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From: David Lewis

Sent: Thursday, September 07, 2006 3:39 PM

To: AB95 Comments

Subject: Proposed new rules for IDSs

To the Honorable Commissioner for Patents,

Regarding the proposed changes to the rules related to submitting and IDS, if Examiners review the submitted reference in the same manner that they review any other source of information (e.g., no different than references found in a relevant subclass), then the added burden of even the longest IDSs is likely to only be the time it takes to search at most one subclass by hand. An IDS with 100 references should only add a few minutes to the search (the time it takes to flip through the references and briefly look at the contents of the front cover of the reference to determine if a further look at the reference is necessary) - at least that is all it would take me when I was an Examiner. Consequently, the limit of 20 references seems to me to be a bit too drastic. The number could be increased to 100 and possibly higher without significantly increasing the Examiner's work load, if the collection of references sent by the applicant is treated as an additional subclass to search by hand.

In contrast, if an agent or attorney inadvertently err and do not submit a reference, because they honestly thought it was not relevant, the livelihood of the attorney or agent could be improperly convicted of fraud on the Patent and Trademark Office and lose his or her source of livelihood. In terms of the balance of the public good, it would seem that the livelihood of an entire class of individuals (patent practitioners) would outweigh the relatively minor inconvenience of a few lengthy IDSs.

Since the Applicants are typically not familiar with patent law and the patent agent or attorney is typically not an expert in the art, encouraging the applicant or the applicant's attorney or agent to filter the references first before sending them to the Patent and Trademark Office is likely to result in at least some references mistakenly not being included in an IDS that should be included in the IDS, which are never found by the Examiner during the search. Consequently, proposed rules are likely to result in at least some lower quality patents than would result under the current rules.

Additionally, the proposed rules do not give any breaks for small entities. If a large number of references are found in a search, a small entity may not be able to afford the added cost of filing a large IDS or of paying an attorney or agent to review the references and submit an IDS. Effectively, this added cost may prevent at least some small entities from filing a patent application.

Finally, even under the present rules, it is not uncommon during litigation for a patent practitioner to be wrongfully accused of fraud on the Patent and Trademark Office. This practice wastes lots of money on behalf of the patent owners and at least sometimes wrongfully deprives a patent practitioner of his or her livelihood (because, although well

intentioned, no court and no standard of evidence is perfect). The point in having an examination system instead of registration system is to decrease the amount of litigation that would otherwise occur. However, insisting that patent practitioners filter out even more references than they do now is likely to increase the number of instances (during litigation) of accusations against patent practitioners of having committed fraud, which will further increase the length and high cost of litigation. Insisting that patent practitioners filter out even more references may result in even more innocent patent practitioners losing their livelihood as result of mistakenly being convicted of fraud, when they were just trying to reduce the number of references submitted as encouraged by the proposed new rules.

Therefore I believe (1) that at the very least under the proposed rules the limit on the number of references submitted should be higher, (2) the fees for long or delayed IDSs should be further reduced for small entities, (3) the proposed rule change will result in at least some patents being of a lower quality than under the current rules, and (4) the current rules are better for the overall public good than the proposed rules in view of the likely increased costs of litigation and loss of income to those unfortunate patent practitioners mistakenly convicted of fraud as a result of the limiting the number of references submitted according to the proposed rules.

Respectfully Submitted,

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