



The Software & Information Industry Association (SIIA) appreciates the opportunity to respond to the request for comments on *USPTO Initiatives to Ensure the Robustness and Reliability of Patent Rights* published by the United States Patent and Trademark Office (“PTO” or “Office”) in the Federal Register on Tuesday, October 4, 2022.¹

Introduction

SIIA is the principal U.S. trade association for the software and digital content industries. With over 800 member companies, SIIA is the largest association of software and content publishers in the country. Our members range from start-up firms to some of the largest and most recognizable global corporations. The innovative companies that make up SIIA’s membership rely on patents to protect their inventions, but also depend on the ability to manufacture, develop, and sell their products free from improper assertions of exclusive rights. Consequently, SIIA’s members are involved in patent litigation as both patentees and accused infringers; they cannot be categorized as generally plaintiffs or generally defendants.

SIIA members have benefited greatly from the patents they own. Yet they also rely on the boundaries of patent protection, as clear boundaries preserve and protect their ability to innovate. As such, SIIA’s collective membership sits at the crossroads of the countervailing interests in many of the ongoing intellectual property debates in recent years. It is keenly focused on issues surrounding intellectual property protection and the effect of IP laws on the pace-setting companies of our digital age. Our members supported and continue to support the improvement to patent quality made by the America Invents Act and appreciate

¹ 87 Fed. Reg. 60130 (October 4, 2022).

the PTO's efforts to ensure that all of its issued patents meet the statutory requirements. Patent quality lies at the center of the innovation ecosystem. To us, a "robust and reliable" patent and a "quality" patent mean the same thing.

Many of the PTO's suggested responses to the President's Executive Order represent meaningful steps towards this goal, and we write to emphasize a few specific points. We also join in full the comments submitted by United for Patent Reform and write to emphasize a few additional points.

- **We agree that robustness will improve by providing patent examiners more resources.**

Vigorous examination is the backbone of the patent system. Yet examiners already do not have enough time needed to conduct the difficult task of examination, particularly around complex and rapidly developing technologies like artificial intelligence. The average examination time for a patent is 18 hours. We believe that in addition to being bad policy, it is fundamentally unfair to expect front-line examiners to improve the quality of issued patents without giving them the time and resources to do so. Developments in the technology that is pursued in patents make clear that both will be necessary.

We welcome the improvements in the new Patents End to End search system, and the PTO's efforts to improve prior art searching. This will help to make the examination process more efficient for examiners and allow more attention to be devoted to time-consuming tasks like evaluating the application for compliance with Section 112 and applying the prior art to the patent claims. But more time is still needed given the ever-increasing complexity of today's technologies, and further improvements to the search process particularly around non-patent literature would be beneficial.

To be clear, we do not expect the PTO to make bricks without straw. SIIA therefore supports the increase of examination fees for the largest patent filers (and not impacting the fees of small

and micro entities) so that more resources are available up front when they are needed most, rather than waiting until maintenance fee payments are made to recoup costs.

- **We agree that increased cooperation between examiners and applicants will improve patent robustness.**

If examination is a patent's backbone, then disclosure is its heart. Not only does the specification provide practical advice to those in a given art to be able to make and use an invention, it defines the scope of the rights to the invention. Opacity in disclosure poisons innovation.

SIIA therefore agrees with the PTO's suggestion that the MPEP (see 87 Fed Reg. at 60132) be amended to require the applicant to point to the parts of the disclosure that support each claim added to the specification in all cases (as opposed to only during reexamination or reissue). As it correctly notes, the policy rationales behind the written description, enablement, and definiteness requirements reveal the wisdom of a uniform policy. The applicant will be in the best position to point to the part of the specification it relies on for a claim amendment or new claims, rather than having the examiner intuit that reliance. In addition, as the PTO has correctly noted, having the applicant show that support can free up the examiner's time.

- **We support any movement toward bringing about some finality to the prosecution process.**

As of now, prosecution can be continuously reopened through serial requests for continued examination (RCEs), or the filing of additional continuation applications. For patent applicants with significant resources, this can stretch out for the entire life of a patent, which means that there is continued uncertainty as to what patent rights may emerge from an original filing.

This is often done to game the system, attempting to get continuation claims that read on later-developed technologies that were not even imagined at the time of filing (and are not

supported by the specification). SIIA encourages the PTO to consider ways to bring more certainty to the prosecution process for the benefit of innovators, whether that is through limitations on the RCE process, or addressing aspects of the continuation process.

Conclusion

SIIA applauds the PTO's focus on improving patent robustness and urges it to continue with these improvements. Thank you for considering our views.

Respectfully submitted,

/s/

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