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From: SEAN MYERS-PAYNE

Sent: Friday, September 08, 2006 6:25 PM

To: AB95 Comments

Cc: SEAN MYERS-PAYNE; BRUCE BERNSTEIN; BRUCE STONER

Subject: Comments on Proposed IDS Rules

<<20060908161353.pdf>> Attached are our comments on the proposed IDS rules.

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The Honorable Jon Dudas
Under Secretary for Commerce for Intellectual Property
And Director of the U.S. Patent and Trademark Office
Mail Stop Comments - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 8, 2006

Attention: Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for
Patent Examination Policy

RE: Comments on Proposed Rules: "Changes to Information Disclosure
Statement Requirements and Other Related Matters"; 71 Fed. Reg. 131
(July 10, 2006)

Greenblum & Bernstein, P.L.C., the undersigned, is a law firm located in Reston, Virginia, that specializes in all aspects of intellectual property law. The firm currently employs over 35 registered patent attorneys and agents that engage in prosecuting and litigating in various areas of intellectual property. The firm also files over 1000 new applications for patents each year. Thus, the firm has an avid interest in the proposed rule change set forth in 71 Fed. Reg. 131 (July 10, 2006)

The undersigned acknowledges that the PTO has an interest in reducing the burden on patent examiners and that review of IDS materials is a significant part of that burden. While the proposed rules would appear, on their face, to reduce some of that burden, it is our view that they would produce unintended consequences and produce a situation that is unworkable for many applicants.

The U.S. patent statutes, presently and historically, have placed upon patent Applicants the burden of presenting an enabling disclosure – nothing more is or should be required. The PTO's burden, then, is to show the unpatentability of the claimed invention. If it is unable to meet its burden, the Patent Office grants a right to exclude through a patent. This basic *quid pro quo* forms the foundation of much of this country's patent law, and the Patent Office's proposed IDS rules turn this foundation on its head.

The undersigned believes that comments from others, including the AIPLA and IPO, will address the issue of *why* the proposed rules are improper. To avoid redundancy, those issues will not be addressed here. Rather, the following specific questions and comments are left unanswered by the proposed rules.

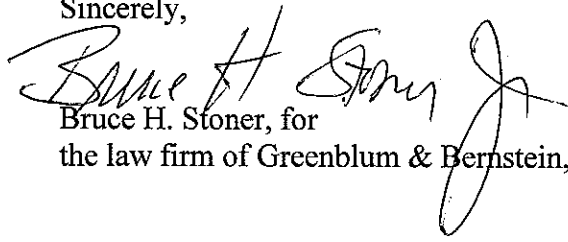
- 1) The proposed rules suggest that Section 1.56 be amended to include a paragraph (f) that will provide for a "safe harbor" for those individuals who, acting in good faith and to the best of the person's knowledge, information, and belief, formed after a reasonable inquiry under the circumstances, took

reasonable steps to comply with the additional disclosure requirements of § 1.98(a)(3). The undersigned submits that the reasonable inquiry will result in decisions both to submit, and *not* to submit, information. The safe harbor should expressly apply to all information considered – not only that which is submitted to the Office.

- 2) The proposed rules suggest that foreign language documents of any length would trigger the explanation and translation requirements. It is unclear why, if a complete English translation is provided, an explanation should also be provided. It would seem that providing an English translation should be sufficient.
- 3) The proposed rules also do not make clear how “equivalent” patents will be counted (toward the limit of twenty). For example, if a foreign language patent is provided, along with an English language family member, would these two patents be counted as one or two, toward the total? It would seem that they should only be counted as one. In such case, would applicants be required to provide an explanation regarding the English family member?
- 4) Presently, U.S. national stage Applicants based upon PCT applications are not required to provide copies of documents cited in an International Search Report, if such papers have already been provided by the international receiving office. Under the proposed rules, it is unclear if copies of such documents would be required. It is also unclear if such documents, if copies are not required, would count toward the total number of documents provided.
- 5) The proposed rules seem to suggest that if the document limit of twenty is exceeded, Applicants would be required to provide an explanation relating to all previously filed documents – even if those documents had already been considered by the Examiner. It is not clear why an Applicant would be required to comment on a document already considered by an Examiner.
- 6) The proposed rules suggest that the Office expects that more than eighty-five percent of IDSs filed prior to first Office action on the merits would not require any explanation because the threshold number only applies to IDSs filed prior to first Office action and has certain exceptions. The undersigned submits that the PTO’s estimation in this regard appears to substantially underestimate the number of files in which foreign-language documents are filed prior to a first action, which, according to the proposed rules, would require an explanation *and* a translation.
- 7) The proposed rules do not appear to indicate that they would apply retroactively to applications pending at the PTO at the time of enactment. The undersigned submits that the rules, if enacted, should *not* apply retroactively. Applying the rules retroactively would create very significant and undue burdens on applicants.

The undersigned appreciates the opportunity to submit these comments and questions, and would be pleased to work with officials at the U.S. Patent and Trademark Office to achieve the goals of reducing the burden on examiners to examine patent applications.

Sincerely,

A handwritten signature in black ink, appearing to read "Bruce H. Stoner". The signature is fluid and cursive, with a large loop at the end.

Bruce H. Stoner, for
the law firm of Greenblum & Bernstein, P.L.C.