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Via electronic mail

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Attention: Nicole Dretar Haines

IBM Corporation comments in response to “Request for Comments and Notice of Roundtable Event on the Use of Crowdsourcing and Third-Party Preissuance Submissions To Identify Relevant Prior Art”

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IBM thanks the United States Patent and Trademark Office (USPTO) for the opportunity to comment on crowdsourcing and third party preissuance submissions to identify relevant prior art. IBM has been a strong supporter of this effort from the start of the Peer to Patent project, and maintains active participation in the program.

In addition to our comments below, please see our previously submitted comments on Third Party Preissuance Submissions:

[www.uspto.gov/patents/law/comments/x\\_aia-e\\_ibm\\_20111104.pdf](http://www.uspto.gov/patents/law/comments/x_aia-e_ibm_20111104.pdf)

<http://www.uspto.gov/patents/law/comments/preissue/index.jsp> - Section E. Companies; IBM

In response to the Questions:

1. How can the Office leverage the collective knowledge available via crowdsourcing to provide an examiner with relevant prior art?

The USPTO can encourage crowdsourcing by reaching out to large pools of technical resources such as universities or the private sector and encourage the establishment of local programs with incentives for finding prior art. At a university, for example, such a program might be part of course work or include recognition similar to a publication. Alternately, a contest could be set up between universities or groups within a university, with victory going to the group with the most submissions, or the most successful (i.e. used in a rejection) submissions, depending on the length of time available for the contest. In the private sector, incentives might be integrated with an inventor award system. The USPTO can act as a conduit for an exchange of ideas on how to establish these programs.

Another avenue would be crowdsourcing among patent offices, or by sponsoring crowdsourcing events at the USPTO remote offices. Such events would be open to the public, and the USPTO could explain the process, encourage submissions, and provide procedural help to enable submissions at the events.

Please also see question 3 and the use of collaborative tools in order to find the most relevant prior art.

2. What suggestions do you have for the Office to encourage more third-party submissions from the scientific and technical community via crowdsourcing activities?

According to recently published statistics on the preissuance page of the USPTO site, the percentage of submissions relied upon is 12.5%, but according to the examiner survey, 23% of the submissions were rated “great” and 29% were rated “moderate” in terms of helpfulness. It is difficult to measure success in ways other than having a rejection cite the prior art, and a very high bar for success does not encourage submissions. IBM suggests that if the examiner finds prior art helpful, even if not relied upon, that the examiner so indicate in the office action, so that helpfulness can be a tangible measure of success.

In the Peer to Patent program, overall there was a success rate of 20%, but more importantly, at the beginning when the program was new and had the benefit of much publicity, the success rate was 40%. This increased success was in large part due to the larger size of the community; the more people were collaborating on each application, the better the resulting quality of the prior art that was identified and submitted. Therefore, in conjunction with enabling collaboration as discussed in question 3, we suggest that the Office implement a strategy involving sustained effort to increase public awareness of the program and increase the size of the community involved.

3. Aside from encouraging more third-party submissions, what are other ways the Office can leverage crowdsourcing to get relevant information from experts in the scientific and technical community to the examiner?

One of the very useful features from the Peer to Patent pilot program was the ability to collaborate as part of the process of finding prior art. It may be that someone has a general idea of where to find some prior art, and another can use that as a start to find the particular item. Without collaboration, the two parties would not be able to find each other. An effective collaboration tool also gives multiple potential submitters to collectively decide which prior art is the best, and reduce workload for the examiner. In Peer to Patent, the tool allowed voting for the most relevant prior art, and the entries with the most votes were submitted using the tool.

The USPTO could also consider outreach to experts in the field, either in a general way to locate categories of potential prior art, or more specifically targeted to applications. In order to reach the right experts, the office could look for inventors on other applications in the technical areas, or use an analytics tool to find experts and contact information from information in the public domain. Alternately, the Office could request expert volunteers to provide their areas of interest as well as availability to generate information such as the following:

Ingrid: semiconductor processes  
Contact: <Ingrid's email>  
Frequency: No more than once per month

Jose: cloud computing  
Contact: <Jose's email>  
Frequency: No more than twice per month

Additionally, although patents are certainly one source of prior art, the emphasis should be placed on non-patent prior art, because that art is more difficult to find through traditional searching. Non-patent prior art is the type that technically skilled individuals would be more likely to be aware of and able to be tapped through crowdsourcing efforts.

4. How can the Office encourage more third-party participation while ensuring that no protest or other form of pre-issuance opposition to the grant of a patent on an application is initiated after publication of the application?

The USPTO can improve some of the procedural aspects of the preissuance submission process. First, rather than reject a submission that contains arguments of non-patentability, the Office can merely strip out the arguments and forward the art to the examiner for consideration. Second, it would be very helpful to see one's own complete electronic submission rather than solely a simple email notification of a rejection, so that the submitter can determine the cause of the rejection. Finally, the Office can provide a one month, no fee period in which to correct minor formal problems with submissions.

5. What, if anything, is preventing you from submitting prior art as part of a third-party submission?

IBM is an active submitter of prior art under the current program, however the Office can make the process easier. Having the ability to easily identify (by means of a query) which applications that do not have substantial prosecution would help a great deal in selecting those to focus on. With the USPTO increasing its efficiency, we are seeing substantial prosecution occur well before the 6 month window after publication, and we do not wish to spend time on those applications out of concern that a notice of allowance would issue before we can make our submission. Unfortunately it is difficult to identify those without separately examining the record for each patent application.

We suggest that the USPTO indicate, for each application, how much of the 6 month window remains, and if possible whether or not a preissuance submission has been received from another party, so that efforts can be focused appropriately on the applications with the greatest need for prior art and the highest chance of that art being accepted.

6. What other ideas do you have to ensure examiners have the most relevant prior art in front of them during examination?

In the short term, IBM suggests that there be increased collaboration among examiners, both within the USPTO and other patent offices, in order to locate the best prior art. Collaboration among the public as mentioned above in question 3 would also serve to increase the quality and relevance of the submitted prior art. As mentioned previously, outreach to the public in the form of prior art requests would also be feasible.

In the long term, IBM suggests that analytics such as IBM Watson be used to locate prior art. Such an effort would take time and resources to develop, but could be a game changer in terms of quality of examination.

## Conclusion

In conclusion, IBM thanks the Office for providing the public and opportunity to submit comments regarding the use of crowdsourcing and third party preissuance submissions in order to identify prior art.

Respectfully submitted,

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