

The Peer-to-Patent Project

Australia trials peer reviewed examination

The Queensland University of Technology Law School, with the financial backing of the Commonwealth government, recently completed a project in which the public supplied information to Australian Patent Office examiners to be considered during examination of a small number of patent applications.

The project mimics one previously conducted in the United States, and other similar projects are proposed or underway in Korea, Japan and United Kingdom.

The idea being explored is whether community/peer reviewers, beyond patent applicants themselves and governmental patent offices, can usefully be involved in the examination process. That is, the general public would bring relevant prior art to the attention of examiners as supplementary information, so that, in one sense, fewer questionably valid patents are granted, and possibly also helping to reduce examination backlogs.

There were estimated to be 65,000

pending, unexamined Australian patent applications in May 2010. The situation is worse in other countries; for example, in a London Economics Report to the UK IP Office in 2008, there were reported to be more than 700,000 US applications awaiting attention by an examiner!

Another point of context for the project is that the patent legislation until only recently required patent applicants to disclose the results of official prior art searches to the Patent Office. This is a markedly lesser obligation than that which applies in the United States, where any prior art, howsoever it came to be known by the applicant, is required to be disclosed to the US Patent Office. The Australian obligation was rescinded essentially because it was redundant, in that national patent offices already share the results of prior art searches.

The Australian project involved 31 patent applications, of which roughly one half were owned by Australian companies: Aristocrat Leisure Industries (10), CSIRO

(1) and Residex (1). The remainder were owned by US corporations. The project was confined to business method and computer software subject matter.

Prior art provided by the peer reviewers was applied by the Patent Office examiners against roughly one third of the applications. We observe, however, that the majority of documents submitted had no relevance, principally because they were published too late in time to constitute prior art (i.e., the documents needed to be published earlier than the priority date of the application in question). Clearly education of reviewers is needed in this regard. We suspect that without such education the situation would arise where examiners would be hindered, rather than helped by having to wade through irrelevant information.

In the First Anniversary Report for the project (December 2010), the QUT researchers stated the project was helpful to patent examiners, though say it is too early to say whether peer review produces a patent of greater validity.

In our view, there is no substitute for technically qualified and legally trained professional patent examiners working in governmental patent offices.

For more information, go to www.peertopatent.org.au



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