

December 16, 2014

Via electronic mail to CrowdsourcingRoundtableNY@uspto.gov

Attention: Jack Harvey, Director, Technology Center 2800.

IBM Corporation comments in response to "Request for Comments and Notice of Roundtable on USPTO Use of Crowdsourcing to Identify Relevant Prior Art"

IBM thanks the United States Patent and Trademark Office (USPTO) for the opportunity to comment on the use of crowdsourcing for identification of relevant prior art as part of the patent prosecution process. IBM strongly supports the USPTO's effort.

In response to the Questions:

1. In what ways can the USPTO utilize crowdsourcing to identify relevant prior art that would be available for use in the examination of published applications while maintaining the ex parte nature of patent examination? Some examples of how the public traditionally uses crowdsourcing include: passively monitoring discussions (thread) between parties on crowdsourcing Web sites, and posting a question on a crowdsourcing Web site and viewing responses to the posted question.

Crowdsourcing can be used in several ways to help identify relevant prior art. As in the Peer to Patent pilot program, published applications can be posted to websites for public comment, optimally in a collaborative fashion. The prior art identified by the public can then be ranked (by vote) and the top ranking entries can be sent automatically to the USPTO. This would achieve a balance between allowing the public to openly comment, yet avoid overwhelming the USPTO with numerous potentially irrelevant entries.

The USPTO could also reach out directly to expert volunteers by email or through a collective interface such as an expert marketplace. The marketplace could be used to facilitate a more impartial method of reaching out; for example a tool could randomly choose one of multiple volunteers in the appropriate technical area to whom to forward the request. In order to alleviate any ex parte or similar concerns, a template request for art could be easily developed that could be used in either situation.

Crowdsourcing could also be used in ways that complement identification of relevant prior art. It could be used to identify experts who could be contacted for additional prior art and encourage them to volunteer; or it could be used to determine the level of ordinary skill in the appropriate art area.

2. If the USPTO were to post a question relating to the technology of a published application on a crowdsourcing Web site, what follow-up communications, if any, could someone from the USPTO have with parties on the Web site? Some examples of how the public traditionally engages in follow-up communications on crowdsourcing Web sites include: a conversation on the thread with a particular party who responded to the posted question to clarify information the party provided, and a conversation on the thread with a particular party who responded to the initial posting to request additional information.

Having the ability to pursue follow up communications with crowdsourcing participants is an integral part of being able to identify the best relevant prior art. If a party has provided information which, if clarified, would help the examiner, there is no reason why such communication should be prohibited, as long as it is a matter of public record. Likewise, answering a request for additional (publicly available) information should be permissible.

Ultimately the best prior art is that which is most relevant to the claim being examined, so an examiner might wish to focus such communications appropriately to achieve the highest degree of relevance.

3. What appropriate precautions, if any, could the USPTO employ to ensure that the use of crowdsourcing tools does not encourage a protest or other form of preissuance opposition to the grant of a patent? (See 35 U.S.C. 122(c).)

As long as the patent applications are already published, and therefore a matter of public record, then IBM does not believe there would be an issue with the use of crowdsourcing tools. IBM also does not believe there is a need for inserting a “buffer” entity between the Examiners and the crowdsourcers; Examiners are trained professionals and the addition of an added layer of complexity would unduly complicate the process and increase costs. If, as IBM has proposed, collaboration among the crowdsourcers will be possible (like in the Peer to Patent pilot), it will be difficult to restrict the level of commentary on such tools. For example, restricting arguments regarding patentability (currently not allowed under the Preissuance Submissions Program) will be nearly impossible in an open forum. Examiners should be trained to ignore such arguments and simply use the features of the prior art found in order to improve examination, as was done during the Peer to Patent pilot. It is in the best interest of the patent system that patents be of the highest quality rather than exclude information from a form over substance perspective.

4. If the USPTO cites in an application prior art obtained via crowdsourcing tools, to what extent, if any, should the USPTO document the crowdsourcing activities used to identify the prior art?

It is helpful to the public, applicants, and USPTO personnel to establish a record of what prior art was found as well as where. For the public, it establishes a feedback loop to demonstrate the effectiveness of participation in the various crowdsourcing tools available. Citation to the particular tool (or even the URL of the page) would be an excellent means of specific feedback. For applicants, documenting the crowdsourcing should be considered a part of documenting the search strategy as is done currently. For USPTO personnel, it would be helpful for both other examiners to learn about good sources of prior art, as well as a specific track record for

subsequent personnel working on the same application. Because of the dynamic nature of crowdsourcing (as opposed to generally a point in time traditional search for prior art), revisiting the particular tool may yield improved results in a subsequent stage of examination such as a continuation or an appeal.

IBM actively participates in the Preissuance Submissions program, and we need to be able to see how effective our submissions are in order to continue our investment in the program. When prior art is cited in an office action, it is a clear indicator of the use of the prior art, however we suspect that other submissions are “helpful” and worth the time and effort to submit. For example, a reference might not be cited, but could be used to increase understanding of a technical aspect of the invention, or to help direct a search in a more productive direction. A clear indication of “helpfulness” is not currently available. If items submitted through the Preissuance Program could each be rated (e.g. used, helpful, cumulative, not relevant) that would be very useful feedback.

5. For each published patent application, if the USPTO gave the patent applicant the option to opt-in or opt-out of the USPTO's use of crowd sourcing, would applicants choose to participate in the crowdsourcing program? What considerations would inform the applicant's decision?

IBM would certainly choose to opt-in to the use of crowdsourcing, as we believe increased opportunities to find relevant prior art will improve the quality of the resulting patent. More generally, IBM believes that no opt-in is needed as all applications are currently subject to the Preissuance Submissions Program once published, and other crowdsourcing tools would not be significantly different in their impact; they are just other avenues to find relevant prior art. If the process of crowdsourcing would lengthen the time of prosecution, it might be advisable to have an opt-out available if there is a time sensitivity in the case of a particular patent application.

Conclusion

In conclusion, IBM strongly believes in the use of crowdsourcing to find relevant prior art for use in the examination of patent applications. We were at the forefront of crowdsourcing with the Peer to Pilot program, and actively participate in the current Preissuance Submissions program. Continued and expanded use of crowdsourcing will benefit the public, applicants, and the USPTO by helping to locate the best prior art and improve the overall quality of issued patents, a goal that should be sought by all participants in the patent system.

Respectfully submitted,

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