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Subject: RIN 0651-95 (Docket P70-P-2005-0024)


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PATENTS, TRADEMARKS, COPYRIGHTS & UNFAIR COMPETITION

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September 8, 2006

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Re: Comments Concerning Notice Of Proposed Rule Making
Docket No.: P70-P-2005-0024
RIN 0651-AB95
Changes To Information Disclosure Statement Requirements
And Other Related Matters

Lerner, David, Littenberg, Krumholz & Mentlik, LLP ("LDLKM") respectfully submits the comments below with respect to the above-referenced Notice of Proposed Rule Making.

LDLKM is the largest intellectual property law firm in New Jersey. LDLKM includes over sixty lawyers, the vast majority of whom are registered to practice before the United States Patent and Trademark Office (the "Office"). LDLKM represents diverse clients ranging from individual inventors to some of the largest corporations in the world, both before the Office and in the courts, and represents both patentees and parties accused of infringement. LDLKM, therefore, is cognizant of the interests of parties with diverse interests in the patent system. However, the present comments are offered solely on behalf of LDLKM and should not be construed as reflecting the views of any client of LDLKM.

It is respectfully submitted that the requirement for a "non-cumulative description" as set forth in proposed Rule 1.98(a)(3)(v) will impose an unnecessary burden on applicants and examiners. In essence, the requirement for an "explanation" in the immediately preceding proposed Rule 1.98(a)(3)(iv) imposes requirements similar to the requirement for a "concise explanation of the relevance" of each reference under the rules which applied prior to 1993. 37 C.F.R. § 1.98(a)(3), as amended 57 Fed. Reg. 2035 (Jan. 17, 1992). Our experience under the old rule was that the requirement to prepare an explanation of the relevance of each reference, and the cost of preparing such an explanation, provided a substantial deterrent against mass citation of references. The requirements for an explanation under the proposed rule will have a similar deterrent effect.

The requirement to prepare a "non-cumulative" description would add substantially to the burden of preparing an Information Disclosure Statement in a complex case where more than twenty references might be required. Under this requirement, once an applicant

has found a reference which appears to have some pertinent disclosure, the applicant must now screen through all other references of record to assure himself or herself that such pertinent disclosure is not found in any other reference of record. Moreover, the applicant must make representations about comparison between one reference and other references. Despite the proposed "safe harbor" of proposed Rule 1.56(f), these additional representations are bound to be questioned in litigation, thus further adding to the burden and cost of patent litigation.

The explanation required by proposed Rule 1.98(a)(3)(iv) may be useful to examiners in resolving the real issues of patentability to be addressed in an application. The information to be provided in a "non-cumulative description" has no utility whatsoever in dealing with the real issues, but is used only to determine whether or not one should allow entry of a prior citation. The burden on applicants provides little or no benefit to the PTO.

If the requirement for a "non-cumulative description" is not deleted in its entirety, then the same should be applied only in those cases where the explanation under Rule 1.98(a)(3)(iv) is the same, or substantially the same, for two or more references. The case pointed out in the explanation of the proposed rule changes at 71 Fed. Reg. 38816, where "documents could be merely cumulative notwithstanding the presence of two different explanations," addresses a theoretical problem. It presupposes that an applicant would deliberately waste his or her own time and money to propose different explanations for documents which the applicant believes to be cumulative.

It is additionally respectfully submitted that the requirement for a "correlation" of specific teachings to "corresponding specific claim language" of portions of the specification under proposed Rule 1.98(a)(3)(iv)(B) should be clarified to state that the requirement for a correlation is satisfied by a statement that the specific features showing the teachings are believed "pertinent to" specific claim language. The purpose of an explanation is to point the examiner to those teachings which are relevant to the claim language. The applicant should not be forced to admit that teachings in the reference "correspond" to language in the claims. Additionally, the rule should include a provision that the explanation in an Information Disclosure Statement does not constitute "admitted prior art," or an admission as to what the reference, properly considered as a whole and without benefit of hindsight, would have taught to a person of ordinary skill in the art. Such an explanation necessarily is composed in hindsight in order to select those teachings of the reference which appear to be pertinent.

Proposed 37 C.F.R. § 1.291(b)(3) should be modified to provide an additional option where an applicant received unsolicited information and provided consent to a protest under § 1.291(b)(3)(ii), but the third party did not file a protest. In that circumstance, the applicant should be permitted to submit the third party information as a protest on behalf of the third party regardless of whether the information meets the requirements of § 1.291(c). The option to submit the third party information as a protest provided by proposed Rule 1.291(b)(3)(iii) only allows the applicant to submit the third party information as a protest on behalf of the third party if the third party information meets the requirements of § 1.291(c). An



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applicant who receives a massive third party citation and exercises the requirement to provide consent may be placed in an untenable position if the third party does not file a protest. Either the applicant must wade through all of the information provided by the third party and compose a proper Information Disclosure Statement (assuming that he or she could do so while still meeting the requirements for non-cumulativeness), or else allow the patent to issue without the examiner ever being placed in possession of the information received from the third party.

It is respectfully requested that the foregoing comments be considered.

Respectfully submitted,

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