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From: Tom Adams

Sent: Friday, September 08, 2006 6:04 PM

To: AB95 Comments

Subject: Comments re 71 Fed Reg 38808.

Dear Sir:

Attached please find comments relating to the proposed Changes to Information Disclosure Statement Requirements and Other Related Matters.

Consideration of the comments is respectfully requested.

Sincerely,
Tom Adams
Reg. No. 35047

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September 8, 2006

Attn: Hiram H. Bernstein
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VIA E-mail

Re: Comments on Notice of Proposed Rulemaking: "Changes to Information Disclosure Statement Requirements and Other Related Matters: 71 Fed Reg. 38808 (July 10, 2006).

Dear Sir:

The following comments relate to the above-identified proposed rulemaking.

To summarize, I urge the USPTO to reconsider and withdraw the proposed rule changes relating to Information Disclosure Statement requirements.

I am a member of the American Intellectual Property Law Association (AIPLA). I have reviewed the letter dated September 6, 2006, submitted by AIPLA in commenting upon the proposed rulemaking. I agree with everything the AIPLA has so eloquently set forth in its letter, and so I incorporate herein by reference all of the comments and adopt the position taken by AIPLA in their letter.

I am writing to express some additional concerns and to amplify certain aspects of the AIPLA statements.

The stated objectives of the proposed changes to the Information Disclosure rules are (1) "to improve the quality of the examination process by getting the most pertinent prior art before the examiner so it can aid in the preparation of a complete first Office action on the merits" and (2) "to have applicants with large submissions utilize their knowledge of the documents (their reason for their submission) to draw the examiner's attention to the relevant feature(s), showing(s), or teaching(s) that caused submission of the documents based on the claimed invention or supporting specification."

While I sympathize with those goals, I respectfully submit that the proposed rule changes do not further the USPTO's objectives, create a conflict with patent attorneys' ethical obligations to represent their clients zealously, and require applicants to place themselves in jeopardy with respect to judicially-created standards for inequitable conduct.

It is my opinion that the proposed changes to 37 CFR 1.98 will result in a variety of apparently unforeseen outcomes. The result of greatest concern is that these rules, if put into effect, will be a gold mine for accused infringers, since it will create a variety of new sources for charges of inequitable conduct. The requirement for an "explanation" in a variety of circumstances creates an inescapable trap for patent applicants, since no matter what is said, there will always be room for someone to contend that the person making the statement improperly omitted something of importance.

The USPTO supposes that a court may take account of the new rules, while clearly recognizing and acknowledging that no court is in any way bound by the USPTO rules. Whether or not a court will take account of the new rules, it is a foregone certainty that many accused infringers will not. Rather, accused infringers will seek to exploit every possible aspect of any such explanation, necessitating the very expensive litigation of the issue. What the USPTO apparently fails to recognize is the necessity and expense of litigation that will result from these proposed rules, even if the patentee is fortunate enough to be in a court that does take account of the USPTO rules. The fact that the patentee may prevail in court does not and cannot reimburse the patentee for the costs incurred by the necessity of litigating such issues.

The second major concern is that the costs to applicants will be unduly, unnecessarily and greatly increased. This cost will be applied across the board, to both the large, multinational corporate applicant (recognizing that it is actually the assignee that is the applicant) and to the solo inventor who already can barely afford to pay an attorney to prepare and prosecute his application. The corporate applicant may well be able to afford the extra costs, but the smaller the entity, the greater the burden that will be created.

With respect to specific rules, I submit the following additional points.

Section 1.98(a)(3)(i)(A) requires the "explanation" for all foreign language documents. In many cases, the only information available is the English abstract. This will most likely not provide sufficient information for the "explanation" required in Section 1.98(a)(3)(iv), without obtaining a complete translation of the document. This is an unreasonable burden. If the examiner considers that the English abstract is possibly relevant, the examiner can either have a translation prepared or base a rejection on the abstract and let the applicant then obtain a translation or further information.

Section 1.98(a)(3)(i)(B) requires the "explanation" for any document over 25 pages. This is arbitrary and completely unreasonable, since it bears no relationship to the actual content or complexity of any given document, or the burden of reviewing any given document. The arbitrariness and unreasonableness is quickly revealed by a simple example. Contrast, for example, a European patent containing 24 pages of

single spaced text (at 800 words or more per page) and no drawings, to a published PCT application with 16 pages of drawings and 10 pages of text (perhaps 200-250 words per page). The European patent would not trigger the "explanation" requirement, even though it may contain 18,000 words, while the PCT application would trigger the "explanation" requirement, despite the fact that it contains only 2500 words or less, and contains numerous drawings to aid in quickly understanding the disclosure. This example shows clearly how unreasonable is this arbitrarily chosen trigger point. If a size limit is to be included it should be based on word count, not on page number.

Section 1.98(a)(3)(i)(C) requires the "explanation" for ALL documents if more than 20 documents are submitted, calculated cumulatively. This is arbitrary and completely unreasonable, since it bears no relationship to the actual content or complexity of any of the documents. As suggested by AIPLA, a limit of 50 documents is much more reasonable.

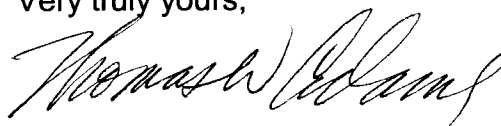
Sections 1.98(a)(3)(ii) and (iii) are even more egregious, in requiring the "explanation" for all documents cited after the period specified in Section 1.97(b), with the specified exceptions. This creates an incentive to ignore any possibly relevant prior art, rather than seek it out, as it should be.

The foregoing are just a few of the objectionable features of the proposed new rules. As noted above, the AIPLA has eloquently set forth many more reasons that these proposed rules should not be adopted.

It is difficult to avoid the conclusion that the USPTO is improperly seeking to shift the burden of its legislative mandate to those it ostensibly serves. While it is well known and understood that the USPTO is under considerable pressure of its workload and backlog, it is my strongly held opinion that the attempts (both the present and that relating to revised continuation, divisional and RCE practice) to shift this burden to the applicants are both unnecessary and will not significantly reduce the load or the backlog. These proposed changes will only make matters worse and will significantly and negatively effect the value of all issued U.S. patents.

For all these reasons, I urge the USPTO to reconsider and withdraw the proposed rule changes relating to Information Disclosure Statement requirements.

Very truly yours,



Thomas W. Adams
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