



Innovative Uses of Technology In Administrative Governance – USPTO

ABA – 2007 Administrative Law Conference

October 25, 2007

Commissioner for Patents John Doll



Agenda

e-Commerce

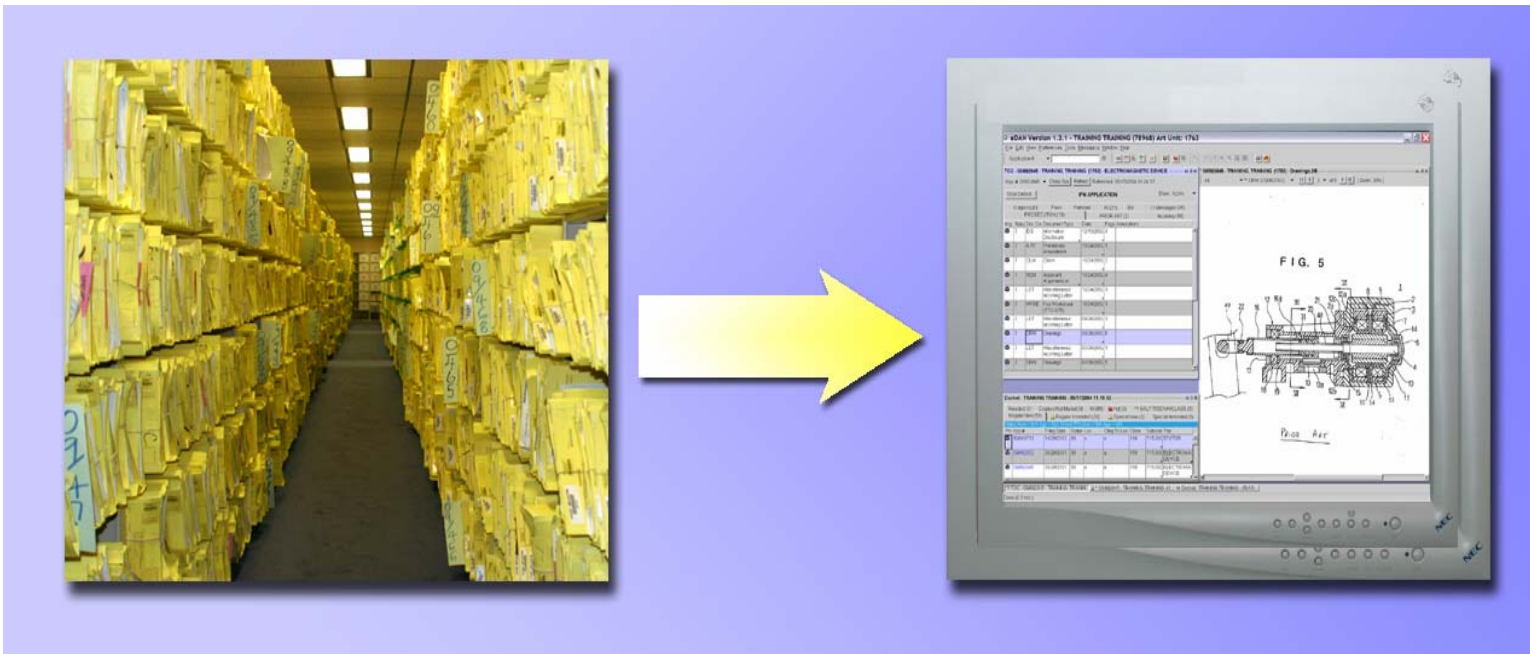
- **e-Commerce Strategy at USPTO**
- **Overview of e-Commerce Tools**
 - Internet Web Site
 - Use of the Internet and Rulemaking
 - Peer Review Pilot Program
 - EFS-Web
 - PAIR
- **New and upcoming e-Commerce initiatives at USPTO**



Increasing Demands on USPTO Resources

Paper File Wrapper

Image File Wrapper



Paper File Room

Desktop Electronic File



Internet Web Site

Use of the Internet and Rulemaking



www.uspto.gov

Web site includes pages for:

Patents

Trademarks

Policy and Law

Strategic Planning

Inventor Support

Other

The screenshot shows the USPTO website homepage. At the top, there is a navigation bar with the USPTO logo on the left, a search bar, and a "Go" button. Below the navigation bar is a red banner with the text "Welcome to the only official Website of the UNITED STATES PATENT AND TRADEMARK OFFICE An Agency Of The United States Department Of Commerce". Below the banner is a dark blue navigation bar with links for "Text Only", "Site Index", "FAQ", "Glossary", "How To Guides", "eBusiness", "eBiz Alerts", "News", "Help", "How To Search", and "Resources". On the left side, there is a vertical menu with buttons for "About USPTO", "Under Secretary & Director", "Public Advisory Committees", "Patents", "Trademarks", "Copyrights", "Policy & Law", "Products & Services", "Strategic Planning", "How To", "Inventor Support", "Emergency Notices", and "Contact Us". The main content area is divided into sections. The "TOP NEWS" section features a headline "USPTO to Hold Live On-Line Chat for Independent Inventors: Thursday, October 25 from 2 to 3 PM (EST)" with a photo of two people at a computer. Below the headline is a paragraph: "Senior officials of the United State Patent and Trademark Office will be available live on-line this Thursday, October 25, from 2 to 3 PM (EST). They will be answering questions and offering tips for independent inventors. Instructions for taking part in the on-line chat will be posted on the home page of the USPTO web site at 10 AM (EST) next Thursday. Inventors can begin logging on for the chat at 1:30 PM." Below this is another headline "USPTO China Road Show: November 7-8, 2007, 8:30 am to 5:30 pm" with a sub-headline "In the World of Intellectual Property, the best Protection is Prevention" and a photo of a road show. Below this is a paragraph: "The United States Patent and Trademark Office (USPTO) will host a free, two-day, seminar for businesses on November 7-8 in San Jose, California, to help them learn about how to protect against intellectual property (IP) theft from China. China was the number one source of counterfeit products seized by U.S. Customs and Border Protection in 2006, accounting for 81 percent of all seizures." Below this is a link ">> Full story". At the bottom of the main content area is a "Reminder: Claims and Continuations Rules Effective Nov. 1". On the right side, there are several promotional banners: "What did you do in your job today?", "HIRING NOW... Great Opportunities available for Patent Examiners", "Inspiring Invention TV Spot 'Cat Magnet'", "STOP FAKES .GOV SMALL BUSINESS Intellectual Property Help from the United States Patent and Trademark Office", "Final Rules on Claims and Continuations Rules Improving the Efficiency and Effectiveness of Patent Examination", "ACCELERATED EXAMINATION of patent applications FINAL DISPOSITION WITHIN 12 MONTHS", "Patents PEER-REVIEWED PRIOR ART PILOT", and "Strategic Plan 2007-2012".



USPTO – Internet and Rule making

United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Patents > Office of the Deputy Commissioner for Patent Examination Policy > Proposed Rule Changes to Focus the Patent Process in the 21st Century

Proposed Rule Changes to Focus the Patent Process in the 21st Century

1. Claims Practice
2. Continuation Practice
3. Accelerated Examination
4. IDS Practice

[Presentation Materials](#)
[Presentation Schedule](#)

>> Find more links to Rulemaking, Policy and Law for USPTO

Background

The U.S. Patent and Trademark Office (USPTO) continues to propose new initiatives to make its operations more efficient, to ensure that the patent application process promotes innovation, and to improve the quality of issued patents. These pages have been developed to provide full transparency to the public about these ongoing efforts.

On July 10, 2006, the USPTO proposed new rule changes related to Information Disclosure Statements. Applicants list information for the examiner to consider in a communication called an Information Disclosure Statement (IDS). These proposed IDS rule changes are designed to encourage patent applicants to provide the USPTO the most relevant information related to their inventions in the early stages of the review process.

On June 26, 2006, the USPTO published new procedures for accelerated examination and made these procedures effective on August 25, 2006. These accelerated examination procedures offer filers a final decision by the examiner within 12 months on whether their application for a patent will be granted or denied, and are designed to give applicants quality patents in less time.

The USPTO inaugurated these pages with information about rule changes proposed on January 3, 2006 related to claims practice and continuation practice. These proposed rule changes will make the patent examination process more effective and efficient by reducing the amount of rework by the USPTO and reducing the time it takes for the patent review process.

The information below includes an explanation of the challenges the USPTO faces, the reasons why proposed rule changes are necessary, the proposed rule changes, and supporting material. Additionally, the information below includes a schedule of dates and places where USPTO representatives have made presentations concerning the proposed rule changes, and scheduling information for new presentations. These pages will be updated as new information or proposals are unveiled.

No rule change will be effective before October 1, 2006, and at least 30 days advance notice of the changes shall be given.

USPTO Requesting More Timely and Useful Information Disclosure Statements (IDSs)

As part of its ongoing efforts to promote investment in innovation and spur economic growth, the USPTO announced on July 10, 2006, new proposed IDS rule changes that would encourage patent applicants to provide the USPTO the most relevant information related to their inventions in the early stages of the review process. As a result, patent applications could be processed in a more streamlined and effective manner.

The USPTO has observed that applicants sometimes provide information in a way that hinders rather than helps timely, accurate examination. For example, some applicants send a very large number of documents to the examiner, without identifying why they have been submitted, thus tending to obscure the most relevant information. Additionally, some applicants send very long documents without pointing out what part of the document makes it relevant to the claimed invention. Sometimes applicants delay sending key information to the examiner. These practices make it extremely difficult for the patent examiner to find and properly consider the most relevant information in the limited time available for examination of an application.

The proposed IDS rule changes are designed to address the above-mentioned issues by encouraging early submission of relevant information, and discouraging submission of information that is unimportant or does not add something new for the examiner to consider. With the proposed IDS rule changes, patent examiners would not have to review documents that do not directly relate to the claimed invention, or that duplicate other information already submitted.

TOP NEWS ...

FINAL RULE - PATENTS

[Claims & Continuations](#)
>> Claims and Continuations Final Rule Information (21AUG2007)

Proposed Rule (10AUG2007)
>> USPTO proposes new measure to require applicants to identify, with more specificity, the claimed invention to be examined

Web pages for significant rule makings



USPTO – Internet and Rule making

The screenshot shows the USPTO website page for "Claims and Continuations Practice - Final Rule". The page header includes the USPTO logo and navigation links: Home, Site Index, Search, FAQ, Glossary, Guides, Contacts, eBusiness, eBiz alerts, News, Help. The main content area contains a paragraph explaining the revised rules of practice, a "Final Rule - Patents" graphic, and a "Contacts" box with the email Patent.Practice@uspto.gov and phone number (571) 272-7704. The page also features sections for Notices, Summaries, Presentation Slide Set, and Frequently Asked Questions.

United States Patent and Trademark Office PATENTS

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Patents > Office of the Deputy Commissioner for Patent Examination Policy > Claims and Continuations Practice - Final Rule

The USPTO has revised the rules of practice in patent cases relating to continuing applications and requests for continued examination practices, and for the examination of claims in patent applications. The revised rules require that any third or subsequent continuing application that is a continuation application or a continuation-in-part application, and any second or subsequent request for continued examination in an application family, be filed to obtain consideration of an amendment, argument, or evidence, and be supported by a showing as to why the amendment, argument, or evidence sought to be entered could not have been previously submitted. The revised rules also require an applicant to file an examination support document that covers all of the claims in an application if the application contains more than five independent claims or more than twenty-five total claims. The USPTO has also revised rules of practice with respect to multiple applications that have the same claimed filing or priority date, substantial overlapping disclosure, a common inventor, and common ownership. These changes will allow the USPTO to conduct a better and more thorough and reliable examination of patent applications.

The effective date for this change in practice is: **November 1, 2007.**

⇒ **Notices**

- [Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications, Final rule](#) (72 Fed. Reg. 46716 - 21Aug2007) [PDF]
- [Clarification of the Transitional Provisions Relating to Continuing Applications and Applications Containing Patentably Indistinct Claims](#) (signed 10 October 2007) [PDF]

⇒ **Summaries**

- [Highlights](#)
- [Changes from Proposed Rule](#)
- [Section-by-Section Rule Summary](#)

⇒ **Presentation Slide Set** [updated 18Sep2007]

- [Claims and Continuations Final Rule](#) [HTML accessible]
- [Claims and Continuations Final Rule](#) [PPT]
- [Claims and Continuations Final Rule](#) [PDF]
- [Claims and Continuations Final Rule](#) [ZIP]

⇒ **Frequently Asked Questions** [updated 22Oct2007, PDF]

FINAL RULE - PATENTS

Claims & Continuations

⇒ **Contacts**

- E-mail: Patent.Practice@uspto.gov
- Telephone: (571) 272-7704

Web pages include:

NPRs

Public Comments

FRs

Explanatory Materials

Training Materials

FAQs

Contact Information



Peer Review Pilot Program



Peer Reviewed Prior Art

USPTO Perspective

- Public Criticism of Patents, Software
- Current Rules Permit Rule 1.99 Submission
- Proof of Concept Pilot



Peer Reviewed Prior Art

USPTO Goals

- Get the best art before the examiner
- Improve patent quality
- Quell negative public perception
- Foster public involvement using Internet collaboration techniques



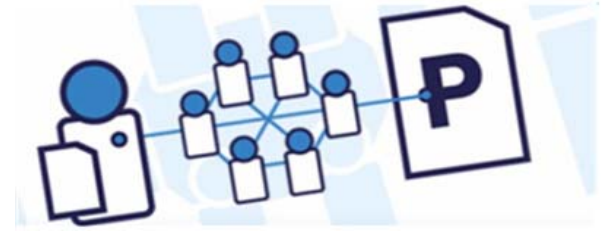
Peer Reviewed Prior Art

Pilot Short History

- Coordination with Community Patent Review Project (CPRP), Dec 2005
- Public meetings in Feb and May 2006



Peer-to-Patent: What is It?



- Pilot program to test the effectiveness of open, public participation in the patent examination process
- Applications not granted patents
- Technology Center 2100 - computer and software inventions (includes some business method applications)
- 250 applications with inventor consent
- www.peertopatent.org -- current applications
- General Electric, HP, IBM, Intel, Microsoft, Oracle, Red Hat, Sun Microsystems, Yahoo!
- Funded by MacArthur Foundation, Omidyar Network and CA, General Electric, HP, IBM, Microsoft, Red Hat
- UK and European Patent Office pilots being considered
- New York Law School's "Do Tank" with USPTO





Peer-to-Patent: How Does It Work?

The screenshot displays the Peer-to-Patent website interface. At the top, there is a navigation bar with 'COMMUNITY PATENT REVIEW', 'MY PROFILE', 'TUTORIALS', and 'ABOUT P-TO-P'. Below this, a 'Welcome to Peer To Patent' banner is visible. The main content area features a 'HERE IS HOW PEER TO PATENT WORKS:' section with a 5-step process flow:

- 1** Review and discuss patent applications
- 2** Research and find prior art
- 3** Upload prior art relevant to claims
- 4** Annotate and evaluate all submitted prior art
- 5** "Top ten" prior art references forwarded to USPTO

The interface also includes a 'MOST ACTIVE TEAMS' list, a 'PEER TO PATENT ACTIVITY' map, and a 'Code of Conduct | Terms of Use | Privacy Policy | DMCA' footer.

Public Participation Works If Structured Targeted Group-Based



Peer-to-Patent: In the News

Open Call From the Patent Office Agency Web Site Will Solicit Advice

By Alan Sipress

Washington Post Staff Writer

Monday, March 5, 2007; A01

The Washington Post

Economist.com

Forbes.com

FORTUNE

"For the first time in history, it allows the patent-office examiners to open up their cubicles and get access to a whole world of technical experts," said David J. Kappos, vice president and assistant general counsel at IBM."

Peer to Patent Creates Shared
Participation in Decision-
Making

Does Not Replace the
Patent Examiner



Why Participate? Inventors

- For Inventors
 - More eyeballs means a stronger application
 - Help searching for prior art
 - Expedited review
 - No fee for participation
 - Create a market for your invention
 - Discover knowledgeable experts
 - Improve quality in the patent system



Why Participate? Self-Selected Reviewers

- Competitive interest
- Interest in that area of science and ensuring good quality patents
- Desire to distinguish oneself professionally - develop reputation
- Desire to be part of a community of practice/conversation in a particular area of innovation
- Interest in and desire to contribute to patent reform process/improving patent quality
- Interest in (positive or negative) a particular patentee/assignee
- Desire to contribute to open decision-making and encourage more of same
- Desire to strengthen a patent application by finding prior art to hone the claims
- Academic credit



Participation & peertopatent Activity (June 15-September 30, 2007)

- 45 applications volunteered, 24 applications posted www.peertopatent.org
- Applications volunteered from Hewlett Packard, Redhat, IBM, GE, Intel, Microsoft, Yahoo, Sun Microsystems and Softwire AG(A Swiss Company).
- Applications also volunteered from 2 pro se applicants
- 90 pieces of prior art cited to published applications along with over 241 general comments
- 128 ratings of the prior art have been posted
- USPTO has received prior art submissions in first 8 volunteered applications;examination is now being conducted on these 8 applications



Peer Reviewed Prior Art

First 5 Submissions have been received by the USPTO

Red Hat 11/164,393 COOPERATIVE MECHANISM FOR EFFICIENT APPLICATION MEMORY ALLOCATION

8 prior art references submitted: 7 – NPL; 1 – US Patent

•HP 11/286,554 USER SELECTABLE MANAGEMENT ALERT FORMAT

9 prior art references submitted: 2 – NPL; 7 – US Patents

•IBM 11/290893 DATABASE STAGING AREA READ-THROUGH OR FORCED FLUSH WITH DIRTY NOTIFICATION

4 prior art references submitted: 2 – NPL; 2 – US Patents

•Intel 11/286,585 REGISTER TRACKING FOR SPECULATIVE PREFETCHING

4 prior art references submitted: 2 – NPL; 2 – US Patents

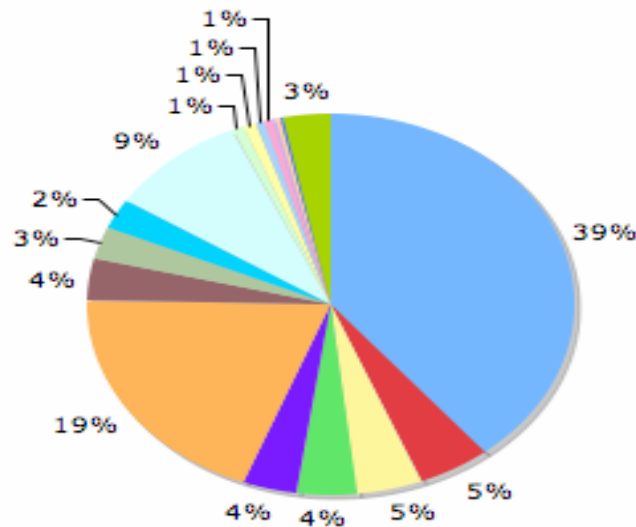
•Intel 11/291,378 STACK TRACKER TO IDENTIFY MEMORY COMMUNICATIONS

5 prior art references submitted: 1 – NPL; 4 – US Patents



Reviewer Demographics (947 Responses)

Participants by Professional Role

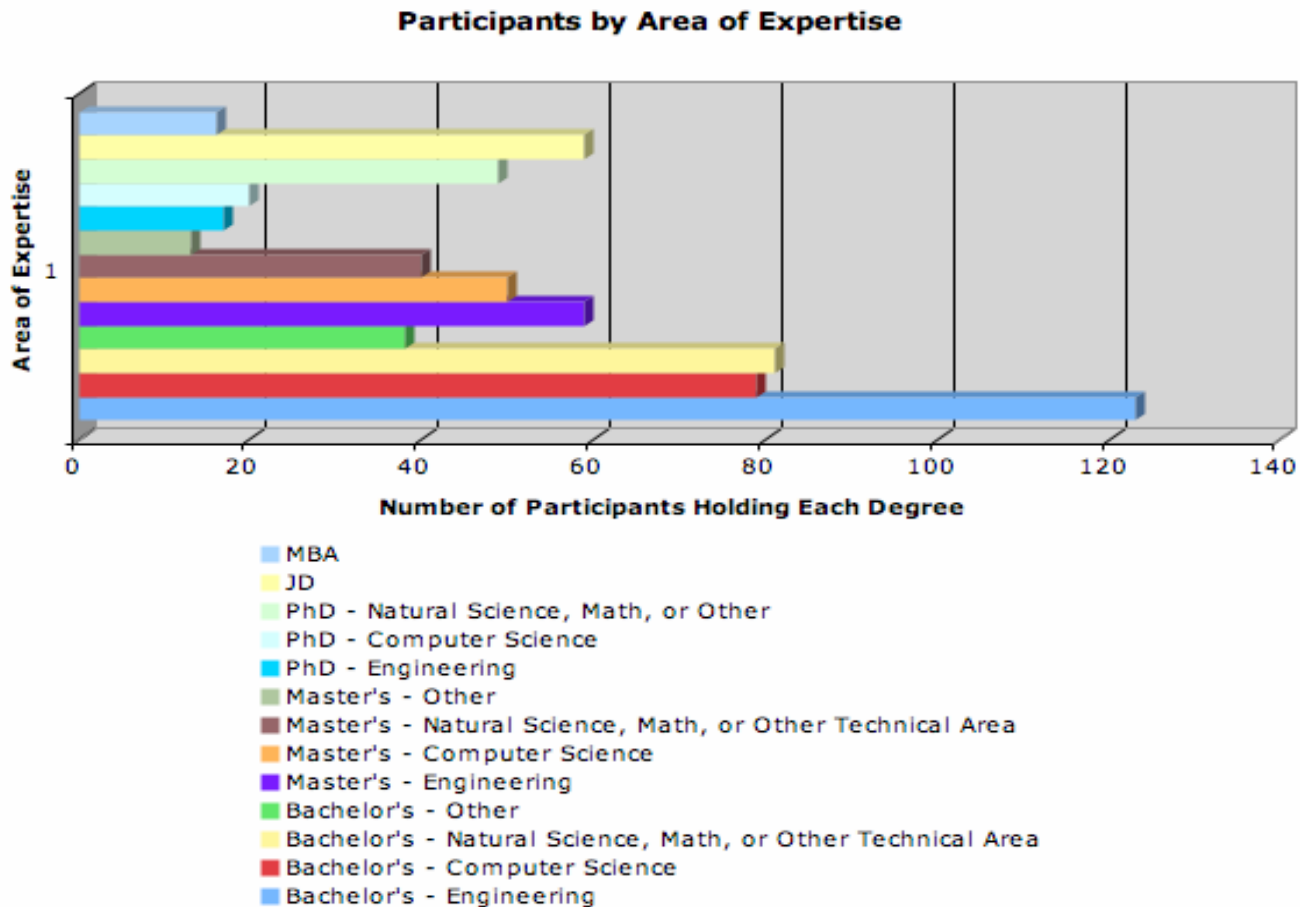


- Computer Professional/Technologist
- Patent Professional/Searcher
- Grad/Undergrad Student
- Academic Technologist/Engineer
- Business/Industry
- Science Academic/Professor
- Legal Academic/Professor
- Doctor/Healthcare Professional (< 1%)
- Journalist (< 1%)
- Other
- Research Scientist
- Patent Professional/Searcher
- Engineer
- Entrepreneur/Business Owner
- Lawyer/Legal Professional
- Writer/Editor
- Government Employee/Civil Servant
- Lab Technician (< 1%)
- Foundation/Philanthropy/NGO (< 1%)



Active* Participants by Area of Training

*Participants who have logged in 1>





Evaluation and Metrics

- Objective USPTO Feedback

Data to be collected by USPTO:

- Did the prior art submitted by CPRP materially effect the patentability determination for any claim?
- Was the prior art submitted available to the examiner during normal examination?
- Did the commentary have any affect on the examination process?
- What was the general perception of the examiners with the pilot and process?



Electronic Filing System EFS-Web



Electronic Filing System

New EFS-Web system launched March 2006

- allows PDF-based submissions
- replaced XML-based system



2005 result: 2.2% of applications filed electronically

2006 result: 14.1% of applications filed electronically

2007 result: 49.3% of applications filed electronically



EFS-Web Benefits



- **Improved Quality and Timeliness**
 - Speeds filing process by eliminating paper and delays caused by manual handling
 - Provides immediate Acknowledgement Receipt for customers and dramatically improves ability of practitioners to track status of applications through PAIR
- **Automatic Integration with USPTO internal systems**
- **Ability to file anytime and anywhere with an Internet connection**
- **Facilitates collaboration and workflow management**
- **Safe, Simple, Secure**



EFS Web Milestone Celebration



EFS-Web Milestone
Celebration held
May 1, 2007

- Michael Gurin
- Jonathon Meyer
- Rolf Hille

- EFS-Web being used by law firms, corporations, and independent inventors
 - Some law firms and corporations have made commitment to 100% electronic filing

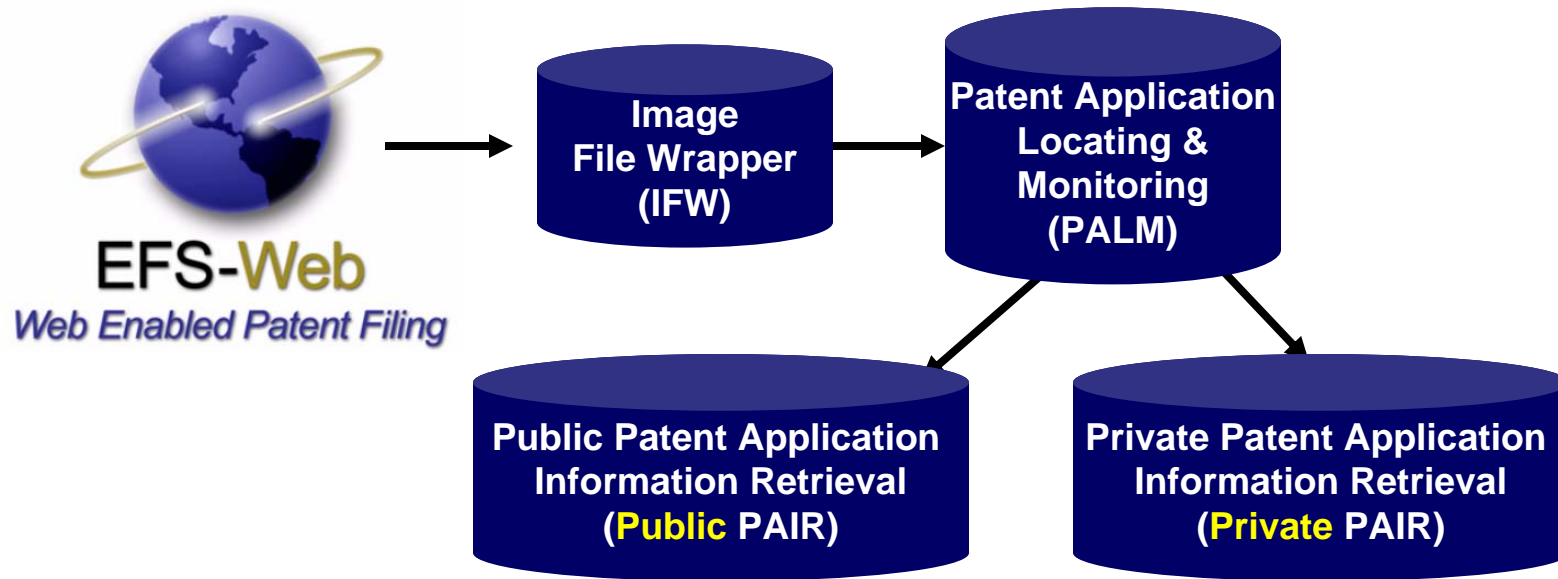


E-Commerce Tools

Private PAIR 7.1



How PAIR Works





New and Upcoming e-Commerce Initiatives

- e-Office Action Notification Pilot
pair@uspto.gov
- Priority Document Exchange (PDX)
pdx@uspto.gov
- e-Grant of Patents
- Patent File Wrapper (PFW)



e-Commerce Support

- **On-line references**

www.uspto.gov/ebc/efs_help.htm

- **Tutorials**

www.uspto.gov/ebc/portal/tutorials.htm

- **Electronic Business Center**



www.uspto.gov/ebc

Email: EBC@uspto.gov

Phone: 1-866-217-9197 / 571-272-4100 * Select option 2

Monday – Friday (6am – Midnight EST)

Fax: 571-273-0177



Contact Information

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Thank YOU !!!