

A New Pilot Program Concerning Public Submission of Peer Reviewed Prior Art

I. Introduction

In June of 2007, the USPTO announced a pilot program to determine the extent to which the organized submission of documents together with comments by the public would be useful to examiners. *See Pilot Concerning Public Submission of Peer Reviewed Prior Art*, 1319 *Off. Gaz. Pat. Office* 146 (Jun. 26, 2007). The purpose of the pilot was to test whether such collaboration could effectively locate prior art that might not otherwise be located by the USPTO during the typical patent examination process.

As announced, the pilot program was limited in scope, duration, and size. In the interest of gathering data from a more diverse pool of patent applications, the pilot was revised on July 17, 2008, to extend its duration, increase the maximum number of applications, and expand the scope of the applications eligible for the program. *See Extension and Expansion of Pilot Concerning Public Submission of Peer Reviewed Prior Art*, 1333 *Off. Gaz. Pat. Office* 103 (Aug. 12, 2008).

The culmination of the two-year pilot resulted in numerous data points that support the premise that members of the public, when collaborating in an organized on-line fashion, are capable of contributing to the location of prior art of value to the examiner during the examination process.

Some of the significant data points collected are:

- 189 applications accepted into the pilot program;
- 603 pieces of prior art were submitted and are now a part of the record in these applications;
- 30 of the accepted applications received a first action on the merits that contained a rejection of at least one claim based upon peer reviewed prior art; in 15 of these 30 applications, the peer reviewed prior art was not found by the patent examiner; in the other 15 of these 30 applications, the peer reviewed prior art was found by the patent examiner;
- More than 500 unique reviewers participated in a review of an application on the Web site; and
- Over 2700 people registered on the Peer To Patent Web site.

These results indicate that members of the public are capable of contributing to the quality of the patent process and willing to participate voluntarily.

In the interest of gathering data from a more diverse pool of patent applications, the USPTO in cooperation with the New York Law School's Center for Patent Innovations is launching a new one-year pilot. This pilot, described in more detail below, will test the scalability of the peer review concept by expanding the candidate pool of applications to technology areas such as Life Sciences, Telecommunications, Business Methods and Computer Hardware and Software, and by significantly increasing the total number of applications that may be accepted into the pilot. This pilot will also streamline the participation process by utilizing automation solutions.

II. Cooperation with New York Law School's Center for Patent Innovations

The USPTO is cooperating with Peer To Patent, organized by the New York Law School's Center for Patent Innovations, which will manage the public aspects of the pilot. More information on this initiative can be found at <http://peertopatent.tumblr.com/abouttheproject>. [This link to a non-Federal Government Web site does not imply endorsement of this particular organization or the content on that site]. Peer To Patent will be responsible for the management of the Internet-based review process by the public that will result in the submission to the USPTO of up to six (6) documents in any participating application as described below. The USPTO did not establish Peer To Patent, and will not set the membership or agenda, nor assume authority or control over Peer To Patent. The USPTO and Peer To Patent are independent entities, and are not agents of each other. Neither party is authorized or empowered to act on behalf of the other with regard to any contract, warranty, or representation as to any matter, and neither party will be bound by the acts or conduct of the other. The USPTO reserves the right to discontinue this pilot program if continuation is not in the best interests of the USPTO.

The USPTO will provide Peer To Patent with published patent application data to aid in the administration of the pilot.

III. Overview and Discussion of the Process

The USPTO is authorized to engage in this pilot under 35 U.S.C. § 2(b)(11), which provides that the USPTO “may conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world,” and 15 U.S.C. § 1525, which provides that the USPTO “may engage in joint projects, or perform services, on matters of mutual interest, the cost of which shall be apportioned equitably.”

A limited number of volunteer applicants with unexamined applications classified in the areas specified below will have the opportunity to consent to the placement of their published applications onto the Peer To Patent Web site for the purposes of collaborative review. Peer To Patent is a non-USPTO Web site developed by New York Law School for this pilot program. These applications will be analyzed by members of the public, who, in an organized manner using Internet Peer Review techniques, will determine the (up to) six (6) most pertinent documents, which will be submitted to the USPTO under a waiver of certain sections of both 37 CFR 1.99 and 1.291.

The volunteer applicants must consent to have comments submitted with each of the documents explaining how the documents relate to the disclosed invention as defined by the claims of the application. This pilot program will accept requests for participation from October 25, 2010, until September 30, 2011, or until one thousand (1,000) participating applications have been accepted into the pilot, whichever occurs first. The period for receiving Peer to Patent submissions into accepted applications will terminate February 3, 2012, or eighteen (18) weeks after the latest date on which an application is accepted into the program, whichever occurs last. Results will be compiled and published in a report on the effectiveness of this public submission process. As the USPTO will be approving applications for participation in the pilot, requests to participate received after the close of the pilot will be dismissed as moot.

To facilitate this pilot, notwithstanding any provision of Title 37 of the Code of Federal Regulations, the USPTO will accept submissions from Peer To Patent for certain (*i.e.*, accepted) applications that:

- (1) are received by the USPTO no later than 18 weeks after the publication of the application.
- (2) are limited to six (6) or fewer prior art documents and accompanying comments for consideration by the USPTO during the examination process. Only comments regarding the relevance of the submitted documents as prior art will be considered. Other comments, such as comments on the applicability of 35 U.S.C. § 112 or 35 U.S.C. § 101, will not be considered; these comments will be either redacted or discarded in their entirety by the USPTO.

In order to facilitate the operation of the pilot program and to collect an adequate sample of data from which to make an effective quantitative evaluation, this pilot program will be restricted to applications classified in areas specified in the classes and subclasses designated in the list posted and available at http://www.uspto.gov/patents/init_events/class_subclasses_FY2011pilot.jsp. With the exception of the provisions of the limited waiver of 37 CFR 1.99 and 1.291, the examination process for these applications will be performed in the normal manner following established USPTO procedure. However, participating applications will be advanced out of turn for examination for the initial examination on the merits so the pilot can be reviewed in an appropriate time frame.

Effective October 25, 2010, the USPTO will waive aspects of 37 CFR 1.99 and 1.291 for submissions presented under and meeting the conditions of this program. All other submissions made under either 37 CFR 1.99 or 1.291, including those submitted during the Peer To Patent time window in accepted applications, will not be affected by this waiver. This pilot program does not affect any procedures permitted under 37 CFR 1.99 and 1.291, nor does it violate 35 U.S.C. § 122 as applicants must provide a certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422) that includes an express written consent to the inclusion of the explanations submitted by Peer

To Patent coordinators regarding how the prior art documents relate to the disclosed invention as defined by the claims.

A. Requirements and Conditions Applicable to Applicants

For the purposes of this pilot, the existing requirements of 37 CFR 1.99 and 1.291 will be waived for submissions that comply with the following conditions:

(1) Applicant will submit to the USPTO a certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422)(signed by all assignees, if any, owning an undivided interest in the application, or all inventors if the application is not assigned) as specified below for a specific application to participate in the program. The certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422) may be executed by a legal representative of the assignee(s), if any, or if no assignee, by a legal representative of the inventor(s). See 37 CFR 1.33 and 37 CFR 11.18.

(a) The certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422) includes an express written authorization for the Peer To Patent submission to the USPTO to include comments describing the relevance of the documents to the disclosed invention as defined by the claims of the application. Applicants will be required to use the USPTO-prepared certification and request form (Form PTO/SB/422) located at:
http://www.uspto.gov/patents/init_events/peerpriorartpilotindex.jsp.

(b) The USPTO will accept no more than 25 total requests to participate in the Peer Review Pilot Program (corresponding to 25 total separate applications) from an applicant and applicant's assignee (to include parents, subsidiaries, and sister organizations). Patent applications that participate in the peer review process, but are not granted advancement of examination for any reason (e.g., because they do not receive at least one document submitted as a potential reference) will not be counted against the 25 total for any one

applicant, and will be redocketed to the order of examination they would have held if the application had not been elected for participation in the peer review project.

(2) To ensure a representative sample of participants, the USPTO will initially reserve at least 150 (*i.e.*, 15% of the total) of the participation slots for small entities as defined by 37 CFR 1.27. The USPTO will revisit this allocation during the course of the pilot and adjust as deemed appropriate to support the goals of the pilot program.

(3) Timing. There are two considerations that affect timing of participation of a volunteered application: (a) the filing of the certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422), and (b) the posting capacity of the Peer To Patent Web site.

(a) The certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422) is timely in relation to the publication of the application. As described in detail below in the section labeled "Timing Considerations," the timing of the publication of the application must provide a period no less than three (3) months and no more than four (4) months for posting (and evaluation) at the Peer To Patent Web site. Therefore, a certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422) for an eligible application must be submitted to the pilot no later than one (1) month following the publication date to be considered for participation in the pilot.

(b) The actual timing of the posting of the applications may vary due to capacity limitations of the Peer To Patent Web site.

(4) The Application must not have previously been granted special status or requested treatment under any of the following currently available programs or similar future programs: Accelerated Examination, the Patent Prosecution Highway, the First

Action Interview Pilot Program, the Patent Application Backlog Reduction Stimulus Plan, or the Pilot Program for Green Technologies Including Greenhouse Gas Reduction. (See http://www.uspto.gov/patents/init_events/index.jsp for details on any of these programs including links to the relevant Federal Register and Official Gazette publications.)

The USPTO will determine if the certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422) and associated application meet all of the USPTO requirements for this pilot. If so, the USPTO will notify applicant and the Peer To Patent coordinators of the inclusion of the application in the pilot. If the certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422) and application do not meet all requirements or the pilot has ended, the applicant will be notified of the decision not to include the application in the pilot.

B. Requirements and Conditions Applicable to the Third-Party Submitter

After an application has been accepted into the pilot and has been posted at the Peer To Patent Web site for the appropriate period, the third-party submissions (the peer review consisting of prior art and comments) will be forwarded by Peer To Patent to the USPTO. The Peer To Patent submission must comply with the following conditions:

(1) The submission forwarded by Peer To Patent must be received by the USPTO no later than 18 weeks after the publication date of the application. It is expected that this period will allow sufficient time to complete the Internet-based peer process.

(2) The submission may include up to six (6) prior art documents and accompanying comments for consideration by the USPTO during the examination process. Only comments regarding the relevance of the submitted documents as prior art will be considered. Other comments, such as comments on the applicability of 35 U.S.C. § 112 or 35 U.S.C. § 101, will not be considered; these comments will be either redacted or discarded in their entirety by the USPTO.

(3) Each submission will be accompanied by the form that is located at:
http://www.uspto.gov/patents/init_events/peerpriorartpilotindex.jsp.

C. Examination by the USPTO

(1) Applications that successfully complete the posting and review process as outlined above with at least one prior art reference document submitted to the USPTO from Peer To Patent will receive advancement of examination for the first Office action on the merits, “to expedite the business of the Office” (*see* 37 CFR 1.102(a)) so the results of the pilot program can be obtained in a timely manner. The application will receive a first action using the USPTO’s usual procedures, with the examiner reviewing the Peer To Patent submission as well as all documents produced from the normal USPTO search. Data will be maintained on the use of the documents submitted under the program and summary statistics will be publicly available. Examiners will consider all documents and comments provided in the Peer To Patent submission consistent with the treatment of any such evidence and remarks submitted in an application. Examiners will only consider comments regarding the application of the submitted documents as prior art. Other comments, such as comments on the applicability of 35 U.S.C. § 112 or 35 U.S.C. § 101, will not be considered. Such comments will be either redacted or discarded in their entirety by the USPTO and will not be provided to the examiner.

(2) Further prosecution of the applications submitted under this program will continue in the conventional manner. No further submissions under the Peer To Patent pilot will be entered into the application file and the application will proceed according to the same timelines for action and response as any ordinary application.

IV. Program Administration

Various details in the administration of this program and the processing of applications submitted thereunder will be considered and resolved as they arise. The USPTO will endeavor to conduct the pilot in a manner that will elicit the best data for evaluation of the effectiveness of the submitted documents, consistent with the proper prosecution of the participating applications. For example, an applicant may be notified by the USPTO of any defects found in the certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422), and may receive an opportunity to correct the defects. Similarly, the Peer To Patent coordinators may be notified by the USPTO of any defects found in the submission, and may receive an opportunity to correct the defects.

V. Timing Considerations

The following examples illustrate some of the timing considerations of which applicants should be aware:

Example 1: Application Expected to Publish During Pilot.

For example, an application filed during the month of May 2009, with no benefit claim under 35 U.S.C. § 120 has a projected publication date during the month of November 2010. In this situation, applicant may volunteer for inclusion in the pilot program if the application meets the classification requirement (*see* the list at http://www.uspto.gov/patents/init_events/class_subclasses_FY2011pilot.jsp) and is not excluded due to inclusion in, or requests for participation in, other programs. (*See* item 4, in Section III.A above for the list of exclusions.) Provided the Peer To Patent Web site has sufficient capacity for posting and evaluation of the application, the USPTO would consider this application eligible for inclusion in the pilot.

Example 2: Application Requires Request for Early Publication so as to Publish During Pilot.

Applications which do not have a projected publication date during the pilot may become eligible for participation provided applicant files a Request for Early Publication (or voluntary publication, if the application was filed prior to November 29, 2000) so as to

induce publication during the pilot period. For example, applicant might file an application during the month of October 2010, along with the filing of a Request for Early Publication. This application would have a projected date of publication during the month of January 2011. In this situation, applicant may volunteer for inclusion in the pilot if the application meets the classification requirement (*see* the list at http://www.uspto.gov/patents/init_events/class_subclasses_FY2011pilot.jsp) and is not excluded due to inclusion in, or requests for participation in, other programs. Provided the Peer To Patent Web site has sufficient capacity for posting and evaluation of the application, the USPTO would consider this application eligible for inclusion in the pilot.

Example 3: Application Previously Published.

An application published prior to the start of the pilot program is still eligible for participation if the certification and request to participate in the Peer Review Pilot Program (Form PTO/SB/422) is submitted to the pilot no later than one (1) month following the publication date.

VI. Other Conditions Not Imposed by the USPTO

Participation in this pilot program may be subject to further conditions as indicated by the Peer To Patent coordinators, who are responsible for the prior art submission. The USPTO has no responsibility for these further restrictions.

For instance, in the timing consideration examples provided above an application may be accepted for the pilot, yet not be available for posting on the Peer To Patent Web site because the Web site is handling its maximum capacity of current participants.

VII. Results

In addition to statistical data on participation rates and the number of prior art references found and utilized by the USPTO, this pilot will be evaluating the effectiveness of the process more closely as it relates to patent examination efficiency and quality and peer

participation behaviors. This pilot will test whether a peer review process is a viable addition to the normal processes of the USPTO and as an option for applicants to choose among the other products offered by the USPTO.

VIII. Additional Information

For further information on this pilot, please e-mail PeerReviewPilot2011@USPTO.gov or contact Jack Harvey, Director, Technology Center 2100, at Jack.Harvey@USPTO.gov. General inquiries on the Peer To Patent Web site may be addressed to info@peertopatent.org.

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