IMPROVING THE PATENT SYSTEM: COMMUNITY SOURCING AND PRE-GRANT OPPOSITION

Christopher J. Worrel

INTRODUCTION

Patent protection provides a crucial incentive for research and development as technology continues to advance. The effectiveness of the protection provided relies on awarding patent protection pursuant to established statutory requirements. To receive patent protection, an applicant prosecutes an application through the examination process at the United States Patent and Trademark Office (“USPTO”). To increase the examination process’s effectiveness and thereby increase the effectiveness of the protection provided by the patent system, the USPTO needs to minimize the number of granted patents that do not meet the statutory requirements. To achieve this goal, the USPTO should provide new and more robust pre-grant opposition mechanisms. These mechanisms would allow interested third parties to become involved in the prosecution of patent applications and augment the limited resources of patent examiners during examination, making the process more efficient and effective at locating and evaluating prior art.

Patent protection grants a 20-year period of exclusivity to the patentee to exclude others from making, using, offering for sale, or selling the patented article. This limited monopoly is the compensation given to inventors in exchange for publicly disclosing their inventions, thereby furthering the state of the art in the related field or technology. As such, patents are an important economic tool. Statutory and regulatory controls ensure that patents are used as envisioned by the framers of the United States Constitution: “to promote the

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3. Id. § 154(a)(2).
4. Id. § 271(a).
5. U.S. CONST. art. I, § 8, cl. 8 (“The Congress shall have Power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).
Progress of Science and useful Arts.” To best achieve this goal, the USPTO’s examination of patent applications needs to be both effective and efficient in establishing which applications meet the requirements for patenting, and which do not.

The consequences of issuing patents that do not meet statutory requirements can be very severe. In 2001, a Canadian patent holding company, NTP, Inc., filed a suit for patent infringement against Research In Motion, Ltd. ("RIM"), the manufacturer of the popular Blackberry cellular telephone. After a lengthy and complex court battle that traveled up and down between the Court of Appeals for the Federal Circuit and the United States District Court for the Eastern District of Virginia, the parties eventually settled the suit in March of 2006, with RIM paying more than $612.5 million to settle the claim. During the litigation, RIM discovered a publication which would have prevented the patent from issuing. This publication had not been considered during the examination of the patents RIM was accused of infringing. RIM filed a request for reexamination with the USPTO, which ultimately resulted in the patents being rejected. This case illustrates how one business, NTP, asserted the legal protection offered by an invalid patent against another business to win a significant financial settlement because the USPTO did not consider the necessary prior art before granting the patent. The USPTO’s failure in this case can be attributed to the limitations of the examination process and thus supports implementing measures to improve the process’s effectiveness.

This comment proposes third-party pre-grant opposition mechanisms as one option that the USPTO should implement to increase the efficiency of the examination process, and to avoid giving undeserved protection to patent applicants like NTP. Implementing these mechanisms would reduce the resources the USPTO requires to evaluate an application and decrease the number of patents erroneously issued, avoiding the need for these erroneous patents to later be invalidated by prior art during subsequent litigation, or reexaminations.

“Prior art” is a term used in patent law to refer broadly to anything negating the patentability requirements of novelty or nonobviousness in a particular case. Sections 102 and 103 of the Patent Statute set forth specific conditions where different prior art will prevent an applicant from receiving a patent. Prior art usually comprises issued patents from the U.S. or a foreign country, publications

6. Id. See also Graham v. John Deere Co., 383 U.S. 1, 5-6 (1966).
7. NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282, 1290 (Fed. Cir. 2005).
9. NTP, Inc. v. Research In Motion, Ltd., 392 F.3d 1336, 1371 (Fed. Cir. 2004).
12. Id.
which disclose the invention or make it obvious, evidence of public use or prior sale, and also may include any other evidence that would otherwise negate novelty or make the subject invention obvious. Rather than relying on a single patent examiner to locate and evaluate all prior art, the USPTO should expand third-party pre-grant opposition mechanisms and explore other community-sourcing options for locating and considering all relevant prior art when examining a patent application.

In the first section, this comment examines the patent system’s importance in today’s society and the importance for patents to meet the requirements of novelty and nonobviousness. The second section explores the different mechanisms which currently ensure the patent system’s integrity by requiring submission of prior art to the USPTO and by reinitiating examination after a patent issues. This section includes both pre-grant and post-grant mechanisms available to the applicant or patentee and to interested third-parties.

The third section describes different organizations formed to challenge patents, different pilot programs in the USPTO and in Japan’s Patent Office to utilize public resources during the patent examination process, and bills introduced in Congress that would enhance pre-grant mechanisms for influencing examinations, all of which illustrate the need for public involvement in the examination process. The fourth section explains how public involvement is already in use at the USPTO in trademark-opposition practice. The fifth section surveys patent systems of foreign countries, demonstrating how third-party opposition is utilized around the world to enhance patent quality. Finally, this article concludes by proposing that the USPTO implement third-party pre-grant opposition mechanisms in the United States to help ease the USPTO’s burden in the examination process and to reduce successful post-grant patent challenges in litigation and reexamination.

I. THE IMPORTANCE OF THE PATENT SYSTEM AND OF THE REQUIREMENTS FOR PATENTING

The USPTO grants patents after reviewing applications for compliance with statutory and regulatory requirements of utility, novelty, and nonobviousness. This comment examines the patent system’s quality by measuring the number of issued patents claiming a patentable invention against the number of issued patents not claiming a patentable invention. The highest possible quality for this system would be when every issued patent claims only patentable subject matter. The patent system is not perfect, however, and issued patents claiming unpatentable subject matter—the so-called “bad patents”—decrease the quality of the system, allowing those patent owners to assert the patent’s exclusivity against their competitors through the patent’s inherent presumption of validity.
The USPTO’s corps of more than 6000 patent examiners\(^{15}\) “read and understand the application, search for prior art, evaluate patentability, communicate with the applicant, work out necessary revisions, and reach and write up conclusions.”\(^{16}\) Although the USPTO has not published official statistics, the Federal Trade Commission (“FTC”) estimates that an examiner spends between 8 and 25 hours examining an application.\(^{17}\) Patent applications are too substantial and complex for an examiner to effectively review in this relatively short time. For example, in both 2006 and 2007, patent specifications averaged more than 7000 words, with more than 18 claims.\(^{18}\) The patent examiner must read and understand the newly invented subject matter described in the specification, search for any and all prior art that may render the claimed subject matter unpatentable, and generate responses in the form of office actions\(^{19}\)—an impossible challenge for a single examiner to accomplish in so short a period of time.

In addition to the severely time-constrained review of state-of-the-art technology, another factor detracting from the effectiveness of the examination process is that patent examiners are incentivized to focus on quantity rather than quality of patent-application reviews. This incentive comes from bonuses awarded for ‘final dispositions,’ i.e., allowance or rejection of the application.\(^{20}\) However, only an allowance is truly final. After an applicant receives a final rejection, the prosecution of an application can continue through appeals, requests for continued examination, and continuation applications.\(^{21}\) Once an examiner issues a notice of allowance, however, the applicants’ options are to pay the issue fee or abandon the application, terminating the prosecution in either case.\(^{22}\) Thus, the bonus system acts as an incentive for patent examiners to allow, rather than reject, claims in an application.

The Office of Patent Quality Assurance (“OPQA”) oversees the operations of the USPTO in examining patent applications, reporting quality measurements both for in-process examinations and patent allowance.\(^{23}\) For the 2009 fiscal year, the OPQA reported the Patent In-Process Examination Compliance Rate at


\(^{16}\) FTC REPORT, supra note 1, at 5.

\(^{17}\) Id.


\(^{19}\) MPEP, supra note 14, § 706.


\(^{21}\) Id.

\(^{22}\) 37 C.F.R. § 1.311 (2010).

\(^{23}\) MPEP, supra note 14, § 1308.03.
93.2% and the Patent Allowance Compliance Rate at 96.9%. This quality review program randomly selects a number of allowed or in-process applications for an independent prior-art search and examination by a Review Quality Assurance Specialist. The reported percentages reflect the number of allowed claims, which were confirmed as patentable by the Specialist. This quality review shows that the USPTO knows that different examiners find different information when they perform prior-art searches on the same subject, even when those individual searchers have the same resources available and have experienced the same training programs. Thus, this evidence supports utilizing resources outside the USPTO to obtain a more complete consideration of prior art during the examination of an application.

The consequences are serious when the USPTO issues patents which do not meet statutory requirements. The role patents play in the economy demonstrates the gravity of these consequences. The results of the examination process’s inadequacy are such that “the integrity of the patent system and society suffer: investors rely upon ‘bad’ patents as enforceable economic devices, and the public remunerates royalties to illegitimate patent holders.” A patent grants the inventor a limited monopoly to profit from the invention disclosed in the patent, and without that monopoly, there is less incentive to invest in further development. Therefore, “bad patents may be chilling to innovation and harmful to the economy.”

Effective and efficient application examination represents a growing concern, as patent-application filing increases year after year. Over the past decade, patent applications have almost doubled from just over 260,000 in 1998 to more than 485,000 in 2008. During that same time period, the number of patents granted has not increased at the same pace, rising from roughly 163,000 in 1998 to only just over 185,000 in 2008, a difference of only 13.5%. This increase in filing creates a growing backlog, with approximately 700,000 patent
applications currently awaiting a first response from the patent examiner. Consequently, great concern remains about the USPTO’s ability of to provide effective and timely review of the patent applications.

This concern over the patent examination process has been widely recognized. Indeed, “[t]he popular press, as well as academic, business, and government publications, is full of articles about low quality patents.”

Inadequate examination and exploration of prior art, underfunding of the USPTO, and the decrease in time spent by an examiner on a given patent cause poor patent quality. During the examination process, the patent examiner evaluates not only the content of the application, but also searches globally for prior art. A patent examiner faces a very significant challenge in sifting through all possible prior art to accurately determine whether the claimed subject matter is both novel and non-obvious. One scholar has noted that “[n]o matter how diligently an examiner acts in reviewing the prior art, the part of that universe accessible to an examiner is so markedly incomplete that it is inevitable that she will never discover pertinent references and inventions without outside assistance.”

Therefore, some change is necessary to adequately address these concerns and improve the quality of the patent system.

II. PRIOR ART SUBMISSION AND REEXAMINATION MECHANISMS

Outside assistance to the patent examiner during examination currently comes in different forms. This section explains what is required from the applicant during prosecution. Then, this section lays out what limited mechanisms are available for third parties to become involved during prosecution, and finally this section explains the different mechanisms available to challenge a patent after it has been issued.

The USPTO requires applicants to assist in the examination process with a “duty of candor and good faith in dealing with the [USPTO]” as required by federal regulations. Interested third-parties may elect to utilize one of three limited options for pre-grant participation: protest, public use proceeding, or merely by submitting prior art to the USPTO. After a patent issues, its validity can be questioned before the USPTO in a reissue or a reexamination proceeding. In spite of these different options within the USPTO, litigation in the courts remains the most common form of challenge to patent validity. This comment explains each of these different mechanisms and the impacts they have
on the examination process when they occur before the patent issues, or the impacts they have on improving the quality of the patent system if they occur after the patent issues.

A. Applicant Assistance During Examination

Before an application can be examined, the applicant must submit an oath or declaration which not only states that the named inventors are the original and first inventors of the subject matter, but also states that the “person making the oath or declaration acknowledges the duty to disclose to the [USPTO] all information known to the person to be material to patentability as defined in § 1.56.”

Section 1.56 of the Code of Federal Regulations places a “duty of candor and good faith in dealing with the [USPTO]” on “[e]ach individual associated with the filing and prosecution of a patent application.” Section 1.56 recognizes that patents affect the public interest and that this public interest is best served when the USPTO “is aware of and evaluates the teachings of all information material to patentability” during the examination of an application. This rule, however, does not go so far as to place any duty on applicants to research or discover information that may be material to the patentability. Instead, it only requires applicants to disclose to the USPTO information “known to be material to patentability.” Failure to perform this required disclosure can result in unenforceability of the entire patent, even if the withheld disclosure only affects a single claim.

With the severity of the possible penalty and the limitations on opposition before the USPTO, competitors or opponents can present prior art to the applicant rather than directly to the USPTO. This option places the applicant under the duty to disclose this prior art for consideration during examination. The applicant does receive a benefit for making these disclosures, should a patent issue. Patents have a rebuttable presumption of validity in litigation with respect to any information considered by the USPTO during examination.

B. Third Party Mechanisms to Challenge an Application

During the examination process, an interested third party does have some mechanisms available to challenge an application before it becomes a patent. These mechanisms are very limited and not widely used, leaving it to the patent

44. 37 C.F.R. § 1.63.
45. 37 C.F.R. § 1.56(a).
46. 37 C.F.R. § 1.56(a) (2010).
47. Id.
49. 37 C.F.R. § 1.56(d).
50. Id. § 1.56(e).
examiner to locate and evaluate all possible prior art. Rather than rely on this single examiner to find all possible prior art affecting the examination of a patent, the USPTO should provide more mechanisms for interested third-party individuals and organizations to augment the USPTO’s resources. Even if the USPTO were to have redundant examiners performing the examination, the second examiner would have identical access to the same resources and would have the same training, minimizing any possible benefit in improving the examination process. Furthermore, the additional resource dedication may make the prosecution of a patent application more expensive and lengthy. The applicant will be the most knowledgeable about the invention, but the applicant’s competitors in the industry may also be useful sources for information material to the invention’s patentability.  

Currently, a third party has three options to affect the prosecution of a patent application: a Rule 291 Protest, a Rule 292 Public Use Proceeding, and a Rule 99 Submission. Prior to an application’s publication, parties may submit Protests under 37 C.F.R. § 1.291 (“Rule 291”) which contain information, patents, or publications that the protestors believe to be relevant to the application. The second option is a Public Use Proceeding under 37 C.F.R. § 1.292 (“Rule 292”). Affidavits or declarations submitted with a petition initiate this proceeding when the examiner finds a prima facie showing that the claimed invention was used publicly or was on sale more than one year before the application was filed. The final option is the submission of publications to the USPTO to be considered during examination under 37 C.F.R. § 1.99 (“Rule 99”). The Rule 99 submission may include a maximum of only ten possible prior-art publications or patents, with no accompanying explanation or comments, and must be submitted within two months of the date of publication.

Although the USPTO does not publish records on how many Rule 99 submissions, Rule 291 Protests, or Rule 292 Public Use Proceedings occur or how often these affect the prosecution of the applications against which they are filed, there are probably few, as the restrictions on these procedures render them largely useless. The biggest limitation on involving the public in the patent examination process is 35 U.S.C. § 122(c). This statutory provision requires the USPTO director to “establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application.” The Section 122 limitation on opposition was enacted when the USPTO began publishing

52. Mack, supra note 29, at 168.
54. Applications are normally maintained in confidence until eighteen months after the date of filing. Parties may request their applications not be published, or issues of national security may prevent them from publishing. 35 U.S.C. § 122.
55. 37 C.F.R. § 1.291(a), (c).
57. 37 C.F.R. § 1.99(b), (d), (e).
58. 35 U.S.C. § 122(c).
applications, which previously had been maintained in confidence until the patent was issued. The limitations were a response to concerns that an applicant’s competitors would harass or delay the USPTO if the USPTO published applications prior to issuing patents and allowed such opposition. Applications are maintained in confidence between the USPTO and the applicant until 18 months after the filing date. After 18 months, the USPTO publishes the applications and makes them available to the public. Applications can be viewed on the USPTO’s website by using a search based on keywords, application number, or publication number.

Section 122’s ban on post-publication opposition effectively eliminates the availability of Rule 291 or Rule 292 opposition. Before the USPTO publishes a patent application, opponents have no way to learn of the pending application and thus, no way to prepare an opposition. Since the Rule 99 submission allows no accompanying explanation or comments, the USPTO determined that a Rule 99 submission does not fall within the Section 122 restriction on post-publication opposition, but a two-month limit remains for when Rule 99 submissions will be accepted. Additionally, with the large size and complexity of patent applications, the limit on ten prior art publications or patents makes the Rule 99 submission of little use to opponents of large or complex applications.

Another disincentive for opponents to make use of Rule 99 submissions and Rule 291 protests arises once the USPTO has evaluated a patent claim with respect to a certain piece of prior art: the allowed claim has a rebuttable presumption of validity against that prior art. The limitations in the opposition procedures put opponents at a severe disadvantage compared to the applicant. Opponents have no continuing contact with the USPTO once they have made their submissions, while the applicant has opportunities to respond and amend its applications in response to the opposition. Thus, an incentive exists for opponents to withhold their prior art until after the patent issues to use as a bargaining chip in negotiating a cheaper licensing agreement, or to take advantage of the lower evidentiary burden in litigating patent validity.

59. Id. § 122.
60. 35 U.S.C. § 122 (1994) (showing the Act’s language prior to the 1999 Amendment).
63. Id.
67. See generally 37 C.F.R. § 1.12.
68. In the absence of a presumption of validity, the party asserting invalidity would only be required to prove by a preponderance of the evidence. Schumer v. Lab. Computer Sys., Inc., 308 F.3d 1304, 1315 (Fed. Cir. 2002) (“To overcome th[e] presumption of validity, the party challenging a patent must prove facts supporting a determination of invalidity by clear and convincing evidence.”) (citing Apotex USA, Inc. v. Merck & Co., Inc., 254 F.3d 1031, 1036 (Fed. Cir. 2001), cert. denied, 534 U.S. 1172 (2002)); Ryco, Inc. v. Ag-Bag Corp., 857 F.2d 1418, 1423...
C. Post-Issuance Challenges to Patent Applications

With the limitations on opposing patent applications before the USPTO, the public is left to challenge issued patents rather than patent applications. In an action for infringement, the defendant may assert a defense or a counterclaim of invalidity, which asks the court to declare the patent invalid or the claims unenforceable. Alternatively, a party may bring a declaratory judgment action on patent validity even if the patentee has not yet filed an infringement action. Finally, the public has the option to challenge a patent’s validity before the USPTO through third-party-initiated reexamination.

Reexamination allows the submission of prior art to the USPTO when it raises a substantial new question of patentability not considered during examination. Any person may file a request for reexamination during the enforceable term of a patent, which is determined by adding six years to the date on which the patent expires. While no statute of limitations exists for patent infringement cases, there is a statutory limit on the length of time during which damages may be recovered. A patent owner can assert his or her rights to recover damages for infringement any time before or after the patent expires, but “no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint.” Thus, the enforceable term of a patent—the time during which a person may request reexamination—is up to the date of expiration plus six years.

The USPTO conducts reexaminations either ex parte or inter partes and may provide different relief than litigation. An ex parte reexamination reviews the prior art submission from the requester and proceeds similarly to the initial examination of a patent application between the patentee and the USPTO, with no continued contact with the third-party requester. An inter partes reexamination resembles an adversarial proceeding and includes input from both the reexamination requester and the patent owner. Either type of reexamination

(Fed. Cir. 1988) (“[A] patent is presumed valid, and the party attacking validity has the burden of proving facts supporting a conclusion of invalidity by clear and convincing evidence.”)).


70. Cardinal Chem. Co. v. Morton Int’l, Inc., 508 U.S. 83, 96 (1993) (“A party seeking a declaratory judgment of invalidity presents a claim independent of the patentee’s charge of infringement.”). However, there does need to be an actual claim or controversy for the courts to hear a declaratory judgment action beyond the situation where one party has a patent that the other party may or may not be infringing. Some action, such as the threat of bringing suit for infringement, must present “a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” Medimmune, Inc. v. Genentech, Inc., 549 U.S. 118, 127 (2007).


72. 37 C.F.R. § 1.510(a) (2010).

73. MPEP, supra note 14, § 2211.


75. Id.


77. MPEP, supra note 14, § 2209; 35 U.S.C. § 305.

78. MPEP, supra note 14, § 2609.
is granted only when the citation to patents or printed publications submitted with
the request raises a “substantial new question of patentability.”\footnote{35 U.S.C. § 303.} Reexamination
is attractive to patentees because it provides different relief than litigation.
During litigation a court may only find the patent claims valid or invalid.
Conversely, the USPTO can modify the patent claims to either widen or reduce
claim coverage through the reexamination process.\footnote{35 U.S.C. § 305 (“[T]he patent owner will be permitted to propose any amendment to his
patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the
prior art … or in response to a decision adverse to the patentability of a claim of a patent.”).}

The reexamination procedures, both \textit{ex parte} and \textit{inter partes}, are recent
additions to the patent system. Governed by 35 U.S.C. §§ 301-307, \textit{ex parte}
reexamination was enacted into law in December 1980 (Pub. L. 96-517) and
became effective on July 1, 1981.\footnote{35 U.S.C. § 301.} Since that time, more than 10,000 \textit{ex parte}
reexaminations have been filed, starting with only 78 in the first year and
growing to 680 in 2008.\footnote{Ex Parte Reexamination Filing Data—June 30, 2011, USPTO,
Editorial Note: It should be noted that these statistics are routinely updated by the USPTO, and the
latest quarterly report overrides prior reports posted on its web page. The statistics cited here are
taken specifically from the June 2011 USPTO EP quarterly report.} Of the more than 11,000 \textit{ex parte}
reexamination requests filed, more than 10,000 have been granted by the USPTO, with 8375
having reached a conclusion.\footnote{Id.} Of those 8375 \textit{ex parte} reexaminations which
have reached resolution, only 23\% have resulted in all claims being confirmed as
of June 30, 2011.\footnote{Id.} These numbers mean that three of every four patents that
were issued by the USPTO and subsequently challenged were either changed
(66\%) or canceled entirely (11\%).\footnote{Id.} These consequences occurred because of
prior art that existed but which had not been located and considered by the patent
examiner during the initial examination.\footnote{Most of the claims were filed by third parties who brought in new information not
originally considered by the patent examiner. \textit{Id.}}

\textit{Inter partes} reexamination procedures, governed by 35 U.S.C. §§ 311-318,
became effective even more recently: it was enacted into law and became
effective November 29, 1999 (Pub. L. 106-113).\footnote{35 U.S.C. § 311 (2006).} Use of this option has also
increased over time, growing from the first and single filing in 2001 to almost
170 in 2008, and more than 280 filed in 2010; more than 270 were filed in the
first half of 2011, as of June 30.\footnote{Inter Partes Reexamination Filing Data—June 30, 2011, USPTO,
Editorial Note: It should be noted that these statistics are routinely updated by the USPTO, and the
latest quarterly report overrides prior reports posted on its web page. The statistics cited here are
taken specifically from the June 2011 USPTO IP quarterly report.} Of the total 1286 \textit{inter partes} reexamination
requests filed, 1099 have been granted, with only 278 reaching conclusion. A significantly smaller percentage of patents going through the *inter partes* reexamination survive with all claims confirmed: only 13% (unlike the 23% of *ex parte* reexaminations). Also, *inter partes* reexamination leads to a much higher percentage of patents in which all claims are canceled or disclaimed: 44% compared to 11% with *ex parte* examination. This difference may be due to the presence of an adverse party with a vested interest in seeing the patent invalidated.

The statistical trends of the different reexamination procedures support two conclusions. First, patent examiners do not find all prior art that reads on patent claims, which results in patents issuing for inventions and claims that do not meet the statutory requirements of novelty and nonobviousness. Second, increased public involvement increases patent quality by providing broader resources to locate and relate prior art to patent claims, reducing erroneous patent protection. Based on these conclusions, Congress should remove the limitations of 35 U.S.C. § 122(c) limiting third-party opposition to post-publication and should allow the USPTO Director to establish new procedures for utilizing the public resources available. This will increase examination efficiency and improve overall patent system quality.

**III. PATENT-CHALLENGING ORGANIZATIONS, PILOT PROGRAMS, AND PROPOSED LEGISLATION**

This section examines both nonprofit and for-profit organizations working to challenge patents and to compile prior art databases for use in patent challenges. Also, this section reviews programs that have started to explore increasing public participation in the patent examination process in the United States, as well as in Japan. Finally, this section considers reforms to the current patent law that would accomplish that increase.

**A. Patent-Challenging Organizations**

There has been an increasing trend in public interest and participation in the patenting process, as evidenced by the following organizations’ activities. Patients Not Patents (“PNP”), a nonprofit organization, challenges patents for medical and pharmaceutical products, devices, and methods in their commitment to ensuring access to healthcare. To submit their challenges, PNP utilizes the Rule 291 Protest when the patent owner files a reissue application. Reissue applications are filed when a patent owner seeks to correct the issued patent or to

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89. *Id.*
90. Compare *id.*, with *Ex Parte Reexamination Filing Data—June 30, 2011*, *supra* note 82.
91. *Id.*
92. *Patients not Patents*, *WISER EARTH*, http://www.wiserearth.org/organization/view/1c1ce4c9123e9e6e29fb74e272f64fa (last visited May 18, 2011).
93. *Id.*
amend the patent by changing the scope of its claims. The USPTO publishes announcements for reissue applications in the *Official Gazette*, and such publication does not prohibit the filing of a protest under 35 U.S.C. § 122(c).

Section 122(c) prohibits pre-issuance opposition after publishing an application, but because the reissue application is a post-issuance proceeding, the prohibition does not apply. Filing Protests on reissue applications is significantly less expensive than filing a reexamination request, but this option exists only if the patent owner first files a reissue application. Filing a protest against a reissue application is identical to filing a protest against an original application. The protestor submits prior art that the protestor believes relevant to the application’s patentability to the USPTO for the examiner’s consideration in determining whether to allow or reject the claims.

Filing a request for reexamination provides an alternative to filing Protests in response to a patent owner’s reissue application. Like PNP, the Electronic Frontier Foundation (“EFF”) is a nonprofit organization that challenges patents, specifically targeting software and internet technology patents. EFF’s Patent Busting Project challenges “patents that suppress non-commercial and small business innovation or limit free expression online.” Unlike PNP, which waits for the patent owner to file a reissue application, EFF uses the reexamination procedure to initiate its challenges before the USPTO. This strategy is more effective because it can be initiated without any action on the patent owner’s part, but this strategy is significantly more expensive.

Another nonprofit organization, the Public Patent Foundation (“PubPat”), follows a similar strategy of filing reexamination requests in their pursuit of “protecting freedom from illegitimate restraint.” PubPat does not focus on a specific technology area. Instead, it focuses on patents having “substantial questions regarding their validity[,]” and which the organization believes to have a “significant chilling effect on some conduct that would otherwise be

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95. 37 C.F.R. § 1.11(b), (c) (2010).
96. MPEP, *supra* note 14, § 1441.01.
98. 37 C.F.R. § 1.16(e) (the cost of a reissue application is between $165 and $850 depending on small or large entity status and date of application filing); *id.* § 1.20(c) (the cost for filing an ex parte reexamination is $2,520, and for inter partes reexamination, $8,800); *id.* § 1.17(i) (the cost for filing a protest under 1.291 is $130).
99. *Id.* § 1.291(a).
100. *Id.* § 1.291(c).
103. *Id.*
104. 37 C.F.R. § 1.16(e) (the cost of a reissue application is between $165.00 and $850.00 depending on small or large entity status and date of application filing); *id.* § 1.20(c) (the cost for filing an ex parte reexamination is $2,520.00, and for inter partes reexamination, $8,800.00); *id.* § 1.17(i) (the cost for filing a protest under 1.291 is $130.00).
permissible, if not desirable, including, for example, competition, research, and the exercise of civil liberties.\textsuperscript{106} The claimed subject matter in some of the patents invalidated as a result of PubPat’s activities include: drug patents, isolated gene patents, patents on certain website behaviors, and computer file format patents.\textsuperscript{107}

Unlike these nonprofit organizations, Article One Partners\textsuperscript{SM} ("AOP") has formulated a strategy to profit from collecting prior art for patent challenges.\textsuperscript{108} Clients identify patents they seek to challenge, and “advisors” within the AOP network (members of the website community) submit prior art documentation, with money paid to the user who submits prior art ultimately used to invalidate the patent.\textsuperscript{109} AOP also uses the information it finds to make informed market trades and has implemented a profit sharing program for active researchers.\textsuperscript{110}

AOP launched its online community on November 17, 2008.\textsuperscript{111} The organization announced its first winning patent study in February of 2009, and by November of 2009, it claimed to be the largest patent validation firm in the world.\textsuperscript{112} Over its years of operation, AOP has reported awarding money for finding evidence of patent invalidity, or otherwise impacting litigation, in 22 cases out of a total 54 patent studies closed.\textsuperscript{113} Although the court system or the USPTO actually declares a patent invalid, AOP has found a way to profit by providing the searching services.\textsuperscript{114}

These organizations demonstrate the significant impact patents have in society, generating interest in the medical field, electronic technology, or anywhere a profit can be made. These organizations also show the role the public may play in providing additional information pertinent to patent validity. AOP’s rapid growth illustrates the opportunities made available by this increasing interest in minimizing the adverse consequences that arise when the USPTO issues patents for inventions not meeting statutory requirements.

\textbf{B. Pilot Programs: USPTO and Japanese Patent Office}

\textbf{1. USPTO}

The USPTO itself began exploring ways to involve the public in the patent examination process with their Peer-to-Patent: Community Patent Review

\textsuperscript{106} Id.
\textsuperscript{109} Id.
\textsuperscript{110} Id.
\textsuperscript{112} Id.
\textsuperscript{114} Id.
A project partnership with the New York Law School’s Institute for Information Law and Policy, the Peer-to-Patent program ran for two one-year pilot programs and “enable[d] the public to submit prior art and commentary relevant to the claims of pending patent applications.” The pilot programs reviewed applications within a very limited range of technology. Patent applicants could request to participate in this program and submit their applications if their inventions involved computer architecture, software, information security, or financial, business practice, management or cost/price determination data processing. The program chose these technology areas because training in computer science would not qualify as technical training to meet the requirements to work as a patent examiner. This is no longer the case, but this prior exclusion of computer science has left the USPTO behind the current state of the art in the computer science industry.

After concluding the second pilot in June 2009, the program began a third pilot in October 2010.

The first year of the program supported the goal that “online public consultation can effectively be employed to improve the quality of issued patents.” As in the first year of the operation, the second year’s results also supported the conclusions drawn from year one. Success of the program was measured against three hypotheses. First, that the public participation would improve the quality of information available to examiners. Second, that “the public is capable of self-selecting on the basis of expertise and producing info relevant to the examination process.” And finally, that “public participation produced a better quality, stronger patent.” While the third hypothesis can only be evaluated over the long term, the program can establish its success by considering the participation and the impact that participation had in the examination process.

116. Id.
120. Id.
123. Id. at 14.
124. Id. at 11.
125. Id.
126. Id.
127. Id. at 12.
Over the two years that the Peer to Patent pilot programs ran, there were 187 patent applications open to community evaluation.128 These applications were enrolled to participate at the election of the applicant. Of the applications participating 66 received an office action, 18 of which used peer submitted prior art as the basis of rejection including prior art that the USPTO examiners did not find during their search.129 Although the average number of active reviewers per application decreased from the first year to the second, the number of prior art references submitted per application nearly doubled.130 Additionally, internet traffic tracked by the program evidenced the growing interest in the program as more people were visiting the program website more often from year one to year two. After the two years of operation, the program administrators concluded that the Peer-to-Patent program was a viable improvement to the examination process in response to the “glut of patent applications awaiting review, the increasing complexity of patents and the intentionally vague language used by [application] drafters.”131

In addition to the quantitative results of the program, the overall reception of the program was very positive. A survey of the participants, the results of which were included in the Second Annual Report, indicated that 75% think “that a third-party submission of prior art program like peer-to-patent should be incorporated into regular USPTO practice.”132 Another 80% of the participants think “there [is] value to public participation in patent examination[.]”133 In total, there were eight office actions that included prior art which was not found by examiners.134 The program organizers conclude that this “establishes that peer review is capable of supplying inaccessible resources to the patent review process that would otherwise go unrecognized.”135 Furthermore, the organizers recognize that the “inclusion of this prior art is vital to the health of the patent system, and peer review is an important venue for providing this resource.”136 The results reported show that the Peer-to-Patent pilot programs are an important advancement to improving the quality of the examination process.137


In addition to the USPTO’s experimentation with the Peer-to-Patent project, the Japanese Patent Office also experimented with a Community Patent Review

128. Id. at 5.
129. Id.
130. Id. at 22-23.
131. Id. at 24.
132. Id. at 21.
133. Id.
134. Id. at 23.
135. Id.
136. Id.
137. Id. at 3 (“Opening government to active citizen participation not only works, citizens are embracing it.”).
(“CPR”) program in an effort to increase the quality of issued patents.\textsuperscript{138} Japan’s pilot program ran on a smaller scale and for a shorter time than the USPTO program—only five months.\textsuperscript{139} Of the 39 applications participating in the CPR program, elected for participation by the applicant, 35 received a first office action, that is, an initial evaluation on patentability by the examiner, 13 of which cited to prior art submitted to the project.\textsuperscript{140} Both the patent office examiners and the participating community reviewers responded positively to questionnaires about the project, reporting that valuable prior art was obtained through community submissions, and that CPR “[w]as effective in maintaining and enhancing the quality of patent examination.”\textsuperscript{141}

Despite the positive opinions from the project participants, the results of Japan’s program identified two main challenges in maintaining that form of community involvement in the patent process.\textsuperscript{142} The first challenge was the level of community involvement associated with the review. Japan’s CPR program involved 253 participants, of which only 22 submitted prior art documents.\textsuperscript{143} The benefits of a community involvement system will only outweigh the financial burdens of establishing and maintaining a system to receive and review community submissions if the community provides valuable contributions to the patent process. The level of involvement in Japan’s CPR pilot program was deemed insufficient.\textsuperscript{144}

The second challenge identified was the content of the prior art submissions received as part of the process.\textsuperscript{145} Throughout the project, the community made 137 prior art submissions, of which only 17 were non-patent documents.\textsuperscript{146} The report concluded that community submission of patent documents may enhance the efficiency of patent examination, but not the quality of the examination.\textsuperscript{147} Patent examiners are well-versed in locating patent documents that may relate to the technology disclosed in patent applications. The value of community involvement is the public’s knowledge and the public’s access to various sources of information outside the patent system. To actually improve patent examination quality through community involvement, the submitted information must include more non-patent documentation than the CPR program received.\textsuperscript{148}

\begin{flushleft}
\textsuperscript{140} Id.
\textsuperscript{141} Id. § VII.
\textsuperscript{142} Id.
\textsuperscript{143} Id.
\textsuperscript{144} Id.
\textsuperscript{145} Id.
\textsuperscript{146} Id.
\textsuperscript{147} Id.
\textsuperscript{148} Id.
\end{flushleft}
3. **Cursory Conclusions on the Pilot Programs**

Without any reported results from the USPTO, the Peer-to-Patent program’s actual impact on the prosecutions of the patent applications involved remains unknown. Based on the challenges identified in Japan’s CPR program, coupled with the decreasing trend in public contributions as the USPTO’s project continued, the USPTO should further explore different options to increase patent integrity. Possible improvements to the project could include providing some kind of incentive for people to submit prior art, more clearly identifying the type of prior art sought by the USPTO, or broadening the scope to include different technological areas.

C. **Proposed Legislation**

Recent legislation has been proposed to work around the Section 122(c) prohibition of post-publication pre-grant opposition by allowing third-party prior art submission as part of wide-reaching patent reform measures, but no reform has been enacted. Since 2005, patent reform legislation has been proposed in both the House of Representatives and the Senate; each of these bills has addressed the use of pre-grant opposition or third-party prior art submission.

The Patent Reform Act of 2005 would have amended Section 122 to allow any person to submit any patent, published application, or other publication potentially relevant to examination of a patent application. 149 This submission was to be permitted before the notice of allowance, or either six months after the application was published or on the date of the first rejection of any claim, whichever was later. 150 An explanation of the relevance of each submitted document would have accompanied the submissions, and the submissions would have been subject to a fee. 151

This provision was mirrored in the Patent Reform Act of 2006, proposed in the Senate. 152 The 2005 bill was referred to the House Committee on the Judiciary, where hearings were held by the House Subcommittee on Courts, the Internet, and Intellectual Property. 153 The 2006 bill was referred to the Senate Committee on the Judiciary, where no further action was taken. 154 In 2007, both the House and the Senate introduced a Patent Reform Act. 155 The House passed the bill by a narrow margin, but the Senate did not vote on the bill. 156

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150. Id.
151. Id.
recently, the House and the Senate introduced the Patent Reform Act of 2009.\textsuperscript{157} The Senate Judiciary Committee voted to bring the Act for a vote before the full Senate in April of 2009, however, no further action has been taken with regards to either the House or Senate bills.\textsuperscript{158} This proposed legislation maintains the same provisions of the Patent Reform Act of 2005 with respect to submissions by third parties.\textsuperscript{159}

In 2005 the Subcommittee on Courts, the Internet, and Intellectual Property held a hearing on patent law changes proposed in bills starting in 2005 and continuing through 2009.\textsuperscript{160} During the hearing, four experts reviewed the proposed changes with perspectives from industry, academia, and patent law practitioners.\textsuperscript{161} While these experts represented different important views on patent law, they all agreed on the importance of maintaining a high-quality patent system, and all agreed that reform is needed to improve the quality of today's patent system.\textsuperscript{162}

Gary Griswold provided testimony at the hearing on behalf of the American Intellectual Property Law Association.\textsuperscript{163} In his statement, he supported the proposed addition to Section 122, as it would "assist applicants to obtain stronger, more reliable patent protection by ensuring that the best prior art is before the PTO."\textsuperscript{164} Furthermore, Griswold recognized that the limitations would "ensure that such submissions cannot be used to harass applicants," as was the goal of the original Section 122.\textsuperscript{165}

Josh Lerner, a professor of investment banking at Harvard Business School, also testified at the hearing as an expert on patents' economic impact.\textsuperscript{166} In his testimony, he recognized "that much of the information to decide whether a given application should be approved is in the hands of competitors of the applicant rather than in the hand of the PTO."\textsuperscript{167} He analyzed the proposed changes, considering the fact that incentives were needed to put that information into the USPTO’s hands for an effective examination.\textsuperscript{168} But Lerner did not
suggest specific methods of how best to accomplish that goal.\textsuperscript{169} Indeed, all of the witnesses present at the hearing supported the idea of third-party submissions during examination of patent application.\textsuperscript{170}

IV. TRADEMARK OPPOSITION PRACTICE

Another option the USPTO may consider for changing patent prosecution procedures comes from the non-patent half of the USPTO, specifically the “publication for opposition” phase of trademark registration.\textsuperscript{171} Similar to patent prosecution, trademark registration begins with filing an application.\textsuperscript{172} Likewise, applications in both systems go through an examination conducted by USPTO examiners to ensure satisfaction of statutory requirements.\textsuperscript{173} Once the requirements have been met, the USPTO issues a patent, whereas the USPTO publishes a trademark for opposition in its \textit{Official Gazette}.\textsuperscript{174}

A trademark published in the \textit{Official Gazette} stays open for an opposition period of 30 days.\textsuperscript{175} During this period, a third party may file an opposition to registration of the trademark based on the belief that he would be damaged by the mark’s registration.\textsuperscript{176} Unlike patents, which have the Rule 291 Protest and the Rule 292 Public Use Proceedings, the opposition period is the first chance the public has to challenge a proposed trademark.\textsuperscript{177} Trademark applications are accessible to the public for opposition during the examination period prior to publication, giving the public an opportunity to be aware of an application before the opportunity for opposition begins.\textsuperscript{178}

This trademark opposition differs significantly from patent opposition, which is currently cut off by 35 U.S.C. § 122 when the patent application is published.\textsuperscript{179} Since patent applications are already accessible to the public prior to being issued as a patent,\textsuperscript{180} this system may be useful for implementing a period of opposition once the application does issue as a patent. However, this system would not differ significantly from the available reexamination and reissue procedures, and it does not present significant advantages in achieving a comprehensive review of all applicable prior art before the patent is issued.

\begin{itemize}
\item[169.] \textit{Id.}
\item[170.] \textit{Id.} at 4-48.
\item[171.] 37 C.F.R. § 2.80 (2010).
\item[173.] \textit{Id.} § 1062(a).
\item[174.] \textit{Id.}
\item[175.] \textit{Id.} § 1063(a).
\item[176.] \textit{Id.}
\item[177.] \textit{See id.} \textit{See also 37 C.F.R. §§ 1.291, 1.292 (2010).}
\item[180.] \textit{See id.}
\end{itemize}
V. THIRD-PARTY OPPOSITION IN FOREIGN PATENT SYSTEMS

In considering new ways to increase patent integrity by expanding public involvement, the USPTO should examine the mechanisms employed in other countries to achieve the same goal. Each country maintains its own system of protection for different types of intellectual property. Most industrialized countries employ a patent system similar to that of the United States for protecting new and useful processes, machines, arts, compositions of matter, or any improvements of these items. Likewise, patent systems share requirements of usefulness, novelty, and inventiveness (or, as the United States refers to it, nonobviousness).

While the United States’ patent system may differ from the patent systems found in other countries in several aspects, two of those aspects are particularly significant: whose rights are protected, and how applications are examined. First, the United States will grant a patent only to the first inventor—the individual or individuals who contributed to the first conception of the invention that was diligently followed by the invention’s reduction to practice. In most other countries, patents issue on a first-to-file basis and may go to an applicant who owns the rights to the invention rather than to the inventor or inventors themselves. Second, the United States has a compulsory examination of all patent applications. In many foreign patent systems, an application is not examined unless and until a formal request for examination is filed with the patent granting authority.

To consider the present state of the United States practice in light of global protection of intellectual property, this comment explores the practices of foreign patent offices. Specifically, this comment examines the practices of Canada, the United Kingdom, Germany, the European Union, China, and Japan.


A. Canada

Canada is an important partner for considering intellectual property protections. Canada’s close geographical proximity provides markets that attract many U.S. companies, and the North American Free Trade Agreement eliminates obstacles for U.S. companies wishing to expand into Canada. Canada’s patent system differs from the U.S. system in the two important aspects mentioned above: (1) The owner of an invention can obtain the patent, rather than just the inventor, and (2) examination of applications is performed only on request. The Canadian Intellectual Property Office will accept a request for examination received within five years of filing the application, and either the applicant or any other person may make such a request. If no one requests an examination within the time limit, the application will be abandoned and no patent will issue unless the applicant requests reinstatement within 12 months of abandonment.

The Canadian patent system resembles the U.S. patent system, with an examiner inspecting the application for compliance with statutory requirements and searching for prior art that may preclude issuance of a patent. All Canadian patent applications and associated documentation are open to public inspection after an 18-month confidentiality period. The Canadian Patent Office publishes a weekly listing of these applications, which is opened to public inspection. Unlike the U.S. patent system, the Canadian patent system allows any person to “file prior art with the Commissioner … consist[ing] of patents, applications for patents open to public inspection, or publications that the person believes have a bearing on the patentability of any claim in a patent application.” In addition to submitting prior art, Canada allows protests to be made by submitting communications to the Commissioner of Patents “with the stated or apparent intention of protesting against the granting of a patent” and which “may develop as a result of public inspection of opened applications.” Any prior art submission or protest becomes part of the open application file available to the public for review and is considered by the examiner once examination has concluded with the

188. Id.
189. Id.
190. Id. § 13.05.
191. Id. § 2.01.01.
192. Id.
193. Id. § 18.01.
194. Id. § 18.02.
195. Id. §§ 18.04-05.
patent being allowed, but before the patent has been issued, a protest or prior art submission will still be considered, and the patent office may withdraw the notice of allowance.\textsuperscript{196}

\textbf{B. The United Kingdom}

Similar to Canada, the United Kingdom allows individuals to protest a patent’s issuance prior to it being granted.\textsuperscript{197} Also like the Canadian system, the U.K. patent system has examination on request and an application right based on legal ownership rather than based on inventive contribution.\textsuperscript{198} Patent applications in the U.K., however, will not publish automatically, as they do both in the U.S. and in Canada.\textsuperscript{199} Rather, the applicant must request a search of patents and publications to check that the invention in the application is both new and inventive.\textsuperscript{200} If the subject matter meets the requirements after the initial search, the application is published 18 months after the filing date.\textsuperscript{201} The applicant then has six months from publication to request a substantive review of the application.\textsuperscript{202} The U.K. patent system allows third-party opposition between the time when an application publishes and when a patent is granted.\textsuperscript{203} Specifically, individuals may make observations on patentability about published patent applications before the applications are granted, and these observations will be considered during examination.\textsuperscript{204} Individuals submit these observations “in writing to the comptroller on the question [of] whether the invention is a patentable invention, stating reasons for the observations.”\textsuperscript{205} Thus, this patent system allows any interested third party to become involved in application process without requiring the party to overcome limitations or hurdles.

\textbf{C. Germany}

Like Canada and the U.K., Germany also allows public opposition, but the mechanism for opposition closely resembles U.S. trademark opposition than the Canadian or the U.K. pre-grant patent opposition. Under German patent law, an application is made to the German Patent and Trademark Office (“DPMA”) and

\begin{footnotesize}
\begin{itemize}
\item \textsuperscript{196} Id. § 18.04.
\item \textsuperscript{198} \textit{Are You the Owner or Inventor?}, INTELLECTUAL PROP. OFFICE, http://www.ipo.gov.uk/types/patent/p-applying/p-before/p-owner.htm (last visited May 31, 2011).
\item \textsuperscript{199} \textit{See After You Apply}, INTELLECTUAL PROP. OFFICE, http://www.ipo.gov.uk/types/patent/p-applying/p-after.htm (last visited May 31, 2011).
\item \textsuperscript{200} Id.
\item \textsuperscript{201} Id.
\item \textsuperscript{202} Id.
\item \textsuperscript{204} \textit{Observations about Patentability}, supra note 197.
\end{itemize}
\end{footnotesize}
goes through a preliminary examination to check for compliance with formal requirements and classification according to Technical Field, that is, the system of technological classification the DPMA has established.\textsuperscript{206} Patent applications are kept confidential for the first 18 months after filing, after which they are published regardless of whether an examination is requested.\textsuperscript{207} Within seven years of the application’s filing date, the applicant may make an examination request—an in-depth substantive examination required for granting a patent.\textsuperscript{208} If the application meets the requirements after the examination, a patent will issue.\textsuperscript{209} There are no restrictions regarding who may oppose the grant of a patent, and “[a]nyone can oppose the grant of a patent within three months from the publication of the patent specification.”\textsuperscript{210} By filing a notice of opposition, opponents may state reasons why they consider the patent unlawful.\textsuperscript{211} Based on the notice of opposition, a panel of the DPMA patent-division members re-examines whether the patent meets requirements for granting.\textsuperscript{212} Then, the patent is “either revoked or maintained as granted or in an amended form.”\textsuperscript{213}

D. European Union

Rather than filing an individual national patent application in the U.K., Germany, or any other country in Europe, an inventor has the option of filing for a regional patent through the European Patent Organisation (“EPO”), an organization created through an international treaty, the European Patent Convention (“EPC”).\textsuperscript{214} Article 99 of the EPC provides for third-party opposition as a post-grant, \textit{inter partes} administrative procedure.\textsuperscript{215} A notice of opposition must be filed within nine months of the published grant of the European patent.\textsuperscript{216} This opposition may be based only on unpatentable subject matter, insufficient disclosure and enablement, or subject matter beyond application content, supported by reference and prior art.\textsuperscript{217} This contrasts with the current U.S. opposition mechanisms including Rule 99 submissions, and reexaminations which may only address the patentability of the subject matter.\textsuperscript{218}

\begin{itemize}
\item \textsuperscript{207} Id.
\item \textsuperscript{208} Id.
\item \textsuperscript{209} Id.
\item \textsuperscript{210} Id.
\item \textsuperscript{211} Id.
\item \textsuperscript{212} Id.
\item \textsuperscript{213} Id.
\item \textsuperscript{214} About Us, \textsc{European Patent Org.}, http://www.epo.org/about-us/epo.html (last visited May 31, 2011).
\item \textsuperscript{216} Id.
\item \textsuperscript{218} See supra Part II.B.
\end{itemize}
During the opposition proceeding, the EPO’s Opposition Division examines whether the grounds for opposition prejudice the maintenance of the patent, inviting the parties to make observations.\textsuperscript{219} The Opposition Division may revoke the patent, reject the opposition, or allow the patent.\textsuperscript{220} Also, the patent owner may elect to amend the patent in response to the opposition, in which case the Opposition Division may revoke the patent if it does not meet EPC requirements, or allow the patent as amended.\textsuperscript{221}

\textit{E. China & Japan}

Outside Europe, China also allows interested third parties to submit opposition to patent applications. The People’s Republic of China established the State Intellectual Property Office to handle intellectual property rights in the country.\textsuperscript{222} In 2001, the Office promulgated Implementing Regulations of the Patent Law of the People’s Republic of China, which included Rule 48.\textsuperscript{223} This rule allows “any person … from the date of publication of an application for a patent for invention till the date of announcing the grant of the patent right, [to] submit … his observations, with reasons therefor, [sic] on the application which is not in conformity with the provisions of the Patent Law.”\textsuperscript{224}

Japan’s Patent Office also allows third party submissions of information during the patent examination process. The office “welcomes a submission of information from a member of the public to improve the effectiveness and expeditiousness of the examination.”\textsuperscript{225} These submissions may be made “at any time after a patent application … is filed, even after a grant of a patent.”\textsuperscript{226}

Although patent systems outside the United States more commonly use a first-to-file system and have examination only on request, they also have much more accommodation for interested third-parties to submit information or oppose patent applications prior to the grant of a patent.

\begin{footnotes}
\item[220] Id.
\item[221] Id.
\item[224] Id.
\item[225] Submission of Information by Third Parties, JAPAN PATENT OFFICE http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/submission.htm (last updated July 24, 2008).
\item[226] Id.
\end{footnotes}
VI. CONCLUSION: THE BEST STRATEGY FOR THE USPTO

There is great support for utilizing third-party involvement to improve the patent examination process and the patent system’s overall quality. The recently proposed patent reform acts show that Congress is working in the right direction to allow third-party submissions to put additional prior art in front of patent examiners. By keeping time limits on when submissions will be accepted and appropriate fees associated with the submission, this accommodation should not present the problems that 35 U.S.C. § 122 was enacted to prevent: harassment and delay at the patent office. There is one common aspect of all the foreign patent systems previously discussed: the availability of mechanisms interested third parties can use to augment the resources of patent office examiners to submit information for consideration during the patent examining process.

Over time, the increased filing of patent applications places a growing incentive on the USPTO to reform patent examining procedures to more effectively and efficiently utilize their available resources. The overwhelming prevalence of these procedures in foreign patent systems supports this option as an improvement over the current, extremely limited options of Rule 291 Protests, Rule 292 Public Use Proceedings, and Rule 99 Submissions. The office already utilizes a similar procedure in the prosecution of Trademark registration with the 30-day Publication for Opposition, which further supports these recommended procedures. Therefore, to increase patent quality and ensure that issued patents meet statutory requirements of novelty and nonobviousness, Congress should eliminate the 35 U.S.C. § 122(c) prohibition against pre-issuance opposition to the grant of a patent when that opposition is initiated after the patent application’s publication.