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**From:** Rick Rezek

**Sent:** Monday, August 14, 2006 4:54 PM

**To:** AB95 Comments

**Subject:** Proposed changes to IDS practice

The federal register notice discusses the burdens on examiners when large IDS's having "irrelevant," "marginally relevant," and "cumulative" documents are cited. The notice states "[t]he proposed changes provide an incentive to the applicant to cite only the most relevant documents, and are designed to provide the examiner with useful and relevant information early in the examination process." The notice lacks any discussion of inequitable conduct (except for a citation to a case holding that submission of large IDS's to intentionally bury a particularly material reference can be probative of bad faith). I am left to wonder how it is that we are going to discern between references that are "most relevant" and one that are "marginally relevant." 37 CFR 1.56 uses the term "material to patentability" and doesn't have any discussions on gradations of relevancy and how a patent practitioner (or inventor) is supposed to properly grade the relevancy of references.

37CFR1.56(f) adds a "reasonable inquiry" requirement that requires both inquiry and compliance with disclosure requirements (of Section 37CFR1.98(a)) that add a burden not previously required. The burden is substantial and without justification. For the reasons that follow with respect to 37CFR1.98(a)(3), it is not clear how compliance with such burden can be achieved in at least some of the possible scenarios facing attorneys.

37CFR1.98(a)(3)(iv)(A) Identification requires identification of the features that caused citation of a document. If the document was cited, for example, in an international search report these features were likely not explained by the citing authority and may not be known to the attorney or applicant. Will applicant be able to satisfy their rule 56 duty by citing the document and just stating that the document is, for example, an "A", "X" or "Y" document?

37CFR1.98(a)(3)(viii)(A) Exceptions relieves applicant from the Identification requirements only if the citation is within three months of the foreign search or examination report. If the IDS is not filed within the three months it may not be possible for applicant to meet the Identification requirement and his rule 56 duty. If the three month period is missed satisfaction of the identification requirement, if possible, can impose an undue burden on applicant to try to identify the features that caused citation of the document.

37CFR1.98(a)(3)(iv)(B) Correlation requires correlation of the features identified in 1.98(a)(3)(iv)(A). This is problematic for the same reasons as noted above with respect to 37CFR1.98(a)(3)(iv)(A) Identification, e.g., the features are often not explained by the citing authority and may not be known to the attorney or applicant. 37CFR1.98(a)(3)(viii)(B) Exceptions relieves applicant from the correlation requirements only if the citation is within three months of the foreign search or examination report. If the IDS is not filed within the three months applicant has same problems as noted above with respect to 37CFR1.98(a)(3)(iv)(A) Identification.

37CFR1.98(a)(3)(v) Non-cumulative description requirement would require an explanation of how each document cited in an IDS is different from each other document cited in that IDS and each other document of record (e.g., cited by the examiner) in the application. This is a substantial amount of work and will add to the applicant's expense without commensurate benefit to the examiner. Is the examiner really going to read all of this additionally required information? Probably not, the examiner may review the reference but likely not the explanation of why the reference is not cumulative of each other citation. This requirement will

encourage attorneys to either cite portions of prior art that are not material or to not cite the prior art at all. Both practices can be dangerous to attorneys and their clients.

37CFR1.98(a)(3)(vi) Patentability justification will, if implemented, likely result in attorney comments on the prior that parrot terminology from the prior art so as to limit file wrapper estoppel. The examiner will have to review the attorneys parroting of the prior art and the prior art. Thus, more work for the examiner and attorney with not much, if any, benefit for either. Also, at the point an IDS is submitted often the patentability issues are not apparent. That is, the examiner has not completed a search and to expect the attorney to identify patentability issues when there has not been a complete search is unduly burdensome and possible harmful as needless file wrapper arguments may result.

37CFR1.98(a)(3)(vii) Meaningful compliance gives the examiner unrestricted discretion to disregard an IDS. An applicant may make a good faith effort to provide an IDS only to find the IDS being refused. The standard for refusing consideration of an IDS is not clear so as to avoid abuse.

37CFR1.98(a)(3)(xi) Translations appears to require translations of foreign documents (e.g., is this what "readily available" means) and such is an additional burden without justification.

At this time our clients are filing information disclosure statements with what we know to be the best prior art. These proposed rules will force applicants to decide to spend substantially more money to try to comply with the identification, correlation and non-cumulative description requirements of 37CFR1.98(a)(3)(iv) or not cite the information and take a chance of facing a possible rule 56 violation. The rules should encourage citation of information. These rules discourage citation by requiring a detailed explanation regarding each reference with the costs of such explanation being unrealistic.

For the above reasons, it is suggest that the proposed rules not be implemented. These proposed rules should be vetted with the bar to air all of the possibilities, benefits and drawbacks. Much more discussion is needed before proceeding with these proposals.

Thanks,  
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