

April 15, 2013

The Honorable Teresa Stanek Rea  
Acting Under Secretary of Commerce for Intellectual Property and  
Acting Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
Attn: Margaret A. Focarino, Commissioner for Patents, and  
Seema Rao, Director Technology Center 2100  
Mail Stop Comments — Patents, Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Submitted via email: SoftwareRoundtable2013@uspto.gov

Re: Public comment on the *Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents*, Docket No. PTO-P-2012-0052

Dear Acting Under Secretary Rea:

The ACM U.S. Public Policy Council appreciates the opportunity to provide comments regarding suggested discussion topics for future Software Partnership events in response to the “Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents,” published at 78 Fed. Reg. 292 and extended by 78 Fed. Reg. 16474.

The Association for Computing Machinery (ACM) is the world’s largest non-partisan, nonprofit association of computer and technology professionals. ACM’s more than 100,000 members come from industry, academia, and government institutions. ACM’s membership represents the diverse views of patent owners, patent licensees, and the public. These comments were developed by expert members within the ACM U.S. Public Policy Council.

The ACM U.S. Public Policy Council encourages the USPTO to consider the following three suggested topics for further discussion by the various stakeholders of the Software Partnership:

### **1. Resources to identify relevant items of prior art for software-related patents**

We support exploration of additional ways that the private sector could facilitate the ability of examiners to identify prior art for software-related patents beyond the current body of U.S. patents and U.S. patent publications. Stakeholders could discuss ways to build upon the successes of initiatives where the USPTO has collaborated with the private sector, shared data with the private sector, or invited public input on prior art submissions. A potential focus area for discussion could be how to

increase the reasonable likelihood of identifying evidence of prior art made available in non-U.S. patent systems and by relevant information providers worldwide.

## **2. Approaches to improve electronic review of software-related technical merits under Section 112**

We endorse the suggestion proposed by other stakeholders at the two Software Partnership Roundtables in February for the USPTO to consider additional software tools to facilitate more effective examinations of software-related patent claims under Section 112. Applicants and examiners could use such tools to foster greater clarity of claim boundaries for software-related claims. For example, one speaker suggested that software tools could potentially be used to determine and efficiently validate whether key claim terms are found in the written description. We encourage the USPTO to consider facilitating further discussion of the opportunities, challenges, and constraints of potential automated approaches to patent examination and validation, as well as how industry and the broader computing community might assist in the development or pilot testing of such software tools.

## **3. Training needs of examiners in software-related topics**

We would welcome the opportunity to engage in a collaborative dialogue with the USPTO on the supplemental training needs of patent examiners in software-related topics and how the computing community could best support the effective development, implementation, and evaluation of software-related patent training programs. The members of the ACM U.S. Public Policy Council are particularly interested in supporting training elements directed at finding and assessing prior art, determining the clarity of the claims, and effectively evaluating the technical merits of software-related patent applications.

The ACM U.S. Public Policy Council recognizes and appreciates the USPTO's ongoing commitment to improving the quality of software-related patents and to engaging the community through innovative initiatives like the Software Partnership.

The ACM U.S. Public Policy Council thanks the USPTO for consideration of the discussion topics suggested above. The staff and members of the ACM U.S. Public Policy Council are available to discuss our suggestions and any questions you may have.

Respectfully submitted,



**Eugene H. Spafford, Ph.D.**  
**Chair**  
**ACM U.S. Public Policy Council**



**Paul Hyland, M.A.**  
**Chair, Intellectual Property Committee**  
**ACM U.S. Public Policy Council**