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From: Scott Wendorf

Sent: Thursday, August 31, 2006 2:39 PM

To: AB95 Comments

Cc: comments@uspto.gov

Subject: Comments to proposed rules regarding IDS practice

Sir:

Regarding the proposed "Changes to Information Disclosure Statement Requirements," 71 Fed. Reg. 38808 (July 10, 2006), please see the attached comments.

Respectfully submitted,

Scott Wendorf

Reg. No. 48,029

TO: Commissioner for Patents, United States Patent and Trademark Office

RE: Proposed “Changes to Information Disclosure Statement Requirements,” 71 Fed. Reg. 38808 (July 10, 2006):

The following comments regarding the referenced proposed rule changes are respectfully submitted:

A. Submission of documents during “third period” or “fourth period”, where document is “known” for more than three months

Under the proposed rules, there would be no mechanism at all for submission of a document during the “third period” of Section 1.97[d][1] or the “fourth period” of Section 1.1197[d][1] under any of the following circumstances:

(a) A document is known by at least one individual designated in Section 1.56(c) more than three months before the filing of the IDS. However, the materiality of the document is only later realized, either because of claim amendments or other activities or document reviews that may take place during prosecution.

-or-

(b) A document that is known to be material by at least one individual designated in Section 1.56(c) more than three months before the filing of the IDS. However, through good faith error and without deceptive intent, the document is not disclosed in a prior IDS. A simple paperwork error or lost e-mail could result in such an omission.

-or-

(c) The existence of a document is known by at least one individual designated in Section 1.56(c) more than three months before the filing of the IDS. However, an actual copy of the document cannot be obtained within three months, despite good faith efforts. This may occur, for example, in the context of obscure documents that must be ordered from overseas sources.

-or-

(d) A document is cited in a communication from a foreign patent office in a counterpart foreign application. However, through good faith error and without deceptive intent, the document is not disclosed in an IDS within 3 months of initial receipt by at least one individual designated in Section 1.56(c). This may occur due to delays in the mail, temporarily lost or misfiled paperwork, or other reasons.

In each of the above “real world” situations, the applicant may be making a good faith attempt to comply with the disclosure requirements, but cannot make the certification required under Section 1.97(e)(1) or 1.97(e)(2), and therefore cannot submit the document for consideration. Under the proposed rules, the applicant’s only option is to abandon the application.

This commenter appreciates the need to encourage early disclosure of documents; however, this commenter is confident that the Office would appreciate the desirability of allowing the

disclosure of documents in each of the above hypothetical situations. In each of the above hypothetical situations, allowing disclosure and consideration of the document would result in (assuming other criteria of patentability are met) the allowance of a higher quality patent (as opposed to, as this commenter understands the proposed rules, no patent at all). Therefore, there should be at least some mechanism for disclosure and consideration of documents in situations like the above. The rules could be written so as to discourage late submissions, through additional fees and/or a requirement to file an RCE, but to still allow for document submission and consideration.

B. Submission of patent applications from same applicant, inventor, or assignee

The proposed rules do not take into account the issue addressed at MPEP § 2004, Paragraph 9, which instructs:

Do not rely on the examiner of a particular application to be aware of other applications belonging to the same applicant or assignee. It is desirable to call such applications to the attention of the examiner even if there is only a question that they might be "material to patentability" of the application the examiner is considering. . . . [emphasis added]

Particularly in the case of prolific inventors or multi-inventor research groups, a list of such applications might take up at least a large portion of the twenty-document allotment under the proposed rules.

The proposed rules should instead state that patent applications disclosed in an IDS that belong to the same applicant or assignee, or that have at least one inventor in common, will not count towards the twenty-document threshold.

Respectfully submitted,

Scott F. Wendorf
Reg. No. 48,029