

**United States Senate Judiciary
Subcommittee on Intellectual Property**

“Promoting the Useful Arts: How can Congress prevent the issuance of poor quality patents?”

**Questions for the Record for Terry Stanek Rea
Submitted by Senator Richard Blumenthal
November 6, 2019**

- 1. As you know, the patent system is complex and technical. Many small inventors lack the knowledge and resources to navigate the system. For that reason, I am a major proponent of the Patent Pro Bono Program, which ensures that the patent system is open to any inventor with a good idea and is not just available for the wealthy and well-connected.**

The Pro Bono Program is also important to the patent quality debate. First, it gives inventors the help they need to submit clear and precise patents. Second, it ensures that as the PTO cracks down on poorly drafted patents, it does not unintentionally harm inventors with valid inventions but without the resources to hire top-dollar attorneys.

- a. Does the Pro Bono Program improve the quality of patent applications?**

Response: Yes. The Pro Bono Program is designed for independent inventors and small businesses that meet certain financial thresholds and other criteria. It is effective and should continue to be supported. There is a critical need for the Pro Bono Program because valuable inventions can be created in any environment. Independent inventors and small businesses should be encouraged to innovate and protect their ideas.

Before the Pro Bono Program existed, independent inventors and small businesses without sufficient resources drafted and prosecuted their own patent applications. Some support was provided by the USPTO for those pro se inventors but it was not significant. The Pro Bono Program matches an applicant with an experienced practitioner so that the application can be properly drafted. Assisting with patent prosecution is also beneficial for responding to questions from the patent examiner and making a decision to amend claims. The Pro Bono Program significantly improves the quality of the work product from independent inventors and small companies.

- b. Do you believe that the Pro Bono Program helps small inventors avoid unintended harms that could be caused by efforts to reduce the issuance of poor quality patents?**

Response: Yes. I believe that the Pro Bono Program helps small inventors avoid unintended harm that could be caused by efforts to reduce the issuance of poor quality patents. The Pro Bono Program assures a higher level of quality with their patent applications.

**Ms. Teresa “Terry” Stanek Rea –
Promoting the Useful Arts:
How can Congress prevent the issuance of poor quality patents?
Questions for the Record
Submitted November 6, 2019**

QUESTIONS FROM SENATOR COONS

- 1. You testified about the potential of international work sharing and the Global Dossier. What specific steps would you recommend that the USPTO take to cooperate effectively with other patent offices?**

Response: I believe that the USPTO is already spending significant effort to maximize international work sharing. International work sharing brings multiple-office examination efforts together. The benefits include multiple examiners searching similar inventions and the best prior art can be obtained from different sources. Further, the multiple offices can benefit from the different search expertise in each office. By using the Global Dossier, examiners in one patent office can look to see how prior art has been applied against the claims in another patent office. This effort continues to be expanded. In addition, the USPTO along with Japan created the Patent Prosecution Highway which allows for coordination of examination with many patent offices. It would be advantageous if the USPTO could continue to increase its collaboration with other patent offices and accelerate the use of these work sharing initiatives.

- 2. You also testified about “crowd-sourcing” prior art searches, the USPTO’s peer search collaboration pilot program, and the need for greater participation in the third-party prior art submission process. How can Congress and the USPTO encourage greater collaborative efforts to identify the most relevant prior art during examination?**

Response: The USPTO should continue their efforts involving international work sharing. Examiners in one patent office can always improve their level of examination by reviewing work conducted by another. While there are different legal regimes in each country, the technology is the same and the claims are often times similar.

The ideal form of crowd-sourcing would involve third parties reviewing published applications. If third parties are aware of prior art that may impact the claims of the application, third parties may send it to the examiner early in the examination process. The examiner should have the best prior art before them early in examination. The AIA third party submission process was designed to encourage the submission of prior art early in examination. This system has not functioned as it was intended. At this time, many third parties do not think that it is worth the effort to bring material prior art to the examiner’s attention because if the claims were allowed over that prior art, the prior art would have less of an impact during subsequent litigation and/or *inter partes* review. The patent owner would emphasize the fact that the examiner already considered the prior art and thus the prior art should not be reconsidered.

It is possible that the examiner misunderstood the prior art and did not correctly apply it against the claims. In that case, the prior art should be able to be reconsidered in another proceeding such as litigation or an *inter partes* review. I do not know how to remedy the situation. Parties are not required to produce prior art at the earliest opportunity. They may require time to understand the invention to decide whether the prior art materially affects the claims.

**Questions for the Record for Teresa Stanek Rea
From Senator Mazie K. Hirono**

- 1. In your opening statement, you suggested that one way to improve patent quality is to encourage more third parties to submit prior art during the patent examination process.**
 - a. What suggestions do you have for how best to encourage such third-party submissions?**

Response: The ideal form of crowd-sourcing would involve third parties reviewing published applications. If third parties are aware of prior art that may impact the claims of the application, third parties may send it to the examiner early in the examination process. The examiner should have the best prior art before them early in examination. The AIA third party submission process was designed to encourage the submission of prior art early in examination. This system has not functioned as it was intended. At this time, many third parties do not think that it is worth the effort to bring material prior art to the examiner's attention because if the claims were allowed over that prior art, the prior art would have less of an impact during subsequent litigation and/or *inter partes* review. The patent owner would emphasize the fact that the examiner already considered the prior art and thus the prior art should not be reconsidered.

It is possible that the examiner misunderstood the prior art and did not correctly apply it against the claims. In that case, the prior art should be able to be reconsidered in another proceeding such as litigation or an *inter partes* review. I do not know how to remedy the situation. Parties are not required to produce prior art at the earliest opportunity. They may require time to understand the invention to decide whether the prior art materially affects the claims.

- 2. I have heard from a lot of startups in Hawaii that they tend not to patent their technology due to the significant amount of time and money needed to prosecute a patent. There is also have data suggesting women and minorities are underrepresented in the patent system in part because of the high barrier to entry.**
 - a. How can we make the patent system more accessible to people with limited resources or who might not have prior experience with the patent system?**

Response: The USPTO has several tools available to encourage everyone to innovate and protect their innovation. The USPTO is excellent at outreach. They visit inventor groups, trade associations and the like to make sure that women and minorities understand what resources are offered by the USPTO. In addition, there are three separate patent fee categories at the USPTO, including micro entities, small entities and large entities. It may be advantageous to consider allowing women and minorities to pay the micro entity fee irrespective of the size of their organization. This would help encourage patent filings from those protected groups whether they are the sole individual in their organization or they are

part of a large organization. Encouraging the protection of innovation by women and minorities in large corporations is also a good idea because it creates awareness and possibly programs within the large corporation to further draw on their talent.