

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

**From:** Lynne Anderson

**Sent:** Friday, September 08, 2006 4:52 PM

**To:** AB95 Comments

**Subject:** Comments - Changes to IDS Requirements and Other Related Matters

Mr. Bernstein - Attached are IBM Corporation's comments.

Regards,

Lynne D. Anderson

Sr. Program Manager

U.S. Patent and Trademark Office Liaison

IBM Corporation

Washington IP Law Dept.

lynnea@us.ibm.com

Voice: 703-299-1455 (TL 494-1455)

Fax: 703-299-1475 (TL 494-1475)

September 8, 2006

**Via Electronic Mail**

AB95.Comments@uspto.gov

Mail Stop Comments – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Hiram H. Bernstein

IBM Corporation Comments in response to Notice of Proposed Rule Making “*Changes to Information Disclosure Statement Requirements and Other Related Matters*”, 71 Fed. Reg. 38808 (July 10, 2006)

---

IBM commends the United States Patent and Trademark Office for its continuing efforts to improve US patent quality and thanks the Office for the opportunity to comment on the proposed Changes to Information Disclosure Statement Requirements and Other Related Matters. The USPTO has a severe problem dealing with excess amounts of redundant or irrelevant prior art being cited in some patent applications. With the number of patent applications steadily increasing, this practice of “prior art flooding” has burdened the US patent system by overwhelming examiners and slowing the examination process. The Office’s proposal correctly focuses on more directly involving applicants in the examination process to assist the USPTO in addressing this problem.

US patent law requires a patent applicant to submit prior art that is material to the examination of the claimed invention. Unfortunately, some applicants flood the USPTO with prior art, whether or not it is material, to avoid inequitable conduct allegations that may arise from their failure to disclose relevant art known to the applicant. The rules provide adverse consequences for such failures to disclose known relevant art, while at the same time not penalizing the practice of flooding the Office with prior art, even where such art is redundant to art already provided, or irrelevant to the patentability of the application. Consequently, there is an understandable incentive to avoid such adverse consequences by submitting all art, irrespective of the relevance of the art. These rules also lead some applicants to provide all prior art references to the Office without undertaking any analysis of relevance since such undertaking can only give rise to legal risk. This practice runs counter to the intent of the rules regarding disclosure of prior art and inevitably results in increased pendency as well as causing buried but relevant prior art to be overlooked or not fully considered during examination, and a presumption of validity improperly attaching to patents issuing from such examinations.

While we agree that measures should be taken to discourage the submission of irrelevant prior art, and we applaud the objectives of the proposed rule changes, we find the process and mechanism proposed by the USPTO to obtain applicant's assistance in clarifying references to be unnecessarily complex. Our concern is that a burdensome proposal will discourage applicants from searching for prior art at all because there is no duty or requirement to search - proposed Rule 10.18(b) only includes a duty to review information contained in an IDS before submission to the Office. Therefore, applicants may resist making any reasonable effort to provide examiners with information that would be useful for assuring an accurate and complete examination. Accordingly, in crafting a workable proposal a balance must be struck between the need to address the problem of prior art flooding and the need to minimize the resultant burden imposed upon applicants who are not obligated to search for prior art. Mindful of these coincident interests, we offer the following comments, concerns and proposed alternatives (suggestions) with respect to the proposed rule changes to Rules 1.97 and 1.98.

IBM generally supports the proposed modifications to Rule 1.97, *Filing of Information Disclosure Statement*, to include four time periods for submission of prior art to the Office. However, the substantial proposed amendments to Rule 1.98, *Content of Information Disclosure Statement*, are of particular concern.

During the first time period set forth in Rule 1.97(b), (with certain exceptions), Rule 1.98(a)(3)(i) provides that an "explanation" is required for 1. each English-language document having more than twenty-five pages, 2. any non-English language document and 3. all documents if the cumulative numbers of IDS references is greater than twenty. As defined by the USPTO, an "explanation" comprises both an "identification" of relevant portions of the document and a "correlation" of those relevant portions to the pending claim language. The requirement for an "identification" for documents having more than twenty-five pages is reasonable in order to guide the Examiner to what is relevant in a lengthy document. However, the proposed rule changes are unclear as to whether the examiner will only be relying on the identified portions of the document or whether the examiner will be required to review the document beyond those sections identified.

With respect to the "correlation" requirement, we feel that the requirement is inappropriate from a policy perspective. "Explanations" may require applicant and his/her practitioner to make "examination" determinations which may create a dilemma or conflict of interest (at least for the practitioner) and which the examiner should be more competent to perform.

Additionally, we are of the opinion that the "correlation" requirement is unnecessary if the "identification" of the relevant document sections is appropriately undertaken. An appropriate "identification" would include the features, showings or teachings that caused the document to be cited, as well as where they may be found, for example, the page and line number(s), figure(s) element number(s), etc., and if such "identification" itself is accomplished in fewer than twenty-five pages. Appropriate identification of the

relevant document sections should perform the function of effectively reducing the examiner's burden of review to the level incurred in reviewing a shorter reference. Once accomplished, the burden associated with the review of the reference is no greater than for a shorter document and correspondingly, there should be no further "correlation" requirement placed upon the applicant.

We advocate that such "identification" be accomplished by specific reference to the portions of the document, since such identification would not require any paraphrasing by the applicant. Inaccurate paraphrasing or mischaracterizations of prior art will inevitably introduce unwarranted file wrapper estoppel issues and lead to allegations of Rule 56 infractions. The applicant would still be required to specify the feature(s) that caused the document to be cited, but this could be done without any paraphrasing, such as by explicit reference to the portion of the document.

We note that at page 33815 of the Federal Register Notice, the Office provided an example of what it considers to be a compliant explanation submission:

"The Office believes that, in most cases, a compliant submission would include several sentences that: identify a specific feature, showing or teaching causing submission of a document (e.g. rotary pump, element 32), identify the portion of the document where the feature, showing or teaching may be found (e.g. Figure 3 in Patent A), and correlate the specific feature, showing, or teaching to specific claim language (e.g. the rotary pump in Figure 3, element 32 of Patent A correlates to the rotary pump in claim 1 of the application)."

The Office should promulgate adequate guidelines clearly advising the public and examiners as to what does and does not constitute a sufficient explanation.

Further, in addition to the "explanation" exceptions listed in the Federal Register, we feel that the following documents should also be excluded from the additional disclosure requirement of Rule 1.98(a)(3).

- 1). US patents regardless of the number of pages,
- 2). Drawings, bibliographies, etc.,
- 3). Prior art cited by examiners (foreign and domestic) in "related applications", and
- 4). Prior art cited by examiners in any parent of continuation applications associated with the current foreign or domestic counterpart application.

These documents are already part of examination process and should not require additional explanation. Patent documents are easy for examiners to quickly review. Drawings, bibliographies etc. speak for themselves and only lend themselves to improper inaccurate characterization. With respect to items 3 and 4 above, it is not within the applicants control what references and how many references examiners cite. Therefore, the applicant should not have to provide an explanation of these documents

in order for them to appear on the face of any patent that issues from the continuing application.

During the second time period set forth in Rule 1.97(c), it is proposed in Rule 1.98(a)(3)(ii) that an IDS may be filed if accompanied by an explanation and a “non-cumulative” description. The third time period set forth in Rule 1.97(d)(1), includes the further requirement of a certification, as well as a “patentability justification”. See proposed Rule 1.98(a)(3)(iii). A “patentability justification” is defined as including an explanation, a non-cumulative description and specific reasons why the independent claims are now deemed patentable or why an amendment places previously unpatentable claims in condition for allowance. However, as discussed above, we are of the opinion that the “correlation” requirement is burdensome and in most cases unnecessary.

Furthermore, with respect to the “non-cumulative” description requirement, at page 38816 of the Notice, the USPTO’s proposal appears to indicate that in accordance with proposed Rule 1.98(c), the examiner will review the references in order, “[w]here review of an IDS reveals the presence of a pattern of merely cumulative documents to such extent that the utility of further review of the IDS is called into question,...the Office may terminate further review of the IDS.” However, there is no guidance provided as to how many documents will be reviewed before the arbitrary cut-off point or what criteria the examiner will use in determining whether a reference is cumulative.

But we support this proposal in general and request clarification. Thus we are proposing to modify and clarify Rule 1.98(c), *Avoid cumulative information*, as follows to motivate applicants to list the most relevant prior art at the beginning of the IDS yet allow a “safe harbor” for applicant to cite a limited number of prior art documents even though the Examiner may not think them relevant.

“The Examiner will review the documents cited in the IDS in the order listed by applicant. At any point in the review after the first ten references in the list where there becomes a pattern of merely cumulative or background documents, the examiner will terminate further review of the IDS and not consider the merely cumulative or background documents or any subsequent documents listed in the IDS. A “cumulative” document is one that does not describe any features in the claims that were not already described by another document listed earlier in the IDS or cited by the examiner. A “background” document is one that is not relevant to the patentability of the invention.”

Additionally, with respect to the second and third time periods, we are of the opinion that the proposed requirements of Rule 1.98 will likely impose an undue burden on examiners due to increased discussions between examiners and applicants regarding the extent and the sufficiency of an “identification”, “correlation”, “non-cumulative description”, as well as providing new grounds for assertions about patent validity. We further note that the proposed rules require applicants to cite relevant “non-cumulative” prior art references regardless of their length and question the policy behind penalizing compliant applicants with an additional “correlation” requirement for such references.

With respect the fourth time period, we have no substantive comments regarding the changes set forth in proposed Rule 1.98(a)(3)(iii).

In view of the above concerns, we suggest that the USPTO consider making more effective use of Rule 105 as a means to appropriately elicit specific information from applicants as it is needed. Rule 105 is an under used tool and should be the mechanism used for obtaining applicant's assistance in clarifying references and entering valuable information into the file history, in lieu of placing a "correlation" requirement on the applicant..

Under Rule 105, at any point during the prosecution of an application, the examiner may request clarification of one or more references submitted by the applicant in an IDS. The references will not be considered by the examiner, and thus the patent will not issue over such references, if a compliant response to the request has not been provided by the applicant within the specified time for response. We feel that this provides a simpler and more appropriate alternative to the Office's proposed "correlation" requirement because it allows the examiner to request clarification of any reference, at any time. Using Rule 105 reduces workload on both the examiner and the applicant, as the request is only issued for those references which the examiner actually determines require further information, and it does not adversely impact the timing of prosecution - if applicant does not provide a compliant response within the specified time, the patent issues without consideration of the references.

In addition, we note that the USPTO is proposing to eliminate all fees associated with prior art submissions. However, we believe that this would result in a loss of income to the Office. It would also encourage excessive submissions and it would tolerate the submission of irrelevant prior art. Therefore, instead of eliminating the fee payment option, we propose alternatively that a fee should be charged that is related to the number of references submitted, but only after a threshold number of references is exceeded. While, we are concerned that the cost of patent prosecution will likely increase if "explanations" of documents (i.e., an identification and a correlation), and updates to any previously submitted "explanations" in view of any amendment affecting the claim scope are required, a fee for submitting an excessive number of references, especially those not cited in an Office Action, is supportable in helping avoid flooding.

Lastly, we point out that there are potential issues not considered by the USPTO's proposal. For example, how is proposed new Rule 1.261 – Examination Support Document going to be reconciled with the proposed changes to Rule 1.98? Who is responsible for providing the additional information? For example, is a solo inventor prosecuting his/her own patent application expected to provide the additional disclosure information? What about jointly owned patents? As the same reference may be submitted in more than one of applicant's patent applications, how are multiple explanations of the same reference to be treated?

In conclusion, IBM shares the Office's concern that prior art flooding makes it very difficult for examiners to find and properly evaluate the best prior art in the limited time available for such evaluation. Any requirement that patent applicants cite "material" prior art should encourage the disclosure of useful art while discouraging the flooding of the USPTO with irrelevant art. Therefore, as discussed above, we have proffered alternative suggestions that we believe best focus the examiner on the most relevant prior art, while minimizing the burden on the applicant. Increased utilization of Rule 105 for requesting information or clarification could rectify the burden the Office feels exists with respect to prior art flooding. We also strongly caution that rules resulting from these proposals be carefully crafted to ensure that they achieve their intended result. Specifically, in order to promote the desirable conduct of citing relevant prior art and not over submitting art that is not material, it is proposed that any changes to the IDS rules be guided by the proper application of fees, inequitable conduct, and the presumption of validity.

Respectfully submitted,

Manny W. Schechter  
Associate General Counsel  
Intellectual Property Law  
IBM Corporation  
schechter@us.ibm.com  
Voice: 914-765-4260  
Fax: 914-765-4290

Lynne D. Anderson  
Sr. Program Manager  
U.S. Patent and Trademark Office Liaison  
IBM Corporation  
Washington IP Law Dept.  
lynnea@us.ibm.com  
Voice: 703-299-1455  
Fax: 703-299-1475