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November 12, 2003

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

Attention: Hiram Bernstein

RE: Comments on Proposed Rule entitled Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan

Walker Digital Management, LLC hereby submits comments on Notice of Proposed Rulemaking, Federal Register Vol. 68, No. 177, September 12, 2003. The submitted comments address in particular the proposed amendments to 37 C.F.R. §1.105.

1. First General Comment: Requests for Confidential and Protected Information

It is requested that Rule 105 include a provision clarifying that confidential and protected information cannot be requested under Rule 105.

The requested clarification of the rule is of particular importance since all information provided during prosecution becomes available to the general public when an application issues as a patent, and there is currently no mechanism for providing confidential and protected information to an examiner during prosecution while ensuring the confidentiality and protection of the information from the general public.

As currently stated and under the proposed amendments, Rule 105 is arguably broad enough to encompass information protected as a trade secret, attorney-work products, information protected under attorney-client privilege, or otherwise confidential information not typically obtainable by an agency. As courts have made clear, an agency cannot routinely request such information to be produced without first meeting heightened burdens, specific to each type of information requested, to show why such information is necessary. For example, in order for an agency to obtain a document that is otherwise protected as attorney work-product, the agency would have to abide by Fed. R. Civ. P. 26(b)(3) and show a substantial need for the information. See, for example, Director, Office of Thrift Supervision v. Vinson & Elkins, LLP, et al., 26 U.S. App. D.C. 332 (D.C. Cir. 1997). By contrast, Rule 105 contemplates the much lower burden of a “reasonably necessity” for such information.

Alternatively, it is requested that a provision be added to the Rule, clarifying that a complete response to a requirement for information is a reply that the information requested is a trade secret, attorney work product, protected by attorney-client privilege or otherwise confidential and thus exempt from submission.

As yet another alternative, it is requested that if an applicant asserts that the information is confidential under one of the above (or another recognized) standards, an unbiased (i.e., not to be decided by the disclosee-examiner making the Request), efficient and confidential mechanism determines whether it is in fact so protected and should be exempted from the request for information.

2. Second General Comment: Timely Resolution of Disputes

Disagreements will inevitably arise among applicants and examiners regarding the precise scope of ambiguously phrased interrogatories and stipulations. It is requested that Rule 105 provide a mechanism for resolving such disagreements in a fair and unbiased manner. Preferably such a mechanism would be more expedient than a Petition to the Commissioner, which can cause a substantial time delay in the prosecution

of an application. Of course, an applicant should still be able to petition to the Commissioner if desired (initially and / or subsequent to a primary mechanism).

3. Third General Comment: Improper Shifting of Evidentiary Burden

It is requested that Rule 105 include a provision clarifying that requests for information may not be used to impose on the applicant a burden to initially demonstrate that a claim is patentable.

Some aspects of the proposed amendments to Rule 105 could be utilized by an examiner to eliminate the *prima facie* burden on the examiner to prove that a claim is not patentable, and instead force the applicant to prove that a claim is patentable.

For example, a first Office Action might include a request that an applicant indicate patentable differences between the claims at issue and the prior art. This would be equivalent to a request that the applicant (i) determine the scope and content of the prior art, and (ii) determine the differences between the prior art and the claims at issue. Absent an initial showing of these factors by the examiner, the request would be equivalent to a request that applicant examine the claims. However, it is well established, the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. Accordingly, a use of the rule to eviscerate the need for a *prima facie* showing would clearly be improper.

4. Fourth General Comment: Necessity of Requests

It is requested that Rule 105 include a provision clarifying that requests for information may not be made unless the requested information is “reasonably necessary” to properly examine or treat a matter in an application. Although the rule currently states that requests for information must be reasonably necessary to treating a matter in an application, the requested language would further emphasize that, absent a reasonable necessity, such a request is improper.

5. Fifth General Comment: Specificity to be Supported in Record

It is requested that Rule 105 include a provision that the record must provide support for the proposition that the particular information being requested is reasonably necessary to further examination of the application.

If the record need not demonstrate that the information is reasonably necessary, then a proper review of such a request (i.e., on Petition to the Commissioner) could at best be decided arbitrarily.

6. Sixth General Comment: Specific Reason for Request

It is requested that Rule 105 include a provision clarifying that the examiner making the request for information must explicitly articulate, based on specific facts in the record, the reason why the information is reasonably necessary. It is also requested that Rule 105 include a provision clarifying that, e.g., simply quoting verbatim the Rule or a mere conclusory statement that the information would be helpful to the examination is an insufficient articulation of the specificity required. As currently stated and under the proposed amendments, Rule 105 does not include a requirement for a specific reason why the information is being requested.

7. Seventh General Comment: Guidance on Reasonable Likelihood of Fulfillment

It is requested that guidance be provided on what types of requests under Rule 105 would not be considered to exhibit a reasonable likelihood of being readily fulfilled by the applicant.

The proposed rule makes it clear that all requests for information must “exhibit a reasonable likelihood of being readily fulfilled by the applicant” but provides no specific guidance on what types of requests would not exhibit such a reasonable likelihood of being readily fulfilled by the applicant. It is requested that the promulgation of the final rule include more guidance on this point and provide examples of requests for

information and / or circumstances under which a request would not be reasonably likely to be readily fulfilled by the applicant.

Further, it is not clear from the statement of the proposed rule whether the record must demonstrate that the request for information does exhibit a reasonable likelihood of being readily fulfilled by the applicant. Clarification is requested on this point. It is requested that the examiner be required under the rule to provide a reasoned statement in the record as to why the request for information does exhibit a reasonable likelihood of being readily fulfilled by the applicant.

8. Comments regarding the specific instances where stipulations and interrogatories may be used:

8(a). Regarding example (2) “applicant’s interpretation of the common technical features shared among all claims, or admission that certain groups of claims do not share any common technical features”

In responding to a request for this type of information, it would arguably be malpractice for applicant’s representative to do anything other than literally quote the specific language recited in more than one claim (*e.g.*, both claim 1 and claim 5 recite “a retractable mechanism for actuating said first lever” but claims 10 and 11 do not recite this feature). If such a response would not be complete and proper, it is requested that the reasons for the deficiency of such a response be articulated in the final promulgation of the rule, and further guidance be provided as to what would constitute a complete and proper response.

8(b). Regarding example (3) “applicant’s intention for the scope of structural and procedural support found in the disclosure for means or step plus function claims”

It is not clear what would constitute a complete and proper response to a request for this type of information, since the request is ambiguously phrased.

Would it be a complete and proper response to indicate the portions of the specification that disclose such structure, and to state that “equivalents thereof” are also included? Need the equivalents also be enumerated in the response? Clarification on this point is requested.

If equivalents need also be specified in the response, such a requirement would appear to go beyond the limits of applicant’s expected knowledge at the time of prosecution, as recently acknowledged by the U.S. Supreme Court (that equivalents which applicant may later be entitled to may have been unforeseeable at the time of the application). Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 62 USPQ2d at 1714.

Further, it is not clear whether citing exemplary structural or procedural support would be sufficient for a response to be complete and proper or whether each instance of structural or procedural support need be cited. Clarification on this point is also requested.

8(c). Regarding example (5) “applicant’s interpretation for the intended breadth of claim terms, particularly where those terms are not used per se in the specification”

It is not clear what would constitute a complete and proper response to a request for this type of information, since the request is ambiguously phrased. Where applicant intends a claim term to be afforded its accustomed meaning, would it be a complete and proper response to merely indicate the intention? If not, must a dictionary definition be given? If a dictionary definition is given, may it be provided as only one example of a term’s accustomed meaning?

In accordance with current principles of claim construction, discerning the usage of claim language involves determining the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art at the time of invention. See Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342 (Fed. Cir. 2001). Indeed, the Federal Circuit has held that normal rules of usage

suggest a “heavy presumption” that claim terms carry their accustomed meaning in the relevant community at the relevant time. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed. Cir. 2002) (citing Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed. Cir. 1999)). In ascertaining the accustomed usage of the relevant community at the relevant time, dictionaries and treatises may also assist the courts. Tex. Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202-03 (Fed. Cir. 2002).

Accordingly, since an examiner examining claims in a certain art unit is presumed to be skilled in the field of the invention and has access to dictionaries and treatises to the same extent as applicant, it does not appear to add to the examination process or to fulfill the goal of expeditiously prosecuting each application to request such readily available information from applicants. Examiners already have sufficient evidence available to interpret claims, and applicant’s interpretations are not of reasonable necessity. Asking for applicant’s interpretation is inefficient, non-expeditious and cannot be reasonably justified in light of what is already available to examiners in the claims, specification, dictionaries, and treatises.

8(d). Regarding example (1): “applicant’s interpretation of the distinctions among claims”

8(d)(1). Such a request is not reasonably necessary to treating a matter in an application.

It does not appear “reasonably necessary to treating a matter in an application” to request applicant’s interpretation of the distinctions among claims. In what circumstances could the applicant’s interpretation be reasonably necessary to examine claims?

Under the currently applied doctrine of claim construction, the first step is to determine the ordinary meaning of the claim terms. Tex. Digital Sys. v.

Telegenics, Inc., 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir., 2002). Dictionary definitions provide evidence of a claim term's "ordinary meaning." Inverness Med. Switz GmbH. V. Warner Lambert Ct., 309 F.3d 1373, 1378, 64 USPQ2d 1933, 1936 (Fed. Cir., 2002). The second step is to determine whether the specification or prosecution history (voluntary statements made by applicant to distinguish over applied prior art) are inconsistent with this ordinary meaning. Accordingly, unless applicant has provided statements in order to distinguish over prior art, applicant's subjective intent for the interpretation of the claims is irrelevant in claim construction. Engel Indus., Inc. v. Lockformer Co., 96 F.3d 1398, 40 USPQ2d 1161 (Fed. Cir. 1996).

8(d)(2). It is not clear what response would be a complete and proper response to such a request

In responding to such a request for information, it would arguably be malpractice for applicant's representative to do anything other than literally quote the specific language recited in one claim but not in another, and possibly any definitions of such language in the specification.

Are there any circumstances under which such a response (quoting the specific language recited in one claim but not in another) would not be appropriate? If so, what are these circumstances?

If there are no circumstances, and such a response by applicant's representative is appropriate, how could such a request further expeditious prosecution?

It appears that such a request would not provide any further information to the PTO than is already available in the claims and specification as filed. More specifically, it would be an inefficient use of time and resources on the part of the PTO and the applicant.

8(e). Regarding example (6) “applicant’s interpretation of which portions of each claim correspond to the admitted prior art in the specification”

It is not clear what the term “correspond to” means in the given example. For example, does it mean “are identical to”, “are analogous to” or something else? Clarification is requested.

Further, it is not clear whether it would be a complete and proper response to such a request to state that no portion of a claim corresponds to admitted prior art if no entire element or feature of the claim literally reads on an element of the prior art. Clarification on this point is requested.

8(f). Regarding example (7) “applicant’s interpretation of the specific utility provided by the claimed subject matter”

It is not clear what would constitute a complete and proper response to a request for this type of information, since the request is ambiguously phrased. Would it be a complete and proper response to such a request to indicate one or more portions of the specification that describe a specific utility? Would it be a complete and proper response to such a request to provide one exemplary utility of the claimed subject matter, where more than one specific utility exists? Clarification on these points is requested.

Further, it is requested that the rule include a provision that this type of request must be accompanied by examiner’s explanation of why the PTO has reason to doubt the objective truth of the statements in the disclosure of a specific utility. This would be consistent with current case law, which requires the PTO to establish a reason to doubt an invention’s asserted utility. See, for example, In Re Cortright, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir., 1999). Not requiring an examiner to provide such reasoning in making this type of request under circumstances where the written description discloses a utility would impermissibly shift the initial burden of proving utility to applicants.

9. Regarding the example of seeking stipulations as to the knowledge of those of ordinary skill in the art and on example of using interrogatories as to applicant's understanding of the knowledge of persons of ordinary skill in the relevant art.

9(a). Unclear as to what would constitute a complete and proper response

It is not clear what would constitute a complete and proper response to a request for this type of information, since the request is ambiguously phrased. Would it be a complete and proper response to reply truthfully that the applicant is not in a position to know the level of ordinary skill in the art? Would it be a complete and proper response to reply truthfully that the applicant does not hold an opinion regarding the level of ordinary skill in the art?

9(b). Request does not exhibit a reasonably likelihood of being readily fulfilled by applicant

The level of ordinary skill in the art, if and when it becomes an issue in litigation, is typically proven by extensive testimony of expert witnesses. It is a burdensome and expensive process and does not involve knowledge that is typically readily ascertainable by the inventor. Thus, it does not appear that interrogatories or stipulations regarding the level of ordinary skill in the art are the types of information that "exhibit a reasonable likelihood of being readily fulfilled by the applicant". Accordingly, it is requested that a provision be included in the rule that a response stating that the inventor does not know with certainty what the level of ordinary skill in the art is, that it would be unreasonably burdensome for the applicant to determine the level of ordinary skill in the art, and / or that applicant and applicant's representative personally believe that the knowledge in question is within the level of ordinary skill in the art be considered a complete and proper reply to such a request.

Alternatively, it is requested that the example be amended such that a request for information may seek an applicant's "opinion" rather than "knowledge" as to the level of ordinary skill in the art. If such a provision is included in the rule, it is further requested that the rule clarify that it would be a complete and proper response to reply truthfully that no such opinion is held by applicant.

November 12, 2003

Respectfully submitted,

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