

PTO-P-2005-0024-DRAFT-0001[1].txt

Comment Info: =====

General Comment: The proposed rules fail to recognize the realities of patent prosecution, and inappropriately shift the burden of examination to the attorneys and agents whose professional responsibility is to represent applicants before the office.

Patent applicants have a duty to disclose material references to the patent office.

However, the determination of whether a reference is truly material cannot be made until a reasonable patent examiner does, or does not, reject a claim based upon the reference.

It is entirely proper that patent attorneys and agents disclose potentially material references to the patent office. This is particularly so because of the tendency for litigants challenging patents to allege inequitable conduct by patent holders - a phenomenon that has been termed a "plague" by the Federal Circuit.

The proposed rules, however, would cause those representing patent applicants to face a Hobson's choice between disclosing all potentially relevant references to the patent office, and being forced, potentially, to make admissions concerning the impact of those references upon the patentability of their clients inventions, or not disclosing the reference, and potentially being charged with inequitable conduct.

It is not appropriate to place such a burden on patent practitioners. While it is reasonable for the PTO to require disclosure of potentially relevant references, it is not appropriate, and is inconsistent with the rules of professional responsibility, to require patent practitioners to take a position contra to the patentability of their clients intention by disclosing how references should be applied to the claims of the application. It is inappropriate to require practitioners to make such disclosure, because the attorneys primary duty is to represent the position of his client, not to perform the examination function that is the responsibility of the PTO.

Applicants do not control the existence of information in the prior art that might be material to, but not inconsistent with, the patentability of their inventions. Applicants also do not control the length of disclosures in the prior art that are potentially material to, but not inconsistent with, the patentability of their inventions. It is not appropriate for the USPTO to require that inventors who suffer the misfortune of having more than 20 references exist in the prior art that are potentially material as to the patentability of their inventions, or of having any one references that happens to be over 25 pages long, to be put to an extra burden of disclosure, particularly where such disclosure potentially opens the inventor to unfounded allegations of inequitable conduct.

The USPTO should retain the burden of examining applications to itself. If evaluating references disclosed in IDS statements presents an undue burden to the PTO, then there are alternatives open to the PTO to offset the burden (such as imposing a per reference charge for evaluation of cited references) where the burden imposed would be proportionate to the problem cited by the PTO (having to evaluate excess references), and would not, unlike the present proposals; shift the current role of the PTO (examining applications) to patent attorneys whose

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responsibility is to represent their clients, and promote the patentability of their clients inventions to the PTO.