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To: AB95 Comments

Subject: Comments on Proposed IDS rule change

The USPTO seeks to change the information disclosure statement (IDS) rules. However, the stated aim “to improve the quality and efficiency of the examination process” will not be advanced by the rule change.

This change drastically increases the burden on the Applicant to disclose the relevancy of art cited. For example, once 21 articles are cited, a statement concerning the relevancy of all articles must be submitted. A rule that so dramatically increases the burden on an Applicant, must also result in equally significant attempts to obviate that burden. As a result, the effect of the rule may be to reduce the total number of articles cited to the Examiner. A reduction in the overall number of articles cited will not help the Examiner in his duties. Further, the rule change is heading in the opposite direction to the process currently being used overseas. The rule change seeks to present the Examiner with an interpretation of the relevant art rather than improving the tools available for the Examiner to search and compare relevant art lists. As a result, the rule change will hinder the examination process.

Effect of Reducing the Art Cited to the Examiner

The requirements of novelty and non-obviousness underlie the conditional nature of the granting of a patent. The information that the Examiner must have available, in particular for obviousness rejections requires a thorough understanding of the art in the case. Therefore, it follows that the Examiner needs to have **ALL** the art in order to modify what is taught or disclosed in one piece of art to meet the claims in question. The Examiner must also be in a position to point to “a motivation or suggestion to combine”. Both these responsibilities require access to an extensive range of relevant art. Any rule that seeks to reduce the art available to the Examiner can only restrict the Examiner in fulfilling his responsibilities.

Investigate Other Alternatives

This rule change comes at a time when the USPTO is laboring under a significant backlog of applications. No other foreign patent office is in a similar predicament despite significant increases in the number of patents processed. The background to the rule change is silent on what investigation the USPTO has carried out of foreign patent office art collating systems. Such an investigation should be carried out before implementing wholesale changes in the current system.

Recently, the EPC made efforts to improve the search facilities. However, they did not introduce a burden on the Applicant to disclose the relevancy of each and every cited article above a set limit (or a burden on references cited which contained more than a set page limit). The USPTO seems to be ignorant of the recent changes in the availability of art using electronic search tools which is the basis for the EPC ‘BEST’ program. Similarly, the USPTO leadership does not seem to have considered the possible synergies

which led the EPC to assign one person to be responsible for searching the art and examining an application. Rather than using the synergy in a constructive manner, the USPTO seems determined to make the Examiner's job as onerous and difficult as possible.

Foreign patent office search facilities have a proven track record of consistently citing relevant art. Amazingly, this is without *ANY* requirement on the Applicant to make a disclosure of relevant art. Despite this proven track record, the USPTO seems reluctant to investigate other countries art collating practices.

Alternative Proposal

The current US requirement to list all relevant art could actually be a very valuable tool.

An Examiner could use such a list to compare the results of an electronic search for completeness and thoroughness. Given the electronic nature of most of the references and the current ability of search routines to select through extensive lists, much of the searching could be accomplished using semi automated algorithms. Using such tools, the Examiner would be able to tell if the relevant art had been cited in an IDS and more pointedly, what relevant art had not been cited. This might be of increasing concern as the number of articles submitted in the IDS increased. The Examiner could also use the IDS to determine what art his search did not return. In this way, the Examiner could use the comparison to know when to stop looking for relevant art. Naturally, the Examiner should not be subject to the requirement that he attest to having read all articles submitted on such an IDS list. However, simply as a check or to act as an aid in comparing the thoroughness of the search, a complete IDS list could prove extremely useful. As the European's have found, there is significant synergy with the searching task and the examination task.

Currently, the USPTO rule change seems determined to make wholesale changes rather than looking for creative solutions that will really minimize the Examiner's work load. Placing a burden on the Applicant that will only reduce the art cited will not improve the quality and efficiency of the examination process. Rather, giving the Examiner the resources to compare his search with the IDS list can improve the quality and efficiency of the examination process.

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