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Meeting :	<b>ExCo in Sydney</b>	Drawn up by :	<b>Francesco Paolo Vatti</b>
Date :	<b>13-17 April 2008</b>	Subject :	<b>PEER TO PATENT EXAMINATION</b>
Purpose :	<b>For Information</b>		

## INTRODUCTION

Patent examination is, and has ever been, a very difficult task. After a thorough research, a deep comparison of patent features with prior art has to be carried out, in order to assess novelty and inventive step.

Even very good research can miss a few documents, so that invalid patents, in spite of such a deep work, are sometimes granted. Taking into account this situation, many patent offices (for instance European Patent Office and German Patent Office) provide post-grant opposition proceedings, in order to allow a nullity action with cost savings, since the proceedings are not before a court but directly at the patent office, with a lower level of formalities.

However, an examination system, which is able to reduce the number of oppositions would be preferred. In this view, different approaches have been studied. E.g., the Brazilian patent law does not provide for a formal pre-grant opposition, but up to the end of examination allows any interested party to submit comments and documents which are relevant to the determination of patentability.

The United States Patent and Trademark Office, Britain's Intellectual Property Office and the European Patent Office are evaluating a radical change: opening the process up to internet-based collaboration.

## THE PROPOSAL

The system was implemented by the team led by Professor Beth Simone Noveck of the New York Law School. Information about this experiment is available on the site <http://dotank.nyls.edu/communitypatent>, whereas the system is operative on [www.peertopatent.org](http://www.peertopatent.org). A registration is needed to submit patents and to submit prior art documents. Presently a one-year pilot programme has been launched in America on 15 June 2007. It involves mainly computer-related inventions on voluntary basis and the first assignees involved include IBM, Microsoft and Hewlett-Packard. Great Britain should start in a few months.

In the first phase, 250 patent applications will be scrutinised with the approval of the Applicants. The full text is posted on the above referenced website and made available to the public. Members of the

public who want to participate into this project should sign up. They are thus entitled to participate into a forum, to suggest examples of prior art and vote for the prior art they consider most relevant. A rating of the other participants is being studied.

Eventually, the ten pieces of prior art which receive most votes in the peer to patent community perusing each patent are sent to the patent examiners, who decide which pieces are in fact relevant and who, in any case, takes into account the community discussion in assessing novelty and inventive step.

## BENEFITS AND COSTS

This systems allows to make examiners aware of documents that presently are not easily accessible, like obscure technical journals, conference slides, doctoral theses etc.. This can be particularly true in fields where patenting is fairly new, such as software, biotechnology, financial services and business methods. It is apparent that this new system allows the Examiner to reach a greater number of public prior documents than before, so that the possibly granted patent is a stronger one, which is more difficult to oppose to. A problem connected to this way of proceeding can be in an excessively large number of prior art citations which can be provided, leading to the impossibility to check all of them, so that the backlog could increase hugely. Anyway, the aim of this system is to reduce uncertainty for inventors and unnecessary lawsuits, with a save in costs, because a wider knowledge of prior art may become available and stronger patents can be obtained. Another critical point is that it is not clear how many persons will really volunteer to provide examples of prior art, to join discussions etc., also due to a rather high specialisation level required.

Furthermore, there is a concern about possible "vested interests", which could be involved in such a process.

As from FICPI's point of view, we should also determine to which extent a strategy outlined by a qualified professional to oppose to a patent can be jeopardized by the adoption of a system in which people lacking an expertise in the patent system can advance prior art documents without the appropriate reasoning about their relevance, which may mislead an examiner to consider such document as insubstantial to the determination of patentability.