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Sent: Wednesday, May 06, 2015 8:58 PM  
To: WorldClassPatentQuality  
Subject: Comment on Enhancing Patent Quality: Pillar 1, Proposal  
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Dear Director Lee:

Please see the attached Comment on Enhancing Patent Quality  
related to Pillar 1, Proposal 2.

Sincerely,

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## Comment on Pillar 1, Proposal 2:

### Preventing the Potential Perils Associated with Automated Pre-Examination Search

Brenda M. Simon<sup>1</sup>

The quality of prior art located for a given application is limited by ability and resources.<sup>2</sup> Automated searching has the potential to mitigate some of these constraints, though the risk of overreliance on automation might offset some of its benefits.<sup>3</sup> For example, an examiner may operate under the flawed assumption that the ease of obtaining prior art using automated searching is indicative of the inventor’s capability of appreciating its significance.<sup>4</sup> Even more problematic, automated searching may facilitate the consideration of prior art that the applicant could not have accessed at the time of filing (referred to as “hidden prior art” for this discussion). In the evaluation of obviousness, the person having ordinary skill in the art (PHOSITA) is deemed to have knowledge of even hidden prior art.<sup>5</sup>

The new system implemented under the AIA exacerbates this problem. Publications, patent applications, and patents typically count as prior art under section 102(a) as of the date they are published or issued. However, prior art applications filed in the United States can be back-dated to their earliest priority application once they are published or issue, even though these were not available to any other inventor as of that early date—they were truly hidden. Although under the pre-AIA section 102(e) these references were also previously entitled to their earliest priority date, applicants are now unable to swear

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<sup>1</sup> Associate Professor, Thomas Jefferson School of Law. These comments represent the view of the author only.

<sup>2</sup> See, e.g., Christopher A. Cotropia et al., *Do Applicant Patent Citations Matter? Implications for the Presumption of Validity*, 42 RES. POL’Y 844 (2013) (suggesting that examiners essentially overlook applicant-submitted art, focusing instead on art they find themselves); Robert P. Merges, *As Many as Six Impossible Patents Before Breakfast: Property Rights for Business Concepts and Patent System Reform*, 14 BERKELEY TECH. L.J. 577, 590 (1999) (“[T]here are numerous incentives inside the PTO to issue rather than reject patent applications . . .”).

<sup>3</sup> See, e.g., Andrew Chin, *Search for Tomorrow: Some Side Effects of Patent Law Automation*, 87 N.C. L. REV. 1617 (2009) (discussing the use of search technology by examiners); Justin Pats, *Preventing the Issuance of “Bad” Patents*, 48 IDEA 409, 418–20 (2008) (describing the limitations of search technology used by examiners).

<sup>4</sup> See, e.g., Brenda M. Simon, *The Implications of Technological Advancement for Obviousness*, 19 MICH. TELECOMM. & TECH. L. REV. 331 (2013) (discussing the chasm between accessing information and understanding it).

<sup>5</sup> *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“[A]ll prior art references in the field of the invention are available to this hypothetical skilled artisan.”). See also Alan Devlin, *Revisiting the Presumption of Patent Validity*, 37 SW. U. L. REV. 323, 342 (2008) (“[T]here is little, if any, long-term social value associated with invalidating patents on the basis of prior art not within the realistic purview of the inventor . . .”); Daralyn J. Durie & Mark A. Lemley, *A Realistic Approach to the Obviousness of Inventions*, 50 WM. & MARY L. REV. 989, 1016 (2008) (“Much of that art is obscure enough that, in the real world, the PHOSITA wouldn’t have access to it and likely wouldn’t know about it.”); Brenda M. Simon, *Rules, Standards, and the Reality of Obviousness*, 65 CASE W. RES. L. REV. 25 (2014) (proposing that examiners view “any hidden art with skepticism”).

behind hidden prior art references by showing an earlier date of invention. In some situations, the effective priority date of the hidden prior art could be dated back to the date of the first foreign filing per section 100(i)(1)(B), another change from the pre-AIA system.<sup>6</sup>

Other countries that emphasize the importance of the filing date in their patent systems do not allow consideration of hidden prior art in evaluating obviousness.<sup>7</sup> For example, neither Europe nor Japan permits hidden prior art to be considered in the obviousness determination.<sup>8</sup>

Though considering the state of the art is essential as to the novelty determination, where the goal is to reward only new invention, its applicability to nonobviousness is less clear. To the extent an invention builds on the state of the art, denying patents for distinct changes to hidden knowledge might make the nonobviousness hurdle almost insurmountable in some situations. The examiner considering hidden art would assume the perspective of an exceptional PHOSITA, having access to knowledge that even those of ordinary skill in the art cannot find in common practice, despite the requirement of section 103 that the prior art considered be that “to which the claimed invention pertains.”

In light of these challenges, I propose that examiner guidance and training materials be provided prescribing a narrow application of the analogous arts test, thereby limiting the consideration of hidden prior art in evaluating nonobviousness, as such art is not practicably available to those of ordinary skill in the art.<sup>9</sup> By limiting the consideration of prior art that is not feasibly accessible, the examiner’s determination of obviousness will more accurately reflect the innovative process.

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<sup>6</sup> At least the potential for harm is mitigated in some situations by section 102(b)(2)(C), which provides that a previously-filed application, publication or patent does not count as prior art if it was “owned by the same person or subject to an obligation of assignment to the same person.” See Dennis Crouch, *Our Expanded Regime of Submarine Prior Art*, PATENTLY-O, April 22, 2015, <http://patentlyo.com/patent/2015/04/expanded-regime-submarine.html> (discussing “this expanded submarine prior art” and “the relative importance of the intra-company-exception.”).

<sup>7</sup> See Amy Nelson, *Obviousness or Inventive Step as Applied to Nucleic Acid Molecules: A Global Perspective*, 6 N.C. J.L. & TECH. 1, 30 (2004) (discussing the main differences in evaluating obviousness in the United States, Australia, Europe, and Japan).

<sup>8</sup> *Id.* at 30.

<sup>9</sup> The analogous arts test allows examiners some discretion in determining to what extent hidden prior art should be considered in evaluating obviousness. *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1237 (Fed. Cir. 2010) (the test considers whether the prior art is “from the same field of endeavor, regardless of the problem addressed” and if not, “whether the reference is still reasonably pertinent to the particular problem” at issue). A narrow interpretation of this test could allow for exclusion of at least some hidden prior art.