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Play a Role in the Patent Puzzle

Peer-to-Patent Australia is designed to improve the quality of computer software and business method patents.

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To many in the ICT industry, computer software patents are akin to a dirty word. Many have a philosophical objection to patenting software on the basis that it interferes with their ability to freely reuse code and build upon the ideas of others. Proponents of free and open source software say that privatising the ideas that underlie software code is inconsistent with the principles of openness that are the benchmark of collaborative distributed open source software projects that create products such as Linux operating systems, the Mozilla and Firefox web browsers, and Apache.

Since the United States Supreme Court decision of *Diamond v Diehr* in 1981, computer software patents have been a prominent feature of the technological landscape. The position under Australian law is much the same. The patentability of computer software was confirmed here as early as 1991 in the Federal Court case of *IBM v Commissioner of Patents*. Nowadays, computer software patents are as ubiquitous as software itself. It seems this situation is unlikely to change, not even with the US Supreme Court's much anticipated *Bilski* decision due out in the middle of this year.

While it appears there is little that can be done to stop software patenting, thanks to a new project, we can now at least play a role in helping the patent office ensure that the software patents that are granted, are granted in respect of subject matter that is actually deserving of a patent, that is for inventions that are novel and inventive.

That project is Peer-to-Patent Australia. Peer-to-Patent Australia is a joint initiative of the Queensland University of Technology (QUT) and New York Law School (NYLS) and is operated with the support and endorsement IP Australia, the government instrumentality that houses Australia's patent office. The project is based on the successful Peer-to-Patent pilots run recently in the United States and Japan.

Peer-to-Patent Australia is designed to improve the quality of issued patents and the patent examination process by facilitating community participation in that process. It allows members of the public to put forward prior art references that will be considered by IP Australia's patent examiners when determining whether participating applications are novel and inventive, and therefore deserving of a patent. Prior art is information that shows that something claimed in a patent to be novel and inventive is not. Put simply, if an invention is described in the prior art, it is not patentable.

According to QUT's Professor Brian Fitzgerald, Peer-to-Patent Australia's Project Leader, Peer-to-Patent Australia is a way of facilitating collaboration between anyone with technical expertise and an Internet connection and patent examiners.

While not a complete solution to patent law's woes, the Peer-to-Patent model has considerable advantages over the traditional model of patent examination. Currently, patent applications are examined by a single patent examiner. Until now, this has been a closed model of governmental administrative decision-making that happens without much public scrutiny. This involves asking whether what has been claimed by the applicant has been done before anywhere in the world (novelty), and whether it would have been obvious to a person skilled in the relevant field of technology (inventiveness).

The job of a patent examiner is a difficult one. Patent law is a complex area to understand and apply. Furthermore, it is simply unrealistic to expect each and every patent examiner to be an expert in every field of technology that comes across his or her desk. Similarly, patent examiners cannot feasibly locate every relevant piece of prior art, even with the prior art databases available to them.

What Peer-to-Patent Australia seeks to do is remedy, to some extent, these deficiencies. This is a process that combines the democracy of open participation with the legitimacy and effectiveness of administrative decision-making. The aim is to encourage experts within the community to pool their knowledge to bring to light prior art, particularly non-patent prior art, that might not otherwise be available to patent examiners. The advantage of doing this is that getting the best prior art before patent examiners leads to stronger, higher quality, and more robust patents.

How does the Peer-to-Patent process work?

Peer-to-Patent Australia will initially run as a six-month pilot. The object of the pilot is to test whether an open community of reviewers can effectively locate prior art that might not otherwise be found by the patent office during a typical examination.

The process works like this. Peer-to-Patent Australia uses an interactive web-based forum that allows self-selecting members of the public to review participating patent applications and submit relevant prior art references in order to assist patent examiners assess the novelty and inventiveness of those patent applications. It involves placing up to 40 business method, computer software and related patent applications that have been filed in Australia and which are open for public inspection on the Peer-to-Patent Australia web site. Each application remains online to be reviewed for a 90-day period. During that time, members of the community can submit prior art references and comment on the relevance of any prior art that has been put forward.

At the end of the review period, the prior art identified by the community of reviewers is submitted to IP Australia to be considered by the patent examiner responsible for examining the patent application in question. So that the patent office is not swamped with prior art, only the 10 most relevant prior art documents, as selected by the community of reviewers, are forwarded to the patent examiner.

It is important to note that Peer-to-Patent Australia in no way abrogates the responsibility of a patent examiner to assess a patent application. The only difference it creates is that the examiner is given a report that contains prior art documents he or

she might not have otherwise located. The examiner will consider all the prior art submitted by the community of reviewers in addition to the results of his or her own searches in making a determination on patentability of an invention.

The pilot runs on a consent-based model. No patent applications are put online to be peer reviewed without the consent of the patent applicant. The participating companies who have so far put patent applications forward to be peer reviewed are IBM, Aristocrat Technologies Australia Pty Limited, General Electric Company, Hewlett-Packard, CSIRO, Residex Pty Ltd and Yahoo.

Patent applications will be released for peer review in two distinct phases of three month's duration. The project is currently on its second phase and its organisers are looking for suitably qualified and interested people to build the ranks of its community of reviewers.

What are the benefits?

Peer-to-Patent Australia operates for the benefit of the public by assisting patent examiners to better ensure that only deserving applications are rewarded with the grant of a patent. This means that patent rights that are granted will more robust and certain, so that users of the patent system and the public can have greater confidence in Australia's innovation system.

The public only benefits when patents are granted in respect of subject matter that is actually novel and inventive. A patent should only be granted for an invention that adds to the existing body of publicly available technological information, not something that has already been created. What's more, it is expensive to challenge the validity of a granted patent and invalid patents stifle innovation and the public's ability to carry on legitimate businesses.

The benefit to participating applicants is that their applications will undergo a more rigorous examination against the strictures of novelty and inventiveness and are likely to be more robust as a consequence. The more robust a patent, the more valuable it is and the less likely it is to be challenged, which is a benefit that represents significant cost savings over time to consumers, patent holders and the public at large. In this way, the chief goal of Peer-to-Patent is to weed out early in the process invalid patents that would likely face challenges further down the line. In addition, the identification and elimination of weak claims early in the examination process ultimately saves the applicant money by avoiding the expensive process of pursuing or enforcing non-meritorious claims.

Looking forward

The pilot project has made an encouraging start. Its first phase, which involved the review of 15 patent applications, resulted in almost 50 prior art documents being submitted. Whether the patent office makes use of these prior art references to reject patentee's claims will be revealed over the course of this year when the participating patent applications are examined.

The question of whether Peer-to-Patent Australia will run again as a permanent concern after its pilot phase is complete will be decided after a review by QUT and IP Australia. Similarly, we are awaiting confirmation from the United States Patent and Trademark Office and NYLS for news of whether Peer-to-Patent will form part of standard practice in the US.

Peer-to-Patent Australia is not a stand-alone project. It is part of an international expansion of the Peer-to-Patent concept into jurisdictions outside the United States and builds upon the successful Peer-to-Patent projects recently run out of the New York Law School in the United States, and out of the Japan Patent Office.

One possibility for the future of the project is that the current model of jurisdiction specific or country-based projects will make way for a combined international platform housing patent applications filed all around the world regardless of jurisdiction. Such an approach makes sense given that the vast majority of patent applications filed today are filed in multiple jurisdictions.

To register as a peer reviewer, go to www.peertopatent.org.au.