The attached comments are offered regarding the Patent Quality Summit.

Thank you

Is Patent Searching Related to Patent Quality

Comments on Enhancing Patent Quality
Submitted on 3/17/2015
by
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In response to the USPTO's request for comments, the following comments directed to prior art and patent searching are offered.   The Office identified three aspects of quality termed Patent Quality Pillars. Two of the three Pillars are entitled: 1) Excellence in Work Product and 2) Excellence in Measuring Patent Quality. Although the comments herein evaluate Pillars 1 and 2, they are actually directed more broadly to "general aspects of quality." The comments are intended to raise questions about the role and function of patent searching and prior art in the patenting process.

BACKGROUND

While there are many contributors to patent quality, legal training and claim clarity, for instance, this writing proceeds on the proposition that patent quality is directly related to quality prior art. This proposition is underscored by the recent Federal Circuit decision to affirm the PTAB's decision in IPR 2012/000001 (6778074). The Board cancelled issued claims on the basis of new prior art. The new art included old patents typically found through manual classification searching and in-force patents with relevant keywords present in the title and abstract. The record does not show an applicant submitted IDS. The record shows a minimal search by the examiner.   In essence, the patent under review in IPR 2012/000001 issued with only rudimentary searching conducted by both the applicant and the Office. The new art appears to have been easily found and is consistent with what a commercial search provider would produce in a patentability search.   IPR 2012/000001 serves to illuminate poor quality prior art as a core issue in today's patenting process.   Since the Board is cancelling in very high numbers the prior art issue appears to be multiply manifest. The comments herein are not intended to be a criticism of any actor and are meant only to underscore the criticality of prior art to high quality patents and the fact that prior art has to be found.

The act of finding prior at is patent searching and the people who do it professionally are patent searchers.   The act of searching requires a human to actually put eyes on documents and make a judgment regarding each document reviewed. Quality prior art is found by people engaged in a qualitative activity.

The Request for Comments addresses patent searching indirectly five times. Under the section entitled Existing Quality Efforts there is, as a first example **1**) comments are made about implementation of the CPC; as a fifth example **2**) the Office is leveraging the search products of other IP Offices through the PPH and CCD programs; as a ninth example **3**) crowdsourcing and pre-issuance submissions are mentioned and as a tenth example **4**) the First Action On the Merits Search Review. In the section

entitled New Quality Proposals, under the heading of Excellence in Work Products **5**) the Office proposes an Automated Pre-Examination Search.

Commencing in 2002 with the 21st Century Strategic Plan and continuing to the present the Office has mostly "talked about" prior art and only once directly addressed the function of prior art searching. That once was in the 21st Century Strategic Plan which proposed Certified Search Authorities. The Office has never had a discussion regarding fundamental aspects of nor defining characteristics of patent searching or finding prior art. While many proposals have been made, at least since 2002, concerning ways to get prior art in front of the examiner nothing has changed.

COMMENTS REGARDING PILLAR 2: EXCELLANCE IN MEASURING PATENT QUALITY

The Office has developed a Quality Composite Metric (QCM) composed of seven factors. Among these factors is an FOAM search review. What does this assess?

A review of the two videos produced by the PTO explaining the QCM, it is apparent that a quality review of search results consists of a review of the procedures, that is, was a proper rejection or allowance made based on the art of record. This procedure does not attempt to ascertain the quality of the art of record. Indeed, the patent involved in IPR 2012/000001 would have passed this review.

As discussed above, the act of finding prior art is a labor intensive activity because it requires human judgment on every document in a given set.

The following questions are asked of the Office.

1. What constitutes a quality prior art pre-examination or patentability search?

2. How long on average (or within an average range) does it take to conduct a patentability search?

3. How long does it take to train a patent searcher?

The three questions herein asked have answers and are addressed regularly as normal business practice within the commercial search industry. A fourth question might be: Do private sector and public sector searchers look for the same thing? On the other head, is it is even appropriate to compare standard operating search practices' utilized by private sector searchers with the standard practices' employed by examiners? I don't know but I think it's worth investigating.

I think that private sector searchers have different motivations and objectives than patent examiners. If this is true what are the differences and why? If there are different motivations why is that so and does this have an effect on quality.

The questions are asked because it is apparent that prior art is critical to quality and it is expected that the Office would fully understand quality patent searching in order to reach its quality goals.

COMMENTS REGARDING PILLAR 1: EXCELLANCE IN WORK PRODUCT

As mentioned above, the Office proposes an Automated Pre-Examination Search tool and solicits input from developers.   The development of such a tool would be greatly welcomed. My only comment is directed to the characterization that such a tool would "…. get the best prior art in front of an examiner…."   Whether found art can be characterized as best would still require a human to make a judgment. Is the Office suggesting that we can dispense with the human element in identifying quality art? Reviewing the results produced by an automated search engine would still represent one step in a pre-examination patentability search.

Another question: How does automated searching comport with the development of the Cooperative Patent Classification system?

CONCLUSION

The Request for Comments identifies several steps the Office is taking to improve patent quality. The Request references the CPC which presupposes that the classification system is an integral tool employed by examiners. However the Office does not demonstrate that there is a mechanism to confirm this assumption.   I think this, combined with characterizing as "Excellence" an Automated Pre-Examination Search, demonstrates a lack of appreciation that patent quality is achieved through a qualitative activity in which human decision-making is indispensable.

In addition, the Request references crowdsourcing and pre-issuance submissions.   Both ideas, while acceptable as a means for the Office to receive prior art, clearly push the act of finding art to a 3rd party. It isn't clear to me why a 3rd party would necessarily do those things. Never the less both suggestions are examples of talking about prior art and do not address the range of efforts required to find it.

The benefits of prior art searching are generally recognized. Since patent quality is directly related to quality prior art then the act of finding prior art must have value.   Only when patent searching and its role within the patent system are better understood can informed policy choices regarding prior art be made.