Harnessing Collaborative Web-Based Technology To Bring Prior Art to the Patent Process— An Inventor's Perspective

By

Bruce D. Sunstein[1]

In her seminal paper "'Peer to Patent': Collective Intelligence and Intellectual Property Reform,"[2] Professor Noveck proposes harnessing web-based technology to develop and utilize a community of experts who can identify and apply prior art pertinent to patentability in the examination of patent applications.

The idea is brilliant. Why should not the patent process benefit from the knowledge of experts? This article provides a response to Professor Noveck's proposal from the perspective of the inventor. In referring to the perspective "of the inventor," I mean particularly the context of the processes experienced by one who is engaged in obtaining patents for inventors. I do not speak for any group of individual inventors, nor for any company that employs inventors, although I represent both kinds of inventors.

Professor Noveck offers her proposal at a time when the patent system is under siege. Unprecedented levels of patent application filings have stretched to an average of 30 months the time that it takes for a patent to get through the system, and the United States Patent and Trademark Office ("PTO") estimates that this figure will reach nearly 34 months by 2011.[3] The PTO plans to hire approximately 1000 examiners per year to increase its patent examining force from about 4,000 in 2005 to more than 7000 by 2012.[4]

Moreover, the siege is driven by more than the number of filings. Major legislative changes to the patent system are pending,[5] while courts are developing a new,

---

 The author is chair of the Patent Practice Group of Bromberg & Sunstein LLP, Boston. His e-mail address is bsunstein@bromsun.com. Additional contact information is at his firm's web site, www.bromsun.com. This paper is prepared for the Annual Meeting of the American Intellectual Property Association to be held in Washington, D.C. in October, 2006. The views expressed herein are personal to the author and do not necessarily reflect the views of any client of Bromberg & Sunstein LLP.

[2] Beth Simone Noveck, "'Peer to Patent': Collective Intelligence and Intellectual Property Reform," (hereinafter "Peer to Patent") available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=898840 (site of Social Science Research Network) and from time to time in wiki format at http://peertopatent.jot.com/WikiHome. References herein are to the version as of April, 2006 as published on the site of the Social Science Research Network (marked, however, March 2006).

[3] United States Patent and Trademark Office, Strategic Plan -- 2007-2012, Draft #6, August 21, 2006 ("Strategic Plan"), available at http://www.uspto.gov/web/offices/com/strat2007/stratplan2007-2012v6.doc, p .7.

[4] Strategic Plan, p. 13.

[5] Patent Reform Act of 2006, S. 3818, introduced August 3, 2006 by Sen. Hatch (available at http://www.govtrack.us/congress/bill.xpd?bill=s109-3818); see also H.R. 2795, introduced June 8, 2005 by

more restrictive calculus for determining when a patent owner can get an injunction.[6] The future structure of the patent system hangs on the outcome of a series of contentious debates between interests such as the Business Software Alliance on the one hand, and the bio/pharma industry on the other.[7]

Against this backdrop, enter Professor Noveck. As motivation for her proposal, Professor Noveck provides us with a "Parade of Horribles."[8] She cites, among other things, the polemical work of Jaffe and Lerner[9] for "horror stories about patents that are anything but 'non-obvious,'" and advances the proposition that "of the two million patents in force in the United States, many do not qualify."[10] In her view, "The system is very much perceived to be broken."[11]

Professor Noveck's proposes to use the World Wide Web to rally interested technologically savvy individuals in performing two tasks: (i) identifying prior art pertinent to the examination of claimed subject matter in a pending patent application and (ii) applying that prior art in evaluating the claimed subject matter for compliance with the non-obviousness requirements of 35 U.S.C. § 103.[12] The work of this community would be made available to the examiner in the PTO.[13]

Professor Noveck models her community of technologically proficient contributors on Wikipedia and other "online peer review processes," such as Yahoo Answers.[14] Wikipedia is an encyclopedia accessible via the World Wide Web.[15] It differs

---

Rep. Lamar Smith (available at http://thomas.loc.gov/cgi-bin/bdquery/z?d109:h.r.02795:) and H.R. 5096, introduced April 5, 2006 by Rep. Berman (available at http://www.govtrack.us/congress/billtext.xpd?bill=h109-5096).

[6] *eBay Inc. v. MercExchange, LLC*, 126 S.Ct. 1837, 74 USLW 4248, 164 L.Ed.2d 641 (5/15/06)(traditional principles of equity govern issuance of injunction in patent cases), vacating and remanding decision of Federal Circuit that had articulated its "general rule that courts will issue permanent injunctions against patent infringement absent exceptional circumstances." *MercExchange, LLC v. eBay Inc.*, 401 F.3d 1323, 1339 (Fed. Cir. 2005); *Paice LLC v. Toyota Motor Corp.*, Slip Copy, 2006 WL 2385139 (E.D.Tex. 8/16/06)(injunction denied); *z4 Technologies, Inc. v. Microsoft Corp.*, 434 F.Supp.2d 437 (E.D.Tex. 2006)(injunction denied).

[7] See "Intellectual Property Review and Outlook," 71 BNA Pat.TM & Copyright J. 278 (No. 1753, 1/20/06).

[8] Peer to Patent, p. 8.

[9] Adam B. Jaffe & Josh Lerner, *Innovation And Its Discontents : How Our Broken Patent System Is Endangering Innovation And Progress, And What To Do About It* (2005).

[10] Peer to Patent, pp. 8-9.

[11] Peer to Patent, p. 8. For a contrary view, see the Strategic Plan at 8, citing Robert Shapiro and Kevin Hassett, "The Economic Value of Intellectual Property," USA For Innovation Report, October 2005: "Our intellectual property system has been, since the founding of the United States, an integral and critical part of what makes America great. The numbers tell the story. 'U.S. intellectual property today is worth between $5 trillion and $5.5 trillion, equivalent to about 45 percent of U.S. GDP and greater than the GDP of any other nation in the world.'"

[12] Peer to Patent, p. 19 et seq.

[13] Peer to Patent, Fig. 3 at p. 26 and related text.

[14] Peer to Patent, p. 20,

[15] Accessible at http://en.wikipedia.org/wiki/Main_Page.

from a normal encyclopedia in that it is free and "exists as a wiki[16], a website that allows any visitor to edit its content."[17] Wikipedia was established in 2001, and has grown to an enterprise including 1.3 million articles in English, and a total of 5 million articles in 159 active language editions.[18] "Wikipedia is written collaboratively by volunteers, allowing most articles to be changed by almost anyone with access to the website."[19]

Because Wikipedia has no process for vetting the entries that are made to its content—other than the right of any editor to edit the content of any article—Wikipedia's content is subject to inherent risks of inaccuracy and incompleteness, and in fact even vandalism. In that connection, Wikipedia (at least in its article on itself as of the time of this author's reading that article) is remarkably candid about these risks, and dutifully reports them.[20] Wikipedia quotes technical writer Bill Thompson:

> It is the same with search engine results. Just because something comes up in the top 10 on MSN Search or Google does not automatically give it credibility or vouch for its accuracy or importance... One benefit that might come from the wider publicity that Wikipedia is currently receiving is a better sense of how to evaluate information sources... The days when everything you saw on a screen had been carefully filtered, vetted, edited and checked are long gone. Product placement, advertorials and sponsorship are all becoming more common. An educated audience is the only realistic way to ensure that we are not duped, tricked, fleeced or offended by the media we consume, and learning that online information sources may not be as accurate as they pretend to be is an important part of that education. I use the Wikipedia a lot. It is a good starting point for serious research, but I would never accept something that I read there without checking.[21]

Professor Noveck suggests a number of techniques to address the potential unreliability of a wiki as a source of prior art and non-obviousness evaluation. She suggests "status and reward" can be harnessed to improve reliability, as they are in other peer-based systems, for example, like "[r]eputation points on EBay, karma points on Slashdot, honorifics in academic circles."[22] In particular, Professor Noveck suggests that "One gets rewarded for submitting art deemed relevant by the community and even more points for art that is eventually used in the final determination by the examiner. By tying

---

[16] The term "wiki" is derived from the name "WikiWikiWeb," given to the first wiki by its founder Ward Cunningham in 1995, who had heard the term "Wiki Wiki" in reference to a shuttle bus line between terminals of Honolulu International Airport; "wiki" is a Hawaiian-language word for "fast." See entry for "wiki" in Wikipedia at http://en.wikipedia.org/wiki/Wiki.

[17] See http://en.wikipedia.org/wiki/Wikipedia for the entry in Wikipedia for "Wikipedia" itself.

[18] *Id.*

[19] *Id.*

[20] *Id.*

[21] *Id.* The Court of Federal Claims has found that articles in Wikipedia do not "remotely meet" evidentiary requirements for reliability, given Wikipedia's "pervasive ... and disturbing series of disclaimers." *Campbell v. Secretary of Health and Human Services*, 69 Fed. Cl. 775, 781 (Ct. Cl. 2006).

[22] Peer to Patent, pp. 29 and 21-22.

status to relevance, the institution of online peer review can encourage, not only participation per se, but better quality participation and the submission of art that is useful and practical."[23]

A portion of Professor Noveck's proposal can be implemented under present rules of the PTO. Nothing actually prevents use of a wiki right now to identify prior art, without rulemaking. An examiner right now is free to cite published prior art of all kinds,[24] so use an Examiner's recourse to a patent wiki to find such prior art would seem to be permissible.

In order to facilitate use of the proposed community of experts, however, Professor Noveck suggests procedures that would require a number of changes to the PTO rules. First, she suggests that "each application will reside on a web page where members of the community of practice and interest can submit relevant prior art for a two-month window after publication" of the application.[25] As she points out, this practice is consistent with existing rule 37 C.F.R. § 1.99 (permitting third-party submission of prior art within two months after publication of an application), but she suggests that the PTO should waive the submission fee of $180.[26]

---

[23] Peer to Patent, p. 30.

[24] Manual of Patent Examining Procedure ("MPEP") § 901.06 (Nonpatent Publications): "All printed publications may be used as references, the date to be cited being the publication date. See MPEP § 2128 - § 2128.02."

See also, for example, MPEP § 904.02 (General Search Guidelines):

"In the examination of an application for patent, an examiner must conduct a thorough search of the prior art. Planning a thorough search of the prior art requires three distinct steps by the examiner: (A) identifying the field of search; (B) selecting the proper tool(s) to perform the search; and (C) determining the appropriate search strategy for each search tool selected. Each step is critical for a complete and thorough search.

"When determining the field of search, three reference sources must be considered - domestic patents (including patent application publications), foreign patent documents, and nonpatent literature (NPL). None of these sources can be eliminated from the search unless the examiner has and can justify a reasonable certainty that no references, more pertinent than those already identified, are likely to be found in the source(s) eliminated. The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed. The field of search should be prioritized, starting with the area(s) where the invention would most likely be found in the prior art.

"Having determined the field of search, the examiner should then determine what search tools should be employed in conducting the search. Examiners are provided access to a wide variety of both manual and automated search tools. Choice of search tools is a key factor in ensuring that the most relevant prior art is found during the search. The choice of search tools to be used is based on the examiner's knowledge of the coverage, strengths and weaknesses of the available search tools that are appropriate for use in an examiner's assigned art. For example, a search tool may cover foreign patent documents; but, if that coverage does not meet the examiner's current search needs, this should be taken into consideration by the examiner who will take recourse to employ other search tools in order to remedy the deficiency.

"Search tool knowledge is particularly important for examiners in arts (e.g., very active, high technology) where patent documents may seriously lag invention and, consequently, represent a reference source of limited value. These examiners must take special care to ensure that their searches include consideration of NPL and employ the effective use of tools specialized to cover NPL pertinent to their search needs. …"

[25] Peer to Patent, p. 26.

[26] Peer to Patent, p. 26; the fee is specified in 37 C.F.R. § 1.17(p).

Secondly, Professor Noveck suggests that the community provide to the PTO at the end of the two-month window "a rank ordered list of prior art, identifying the top ten submissions as judged by the community."[27] She also suggests that the examiner would nevertheless have access to the full list. To the extent that the full list is considered a third-party submission under 37 C.F.R. § 1.99, a rule change would be required, because such submissions are limited to 10 references under the rule.[28] Moreover, she points out that the rule currently prohibits public comment on the references, but observes that "it would seem logical to require explanation from those submitting art as to why they feel something is relevant and what they think the submission teaches vis-à-vis the patents' claims."[29] A rule change would be required to permit such an explanation.

Thirdly, Professor Noveck suggests that, from those who participated in the first-level prior art gathering discussed in the previous paragraph, there should be a software-driven selection of six individuals to receive an offer to participate in a second-level activity of applying the prior art to the claims of the published application. It would take time to convene such a panel. Professor Noveck offers suggestions to "minimize the risk that the system will be abused and gamed by those hired by competitors,"[30] including requiring the payment of a one-dollar fee by each participant via a credit card and the surrender of anonymity.[31] Once the panel is convened, it would be afforded a period of one-month within which to address relation of the prior art to the claims of the application.[32]

Rule changes would be necessary to accommodate this second-level activity, which, in relation to the existing rule structure, is a completely new concept. The nature of the rule changes would necessarily depend on how the second-level activity is implemented. As to implementation, Professor Noveck has made a series of suggestions, including (a) that the panel comment on novelty and inventiveness of "the preferred embodiment of the invention" in order to avoid having it "opine directly as to the obviousness of the claims"[33] or, alternatively, (b) that the panel discuss the claims themselves to address obviousness head on.[34] In either event, at the end of the period, a transcript of the panel's discussions would be made available to the examiner.[35] She suggests testing whether the panel should carry out its activities before the examiner begins his examination or, alternatively, whether the panel should respond to a series of questions posed by the examiner in the course of examination.[36]

We opened this article with the observation that Professor Noveck's proposal is brilliant. It is brilliant, because it offers a completely new paradigm for bringing technical

---

[27] Peer to Patent, p. 28.
[28] 37 C.F.R. § 1.99(d).
[29] Peer to Patent, p. 29; the prohibition is in 37 C.F.R. § 1.99(d).
[30] Peer to Patent, p. 31.
[31] *Id.*
[32] *Id.*
[33] *Id.*
[34] *Id.*
[35] *Id.*
[36] Peer to Patent, p. 32.

expertise, from a potentially limitless community of interested individuals, to bear in the examination of patent applications.

Yet not every brilliant idea is infused with wisdom. What can the inventor expect if Professor Noveck's proposal is implemented? Let us assume initially that the proposal is successfully implemented according to its terms. As a result of the first-level activity of the community of experts—we are assuming that the proposal is a success—the inventor could expect good quality prior art to be cited by the examiner in the course of examination of the patent application. From the inventor's point of view, good quality prior art is a benefit. Although good quality prior art can certainly make it harder for the inventor to get a patent, the benefit of having a patent that issues with the good prior art already considered is enormous. Professor Noveck has suggested that downstream there could be a law change giving an enhanced presumption of validity to community-reviewed patents.[37] She points out, "patents that undergo this process will be much less likely to be challenged subsequently."[38] No law change is necessary, however, to implement the enhanced presumption suggested by Professor Noveck. In fact, under existing law, the presumption of validity operates to make it much more difficult to challenge a patent's validity based on prior art that has been considered in the course of examination.[39] Therefore when good prior art has been considered in the manner Professor Noveck proposes, it will be much more difficult to find better prior art to attack validity. In other words, the enhanced presumption of validity will occur automatically.

While still assuming that the proposal is a success, we can see that it also shows a dark side to the inventor. The dark side faces the inventor in the second-level activity when a panel of experts sets about considering prior art in relation to the patent application for the purpose of assisting the examiner in determining whether the subject matter of the application meets the non-obviousness standards of 35 U.S.C. § 103. While admitting that the determination of non-obviousness ***vel non*** is ultimately a legal question and not a factual one,[40] Professor Noveck opines that the "Federal Circuit has further denigrated the role of the person skilled in the art by rarely turning to the expert."[41] She views the second-level activity of the panel of experts as restoring "the original, statutory standard from which recent case law has deviated."[42]

Although the "original, statutory standard" has eluded Professor Noveck as it has sometimes eluded patent examiners and sometimes the courts, the Supreme Court explained in *Graham v. John Deere Co.*[43] that the language of 35 U.S.C. § 103 was developed and first introduced by Congress in the 1952 Patent Act, among other things, in order to "to abolish the test it believed this Court announced in the controversial phrase

---

[37] Peer to Patent, p. 33.
[38] Peer to Patent, p. 38.
[39] For example, *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1352 (Fed. Cir. 2001), citing *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed.Cir.1984).
[40] Peer to Patent, p. 17, citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).
[41] Peer to Patent, p. 18.
[42] Peer to Patent, p. 30, n. 103 (I have made "caselaw" two words), citing Rebecca Eisenberg, *Obvious to Whom? Evaluating Inventions from the Perspective of PHOSITA*, 19 BERK. TECH. L.J. 885, 888 (2004).
[43] *Graham v. John Deere Co.*, 383 U.S. 1, 12-15 (1966); see above, n. 39.

'flash of creative genius,' used in Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58 (1941)."[44]

In *Graham v. John Deere*, the Supreme Court articulated an objective standard for determining whether a patent application is directed to subject matter exhibiting a level of innovation sufficient to support grant of a patent under section 103. In this sense, the Supreme Court's objective standard is designed to implement the mandate of Congress in enacting section 103. The objective standard articulated by the Supreme Court requires a series of determinations: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy."[45] While Professor Noveck quotes this language from *Grahm v. John Deere*,[46] she does not point out that here the Supreme Court has identified an objective standard for non-obviousness under a statutory provision intended to eliminate the "flash of creative genius" test of *Cuno Engineering*.[47]

Can a community of experts who lack legal training implement this standard for determining obviousness or non-obviousness of subject matter? At bottom, as pointed out by Professor Noveck, the standard is a legal standard. It cannot be implemented by persons who lack legal training. Professor Noveck has hedged her bets on the role of the panel by suggesting that alternatively an examiner could engage in a dialog with the panel to deal with the question of obviousness.[48] Yet even here, the Supreme Court has spoken on exactly what the examiner must do in order to assess obviousness. The examiner must determine "the scope and content of the prior art". The examiner must ascertain "differences between the prior art and the claims at issue". The examiner must resolve the level of ordinary skill in the art. Against this background, the examiner makes a determination of obviousness. Although factual questions are part of the inquiry, it is a legal conclusion, and the inquiry is relatively straightforward for a person having both technical knowledge and legal training, namely a patent examiner—provided the inquiry is followed in the manner required by the law.

---

[44] "'(T)he new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling.'" *Graham v. John Deere Co*. at n. 7, quoting *Cuno*, 314 U.S. at 91, 62 S.Ct. at 41.

[45] *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In pages of the decision following this excerpt the Court proceeds to apply just such an inquiry. An abundance of case law has followed the precedent of this case by adhering precisely to the inquiry articulated in this case. See, for example, *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 1355-1360 (Fed. Cir. 1999).

[46] See above, n. 39.

[47] LIkewise, the Eisenberg article cited by Professor Noveck fails to address the legislative history of 35 U.S.C. § 103.

[48] See discussion above, text accompanying notes 32 et seq.

The second-level activity of the panel of experts therefore does not restore "the original, statutory standard from which recent case law has deviated."[49] Instead it undermines the objective standard of non-obviousness articulated in section 103 of our patent law. The second-level activity of the panel of experts in the proposal of Professor Noveck thus deprives the inventor of the objective analysis of invention to which the inventor is entitled under the patent law. It is potentially harmful, because it validates evaluations, by the panel of experts, that do not comport with the standards of *Graham v. John Deere*.

The dark side of Professor Noveck's proposal reflects a series of assumptions present in much of the patent "reform" rhetoric. One of the assumptions is that "bad" patents are causing so much harm to the patent system that we must make it harder to get patents generally so as to prevent "bad" patents from issuing.[50] Yet many of the examples of "bad" patents—such as patent number 6,368,227 for "Method of Swinging on a Swing" awarded to a five-year-old boy[51]—manifestly have caused no economic harm. Many of these "bad" patents make no difference, because they do not cover practices that have any importance or that the patent owners are in a position to monetize. And situations where a "bad" patent has importance and is clearly invalid, the remedy of re-examination will typically take care of the problem.[52]

What if a "bad" patent is not clearly invalid? Then maybe the patent is not so bad after all. On the other hand, I might be able to argue that even if the patent is not bad, it is being asserted by a "patent troll." The term "patent troll" was coined in 2001 by Peter Detkin, then assistant general counsel at Intel Corp, to describe a patent holder who seeks to enforce a patent without intending to practice the technology that is patented.[53] "Patent troll" rhetoric is used to justify "reform" as well. Consider this passage of Professor Noveck: "Even the biggest patent holders like IBM recognize the desperate need for patent reform. No one wins when patent grants become meaningless, uncertain and subject to expensive legal challenges. The largest companies with the deepest pockets are the ripest targets for patent trolls."[54] The implication is that "patent trolls" are those who

---

[49] See above, text accompanying n. 41.

[50] Consider these remarks at p. 37: "*Inventions will be excessively scrutinized. Won't the level of patenting decrease?*
Hopefully, yes. We grant too many patents already."

[51] Peer to Patent, p. 9.

[52] Indeed, the "Method of Swinging on a Swing" patent was subject to this very procedure. The official PTO records show that re-examination proceeding was initiated by the PTO, and all four claims of the patent were canceled.

[53] See excerpt from Brenda Sandburg, "Inventor's lawyer makes a pile from patents," The Recorder, July 30, 2001, at www.wordspy.com/words/patenttroll.asp. Peter Detkin, who after accepting employment as counsel with the patent aggregator Intellectual Ventures, co-founded by Microsoft alumni Nathan Myhrvold and Edward Jung, changed his position and decided that the term "patent troll" should apply only to one who "must own no more than a few patents of questionable merit and is not in any business related to the patents." (This quote is a paraphrase appearing in Brenda Sandburg, "A Modest Proposal," The Recorder, May 9, 2005, reproduced at www.law.com/jsp/article.jsp?id=1115370308794, which in turn is cited on the web site of Intellectual Ventures at www.intven.com/RecentNews.)

[54] Peer to Patent, p. 40.

have "meaningless" patents but somehow extort millions of dollars from the hapless big companies.

Yet a hapless big company on the receiving end of a big patent infringement judgment gets there only after a trial court has determined that the patent is not invalid and is infringed. A patent at the end of this process has thus been vetted by both the PTO and by the judicial system. Consider the case of *Eolas v. Microsoft*,[55] which is a poster boy for those who rail against patent trolls. Eolas obtained a judgment against Microsoft for $521 million for infringement, by Microsoft's Internet Explorer web browser, of a patent covering use of a web browser in a fully interactive environment.[56] The patented technology "enables a user to view news clips or play games across the Internet."[57] The patent asserted in this litigation, number 5,838,906,[58] has withstood not only the original PTO examination leading to issuance but also a re-examination proceeding.[59] Indeed, yet another re-examination proceeding is pending.[60] The patent has withstood a first trial at which its validity was challenged. If Eolas succeeds in enforcing against Microsoft a judgment of infringement, it will be only after a new trial on the remanded issues of anticipation, obviousness and inequitable conduct.[61] Given the rigorous examination that the patent has already withstood, it is certainly not "meaningless" or "uncertain". Should the patent survive the remaining challenges, it can be viewed only as stunning.

There is a story behind the patent in the *Eolas v. Microsoft* dispute. The inventors, Mike Doyle and others, were researchers in the Innovative Software Systems Group at the University of California San Francisco campus, and, as part of their research, developed the software leading to the patent, which was filed by the University of California.[62] In 1994, the University of California granted an exclusive license to the technology to Eolas, a company founded by Doyle to commercialize the technology.[63] In that same year, Microsoft and other companies were offered a license to the technology, but turned it down.[64] However, while the patent application was pending, Microsoft adopted the technology, and, by the time the patent had issued, Eolas was crowded out of the marketplace.[65]

Here, as in many situations where the plaintiff is charged with being a "patent troll," the infringement litigation brought by the plaintiff is to enforce patent rights that

---

[55] *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed.Cir 2005)(judgment of $521 million for patent infringement set aside pending remand for retrial of anticipation and obviousness defenses and inequitable conduct defense).
[56] 399 F.3d at 1328.
[57] *Id.*
[58] *Id.*
[59] *Ex parte* reexamination certificate issued June 6, 2006 on request 90/006,831.
[60] *Ex parte* reexamination request 90/007,858.
[61] See n. 55 *supra*.
[62] University of California, Office of the President, "Questions and Answers about UC/Eolas patent infringement suit against Microsoft," last modified December 15, 2004, available at http://www.ucop.edu/news/archives/2003/aug11art1qanda.htm.
[63] *Id.*
[64] *Id.*
[65] *Id.*

were granted to an innovator forced out of the marketplace by a company adopting the innovator's technology and having superior marketing power. If the patent system were not available, it is doubtful that Eolas would have been formed to pursue Doyle's innovation. In other words, the *Eolas v. Microsoft* litigation is evidence, not of the failure of the patent system, but of its success.

My digression into the rhetoric of those who would reform the patent system is to point out that goal of would-be reformers in making patents more difficult to obtain is not solving a universally recognized problem as much as it is attempting to cure a patient of a stomach ache by performing surgery to remove an arm. While much fuss has been made about the economic harm caused by the granting of worthless patents, little has been made of the economic harm in making it more difficult to obtain meritorious patents.[66] As a practitioner, I encounter not infrequently inventors and small companies with inventions that are important advances over the prior art, but where the time and expense of a drawn-out proceeding in the Patent and Trademark Office to establish their rights to a patent significantly delays or prevents funding of the enterprise. In other words, I do not share the premises of Professor Noveck's "Parade of Horribles."[67]

Yet while I do not share the premises of Professor Noveck, neither do I reject the proposal out of hand. If we assume that her proposal is a success, at least the first-level activity promised by the patent wiki offers the PTO a useful source of prior art. Of course, there is no guarantee of success. In fact, experiments to date with web sites for gathering prior art do not bode well. BountyQuest, a web cite promising rewards for finding prior art, and launched with fanfare in 2000,[68] no longer exists. Another web site, ip.com, reports that it has been running, since April 7, 2006, a database which enables the public to comment on pending patent applications. As of September 7, 2006, five months later, this author has observed a total of 6 comments on 5 applications.[69]

While I have stated my reasons for believing that the second-level activity proposed by Professor Noveck (in having a panel of experts attempt to address obviousness rejections) is potentially harmful, the first-level activity proposed by her (in using a patent wiki to uncover relevant prior art) has great promise. The risk of failure should not prevent experiments which, if successful, have much to offer. According to the Institute for Information Law & Policy at New York Law School, Professor Noveck's proposed community patent review project has been selected by the PTO as one of the

---

[66] See email comment of Ernie Rogers to Peer to Peer article, at http://cairns.typepad.com/peertopatent/comments_on_proposal/index.html: "Read your short paper, and boy can I agree. I am presently helping an inventor to understand why his perpetual motion machine that he just got a patent on isn't going to work. He states in the description that it violates the second law, and he claims that as one of its benefits!
"Besides granting patents on non-inventions, I think a worse fault with many examiners is that they are rejecting important inventions. Bad patents are taken care of by the marketplace (eventually). BUT important inventions that don't make it to publication are a loss to the world for who-knows how long.
"You might say that there are safeguards to overly-critical examination, but the high cost of legal representation can prevent an independent inventor from getting the help he needs."

[67] Peer to Patent, p. 8 *et seq.*

[68] See Peer to Patent, p. 26, n. 95.

[69] See http://www.patentdebate.com/.

agency's strategic initiatives for improving and streamlining the patent application review process.[70]. May the patent wiki flourish.[71]

[70] 72 BNA Pat. TM & Copyright J. 485 (9/1/2006, No. 1784); see also story at http://cairns.typepad.com/peertopatent/, reporting that "the Community Patent project will launch as a pilot of the USPTO in 2007. Large companies like IBM, Microsoft, Red Hat and Hewlett-Packard as well as small ones like International Characters and Out of the Box Computing have already volunteered to have their patents peer reviewed."

[71] A beta site version of the patent wiki has been established at http://wikipatents.com/. In a press release, provided at a web site devoted to the proposed community patent review, it is asserted that "Community Patent Review is not a wiki...or, at least, not in the way that is being suggested. Community Patent Review is not a wiki (though that term conveys the appropriate sense of openness, transparency and collaboration). Rather, this is a software system for open peer review. We are collaboratively building a knowledge environment about patents. We will not edit patent applications but will, instead, collaborate to submit prior art and commentary to assist the patent examiner. The system will be directly tied into patent office decision-making practices. The aim of the system is to inform the patent examination process. The aim of the pilot is to gather empirical data to determine if community input can improve the patent examination process and produce better quality patents. Our broadest goal to develop a blueprint for mechanisms to increase the institutional competence of administrative agencies like the USPTO." Available at http://cairns.typepad.com/peertopatent/.