



September 8, 2006

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The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments-Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

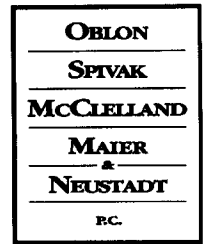
Attention: Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for
Patent Examination Policy

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 Under Secretary Dudas:

Oblon, Spivak, McClelland, Maier & Neustadt P.C. ("Oblon Spivak") is one of the largest firms in the United States specializing exclusively in intellectual property (IP) law, and was the largest filer of U.S. patent applications in 2005. As such, Oblon Spivak welcomes the opportunity to provide suggestions and comments on the Changes to Information Disclosure Statement Requirements and Other Related Matters published at 71 Federal Register 38808 (July 10, 2006) ("proposed IDS changes").

As with all proposed rule making packages pertaining to practice before the United States Patent and Trademark Office (USPTO), Oblon Spivak appreciates the opportunity to provide comments and suggestions prior to the promulgation of any final rules. Oblon Spivak provides its comments from the perspectives of its over 100 patent and trademark practitioners, and IP counsel for many of the USPTO's largest corporate customers. In particular, Oblon Spivak provides herein suggestions and comments pertaining to treatment of information disclosure statements that identify related applications, office actions from related applications and prior art that was cited or applied by a patent examiner in a related application. Our suggestions and comments are a result of our analysis of IDS submissions in more than 700 of our randomly



selected patent applications, and the extra burden the proposed IDS rule changes would have if applied to these applications.

1. Identification of Related Applications

Under the proposed IDS changes, Applicants will have an obligation under 37 C.F.R. section 1.78 to inform the USPTO of related applications that may raise obviousness type double patenting issues. Submission of such information is best done through the filing of an information disclosure statement (IDS), since such information may be material to patentability under 37 C.F.R. section 1.56. *See* MPEP sections 2001.06(b) and 2004 item 9. Applicants should be permitted to merely list the related application number on an IDS without having the identification of the related application be included in the 20 document limit.

2. Prior Art Applied by USPTO Examiner in Rejecting Claims in Related Application

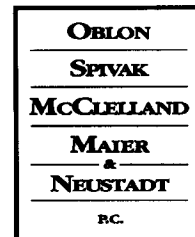
Applicants have a duty of disclosure obligation to disclose prior art cited by the USPTO in related applications where that prior art is also material to patentability of the claims in the examined application. *See* MPEP section 2001.06(b). The USPTO's own office actions should suffice to provide the "explanation" of the relevancy of the applied prior art. Moreover, the USPTO should treat these cited references equivalent to the way the USPTO treats prior art cited in a foreign search report or office action. *See* MPEP sections 609 and 2001.06(a).

As pointed out in MPEP section 2004, item 10, when in doubt it is desirable and safest to submit information. Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently. The court in *U.S. Industries v. Norton Co.*, 210 USPQ 94, 107 (N.D. N.Y. 1980) stated "In short, the question of relevancy in close cases, should be left to the examiner and not the applicant." *See also LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066 (Fed. Cir. 1992).

The proposed IDS changes state that approximately 85% of IDSs filed prior to the first Office Action would not require any explanation. Our statistics support this conclusion, but only if the related applications cited to the USPTO, and the references cited by USPTO examiners in these related applications are not included in the 20 document threshold. On the other hand, if related applications and prior art cited by USPTO examiners in those related applications are included, virtually all applications with related applications will surpass the 20 document threshold.

Once the 20 document threshold has been surpassed, the proposed IDS changes impose a duty for applicants to provide an "explanation" for each of the references cited in the IDS. In view of the harsh penalties for inequitable conduct and malpractice, practitioners cannot take

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such explanations lightly. As such, if the proposed IDS changes do not exclude related applications and prior art cited in those related applications, the added burden of providing an explanation will impose sizeable analysis and financial burdens on a majority of patent applications. In contrast, if the related applications are handled in the same way as a foreign Office Action on a counter-part foreign application, the statistics cited in the proposed IDS changes are much more reasonable.

In view of the above comments, we therefore request that before the proposed IDS changes are made final, the issue of related applications, and prior art cited in the related U.S. applications be handled consistent with the way the proposed IDS changes handle foreign Office Actions.

Respectfully submitted,
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Norman F. Oblon *Per*

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