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From: Salehi, Dan

Sent: Friday, September 08, 2006 3:31 PM

To: AB95 Comments

Subject: Comments of the Bar Association of the District of Columbia to PTO's Proposed IDS Rules

Dear Mr. Bernstein:

Attached please find comments of the Bar Association of the District of Columbia to the proposed IDS rules.

<<BADC's Comments to Proposed IDS Rules.pdf>>

Sincerely,

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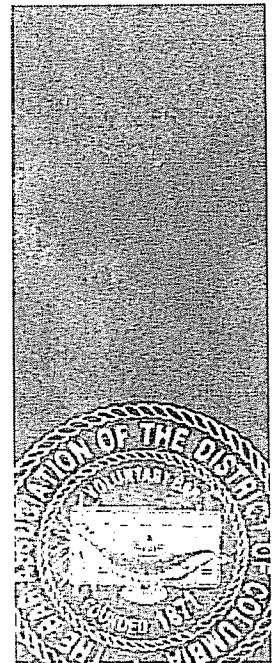
THE BAR ASSOCIATION *of the* District of Columbia

DEPARTMENT OF COMMERCE Patent and Trademark Office

Statement of the Bar Association of the
District of Columbia PTC Section concerning the proposed Modification to the Code of
Federal Regulations,
*Changes to Information Disclosure Statement Requirements
And Other Related Matters*
Rulemaking Notice of July 10, 2006, 71 Fed. Reg. 38808
Submitted September 8, 2006

The Bar Association of the District of Columbia (“BADC”) appreciates the opportunity to submit the following statement regarding the United States Patent and Trademark Office’s (“PTO”) Notice of Proposed Rulemaking appearing at 71 Fed. Reg. 38808 (2006)(to be codified at 37 C.F.R. 1.97 *et seq.*), entitled: “*Changes to Information Disclosure Statement Requirements And Other Related Matters*” (herein, “*Proposed IDS Rules*”). The *Proposed IDS Rules* contain two major components: changes to the applicant’s ability to submit an IDS during various prosecution timeframes (Section 97(a) – (d)); and changes to the substantive contents of an IDS filed at each stage (Section 97(a)(3)).

The BADC is one of the senior intellectual property bar associations in the United States. It is uniquely situated in the Nation’s capital, and has a broad cross-section of members who represent a wide range of technical and practice areas in industry, government, and private practice. Some of its members specialize primarily in patent procurement, some entirely in litigation and counseling. Others have a mixed practice, combining patent procurement with litigation, while still others may participate in patent procurement issues by advising others on strategy. Many of our members have served the PTO at a professional capacity and are intimately familiar with this agency’s mission and practice. The BADC is concerned with the efficiency and practicability of the Proposed Examination Rules as well as the effect it will have on the public’s right to



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obtain, protect, and enforce patent rights. The interest of the BADC is entirely *pro bono*, and this statement is aimed at advancing the patent profession.

The *Proposed IDS Rules* are the third set of rules proposed by the PTO this year. In January, the PTO issued two Notices of Proposed Rulemaking seeking to make major changes to the rules concerning continuation practice and the examination of claims.¹ The BADC believes that the *Proposed IDS Rules*, in combination with the *Proposed Examination Rules* and the *Proposed Continuation Rules*, represent a significant shift of the examination burden from the examiner to the applicant. Although the BADC appreciates the PTO's need to take steps to reduce its examination backlog and the burden on examiners, the BADC believes that the PTO's proposed rules, including the *Proposed IDS Rules*, unfairly prejudice applicants and will not lead to any significant improvements in examination. The BADC is also concerned that the *Proposed IDS Rules* will have a chilling effect on the *Ex Parte* examination process, particularly for independent inventors or small entities who cannot afford the costs associated with its compliance. The BADC provides some alternative suggestions to address some of PTO's concerns while protecting the rights of applicants and patentees.

The BADC does not object to many of the proposed changes to the provisions of 37 C.F.R. § 1.97 relating to the timeframes for filing Information Disclosure Statements, to the extent that the proposed rules comport with present practice and encourage the submission of references early in the prosecution stage so that they may be fairly considered during examination.

¹ Notice of Proposed Rulemaking at 71 Fed. Reg. 61 (2006)(to be codified at 37 C.F.R. 1.75 *et seq.*), entitled "*Changes to Practice for the Examination of Claims in Patent Applications*" ("*Proposed Examination Rules*") and Notice of Proposed Rulemaking, appearing at 71 Fed. Reg. 48 (2006)(to be codified at 37 C.F.R. 1.78 *et seq.*), entitled "*Changes to Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims*" ("*Proposed Continuation Rules*").

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However, the BADC has significant concerns regarding the provisions of the *Proposed IDS Rules* governing the content of Information Disclosure Statements. A principle of the *Ex Parte* examination is the applicant's indelible duty to provide the Office with relevant references. Any rule that would interfere with or have an otherwise chilling effect on this duty would fundamentally compromise the *Ex Parte* examination system. The BADC respectfully submits that the *Proposed IDS Rules* effectively deter applicants from complying with its obligation to disclose relevant prior art.

For example, the *Proposed IDS Rules* require applicants to comply with an additional disclosure requirement by filing an explanation under §1.98(a) *et seq.* if (i) the cumulative number of cited references exceeds twenty, or (ii) any submitted reference is over 25 pages long. There are many reasons why the applicant may submit more than twenty references during prosecution of an application. For example, applicant may become aware of a large number of references uncovered during litigation of a related patent or technology. References may also be uncovered during prosecution of a related application or during prosecution of an application in a similar technical area. The prevailing practice suggests disclosing all such references in order to avoid inequitable conduct allegations and in order to inform the Examiner of related references. Requiring applicants to comply with additional disclosure requirements would unduly burden applicants for events beyond their control.

Applicants also have no control over the length of an uncovered reference. Yet the Office proposes that applicants provide a thorough explanation of the reference should it exceed 25 pages. Noticeably, the drawings are considered part of the reference and contribute to the length of the reference. Many issued patents and published applications have several pages of drawings, and consequently, their submission will trigger the explanation requirement. Requiring applicants to explain all such references would unduly burden applicants for events beyond their control.

The BADC also has significant reservations regarding the provisions of the *Proposed IDS Rules* requiring an applicant to provide an explanation and/or description of the prior art (37 C.F.R. § 1.98(a)(3)(iv) and (v)) and the patentability justification (37

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C.F.R. § 1.98(a)(3)(vi)). For example, the *Proposed IDS Rules* require an applicant to provide an explanation under § 1.98(a) *et seq.* identifying the specific features, showings, or teachings that caused a document to be cited, as well as the portions of the document where such features, showings or teachings may be found. Complying with the *Proposed IDS Rules* will impose significant substantive and procedural burdens on an applicant and will require prosecutors to make statements that will inevitably create detrimental estoppels. Interestingly, such estoppel will likely be created even before prosecution begins.²

In short, the *Proposed IDS Rules* will make submission of an IDS expensive, difficult and hazardous. The consequences of submitting an IDS under the *Proposed IDS Rules* may even deter applicants from making inquiries to discover relevant prior art, thus thwarting the PTO's stated goal of strengthening patent examination and issuing better quality patents. Finally, certain independent inventors and small entities will find compliance with the *Proposed IDS Rules* cost prohibitive.

The BADC proposes that applicants be permitted to submit all references uncovered during litigation or during prosecution of related applications, whether foreign or domestic, at any time and irrespective of the number of references or the length of each reference. To assist the examiners facing a large volume of references, the BADC proposes imposing an additional surcharge to offset the additional examination time.

In addition, the BADC proposes that applicants be permitted to submit relevant art at any time during prosecution, including after payment of the Issue Fee, if the certification regarding timeliness under 37 C.F.R. § 1.97(e) can be made. Under the

² While BADC appreciates PTO's backlog, the *Proposed IDS Rules* go beyond sharing the prosecution burden with the applicant and seem to effectively require the applicant to carry the brunt of the examination process. The explanation requirement requires applicant to make legal and technical determination much of which has been the purview of the Examiner.

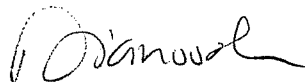
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current practice, an applicant wishing to submit art after the Issue Fee has been paid may do so by petitioning to withdraw the application from issue and filing an RCE to submit the IDS before the first Office Action. The BADC proposes that this practice be continued and the number of RCE's filed under such circumstances not be limited.

In conclusion, the BADC applauds and supports the PTO's initiative in drafting the *Proposed IDS Rules* and for its efforts in improving the examination process. It is this Association's sincere hope to assist the PTO in its endeavor while preserving applicants' right to a fair and efficient prosecution. The BADC would welcome any opportunity to assist the PTO in this endeavor.

Respectfully Submitted,



Dianoosh Salehi, Patent Committee *Chair*
Joslyn Barritt, Patent Committee *Vice Chair*
Anthony W. Kandare, PTC Section *Chair*