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Dec. 11, 2014

The Honorable Michele Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314   *Via email*: CrowdsourcingRoundtableNY@uspto.gov

Re: Comments on: "USPTO Use of Crowdsourcing to Identify Relevant Prior Art," 79 Fed. Reg. 67159 (November 12, 2014)

Dear Deputy Under Secretary Lee:

Article One Partners, LLC (AOP) respectfully submits its comments on the "USPTO Use of Crowdsourcing to Identify Relevant Prior Art" 79 Fed. Reg. 67159 (Nov. 12, 2014).

AOP's leadership appreciated the opportunity to participate in the Dec. 2, 2014 Roundtable on Crowdsourcing which was presented in the same 79 Fed. Reg. 67159 announcement. We further commend the White House and the USPTO for the appointment of Christopher Wong as the Presidential Innovation Fellow assigned to assist the USPTO with a crowdsourcing program. Most importantly, we are honored to represent AOP's patent research community. We commend and congratulate AOP researchers and those from other crowdsourcing communities such as Ask Patents and Peer-to-Patent, for their accomplishments, which continue to support progress at the USPTO on this project.

Summary:

AOP is honored to provide additional comments to build upon its comments dated April 28, 2014 for the initial USPTO Roundtable on Crowdsourcing (79 Fed. Reg. 15319). The USPTO's request for comments focused on several issues for which AOP has developed best practices that can be instructive for the USPTO's consideration. AOP has selected the following issues presented by the USPTO: issue 1, maintaining the ex parte nature of patent examination; issue 3, precautions to employ to ensure that the use of crowdsourcing does not encourage a protest; and, issue 5, whether patent applicants would opt-in on a voluntary basis to a crowdsourcing program.

AOP summarizes its suggestions for the USPTO as follows:

1) The Evidence Speaks for Itself
The value of increasing patent quality by accessing evidence from the public is laudable, but carries risk of adding additional parties to the prosecution proceeding or enabling misuse of the system. To protect the patent applicant, AOP strongly advises the crowdsourcing platform to eliminate the ability of the researchers to provide qualitative feedback on the prior art. AOP addresses this issue by presenting the notion to the community that the prior art speaks for itself. AOP provides a way for the responding researcher to identify where in a publication to focus as the

basis for providing the publication, without allowing the entry of any additional commentary. AOP accomplishes this by presenting an entry in its response platform for the location, page, paragraph, figure, column, line etc. of where in the responsive publication the relevant teaching resides. This protects the ex parte nature of the system (issue 1), reduces the risk of prompting a protest (issue 2) and supports reducing risk for applicants, thereby increasing the likelihood of applicants volunteering for the program (issue 5). Peer review can still be implemented within this paradigm by rating the responsive evidence on a binary basis as a whole rather than commenting or interpreting the evidence.

2) <u>Promote Value to Applicants</u>
The USPTO program supports "Gold Plating" patent applications that are issued as patents based on increasing the quality of the prior art available to Examiners. A best practice by leading IP strategists is to provide the USPTO with the most comprehensive relevant prior art collections to support the strongest examination possible. AOP clients provide feedback that it is no longer sufficient to rely on the quality of patents in the ordinary examination process, as evidenced by the high rate of invalidity in post grant proceedings. AOP suggests that the USPTO focus on this value proposition to bring stakeholders into the program on this basis, with major stakeholders making a commitment to have their applications opted-in to the program and for academic and other analytical resources who favor the program to aggregate historic research on "Gold Plating" and to form an analytical framework as part of the program to measure and report on the success of this aspect of the program over time. Similarly, the outcome for non-crowdsourced applications can be evaluated over time, so that statistics also can measure the risk of not participating in the program as a function of the efficacy of patents through the patent lifecycle, including potential monetization events and/or litigation or post grant proceeding reviews. This will support an informed basis for applicants to opt-in as a participant in the program (issue 5).

3) <u>Honor the Individual</u>
AOP's presentation at the Roundtable on Dec. 2nd began with a quote from one of our researchers:

"Patent invention ideas have made our nation as Americans one of the most industrious and wealthiest nations on earth. Different and new innovations have provided a great sense of ease, comfort and better quality of living in our society as consumers and citizens, which have made us a very strong economic nation."

Anonymous, AOP researcher. 2014 (AOP researchers' information is subject to privacy protection).

AOP is deeply committed to providing value to the sponsor of patent research. In this case, the USPTO would be the sponsor of the research. But as the USPTO seeks to improve the quality of every patent application on an individual basis, AOP strongly urges the USPTO and other stakeholders to similarly treat the value of each and every researcher who contributes to the program and to properly value and honor every responsive contribution. AOP recognizes contributions from the researchers through monetary compensation, among other mechanisms. AOP also provides recognition to the researchers in many aspects of our crowdsourcing platform. In the case of the USPTO, the program must recognize the contributions of researchers, applicants and Examiners to support transparency and a symmetric exchange of value. Importantly, it promotes members of the public as researchers who possibly are encountering the patent system for the first time, engaging on a positive basis to produce the highest quality applications. By honoring the individual in all aspects of the program, the USPTO improves its chances of voluntary participation by applicants and the resulting value to the patent system and public perception of the fairness and comprehensiveness of the process. The USPTO can implement this through the official rule-making of the USPTO for Examiners or applicants, voluntary opt-in or by incentivizing members of the public to participate as researchers. This supports the opt-in objective (issue 5).

Additional Data:

A.   Skill Set of the Public as Crowdsourced Researchers

AOP noted a number of comments at the Roundtable and an oft-repeated statement pervasive within the IP industry that the public does not understand patents. The USPTO has had programs recently to attempt to simplify and reduce some statutory requirements of patent laws into plain language. However, the broader cycles of complexity in our patent laws, court standards and patent attorney work product, are ripe for simplification and conversion of complex rules into plain English.

Be that as it may, AOP's leadership disagrees with the notion that the public does not understand patents. AOP's position is supported empirically; about 50% of AOP researchers do not have any background in patent law. The highest value responses often come from researchers without a background in patent law and sometimes from researchers with a technology background distinct from the subject matter of the researched patent. Regardless of their background, the public individually and on a collective basis provides the highest quality of prior art references available globally. It is the varying perspectives of the public unencumbered by formal patent legal analysis that may be an advantage to the public. AOP strongly urges the USPTO to take every opportunity in developing this program to consider whether a view of the public as unable to understand patents will act as an incentive or disincentive to their participation. AOP also encourages the program stakeholders to support a vision of placing responsibility on applicants

and members of the patent bar to improve the clarity and plain meaning of patent applications.

B.   Compensation

AOP reiterated its position that crowdsourced researchers should be compensated. Please refer to AOP's April 28th comments and statistics about the success of the AOP / Ask Patents pilot program that involved compensation. At the Dec. 2nd Roundtable, the administration presented the notion of piloting the program. AOP further suggests that the pilot include variations on incentive programs for the researchers. In some cases, researchers may receive compensation and in some cases researchers can volunteer their efforts. An interesting element is to allow researchers to designate any monetary compensation to be reinvested into the USPTO crowdsourcing program. As the USPTO is assessing the cost of compensating the researchers, AOP suggests that the USPTO also provide an optional payment selection to the applicant, so that the applicant can fund the specific crowdsourced research with a predetermined amount or a selection of different levels. This will enable a series of pilots to best evaluate the investment and return for all participants, applicants and researchers, in the program.

C.   USPTO Objective Assessment of the Quality of Patent Applications to Determine Input into A Crowdsourcing Program

AOP provided a paradigm in its April 28th comments for the USPTO to assess the quality of the applications it receives and to rank them relative to each other to determine the candidate applications which on a lower tier quality basis may require additional research by the Examiner. Some standard measurements include number of claims and number of words in each claim. AOP has also identified additional and more sophisticated metrics that can be applied and AOP would support working with the USPTO to build out this system. For the purposes of these comments, the value of relative weighting is twofold: first, it segregates on a merit basis those applications which can most benefit from input from the public in order to assist Examiners; and, second, it shifts responsibility to the applicants to provide better quality applications relative to each other in order to contribute to the overall improvement of the patent system. This can form the basis for an involuntary crowdsourced program or it can be implemented in tandem with a voluntary opt-in system, but providing more guidance to applicants as to why their applications may or may not benefit from the crowdsourced program. While the USPTO is looking for participation from the public to improve the patent system, applicants can be considered as members of this constituency as well.

Respectfully submitted,

Cheryl Milone, Esq., B.S.E.E.
Chairman and Founder
Article One Partners, LLC

**Roundtable on USPTO
Use of Crowdsourcing
to Identify Relevant Prior Art:
Article One Presentation**

Dec. 2, 2014

New York

Chicago

London

Boulder

Palo Alto   Boston

1. The Evidence Speaks for Itself

**2. Promote The Value to Patent Applicants
of "Gold Plating" Applications**

3. Honor the Inidividual

1. The Evidence Speaks for Itself

Theory: Evidence should be interpreted

- **wtihin the four corners of the publication,**
- **only by USPTO officials.**

Execution:

- **Eliminate any opinion/interpretation by the crowd. Responses should include the publication itself and a reference to text locations (page, para. numbers, cols./lines, figures) for the relevant teaching. The response input form should omit entry points for narrative and instruct the researcher that any interpretation will void the response.**

- **Peer review should be disabled.**

Addresses PTO Issues 1, 2 and 5

- **Disabling interpretation maintains the ex parte proceeding as the crowdsourced program is used as an additional research database rather than a platform for interpretation of the art.**

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2. Promote Value To Applicants

Theory: The best practice by leading IP strategists is to provide the USPTO with the most comprehensive IDS to support the strongest examination possible, resulting in "GOLD PLATING" issued patents. Without gold plating, there is no longer a reasonable certainty that the patent will stand the test of validity in court or in post grant proceedings. The cost to prosecute patents and maintain them through monetization warrants this investment up front.

Execution: (Addresses PTO Issue 5)

- **As part of launching the program, promote the value of gold plating patents with industry thought leaders and challenge companies involved in the program to volunteer to have their applications crowdsourced.**

- **Target developing a recognition of applicants who volunteer their applications for crowdsourcing, regardless of whether the program makes it mandatory.**

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3. Honor the Individual

Honor EACH individual as a stakeholder in the crowdsourced program:

the Patent Applicant, Examiner and Crowdsourcing Member of the Public

Theory: The motivations of each party to the program need to considered and balanced to achieve the goal of higher quality patents, as well as minimizing risk to applicants and providing value to Examiners.

Execution: (Addresses USPTO Issue 5)

- **Seek a formal acknowledgement of opt-in decisions by applicants and seek to add a level of quality certification to those patents where the applicant volunteers.**

- **Provide support to Examiners to efficiently review crowd provided prior art and enhance examination.**

- **Honor the crowd of researchers, whether through formal notices of recognition, monetary compensation or other forms of recognition.**