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From: Michael Morgan

Sent: Wednesday, September 06, 2006 3:33 PM

To: AB95 Comments

Subject: Comments on Notice of Proposed Rule Making: "Changes to Information Disclosure Statement Requirements and Other Related Matters"

Via e-mail to AB95.comments@uspto.gov

Hiram H. Bernstein
Mail Stop Comments-Patents
Commissioner for Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

Dear Sir,

Attached are the comments from Colgate-Palmolive Company with regard to the proposed rule making for Changes to Information Disclosure Statement Requirements and Other Related Matters.

Respectfully submitted,

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September 6, 2006

Hiram H. Bernstein
Mail Stop Comments
Commissioner for Patents
United States Patent and Trademark Office
P.O. BOX 1450
Alexandria, VA 22313-1450

Re: Comments on Notice of Proposed Rule Making: “Changes to Information Disclosure Statement Requirements and Other Related Matters”
Federal Register/Vol. 71, No. 131/Monday, July, 10, 2006/pp. 38808-38823

Colgate-Palmolive Company appreciates the opportunity to offer comments on the above mentioned proposed rule. Comments are provided regarding the inequitable conduct standard and the conflict in the materiality standards used by the courts and the Patent and Trademark Office (PTO). Additionally, comments are provided for qualifying when the additional disclosure requirement applies to specific situations and setting a standard for the amount of subject matter contained on a page.

Conflict in Materiality Standard

The PTO is proposing a safe harbor under 37 C.F.R. §1.56(f) in an attempt to shield practitioners from claims of inequitable conduct when complying with the proposed regulations. The PTO recognizes that a court is not bound to follow this safe harbor, and thus there is no guarantee to applicants and practitioners that the safe harbor will be effective.

Earlier this year, the Court of Appeals for the Federal Circuit revisited the inequitable conduct standard in *Digital Control, Inc. v. Charles Mach. Works*, 437 F.3d 1309 (CAFC 2006). In this case, the court provided a brief history of the inequitable conduct doctrine and the tests for materiality. *Id.* at 1314-1316. Four tests for determining the materiality standard for inequitable conduct were discussed. They were:

objective but for – where the misrepresentation is so material that the patent should not have issued;

subjective but for – where the misrepresentation actually caused the examiner to approve the patent application when he would not otherwise have done so;

but it may have – where the misrepresentation may have influenced the patent examiner in the course of prosecution; and

37 C.F.R. §1.56 – where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent. *Id.* at 1315.

The court went on to state that even though the PTO's reasonable examiner standard became the dominant standard invoked by this court, in no way did it supplant or replace the case law precedent. Rather, it provided an additional test of materiality, albeit a broader and all-encompassing test. Similarly, the PTO's recent adoption of an arguably narrower standard of materiality does not supplant or replace our case law. *Id.* at 1316.

Because the court states that the PTO's standard does not supplant or replace case law, patent applicants are still bound by the broader tests for materiality. Even though it appears that the PTO does not want to review material within this scope but which is outside of the scope proposed by the PTO, applicants still have a duty under the broader standard to submit it.

The broadest standard is the "but it may have" test. The inquiry is whether a patent examiner may be influenced. While this is a test developed by the courts, the PTO is in the position of defining how examiners review applications and what influences an examiner.

A stronger safe harbor could be crafted to define that an examiner would never be influenced by a reference that is outside of the scope of the standard set forth by 37 C.F.R. §1.56. It would be more difficult for a court to state that a reference may have influenced an examiner when there is an express prohibition against an examiner considering such reference as material.

While a safe harbor provision might be workable, the conflict in the standards applied by the courts and the United States Patent and Trademark Office should be resolved. The best way to resolve this conflict would be to codify a standard. Once codified, the standard would be universally applicable to the courts and the United States Patent and Trademark Office. Setting the standard is left for its own debate.

Abstracts

The proposed rule will require additional disclosure for each document to be provided when there are more than twenty (20) documents cited in the application. This will aid the examiner in reviewing all of the documents. Under the proposed rule, an abstract is not excepted from a document type that counts towards the twenty (20) document trigger and from being subject to additional disclosure.

Abstracts by their very nature are short and concise. They are not amenable to further explanation as is proposed by the current rule without just repeating the abstract. There is no benefit to having abstracts subject to the additional disclosure requirements.

It is proposed that abstracts not be subject to the additional disclosure requirements of the proposed rule. Also, because abstracts are already a short summary, they should not count toward the threshold number of documents that triggers the additional disclosure requirements.

Related applications

In the proposed rules, a foreign issued search or examination report can be submitted instead of an additional disclosure description. A similar alternative should be used for U.S. issued office actions in related applications.

Receiving an office action in a related U.S. application is the same as receiving a search report from a corresponding foreign application. Just like citing the foreign search report and the references cited in the report, a copy of the Notice of References Cited and the Office Action from one application can be cited in the other related applications. Also, just like the references cited in the foreign search report, the references cited by the United States Patent and Trademark Office in a related application should not count toward the threshold number of documents.

To reduce the amount of paper that is cross submitted in related applications, the rules can be amended to state that actual copies of Office Actions and Notices of References Cited from related applications do not need to be provided. The Office Action and Notices of References Cited can be cited in an information disclosure statement, and the copies can be reviewed in the Image File Wrapper (IFW) system. This situation is identical to the situation in which the specification of a U.S. patent application is cited, but a paper copy does not need to be provided when the application is available in the IFW system (37 C.F.R. §1.98(a)(2)).

Related applications should be defined to include continuation, divisional, or continuation-in-part applications under 35 U.S.C. §120 as well as applications not related under 35 U.S.C. §120 but which are subject to an obviousness type double patenting rejection over a copending application. In the obviousness type double patenting rejection scenario, the United States Patent and Trademark Office is making an assertion that the claims in the applications not linked by continuity under 35 U.S.C. §120 are not patentably distinct. Therefore, the art cited in one application may be material to the other application.

Twenty-five (25) page standard.

The proposed rule requires that any English language document or translation of any foreign language document of 25 pages or more is subject to the additional disclosure requirement. Clarification is needed as to what a page is that counts towards the 25 page trigger, and how much subject matter is on a page. The following points should be considered when setting a page standard.

- a) It is recognized that one page of a WO publication typed in 12 point font at 1½ line spacing with one inch margins, or a similarly typed document, contains less subject matter than one page of a U.S. patent or patent application publication. The trigger requirements should be based on a set amount of subject matter. Based on the set amount, there should be individual page trigger requirements for different types of documents. Also, for translations or similarly typed documents, a page needs to have the margins, font type, font size, and line spacing specified to define the page.
- b) Sheets of drawings should not be counted in the page total. They do not contain the same amount or type of subject matter as a page in the specification.
- c) For any non-U.S. patent or patent application publication, search reports should not be counted in the page total. They do not contain the same amount or type of subject matter as a page in the specification.

- d) For U.S. patents, Certificate of Corrections should not be counted in the page total. They do not contain the same amount or type of subject matter as a page in the specification.
- e) For any U.S. or non-U.S. patent or patent application publication, the bibliographic first page should not be counted in the page total. While the bibliographic page contains an abstract, it does not contain the same amount of subject matter as a page in the specification.

We appreciate the opportunity to provide comments on these proposed rule changes. Should there be any questions regarding the above comments, please contact us at the address above.

Respectfully submitted,



Michael F. Morgan
Colgate-Palmolive Company