

**From:** email redacted (rh)  
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**Subject:** Comments regarding patent quality

The attached comments are submitted regarding the patent quality summit.

Thank you

# Is Patent Searching “Valuable Service”

Comments on Enhancing Patent Quality

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by

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In response to the PTO’s Request for Comments and offered in the spirit of “general aspects of quality” the question is asked “is patent searching a functional part of the patent system?” Proceeding from the premise that patent quality is a direct result of quality prior art I will show that there is no space within the regulatory framework for the act of finding prior art. By regulation, the act of finding prior art e.g. patent searching is not recognized as a substantive function in the patent process. The lack of said recognition is a significant driver behind low quality patents.

## WHAT IS VALUABLE SERVICE

Valuable service is the standard that conveys professional status to private sector patent actors. Valuable service is embodied in the patent agents’ number. The Agents number is a license to write and prosecute patent applications for the public. The idea of valuable service is very old and appears to predate even the Patent Act of 1952. Valuable service is established by statute and implemented through regulation.

The Statute 35 USC §2(d) reads in part:

“...possessed of the necessary qualifications to *render applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the office...*”

The Regulation 37 C.F.R. § 10.7(a)(2)(ii) reads in part:

“(a) No individual will be registered to practice before the Office unless he or she shall:

(2) Establish to the satisfaction of the Director that he or she is:

(ii) Possessed of the legal, scientific, and technical qualification necessary to enable him or her to render applicants for patents valuable service.”

Where the Statute reads “...render applicants or **other persons** valuable service, advice, and assistance in the **presentation** or prosecution of their applications or **other business** before the office...,” the Regulation reads render applicants for patents valuable service.

Valuable service therefore is the preparation -- drafting a specification with claims -- and prosecution of a patent application for a patent applicant. “Other persons,” “presentation” and “other business” has been eliminated.

Interestingly, on this point the PTO is on record as agreeing that valuable service is not clearly defined.<sup>1</sup>

## PRIOR ART

The impact of low quality prior art is well documented. Because of the PTO’s interpretation of the governing Statute, the act of finding prior art is rendered a secondary skill appended to the patent attorney and for other reasons appended to the examiner. In reality, finding prior art is an independent function where the searcher has a focus quite different than the application writer or the examiner. Neither the application writer nor the examiner is exclusively focused on finding prior art. On the other hand finding prior art is the sole focus of the patent searcher.

The patent searcher engages on a daily basis in the act of identifying and evaluating prior art. This process requires ascertaining the scope and contents of the art, as well as distinguishing the differences between the identified art and the inventive subject matter. It is a substantive act critical to patent quality and a highly specialized skill. Valuable service manifests in more than just a single manner and patent searching is a vivid example. Competence performing highly specialized technically based prior art search work is an act of providing a valuable service. New prior art is proving very valuable in the IPR process.

Public sector patent searching has been and still is the responsibility of the patent examiner. There is no responsibility for prior art in the private sector. While prior art searches are sometimes conducted by private sector patent searchers it is a service provided as an extension of the patent attorney because the attorney is responsible for the application. In effect, the act of searching has no locus within the broader patent system. Patent searching is a non-professionalized profession. It is obscured from view.

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<sup>1</sup> See Office of Enrollment and Discipline Decisions, Proceeding Number Tech-12, 4/30/2009, p. 7.

## THE PAST AND THE PRESENT

As stated above the concept of valuable service is very old predating the Patent Act of 1952. It is a cliché but the world is vastly different today than 60+ years ago. The same is true of patents. The value of patents has changed. Where patents were once primarily a defensive tool they are today important economic drivers and commodities in their own right. The changed nature of patents in society is reflected in the sheer volume of issued patents in 1952 (46,830) and 2014 (326,038). What worked and was perfectly justified in the past, where there was far less application volume and where patents carried lesser economic value, does not work today. If it did we would not be talking about patent quality.

In the last 15 years there has been a lot of proposals generated by the PTO about prior art. Several years ago there were the ideas of Shared Responsibility and Mandatory IDS's. In 2007 HR 1990 required applicants to submit a search report. More recently the AIA expanded the mechanisms for introducing prior art. The immediate Request for Comments imagines crowd sourcing. It's as if patent searching is something that just happens. All the proposals have one thing in common. They attempt to leverage the skills of the private sector searcher. Despite the rhetoric and legal changes the problem of low patent quality and low quality prior art persists.

The attitude that prior art is just happens has to change. Valuable service must include all functions where a contribution of a substantive nature is made in the prosecution process. Patent searching has never been discussed directly and with good reason; it is not a designated function in the patent system. If the value of prior art is not visibly established then the likelihood that any prior art based reforms will work is remote.

## A NEW INTERPRETATION

Because patents have far greater societal impact today than 60 years ago the time has arrived to reevaluate 37 C.F.R. § 10.7(a)(2)(ii). Congress clearly allowed for "other persons" separate from applicants and "other business" separate from application. Congress apparently recognized that there is more to patents and patenting than the particular skills or function of writing and prosecuting applications.

The Patent Agent number is a credential obtained by passing a rigorous exam of patent laws and regulations. Because the PTO is tasked with protecting the public from non-qualified practitioners the exam was created to further that objective. The Agents number is a license specifically to write and prosecute patent applications.

However, as has been argued, there is another system function extremely valuable to patent quality. Under authority the PTO already possesses and by recognizing "other persons and other business" the Office can create a second exam of rules and regulations that would

confer official recognition to the function of finding prior art and establish the professionalism and visibility of the role. The second exam would not convey a license to prosecute but only show that the individual is a patent professional knowledgeable about subject matter one would expect a patent professional to know.

The need for such a reform should be apparent. In an effort to get prior art in front of the examiner, the PTO once tried to force applicants to submit search results with each application. More recently it has created avenues for third party submissions. Such attempts appear to be efforts to leverage the skills of private sector searchers by having the applicant commission the search work. Prior art will not be treated as valuable if the act of finding it is not clearly visible. Further, creating a second exam would signal the PTO's resolve to find solutions to the issue of low quality prior art.

## AN INCENTIVE SYSTEM

The point of the comments made herein are intended to both draw attention first to the fact that the rules and regulations are silent on a very important contributory role of the patent process and to second show why the rules are silent. The broader idea being that unless patent searching is clearly recognized as integral to the system the skill cannot be exploited. If the skill cannot be exploited then patent quality will not improve.

The PTO can't make applicants search. Only the PTO has the legal responsibility to find prior art. However, encouraging the applicant to search before filing is a different matter. Creating incentives where the applicant is rewarded for searching is an option not before tried.

Identifying incentives to encourage the applicant to search is not within the scope of the comments herein made. It is hoped though that an incentive oriented approach can be identified. By making searching a visible and integral part of the process, e.g. valuable service, incentives to search has potential to work where nothing else has.