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From: Debbie Potter

Sent: Thursday, September 07, 2006 1:52 PM

To: AB95 Comments

Cc: Marty.Simpson@ucop.edu; William Tucker; Kamala Lyon; Wendy Streitz; Janna Tom

Subject: Changes to Information Disclosure Statement Requirements and Other Related Matters

Dear Mr. Bernstein,

The attached comments are sent to you on behalf of University Counsel Martin Simpson.

Debbie Potter

Sr. Legal Secretary

Office of the General Counsel

(510) 987-9958

(510) 987-9757 fax

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA
OFFICE OF THE GENERAL COUNSEL



1111 Franklin Street, 8th Floor • Oakland, California 94607-5200 • (510) 987-9800 • FAX (510) 987-9757

Jeffrey A. Blair
ACTING GENERAL COUNSEL

Writer's direct line: (510) 987-9763
E-mail: marty.simpson@ucop.edu

September 7, 2006

Submitted by electronic mail to: AB95.comments@uspto.gov

Mail Stop Comments—Patents
Attention: Hiram H. Bernstein
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Mr. Bernstein:

This is in response to the USPTO's request for public comments on the "Changes to Information Disclosure Statement Requirements and Other Related Matters" published in the Federal Register on July 10, 2006. (71 FR 38808) For the past twelve years, the University of California has ranked first on the USPTO's list of universities receiving the most patents. As a frequent user of the patent system, the University values strong and enforceable patents, as they are essential to the University's technology transfer operation and its success in translating laboratory innovations into products that are useable to the general public.

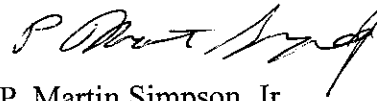
The University understands the USPTO's desire to focus the attention of and ease the burden on the patent examiners, but is concerned that the procedures contemplated would place an extra and significant burden on patent applicants. Furthermore, the proposed procedures could be counterproductive to the overall goal of a patent system that produces valid, enforceable patents by resulting in patents that are more susceptible to attack on subjective inequitable conduct grounds or allegations of prosecution history estoppel as an infringement defense to limit claim coverage.

In lieu of a more expensive patent application process that increases the burden on the applicants, the University continues to support increased resources to the USPTO to ensure that the patent

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examiners maintain reasonable workloads to undertake quality examination and produce sound patents that are critical to the nation's economy.

Sincerely,



P. Martin Simpson, Jr.
University Counsel

cc: Senior Legislative Analyst Kamala Lyon
Director Wendy Streitz
Assistant Director Janna Tom
Executive Director William Tucker
Council on Governmental Relations

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