

**From:** Vera Ranieri  
**Sent:** Monday, December 08, 2014 9:23 PM  
**To:** CrowdsourcingRoundtableNY  
**Cc:** Daniel Nazer  
**Subject:** Comments of the Electronic Frontier Foundation - PTO-P-2014-0013

Attached please find the comments from the Electronic Frontier Foundation in response to PTO-P-2014-0013, Request for Comments and Notice of Roundtable on USPTO Use of Crowdsourcing to Identify Relevant Prior Art.

Kind regards,

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**COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION  
REGARDING USPTO USE OF CROWDSOURCING TO IDENTIFY RELEVANT  
PRIOR ART**

**Docket No. PTO-P-2014-0013**

The Electronic Frontier Foundation (“EFF”) is grateful for this opportunity to respond to the request by the United States Patent and Trademark Office (“PTO”) for comments regarding the use of crowdsourcing to identify relevant prior art. EFF is a non-profit civil liberties organization that has worked for more than 20 years to protect consumer interests, innovation, and free expression in the digital world. Founded in 1990, EFF represents more than 22,000 contributing members. EFF and its members have a strong interest in promoting balanced intellectual property policy that serves both public and private interests. Through litigation, the legislative process, and administrative advocacy, EFF seeks to promote a patent system that facilitates, and does not impede, “the Progress of Science and useful Arts.”

**I. Introduction**

The rise of the Internet and the vast amounts of information it makes easily accessible provides incredible opportunities for the PTO to improve the quality of the examination of patent applications. EFF welcomes the PTO’s interest in working to improve patent quality through crowdsourcing. This new tool and the Internet more generally could become instrumental and essential to ensuring patent quality. However, given the large quantity of applications, these tools will have a significant impact on patent quality only if the PTO and the public are able to harness automated search and other computer tools to generate prior art leads. EFF previously submitted comments regarding these issues, and we incorporate those comments herein.<sup>1</sup>

In this submission, our suggestions are directed to helping the PTO leverage the vast information on the Internet by proposing the PTO evaluate whether its Internet Usage Policy, adopted in 1999, reflects the needs and concerns of today, and to note that the PTO should use

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<sup>1</sup> See Comments of the Electronic Frontier Foundation Regarding Crowdsourcing and Third-Party Preissuance Submissions, Docket No. PTO-P-2014-05996, May 9, 2014, available at [http://www.uspto.gov/patents/law/comments/cr\\_a\\_electronicfrontierfoundation\\_20140509.pdf](http://www.uspto.gov/patents/law/comments/cr_a_electronicfrontierfoundation_20140509.pdf).

any and all means at its disposal to investigate the state of the prior art, including by leveraging crowdsourcing websites.

**II. The PTO should re-evaluate its position on the use of the Internet for prior art searching generally.**

MPEP § 904.02(c) sets out rules for examiners on the use of the Internet for searching for prior art. That section resulted from a Request for Comments published in October 1998, and adopted on June 21, 1999. *See* Request for Comments on Proposed Internet Usage Policy, 63 Fed. Reg. 57101 (Oct. 26, 1998); Internet Usage Policy, 64 Fed. Reg. 33056 (June 21, 1999). The resulting Internet Usage Policy restricts the ability for examiners to use the Internet to search for prior art for any unpublished application, for fear that such a search could disclose proprietary information directed to a specific application. MPEP § 904.02(c). The apparent reason for this restriction is that at the time the rule was adopted, there were unresolved issues as to whether the capture of search requests by unauthorized individuals could compromise the confidentiality of unpublished pending applications. *See* Internet Usage Policy, 64 Fed. Reg. at 33058 (comment 11).

Technology, including technology to increase security and anonymity, has certainly changed since the PTO issued its rule in 1999. Tools now exist to anonymize IP addresses (e.g., Tor, [www.torproject.org](http://www.torproject.org)), to create anonymous searches (e.g., DuckDuckGo, [www.duckduckgo.com](http://www.duckduckgo.com)), and to limit the tracking of Internet usage across websites (e.g., Privacy Badger, <https://www.eff.org/privacybadger>). Given that over 15 years have passed since the adoption of the restrictions on searching the Internet, the PTO should revisit its Internet Usage Policy to determine whether concerns regarding confidentiality remain in light of the tools that exist today. Relatedly, to the extent any concerns remain, the PTO should study whether it can develop its own internal tools, such as browser extensions, to further minimize any perceived risk to the confidentiality of applications.

Finally, to the extent risks to confidentiality cannot legitimately be removed, the PTO should consider adopting a policy which encourages examiners to conduct an Internet search once an application has been published. Currently, the MPEP encourages examiners to make one efficient search at the outset of prosecution so as to minimize the need to make additional prior art searches at a later time. MPEP § 904 (“The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the

claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search.”). While efficiency is a laudable goal, the importance of Internet searches to patent quality means that examiners should consider a second search, and specifically an Internet search, not only in the situations listed in § 904, but also if the application is published after the original search was conducted. In general, examiners should be encouraged to engage in Internet searches for prior art as soon as practicable after an application publishes.

### **III. The PTO Should Encourage the Use of Crowdsourcing To Investigate The Prior Art.**

EFF welcomes the opportunity to comment on specific questions presented by the PTO in its request for comments. EFF’s comments are below, addressing the nature of the information that should be sought while maintaining the *ex parte* nature of examination, as well as a suggestion to implement an opt-in pilot program investigating the best methods of gathering prior art.

#### **1. The PTO should use crowdsourcing to enquire as to factual matters relating to the state of the prior art.**

The PTO has requested comments on the manner the PTO may use crowdsourcing tools to identify relevant prior art and what sort of follow-up could be engaged in on crowdsourcing sites while maintaining the *ex parte* nature of patent examination. EFF’s position is that any tools that gather factual knowledge regarding the state of the art can be used, including follow-up questions, and doing so would not violate the *ex parte* nature of patent examination.

For example, for a claim directed at manufacturing microprocessors, the PTO could enquire about the various processes used to do so as of the priority date of the application. The PTO could also enquire about aspects of the processes, gathering more *factual* information as to the state of the art. To be clear, the PTO can and should ask about specific aspects of a claim and whether or not certain aspects existed in the prior art as a *factual* nature. What would perhaps impose on the *ex parte* nature of patent examination would be to solicit information regarding *legal* conclusions regarding the patentability of a particular claim. For example, the PTO should refrain from asking whether it would be obvious to utilize certain manufacturing processes in

developing microprocessors, or whether any particular aspect of a claim is legally inherent in the prior art.

Concerns regarding 35 U.S.C. § 122(c) should not prevent the PTO from inquiring as to what exists in the prior art. Indeed, the PTO already engages in such interaction with the public. The PTO has recently expanded its Patent Examiner Technical Training Program so as to invite members of the public to speak as to the state of the art in certain fields. *See* Patent Examiner Technical Training Program (“PETTP”), described at <http://www.uspto.gov/patents/pettp.jsp>. The fact that the receipt of technical information occurs within the context of a particular application should not alter the ability of PTO examiners to learn about the prior art. That is, the *ex parte* nature of patent applications does not prevent PTO examiners from learning facts regarding the state of the prior art and making independent legal determinations as to the effect of those facts. Instead, the *ex parte* requirement merely limits the procedural *right* of third parties to make legal arguments as to the invalidity of a patent application. *See* Black’s Law Dictionary (defining *ex parte proceeding* to be “any judicial or quasi-judicial hearing in which only one party is heard”); *see also* MPEP § 1134 (noting that pre-issuance submissions, consistent with 35 U.S.C. § 122(c), allow for factual descriptions of a document’s relevance).

Interpreting 35 U.S.C. § 112(c) to allow for fact finding by examiners is also consistent with patent laws. 35 U.S.C. § 131 allows for the PTO to grant a patent only when “it appears that the applicant is entitled to a patent under the law[.]” This law includes the requirement that the invention be new and nonobvious. *See* 35 U.S.C. §§ 102, 103. Thus the PTO must apprise itself of facts, wherever they may be found, relating to whether or not the application meets the requirements of §§ 102 and 103. Indeed, any opinion to the contrary would seem to require the PTO to ignore real-world developments as to the state of the art and would allow patent applicants to exploit PTO ignorance to gain patents on systems, methods, and apparatuses to which they were not entitled.

Admittedly, there is a risk that third-parties may, purposely or not, make legal arguments regarding patentability through the use of crowdsourcing tools. That risk is minimized, however, by not posting requests specifically referencing the proposed claims with a request for invalidating prior art, but rather inquiring more broadly as to the state of the art in the field and invention to which the patent claim is directed. Furthermore, the PTO could train examiners to disregard any legal arguments made by third parties by giving them no weight, or utilize a

reviewing process to determine they do not raise legal arguments. Indeed, the PTO has already implemented a reviewing process when it receives third-party submissions. *See, e.g.*, MPEP § 1134.01 § V. The PTO could implement a similar process for collecting information regarding the prior art by either tasking a team to review submissions before they are entered into the file history, or by contracting with a third-party to make such reviews. Such a review could disregard any legal arguments presented via crowdsourcing.

The PTO has further requested comments on what follow-up communications, if any, could someone from the PTO have with parties on a website. The PTO should allow examiners to engage in such communications where this would help review. Seeking knowledge regarding the state of the art, including by interacting with the public through follow-up communications, does not alter the *ex parte* nature of examination and should not be objectionable, for the reasons discussed above. That is, an examiner seeking information as to the state of the art, whether it be through initial inquiry or follow up questions, should raise no concern that a proceeding is not *ex parte* in nature given that the information sought is factual in nature, does not request legal argument, and does not give any procedural rights to third parties.

**2. In order to determine the best crowdsourcing methods, the PTO should conduct trials of various methods to determine what method is best.**

The PTO has requested comments on what ways it could use crowdsourcing to identify relevant prior art. EFF believes that in order to determine the best method, the PTO should consider trialing several methods and soliciting feedback from examiners regarding what methods produced the highest quality results in various technological arts.

Different Internet services exist that could be used to gather information regarding prior art, including services such as GitHub<sup>2</sup> (code repository), StackExchange<sup>3</sup> (technical Q&A), and even YouTube<sup>4</sup> (user-generated videos, often containing “how-to” videos regarding technical products and services) can be sources of prior art information. Services such as the “Wayback

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<sup>2</sup> github.com

<sup>3</sup> stackexchange.com

<sup>4</sup> www.youtube.com

Machine” at the Internet Archive<sup>5</sup> can also be used not only to locate prior art, but to corroborate dates.

The PTO is likely concerned that using crowdsourcing may generate significant irrelevant information that may hinder efficient examination of applications. In order to determine the best methods of crowdsourcing, the PTO should consider running a trial program using various methods, and solicit examiner feedback as to the quality of the results achieved using various methods.

**3. The PTO should offer prioritized examination to applicants that opt-in to using crowdsourcing during the trial period.**

EFF believes that once final crowdsourcing procedures are in place, applicants should not be able to opt-out of having an examiner use crowdsourcing to find prior art. The best prior art is essential to improving patent quality, wherever it comes from. The PTO should not limit any potential source of prior art, so long as it is consistent with the patent laws. This is especially important given that the Supreme Court has clarified that a defendant in an infringement action must prove invalidity by clear and convincing evidence, regardless of whether the particular prior art was previously considered by the PTO. *See Microsoft Corp. v. i4i Ltd. P’Ship*, 564 U.S. \_\_\_, 131 S. Ct. 2238, 2249-51 (prior art must show invalidity by clear and convincing evidence regardless of whether or not it was considered by the PTO, although art not considered by the PTO may carry more weight in the invalidity analysis). If applicants are allowed to opt-out of crowdsourcing prior art, the PTO would limit its prior art toolkit, and a later defendant is disadvantaged by having to meet its burden to prove invalidity despite never having the prior art considered under the standards for granting a patent.

A second, related concern is that crowdsourced prior art may become more difficult to obtain through the passage of time. Websites change. Memories become fuzzy, and documentation is destroyed. A patent applicant that opts-out of prior art searching could use the passage of time to help ensure that the most relevant prior art cannot succeed in invalidating the patent, not because the prior art doesn’t invalidate, but because the proof of the prior art is no longer available. The PTO is in the best position to find crowdsourced prior art given that its search will occur closest in time to the priority date of the application.

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<sup>5</sup> [archive.org/web/](http://archive.org/web/)

EFF recognizes that searching crowdsourced prior art will require shifts in examination procedure. As such, EFF also suggests that if the PTO implements a trial program to investigate the best methods of crowdsourcing, the PTO could make such a trial program opt-in, granting patent applicants who opt-in to such a program the ability to receive prioritized examination.

#### **IV. Conclusion**

EFF again thanks the PTO for the opportunity to comment regarding crowdsourcing prior art. We commend the PTO for its work so far in its efforts to improve patent quality through investigating non-traditional avenues for locating prior art.

Respectfully submitted,

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