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Via Electronic Mail

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United States Patent and Trademark Office
Office of International Relations
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Attention: Jon P. Santamauro

IBM Corporation Comments in response to Notice of Proposed Rule Making "Request for Comments on International Efforts to Harmonize Substantive Requirements of Patent Laws", 72 Fed. Reg. 24566 (May 3, 2007)

International patent protection is essential in today's global economy. IBM believes in a strong, global intellectual property system that encourages innovation. Substantive harmonization of international patent laws benefits all applicants by simplifying procedures, increasing the uniformity of patent examination, reducing costs, and improving patent quality. Therefore, IBM commends the United States Patent and Trademark Office (USPTO) for its continuing efforts to improve the quality and efficiency of the examination process through participation in the World Intellectual Property Organization (WIPO) Standing Committee on the Laws of Patents (SCP) and the Trilateral Working Groups.

The Federal Register Notice includes a number of proposals that the United States is considering in the ongoing international effort to harmonize substantive patent laws. Many of these proposals are the subject of pending US patent reform legislation. IBM generally supports US patent reform efforts as expressed in several bills recently introduced into Congress. We appreciate the opportunity to comment on the following select aspects of the proposed rule making.

5) Geographical Limitations in the Definition of Prior Art

We support this provision provided that all countries are subject to the same geographical restrictions.

8) Prior User Rights

We support a prior user rights defense to patent infringement. We further support broadening this defense beyond the current restriction to business methods such that it applies to all technologies, including both products and processes.

10) Eighteen-Month Publication of US Patent Applications

We support this provision and strongly encourage the publication of all US patent applications eighteen months after earliest priority date, unless the application is withdrawn prior to the completion of the publication process. Publication of all US patent applications will promote the dissemination of information, thereby reducing uncertainty and contention and freeing resources to focus on innovation.

Publication of all US patent applications will also facilitate the recently announced peer review pilot program (Peer-to-Patent: Community Patent Review). During the pilot, the public will be able to collaborate on certain published patent applications in order to identify the most relevant prior art and provide explanatory commentary. The art and commentary will then be forwarded to the patent examiner. The program will promote patent quality by ensuring that the best prior art is available to examiners and that examiners will be able to properly comprehend and apply that prior art. Should the program succeed, implementation for all US patent applications will be enabled by requiring universal publication.

Furthermore, identification of the assignee should be required on all published patent applications. Patent ownership should be transparent to allow members of the public to determine what rights they have with respect to any patents that might issue (e.g. under a license from the assignee). IBM's recent patent policy statement demonstrates IBM's commitment in this regard.

OTHER COMMENTS

Global Collaborative Search and Examination

There is an increasing backlog of patent applications pending before the major patent offices. In order to help address this, the USPTO has established a pilot program authorizing other patent offices to perform search and examination of PCT applications. We support resource sharing among patent offices to improve efficiency, and we believe more could be accomplished in this regard. We therefore propose a new program; Global Collaborative Search and Examination (GCSE).

GCSE would create a collaborative search environment for international patent applications and patent application families. The GCSE program would include a secure discussion workspace, such as a wiki or similar technology, that would establish for

examiners a worldwide forum to permit discussion of search strategy, sharing of search results, and collaborative analysis of the prior art as applied to the claims of an application. The applicability of the prior art would be discussed among examiners; and, after the discussion is concluded, each examiner would independently write an Office Action. A single representative application for a patent application family would be searched by each participating patent office, and the searches performed by each of those offices would be made available to all participants along with search results and references as attached files (or links). Collaboration could include all participating patent offices where a patent application family member is filed and would help develop search confidence for offices that have relatively less experience and expertise.

A Global Search Authority (GSA) could be created so that member patent offices would be interconnected electronically. The GSA would be driven and supported by the resources and expertise of its members, and would better enable collaborative search and examination. Electronic application files would allow for “virtual searches” by participating patent offices. These searches could be tailored in accordance with the linguistic and technological capacities of a particular office, while seamlessly enabling input from the other interested offices having complementary expertise.

Conclusion

IBM encourages the USPTO to continue its efforts to increase patent quality. A harmonized global patent system will help achieve this goal while also improving the consistency of examination, reducing costs, and relieving workloads.

Respectfully submitted,

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