



**IN THE MATTER OF REQUEST FOR COMMENTS ON USPTO INITIATIVES TO
ENSURE THE ROBUSTNESS AND RELIABILITY OF PATENT RIGHTS**

Docket No. PTO-P-2022-0025

COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION

The Electronic Frontier Foundation (“EFF”) welcomes this opportunity to respond to the United States Patent and Trademark Office’s (“USPTO”) Request for Comments on USPTO Initiatives to Ensure the Robustness and Reliability of Patent Right, Docket No. PTO-P-2022-0025 (“Request”).

EFF is a nonprofit civil liberties organization that has worked for more than 30 years to protect consumer interests, innovation, and access to knowledge in the digital world. EFF and its more than 39,000 dues-paying members care deeply about ensuring that intellectual property law in this country serves the goal set forth in the Constitution: promoting the progress of science and technological innovation by granting limited exclusive rights.

To ensure the voices of consumers, end users, and developers are heard, EFF routinely submits comments regarding USPTO policies and procedures that affect the patent system’s ability to achieve these goals, including PTAB trial practice and procedures, measures to enhance patent quality, and the correct application of patent-eligibility law.¹

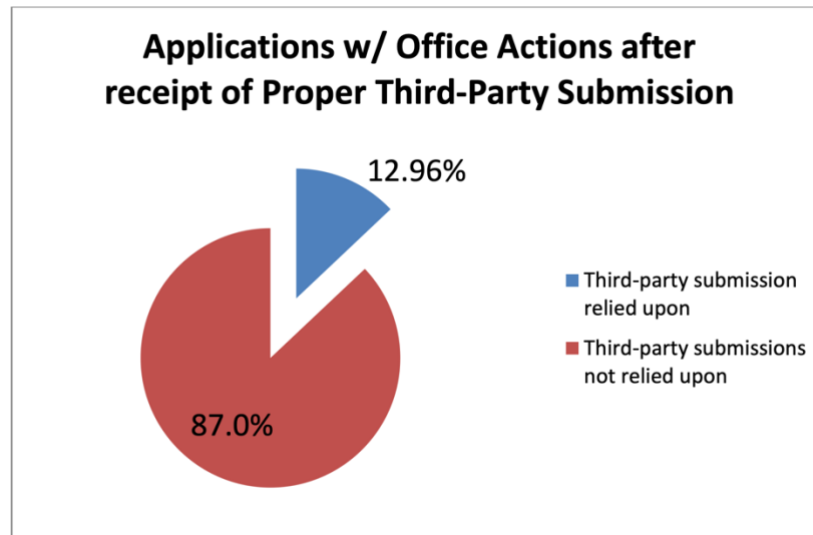
¹ See, e.g., Comments of EFF re: Request for Comments on Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, Docket No. PTO-P-2018- 0062 (Dec. 20, 2018), <https://www.uspto.gov/sites/default/files/documents/12.20.2018%20EFF.pdf>; Comments of EFF re: Notice of Proposed Rulemaking for Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings before the Patent and Trial Appeal Board, Docket No. PTO-P-2018-0036 (July 9, 2018), https://www.eff.org/files/2018/07/13/comments_of_eff_re_docket_no._pto-p-2018-0036.pdf; Comments of EFF, Engine, and Public Knowledge re: Enhancing Patent Quality, Docket No. PTO-P-2014-0043 (May 6, 2015) https://www.eff.org/files/2015/05/08/final_eff_engine_and_pk_comment_on_patent_quality.pdf; Comments of EFF Regarding Guidance Pertaining to Patent-Eligible Subject Matter, Docket No. PTO-P-2014-0036 (July 31, 2014), at https://www.eff.org/files/2014/08/11/eff_comments_regarding_patentable_subject_matter_and_a_lice_corp.pdf.

I. THE USPTO SHOULD FURTHER ENCOURAGE THIRD-PARTY SUBMISSIONS

The Leahy-Smith America Invents Act (AIA) brought important changes to the United States patent system, including potentially improving patent quality with the expansion of the third-party pre-issuance submission process, by which a third party can submit prior art references in a pending U.S. patent application for consideration by the examiner. However, entities may be hesitant to participate in the improved AIA submission process because a third party's submission may result in weak patents being harder to invalidate post issuance.

Currently the USPTO allows third-party prior art submissions, but usage of the current procedure is "quite rare".² "Out of every 10,000 issued patents, only about 14 include prior art submissions from third parties."³ One possible explanation for the rare use of the third-party submission process is that it can do more harm than good.

During the first two years of the revised third-party pre-issuance submission process there were 2116 submissions.⁴ Approximately 1600 of those submissions were deemed proper by the USPTO.⁵ However, only 12.96% of the submitted references were relied upon by examiners.⁶



² <https://patentlyo.com/patent/2022/02/uspto-third-submissions.html>

³ *Ibid.*

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https://www.uspto.gov/sites/default/files/patents/init_events/preissuance_submission_statistics1.pdf

⁵ *Id.*

⁶ *Id.*

That is, 87% of the third-party submissions were not relied upon by the examiners. And each of these references are presumed to be considered upon issuance, even if the examiner completely ignored the references. *Stone Basket Innovations, LLC v. Cook Med. LLC*, 892 F.3d 1175, 1179-80 (Fed. Cir. 2018).

As such, later in litigation, “where a party only relies on prior art considered by an examiner in its invalidity contentions, that party has the burden to overcome[e] the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and . . . whose duty it is to issue only valid patents.” *Id.*

Thus, a third-party attempting to improve patent quality by submitting prior art references, runs the very real risk of actually weakening the patent system by increasing the burden required to invalidate that patent later. Under the current practice, a third-party is better served by waiting, holding the prior art reference, and using the prior art in litigation or an *inter partes* review. As such, the current practice promotes the opposite of the intended outcome, *i.e.*, disincentivizes third-party pre-issuance submissions.

One possible solution is to change the presumptions afforded prior art in the pre-issuance process, *i.e.*, if an examiner does not actually cite and rely upon a reference in an office action, then heightened burdens should not attach to a litigant later attempting to invalidate a patent using art that was submitted, but never actually considered.

All told, the current third-party pre-issuance submission process actually disincentivizes submissions.

II. APPLICANTS SHOULD BE REQUIRED TO SHOW SUPPORT FOR NEW/AMENDED CLAIMS

As the Request for Comment (“Request”) notes, “[c]urrently, the MPEP states that applicants ‘should’ show ‘support’ for claims during prosecution.” *See, e.g.*, MPEP 2163 II.A. (“With respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims.”).

Conversely, as the Request explains, the reexamination and reissue rules require that during reexamination or reissue proceedings, patentees “must” supply an “explanation of the support in the disclosure” for new and amended claims. Rules 1.530(e) and 1.173(c), respectively.

Similarly, in *inter partes* review and post-grant review proceedings, motions to amend “must” set forth “[t]he support in the original disclosure of the patent for each claim that is added or amended.” 37 CFR 42.121(b)(1), 42.221(b)(1).

There is no principled reason to have a more lax standard for prosecution that does not match the standard for reexamination, reissue, and *inter partes* review. Especially given that the divergent standard for prosecution conflicts with other prosecution rules, *e.g.*, that applicants are

required to file claims that “conform to the invention as set forth in the remainder of the specification,” with claim terms that “find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1).

Respectfully submitted
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