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From: Mary Aburto

Sent: Friday, September 08, 2006 5:52 PM

To: AB95 Comments

Cc: Tom Riley

Subject: Comments Regarding Proposed Rule Changes

Attached herewith, please find "Comments Regarding Proposed Rule Changes," with regard to changes to Information Disclosure Statement requirements and other related matters in connection with 37 CFR Part 1.

[Docket No.: PTO-P-2005-0024]

RIN 0651-AB95

Thank you for your consideration and attention to this matter. Regards, McCracken & Frank LLP.

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**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Mail Stop Comments - Patent
Commissioner for Patents
P.O. Box 1450
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COMMENTS REGARDING PROPOSED RULE CHANGES

Sir:

Please enter into the record and consider the following comments regarding the notice of proposed rulemaking reported in the Federal Register, Vol. 71, No. 131, on July 10, 2006, entitled Changes To Information Disclosure Statement Requirements and Other Related Matters.

Arguments against Proposed Rulemaking Regarding IDS Submissions

As recently suggested by the Patent Office itself, it is clear that there is a severe problem looming for the United States patent system with respect to the rapidly growing backlog of pending patent applications. Simply put, the capacity of the examination corps is inadequate to meet the increased and continually increasing volume of patent applications sought in the United States. Although steps to require IDS submissions and then control the volume of IDS submissions from applicants have already been made and are continually being considered, such steps are not a realistic solution within the framework set out by the Congress to promote the development and dissemination of knowledge in the United States through the patent system. Rather, limiting the volume of patent submissions counters the goal of promoting the progress of science and the useful arts as set forth in Article I, Section 8 of the Constitution. Therefore, possible solutions to the growing pendency problems should focus on increasing the capacity of the examination corps rather than limiting the volume of patent applications and IDS disclosures submitted by applicants. Set out below are arguments against implementing the proposed rules regarding Information Disclosure Statement submissions and a suggested alternative.

I. The proposed rule changes will place a disproportionate burden on some applicants that contradicts the statutory entitlement to a patent if an invention meets the statutory requirements.

The proposed rule changes will make it unduly burdensome for many inventors to obtain patents due to greatly increased costs associated with preparing and submitting required information. The Office has summarily and arbitrarily chosen the proposed number of twenty documents based on a statistical analysis that shows that eighty-five percent of applications cite twenty or fewer documents without considering the effect that the added burdens will cause to the remaining applicants. The supplementary information that was provided by the Office with the proposed rule changes suggests that about fifteen percent of applicants will be required to supply “additional disclosure” due strictly to the number-of-documents requirement, which does not include applicants that will be affected for citing foreign documents or “large” single documents. However, the Office’s proposal does not address the fact that the additional disclosure requirement will increase the costs associated with preparing and filing IDS’s to thousands of dollars in most of the applications of that fifteen percent. This additional cost in at least some instances will prevent inventors from being able to pursue patent protection for their inventions, and in all cases presents an added burden on any applicant that is unfortunate enough to be aware of large volumes of potentially relevant prior art, foreign documents, or any document that has more than 25 pages, that other applicants will not have. In addition, the proposed 25 page limit for a single document will arbitrarily and unfairly place a disproportionate burden on many applicants in certain fields, such as the biotechnical and pharmaceutical arts, many of which are small start-up companies without large assets to pay for the added burden.

As stated by Congress in 35 U.S.C. § 102, however, every inventor is entitled to a patent if the invention meets certain requirements. Ignoring the right of fifteen percent of the applicants by requiring burdensome additional costs not required of other inventors contradicts our nation’s basic notions of fair play and equal justice under the law. Lastly, the 25 page limit ignores the reality that certain documents, such as PCT publications, are longer based on formatting but add no real burden to an examiner.

II. The proposed rule changes are contradictory to the law regarding the burden of proof.

The proposed rule changes would unlawfully shift the burden of proving that an invention is patentable to the applicant. The law is clear that an inventor has a right to claim and protect what he or she thinks is patentable in an invention unless the Patent Office can show reasons to deny that claim. It is for this reason that the Patent Office has the initial burden of searching, examining, and establishing a *prima facie* case of unpatentability against the applicant's claims before the applicant's burden of surmounting the examiner's basis of rejection arises. However, requiring applicants to anticipate what rejections the examiner might make, provide additional disclosure and, perhaps arguments before possibly knowing what the examiner considers material, effectively shifts the burden to the applicant to prove that the claimed invention is patentable before the examiner ever makes the initial *prima facie* showing of unpatentability. Therefore, the proposed changes are contradictory to the law.

III. The proposed rule changes are potentially harmful to the patent system by creating an examination environment that will likely produce more patents that are subsequently found invalid by the courts.

By requiring the applicants to anticipate what the examiner is likely to identify as "material" before the fact, the proposed rule changes effectively require the applicant to do the examiner's job. The rule changes would require the applicant to pre-analyze each document, decide its relative relevance versus other art and whether to even cite the document, point out all the relevant portions in the document, and frequently, provide reasons why the claims are patentable thereover. It is not unlikely that the reality of such a practice would become harmful to the process by causing the applicant to take on the role of the examiner and discouraging independent analysis of documents by the examiner. In view of the inexorable increase in patent filings, the constant or increasing pressure on the examiner will foreseeably encourage increased reliance on the explanations and documents submitted by the applicant in order to simply save time. Such practice is likely to have more patents issue that are subsequently found invalid by the courts on documents that should have been identified and independently considered by the examiner.

Further, a process that causes the applicant to make examination-like decisions, descriptive summaries (and consequently admissions and omissions), and anticipatory arguments about documents that may or may not even be necessary is likely to produce more errors that could potentially invalidate a patent after issuance. Specifically, an error made by an examiner in a description or argument is not subject to being considered a fraud upon the Office that could cause the patent to be invalid. However, every statement or omission by an applicant is subject to close scrutiny for accuracy, completeness, and any of a myriad of contrived "frauds" during subsequent litigation in an effort by an accused infringer to invalidate a patent. The only practical way for applicants to reasonably avoid such future pitfalls is by saying as little as possible and relying on the examiner to conduct the examination with his/her independently identified documents plus all the potentially relevant art known to any person having a Rule 56 duty of disclosure. Requiring applicants to anticipate what is "material" to an examiner in order to maintain some control on IDS preparation fees or else provide detailed explanations regarding applicability of a document will only provide more material for subsequent litigators to sift through to discover reasons to claim fraud upon the Office. Thus, it is very possible that the patent process as a whole would be degraded by issuing more invalid patents. Therefore, it is better for the patent process as a whole to reduce the burdens placed on applicants to pre-examine documents to make examiner-like decisions regarding what is or is not "material" and leave those burdens where they are designed by law to lie, with the examiner.

IV. A possible alternative would be to charge a per-document fee for independently identified documents over a certain number in order to pay for the cost of increasing the capacity of the examination corps.

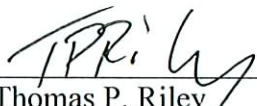
Although the undersigned have no wish to further increase fees that clients must pay to the Office during the life of an application, it is also understood that the Office needs some way to manage the volume and extent of the search and examination process. Therefore, one possible alternative solution to the problems currently faced by the Office might be to charge a reasonable per-document fee for any documents over a certain number that are cited by an applicant. Those documents cited by another examination entity or revealed by a potentially adverse party would appropriately not incur any such fee.


Fees designed to increase efficiency of the United States patent system should **only** be imposed if indeed the proceeds are so employed. Accordingly, this proposal would **only** be effective and should only be imposed if the Patent Office concurrently increases the **capacity** of the examination corps to handle the increasing volume of applications. In this manner, the Office could use those additional fees to justify allowing examiners to spend more **time** examining the documents submitted while at the same time hiring additional examiners to **make** up the difference in examination times.

Respectfully submitted,


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September 8, 2006

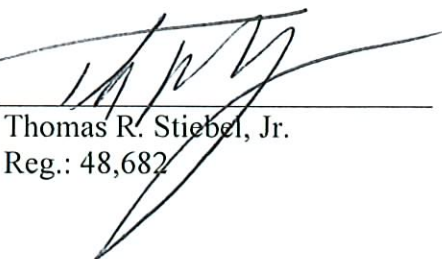
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