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Via Electronic Mail

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US Patent and Trademark Office
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Attn: Karen Ferriter

IBM Corporation Comments in response to Notice of Proposed Rule Making, "*Patent Cooperation Treaty Task Force*", 74 Fed. Reg. 65101 (December 9, 2009)

IBM appreciates the opportunity to comment on the proposed rule making. Patents play a vital role in the global economy. International patent protection is an essential part of the foreign filing strategy for IBM to protect our valuable intellectual property assets. Therefore, we support the Office's efforts to improve the PCT process and worldwide patent protection. Although the Notice of Proposed Rule Making requests feedback on several issues, our comments are directed only to questions 1, 5, 8 and 10.

Question 1

Please identify overall system changes you recommend to the PCT System.

IBM does not propose any changes to the Treaty or Rules. Rather, our comments are directed to a proposal for changes in the processing of international applications and their national phase extensions.

In order to enhance delivery of PCT related information by the International Bureau to the PCT Offices and users, IBM Corporation recommends that the World Intellectual Property Office (WIPO) offer transparency to the PCT process by providing an enhanced, online database that captures from the time of filing the bibliographic information, documents, and prosecution events (collectively "the file") of the international patent application and every other national and regional application having the same priority as the international application. Access to the file of the international application and preliminary examination resulting therefrom would remain confidential pursuant to Article 38 of the Patent Cooperation Treaty, accessible only to the selected International Authorities for the application and the Agents authorized by the Applicant to have access during the international phase.

However, immediately on national phase entry, Applicant(s), any designated Agents worldwide, Designated and Elected Offices, as well as third parties would have access to the complete file

of the patent application family including its international and national phase prosecution activity. This centralized, online patent application database would greatly assist applicants in timely transferring all relevant information to the Designated and Elected Offices for the most effective, efficient and timely prosecution of the applications in the family. It would permit Designated and Elected Offices to exchange search and examination reports and related information. Also, it would make available to third parties at the earliest opportunity the additional technical and prosecution information raised in the international prosecution. We envision that such a comprehensive patent application database would seamlessly integrate with the heterogeneous electronic systems of the Designated and Elected Offices in a hub and spoke relationship, with WIPO providing the central hub and each Designated and Elected Office providing a connection between the hub and its internal information systems. This comprehensive, centralized patent application database would fulfill WIPO's functional mandate to provide an accessible and cost-effective international system for the filing and examination of patent applications.

IBM further recommends that in order to assist technology transfer to all other parties (including third parties), the online WIPO database be built on a foundation of open and transparent standards and tools (including document editors and interchange formats) so that no user is disadvantaged by virtue of not having a paid license to any particular software program.

Question 5

Please explain whether you support including PCT search and examination results in worksharing mechanisms such as the Patent Prosecution Highway (PPH).

IBM would support this proposal of the US PTO, provided applicants are assured that the results of international search and examination (where applicable) before the US PTO as International Authority, are given "full faith and credit" in all Designated and Elected Offices, starting with the offices involved in the initial pilot currently proposed by the PTO.

Question 8

Please Identify any changes recommended to improve the quality of the work produced under the PCT system.

IBM recommends that the International Authorities should be "strongly encouraged" to keep the fees for supplemental internal searches low.

Also, during the national phase, one utility of the comprehensive online patent application database outlined in our response to Question 1 above would be that use of the WIPO database hub by the Designated Offices and Elected Offices to exchange prosecution documents and other information will develop true international collaborative examination and thereby lead to greatly improved patent quality worldwide.

Question 10

Please explain whether you believe that the PCT could benefit from a third-party observation system (including submission of prior art) and/or more efficient means for applicant-submitted prior art.

The issue here is confidentiality - that is, most international searches are completed before publication of the international application (i.e., while the application is still confidential) and Article 38 of the PCT mandates the confidentiality of international preliminary examination phase, which IBM does not support changing at the present time.

Another utility of the comprehensive online patent application database outlined in our response to Question 1 above, would be to provide a facility for third parties to centrally submit potentially relevant prior art to the Designated or Elected Offices for an application undergoing examination during national phase in multiple jurisdictions. During the confidentiality period of the international application phase, third parties could ascertain potentially relevant prior art prior to national entry phase based on limited information gleaned from the title, the published international application and published international search report (once available), and vitals, such as filing and priority dates. Any potentially relevant prior art could be submitted to the applicable International Authority through the WIPO database and would immediately be available to the International Search and Preliminary Examination authorities, and would also promptly and automatically become available to the Designated and Elected Offices for consideration during national phase. This would be particularly effective in conjunction with public prior art submission systems such as the "Peer to Patent" program now being piloted in the USPTO, the Australian Intellectual Property Office, and the Japanese Patent Office.

In conclusion, IBM encourages the Office to continue its collaboration with WIPO and the other members to improve worksharing efforts and PCT process improvements. We look forward to continuing to work with the USPTO PCT Task Force on improving the efficiency of the PCT system as a whole.

Respectfully submitted,

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