

-----Original Message-----

From: albongo@aol.com

Sent: Saturday, September 09, 2006 12:57 AM

To: AB95 Comments

Subject: Fwd: Information Disclosure Statement Rules

Dear Mr. Bernstein:

Attached is a pdf version of the comments that I sent you a short while ago in Word. (My home printer ran out of ink at a most inopportune moment for printing on letterhead and scanning the comments into pdf.) I would appreciate it if this more formal, but textually identical, version be the one that is included on the PTO website when the comments are published.

I hope these comments are helpful in the finalization of the rules.

Best regards.

Bill Berridge

-----Original Message-----

From: Albongo@aol.com

To: ab95.comments@uspto.gov

Sent: Fri, 8 Sep 2006 11:59 PM

Subject: Information Disclosure Statement Rules

Attached is a Word version of my comments. A pdf version follows that I believe is better suited for presentation on the PTO website, but may not arrive on September 8 precisely.

Respectfully submitted,

William P. Berridge

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September 8, 2006

Commissioner for Patents
AB95.comments@uspto.gov

Attn: Hiram H. Bernstein

Re: Comments on proposed Rulemaking:
Changes to Information Disclosure Statement
Requirements and Other Related Matters

Dear sir:

The Patent Office is to be commended for its continuing efforts to find ways to expedite examination of patent applications. However, I respectfully submit that those efforts, in the present guise of the proposed changes to information disclosure statement requirements, continue to be misdirected toward an attempt to shift the Patent Office's duty to examine applications to the applicants rather than toward finding ways to ensure prompt and thorough examination by the Patent Office.

I believe that the proposed rules impose huge cost burdens and substantive claim scope penalties on applicants that are trying to achieve strong, well-justified patent protection. I further believe that the desired result can be achieved in other ways that are not so burdensome to applicants, either in terms of cost or substantive patent protection, and provide specific recommendations for changes that may help in this respect.

The Relative Burdens

The burden of examination of prior art is extremely different from the burden on an applicant of creating and filing a permanent written record of the relevance of that prior art. While an examiner or an applicant may be able to review and judge the relevance of a reference in a few minutes, it may well take hours to craft a written explanation of the relevance of that same reference to the claims that will even come close to (1) taking into account the full twenty-year term of the patent and all of the potential future attempts of others to design around the patent that need to be considered before making submissions that will invoke the doctrine of prosecution history estoppel for that full term or (2) ensuring that inequitable conduct allegations will not be made and litigated (at huge expense) for any accidental imprecise characterizations that may be made of the reference. Of course, it is well-established in Federal Circuit

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jurisprudence that statements made in Information Disclosure Statements will invoke the application of the doctrines of prosecution history estoppel and inequitable conduct.

In making rules relating to Information Disclosure Statements, the Office should take this fact into account. It should seriously consider that every statement made by an applicant in a prosecution history is analyzed under a microscope in any attempt to enforce the rights granted by a patent, and thus that very significant resources must be, and are, devoted to every statement that is made by the applicant. It should further take into account that this burden is not shared by the Office. Statements made by examiners do not create estoppels, and the Office need merely make a *prima facie* case of unpatentability as a basis for rejection, at least in initial office actions.

Thus the requirements for detailed written explanations in the permanent record that are imposed by the proposed rules impose an unfair and disproportionate burden on applicants, and should not be included in final rules, especially in connection with information submissions before the first office action. Thus proposed rule 1.98(a)(3)(iv)(B), (v) and (vi) should not be included in the final rules.

The Respective Roles of Applicants and Examiners

While applicants do have a duty of candor to the Patent Office, they remain interested parties with attorneys who have the ethical duty under the rules of the Patent Office and the ethical codes of every state bar to act as their zealous advocates. It is the duty of the Patent Office examiners to act as neutral administrative judges to determine the patentability of claims that are presented to them over the prior art that is available to them. Thus while applicants must provide the Office with the information available to them that should affect the Office's decision-making process, they and their attorneys should not be required to take on the role of an examiner in characterizing the relevance of references to their own applications. The proposed rules on explanation of relevance and application of the details of the references to the claims in issue (e.g., proposed rule 1.98(a)(3)(iv)(B), (v) and (vi)) improperly confuse these roles, and should not be included in final rules.

Applicants Should Not Be Discouraged from Submitting Relevant Information

Furthermore, it is the historical, and indeed definitional, job of a patent examiner to sift through the potentially relevant prior art to determine, as required by the Supreme Court in *Graham v. John Deere Co.*, 15 L. Ed. 2d 545 (1966), the full scope and content of the prior art and the level of ordinary skill in the art, as well as the differences between the claimed invention and the prior art, in making a patentability determination. In doing so, examiners routinely review hundreds of references in entire subclasses of the Patent Office classification system, in the course of which they become familiar with the scope and content of the prior art and the level of ordinary skill in the art, as well as identifying the closest prior art, including prior art that may *prima facie* anticipate or render obvious the patent application claims under examination.

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In over 25 years of practice of patent law, including involvement in prosecution of thousands of patent applications and rendering opinions on and monitoring or participating in litigation of hundreds of patents, I have never seen an application in which an applicant intentionally submitted prior art that was less relevant than the subclasses in which a claim is classified. To the contrary, while I have seen, and filed (very occasionally), Information Disclosure Statements that included over 100 references, I have only seen them filed in an attempt to provide the Patent Office with all of the potentially relevant references that were cited in a specification, in searches directed to the claims at issue or claims in related applications, or by competitors who had an incentive to limit the scope of the claims at issue. These are precisely the types of references that I believe should be available to an examiner for the examiner to be able to come to a full understanding of the art as required by the Supreme Court for a patentability analysis in the *John Deere* case.

Even when a few hundred references are provided, which is an extremely rare event due at least in part to the cost to applicants of uncovering, identifying and filing such a number of references, the total number is no more than the total number of patents in an average subclass that is only a portion of the search that an examiner is required to perform without any other guidance in every application. In view of the Patent Office's comment that "Documents submitted in an IDS are reviewed in the same manner as items of information obtained by the examiner from other sources" (Federal Register, Vol. 71, No. 131, page 38810, col. 3), the Patent Office should welcome, rather than penalize, applicants' submissions of rich fields of search in early Information Disclosure Statements. Indeed, any such submission should be considered at worst the identification of an additional subclass of potentially particularly relevant art.

Thus I recommend that there be no limitation on an applicant's submission of information before the first office action (the first time period of proposed rule 1.97(b)).

There is Already a Strong Incentive Against "Burying" Particularly Relevant References

If the Office fears that applicants may "bury" very relevant art in such early submissions (which involve the disincentive of expense to applicants in any event), it should rest assured that applicants would do so at the risk of an inequitable conduct result under the very longstanding *Penn Yan Boats* rationale.

More Focused Responses to Delays Should be Implemented

The Office is concerned that late submissions of prior art may unnecessarily delay examination of applications. While this concern may in some cases be reasonable, it should be taken into account that delays occasioned by specific applicants can and should be borne by those applicants, rather than by penalizing all applicants, and substantively rather than merely procedurally penalizing the involved applicants, for the potential delays caused by a few applicants. Thus a more reasoned approach would be to provide examiners with a longer time to address applications in which a large number of references is cited by the applicant, and possibly

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applying higher fees for such applicants, rather than substantively penalizing applicants for presenting a large number of references where they believe it is to the advantage of the patent system and the particular application in question for the examiner to consider such a number of references.

Thus I recommend that the Office permit examiners more time to examine those applications in which a large number of references is cited, for example an additional month for every twenty references, or impose a fee, such as twenty dollars per reference over 20, rather than impose the substantive patent scope penalties imposed by the explanation requirements of proposed rule 1.98(a)(3)(iv)(B), (v) and (vi). As stated above, I do not believe that even this temporal or fiscal penalty is appropriate before the first office action, but it might be more reasonable if the references are submitted after the first office action.

The Incentives and Disincentives Applied by the Rules Should Be Less Drastic

For the reasons relating to the cost, estoppel and inequitable conduct litigation effects of the explanations required by the proposed rules as discussed above, the clear and obviously intended result of the proposed rules is that applicants should under no circumstances ever submit foreign language references or more than twenty references in a pending patent application. The inevitable effect of this result is that the Office will not have the benefit of applicants' presentation of the enriched search field derived from the claimed invention, or even the Supreme-Court-required scope and content of the prior art. A likely further result is that the interested applicant or his or her ethically-necessary zealous advocate, will more often err on the side of non-disclosure rather than disclosure of material prior art, thus further burdening the system with inequitable conduct charges and litigation. The societal benefit of avoiding the huge judicial and financial burden of such charges and litigation more than overbalances the needs of the Office in avoiding its examination responsibilities.

The Rules Should Not Be Punitive

The features of the rules that they apply all of the explanation requirements to all of the references ever cited by an applicant once the twenty-first reference is submitted is purely punitive rather than addressing the legitimate examination costs of the Office. At most, the (improper as discussed above) explanation requirements should only be applied to those references that exceed the limits defined by the Office on its own normal examination capabilities (i.e., twenty applicant-identified references). Thus at the most, proposed rule 1.98(a)(3)(C) should be modified to apply the explanation requirements to each reference after the first twenty that are counted against the applicant.

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There Should Be an Incentive to Submit References
Identified as Relevant by Foreign Search Authorities

The rules correctly recognize, under some circumstances, that there should be an incentive to submit references cited by foreign search authorities in counterpart applications. However, the rules do not go far enough in this regard.

The applicant has no control over the number or timing of references cited by other search authorities. Thus the applicant should not be penalized for their citation of references, either in terms of timing or number.

Thus, there should be no limit on the number of such references cited without the burdensome explanations even in the third and fourth time periods of proposed rule 1.97(d). In addition, such references should not be counted against the numerical limit of explanation-free references (presently 20), but should be expressly excluded in a rule corresponding to proposed rule 1.98(a)(3)(xi).

Clarifications

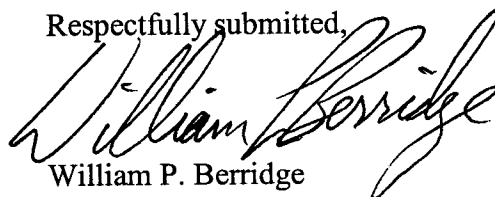
The rules (e.g., proposed rule 1.98(a)(3)(xi)) should make clear that foreign language references for which a translation is provided should be treated as English-language references.

The rules should make clear that references previously considered in a parent application or pre-RCE examination do not count toward the numerical limit.

The rules should make clear that references cited in support of patentability arguments, as opposed to references cited to satisfy the duty of disclosure of material (i.e., adverse to patentability), do not count toward the numerical limit.

The effective date of the rules should not impose huge, unanticipated burdens on applicants. Thus the rules should only apply in applications filed after the effective date, or to a count of references filed after the effective date (i.e., references cited before the effective date of the rules should not be subject to the explanation requirements).

Respectfully submitted,



William P. Berridge