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**To:** comments@uspto.gov; AB95 Comments

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**Subject:** Comments of Steven M. Hoffberg re: 37 CFR Part 1; [Docket No.: PTO-P-2005-0024]; RIN 0651-AB95

Hon. Commissioner:

The U.S. Patent and Trademark Office (USPTO) continues to propose new initiatives which it alleges will make its operations more efficient, and ensure that the patent application process promotes innovation, and to improve the quality of issued patents.

These comments address whether the proposal of the USPTO is rationally related with achieving these goals. As set forth in more detail below, it is respectfully submitted that the proposal will not make the USPTO more efficient, using a reasonable definition of that term, will not promote progress, and will not increase the quality of issued patents. Therefore, the proposed rules should be withdrawn.

It is noted, as an initial premise, that US patent examiners are presumed to review ALL relevant art, at least to the extent that it is in the form of properly classified US patents, within the principal search classes into which the invention is classified. It has become apparent, that such review is becoming increasingly difficult. Certainly, the presentation of additional prior art to the Examiner will not make the examiner's job easier, unless that prior art invalidates the claims, which presumably would not typically be expected to be the case. Since the information disclosure process is now REQUIRED by USPTO rules, it is disingenuous for the USPTO to also claim that represents an undue or unfair burden on the Office. Rather, it is a necessary part of the examination process, and not one which can be simply transferred to applicant by interpretive rulemaking.

In fact, even massive information disclosures provide the Examiner with a body of relevant prior art, which, even in the most extreme cases, represents far fewer references than are available within the designated search classes, and on the whole, are likely more relevant than the unfocused search. Examiners are trained to quickly review the art, whether it be in patent databases, or in non-patent literature, and therefore the excess burden on an Examiner is not clear, especially as compared to identifying such references de novo if not voluntarily presented.

While it might be reasonable to assume that redundant or irrelevant art is de facto an unfair and unnecessary burden on the examiner, experience indicates that it is not easy, for Examiners, Applicants, or the Courts, to ascertain a priori what would be considered irrelevant, and what threshold to apply to similar references to make a determination of redundancy. In fact, it is the undersigned's experience that even two different examiners do not interpret the same reference or claims the same way, and even a single examiner does not treat the same reference or claims the same way over time. Given these significant uncertainties, and the significant legal prejudice to applicant, the proposed rules provide no good standard for implementation, and are therefore vague and indefinite.

The best argument in favor of the rules is that they seek to discourage the submission of prior art to the USPTO, which results in a reduced burden on the Examiner in reviewing this prior art which he or she does not care to see. However, the USPTO, as an administrative agency under the Commerce Department, has neither the power nor the authority to create punitive sanctions. Yet, when one reviews the proposed rules, the USPTO does not assert that Examiners will review or be benefited by the newly required explanations of the prior art references, and if reviewed,

that this will increase their efficiency, promote innovation, or improve the quality of issued patents. In fact, one could argue that, since the Examiner's will be required to review the references in any case, the newly required descriptions of the references will simply amount to an added burden on the Examiners.

It is also noted that in some cases, documents supplied to the USPTO are not themselves prior art, but are relevant to the examination. For example, applicants will sometimes cite non-prior art documents as supporting evidence of claim language interpretation. Likewise, documents may be presented to provide context to the examiner as to what applicants believe to infringe the patent. Further, non-prior art reference might be cited to provide search clues to the Examiner, including but not limited to information which might assist an examiner in unearthing secret (unpublished) USPTO files. The proposed rules would essentially prohibit presenting such information to the Examiner.

The proposed rules apparently do not seek to encourage cooperation between applicant and examiner in the form of full disclosure, but rather to strictly limit disclosure to a very few documents which have fully explainable and concrete relevance to the claims as they exist.

In the preamble to the proposed rules, the USPTO states that the new proposed IDS rule changes would encourage patent applicants to provide the USPTO the most relevant information related to their inventions in the early stages of the review process. As a result, patent applications could be processed in a more streamlined and effective manner. However, there are already rules in place seeking to encourage early disclosure of known most relevant prior art. While current rules do not seek to limit the number of references disclosed. That is, the proposed rules seek to discourage disclosure of references other than those deemed "most relevant."

The USPTO observes that: "...some applicants send a very large number of documents to the examiner, without identifying why they have been submitted, thus tending to obscure the most relevant information. Additionally, some applicants send very long documents without pointing out what part of the document makes it relevant to the claimed invention. Sometimes applicants delay sending key information to the examiner."

The difference of opinion between the undersigned and USPTO management is how to address this possible inefficiency. One way is to change the applicable rules, especially Rule 56, to provide that applicants are obliged to disclose only references which could reasonably be interpreted to counter applicant's or examiner's asserted position, such as disclosure of an element of the claims which is asserted by either to be absent from the art, or which supplies a missing motivation, but only at the time it becomes apparent that such information is actually material to an assertion. While this process would not necessarily provide these references at commencement of examination, and perhaps require an additional consideration of the claims by the Examiner, it would alleviate what is currently expressed as a significant burden on the Examiners. In fact, it would appear that it is the very demand for early initial disclosure of all references which might be deemed material by an examiner (regardless of the actual standard applicable today, since the USPTO has expressed a substantial willingness to change longstanding rules and policies), that has created the very problem confronted by the USPTO.

It is difficult to imagine how intentionally limiting the variety of prior art available to the Examiners would improve patent quality. While a good faith description of only the very best references would provoke many applicants to draft better claims, and would possibly provide examiner's with useful art for formulating rejections, the process as proposed by the USPTO would dramatically increase costs and legal prejudice to applicants, with potentially higher burden than that imposed on the Examiners and the USPTO. That is, the cost of preparation of the required IDS may exceed the cost of the Examiner in reviewing the documents received. Since the examination burden is on the USPTO, not applicant, shifting the burden in this way that imposes a substantial cost on applicant, without any reduction in fees paid to the USPTO, is unfair.

IDS's serve another purpose, clearly ignored by the USPTO. That is, the cumulative IDS's provide a vast repository of classified prior art, available to both examiners and the public. To date, the USPTO has limited cross referencing of IDSs on its web site to issued US patents only; however, this situation need not persist, and indeed, it would promote innovation and the issuance of valid patents if the USPTO encouraged exploitation of this national resource, rather than seeking to destroy it by "discouraging submission of information that is unimportant or does not add something new for the examiner to consider."

One particular negative impact of the new rules is that they would substantially discourage searching of prior art by applicants, since the result of a comprehensive search is an inordinate disclosure burden. Thus, instead of encouraging applicants to participate in the process to assist the examiner in unearthing the most relevant art, the rules will discourage such activities. This, in turn, will reduce patent quality and discourage innovation.

The foregoing represents the opinion solely of the author, and not the position of any organization or client thereof.

Respectfully Submitted,

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