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From: Steve Cahill

Sent: Friday, September 08, 2006 8:08 PM

To: AB95 Comments

Subject: Comments on Proposed Changes to IDS Rules

To the U.S. Patent Office:

The proposed changes to the IDS rules (37 CFR 1.97 and 1.98) would allow a patent applicant to submit as many as 500 pages of documentation in an IDS before the first office action without any explanation, as long as the 500 pages are located in no more than 20 different documents, and none of the documents has more than 25 pages. Yet, the proposed new rules would require an applicant who submits in an IDS a total of only one single document having only, e.g., 26 pages to provide an explanation, including (1) an identification of the relevant features, etc. that caused the document to be cited and a representative portion of the document where the features are found; and (2) a correlation of the relevant features to specific claim language or a specific portion of the specification.

These proposed rules are unfair, because they arbitrarily require a significant amount of extra work from an applicant who happens to discover relevant prior art information in a document having more than 25 pages. Why penalize applicants based on the length of one particular document submitted in an IDS? The burden on a patent examiner in reviewing documents submitted in an IDS is proportional to the total number of pages in all of the documents submitted in the IDS, not just to any one particular document. It would be more fair to applicants and examiners to base any changes to the IDS rules on the total number of pages in all documents submitted via an IDS, rather than on the length of individual documents submitted in an IDS.

With respect to proposed rule 1.98(a)(3)(v), it is not clear what would satisfy the requirement of a non-cumulative description. Would it be sufficient for an applicant to identify a feature or teaching in a newly cited prior art reference and state that the feature or teaching is not disclosed in previously cited references?

Or would an applicant be required to provide a detailed description of how a feature or teaching in a newly cited prior art reference is different from the disclosure in each previously cited prior art reference? This latter type of requirement may necessitate an extensive

discussion comparing prior art references to each other. It is not clear why such a requirement is necessary, or how such a discussion would benefit a patent examiner in examining the claims.

Thank you,

Steven Cahill