

Learning from PTO: CIPO's solution to prior art

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We are living in the Information Age, an era of unprecedented information, innovation, and creativity. The US Patent Trade Office (PTO), however, is struggling to keep up with this tidal wave of data. The Canadian Intellectual Property Office will be next unless recent American experience is heeded.

The Internet revolution resulted in a massive increase in the volume of patent applications received by the PTO (Malone, 2002). Unprecedented numbers of applications were filed for patents in the fields of software, hardware, and biotechnology. US patents are only granted for applications representing inventions that are “novel, non-obvious, and useful” and determining novelty requires the PTO to conduct labour intensive searches for prior art. If prior art has existed for more than year before the filing date of the patent application, the patent is not granted.

The PTO's struggle to complete prior art searches is threatening the institution of intellectual property in the United States (Van Barr, 2000). The rapid increase in patent applications, however, is coincident with several other issues facing the PTO including eroding funding and fragmented databases of prior patent applications.

Prior art examinations must rely on more than just previous applications. In rapidly emerging industries such as technology and biotechnology prior art is documented in a myriad of poorly indexed sources: professional journals, academic journals, conference proceedings, whitepapers, marketing presentations, web sites, usenet postings, and gray literature. Patent examiners are not equipped to conduct these sort of examinations (Sandburg, 2002).

The recent increase in patent applications was caused by more than just technological advances. In the late nineties the US PTO began granting patents for internet business methods. Patent applications for business methods, however, are difficult to assess with respect to novelty so examiners are further burdened and the pendency of approvals is further compromised.

In 1999, Canada ranked second only to the United States in patent applications (Anon, 1999). Based on the lack of critical literature, it seems that the Canadian Intellectual Property Office (CIPO) has managed to avoid the PTO's problems due to administrative differences. Notably, these differences extend to Canada's limitation of business method patents. Canadian business method patents, however, seem inevitable (Van Barr, 2000).

CIPO will have to learn from the PTO's problems and rapidly adopt solutions. This research paper will explore the technology and policy issues currently facing the PTO with respect to prior art and will identify CIPO's responses to those challenges. Suggestions will be made for unaddressed issues.

References

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