (“FTD”) to search defensive publications in concert with the remaining corpus of databases used by Examiners allows Examiners to do a more accurate, up to date search of existing prior art in the software-related field.

To coincide with the effective date for the first-inventor-to-file provisions of the America Invents Act, the BLIP Clinic developed a free, publicly available, defensive disclosure repository. This repository, located at FTD, anticipates the increased use of inventors

strategically disclosing inventions publicly to take advantage of the operation of this regime change in patent protection.

FTD provides for a standardized yet flexible format for the submission of defensive publications and for a centralized and structured way to search defensive publications. The goal of FTD is to establish a universally accepted process and format by which inventors can make public disclosures and USPTO Examiners can locate these disclosures efficiently.

This website benefits both users and Examiners. FTD allows users to defensively publish their ideas. These publications then become prior art against any subsequently filed patent application. Users publish the following: a title, summary of the invention or idea, self-selected key words related to the invention/idea, the CPC category that best encompasses the invention, and a document (e.g. PDF) detailing the invention. Since the FTD website accepts documents in PDF format, the user has the flexibility to describe his or her invention in as much detail as necessary. FTD allows Examiners to search defensive disclosures in a variety of ways. Examiners would be able to search using a large number of criteria: key word, CPC art unit, date, and author. In addition, FTD disclosures contain a unique identifier that allows each disclosure to be cited in academic and other research.

FTD integrates many of the principles that were advocated for by the technology industry for improving prior art search at USPTO's Software Partnership Meetings and Roundtables. FTD is easy to use and would not require that examiners undergo extensive additional training. Examiners would be able to perform full-text searches of disclosures using keywords related to purpose, use, and composition. Additionally, examiners would be able to further increase the specificity of their searches by limiting disclosures using tags, date of disclosure, CPC classification, as well as other elements that can be introduced in further iterations of the system.

FTD addresses the two major problems associated with Non-Patent Literature as identified by Brad Pederson in his December 5, 2013 presentation to the USPTO at the Alexandria Roundtable on Prior Art. FTD establishes a date for the publication thereby limiting the problem of relying on undated web postings. Since FTD serves as a centralized repository only for public disclosures of inventions it solves the "illusive and ever-changing world-wide web" problems. FTD prevents the need for web crawlers to search the entire Internet to locate disclosures and the risk of a disclosure being excluded because of unseen programmatic factors of a website that would prevent the website from being crawled. FTD also does not allow a disclosure to be edited once it is submitted without a public record remaining, as was a concern with technologies like Wikipedia.

With web search engines, USPTO must rely on the secret and constantly changing algorithms of major search engines to return relevant results. Additionally, an inventor's defensive publication made on a general website over the internet may not be properly programmed to be indexed by

search engines. Moreover, disclosures may not be properly formatted when generally made over the internet.

FTD is developed and administered by the BLIP Clinic at Brooklyn Law School. Brooklyn Law School is an independent legal teaching institution founded in 1901 that is not associated with a research institution. Brooklyn Law School's Dean is Nicholas Allard, who has a storied career in interfacing between industry and government. Additionally, the BLIP Clinic is directed by Jonathan Askin, an expert in Internet law and a trusted advisor to the technology industry.

With the United States Patent & Trademark Office Examiners using FTD, inventors will be publishing their ideas so that Examiners can use them to examine current patent applications.

Thank you for allowing BLIP the opportunity to provide comments on this important issue. BLIP looks forward to further dialogues with the United States Patent and Trademark Office regarding solutions to software related patent searches.

Sincerely,



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