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From: Wigmore, Steve

Sent: Friday, September 08, 2006 11:45 PM

To: AB95 Comments

Subject: Comments onf IDS Proposed Rule Changes

Importance: High

Please find my comments on the Proposed Rules: "Changes to Information Disclosure Statement (IDS) Requirements and Other Related Matters" 71 Fed. Reg. 131 (July 10, 2006) in a pdf file attached to this e-mail.

Please call me if you have any questions.

Sincerely,

Steve Wigmore

Reg. No. 40,447

(404)572-2884

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent
and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450
September 8, 2006

Attn: Hiram H. Berstein
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Comments on Proposed Rules: "Changes to Information Disclosure Statement
(IDS) Requirements and Other Related Matters" 71 Fed. Reg. 131 (July 10, 2006)

Dear Under Secretary Dudas:

I submit the following comments in opposition to the proposed revision of the patent rules of practice entitled "Changes to Information Disclosure Statement (IDS) Requirements and Other Related Matters" (the "Proposed Revision"), published by the U.S. Patent & Trademark Office ("USPTO") on July 10, 2006, at 71 Fed. Reg. 131. While I wholeheartedly support the USPTO's goals of increasing efficiency, improving the quality of issued patents, and promoting innovation, I respectfully disagree with the Proposed Revision because it is not consistent with those goals.

I am opposed to any rules that require individuals associated with the filing or prosecution of a patent application (hereinafter, "1.56 Individuals") to provide a written explanation on any English language document submitted in an IDS that is filed prior to a Notice of Allowance. While I acknowledge that in some cases the USPTO may become overburdened with the amount of information that may be provided by 1.56 Individuals and that requires a "mandatory cursory review" from an Examiner, the USPTO has other means besides a written explanation requirement prior to a Notice of Allowance to help alleviate this burden. I propose other means in my recommendations section listed below.

Before providing my recommendations, I want the USPTO and the public to be aware that the Proposed Revision is a complete and unfair shift in patent examination policy that will force 1.56 Individuals to cite less information that may be relevant. In some cases, the Proposed Revision will force 1.56 Individuals to cite less information that may be material to patentability.

If the Proposed Revision is adopted as it currently stands, then the reality is that many patent applicants who are often clients of patent practitioners will not pay for the extra time needed by patent practitioners to review documents and to prepare carefully worded explanations that are required by the Proposed Revision. To conserve legal costs for a patent applicant, the patent practitioner will be forced to make more judgments on whether information is material to patentability and simply not cite information that he or she believes is immaterial.

These are the judgments on materiality that the USPTO has counseled against 1.56 Individuals from making for the past several years. The USPTO has already acknowledged the significant burden placed on 1.56 Individuals when written explanations of information are required and how such written explanations will force 1.56 Individuals to cite less information in a patent application. The Manual of Patent Examining Procedure (MPEP), Section 2001.04, page 2000-4, first column (Rev. 2, May 2004) states the following:

“Presumably, applicants will continue to submit information for consideration by the Office in applications rather than making and relying on their own determinations of materiality. An incentive remains to submit the information to the Office because it will result in a strengthened patent and will avoid later questions of materiality and intent to deceive. In addition, the new rules will actually facilitate the filing of information since the burden of submitting information to the Office has been reduced by eliminating, in most cases, the requirement for a concise statement of the relevance of each item of information listed in an information disclosure statement.” [Emphasis Supplied.]

The USPTO has also acknowledged the true risks of not citing any information that may be believed relevant and not necessarily material to a patent application: the charge of inequitable conduct against the patent practitioner or patent applicant (or both) because of error(s) in judgment on materiality. The USPTO has further admitted that submitting information that is not material CAN STRENGTHEN a patent. MPEP, Section 2001.05, page 2000-4, second column (Rev. 2, May 2004) states the following:

“Under the rule [1.56], information is not material unless it comes within the definition of 37 CFR 1.56(b)(1) or (2). If information is not material, there is no duty to disclose the information to the Office. Thus, it is theoretically possible for applicants to draft claims and a specification to avoid a prima facie case of obviousness over a reference and then to be able to withhold the reference from the examiner. The Office believes that most applicants will wish to submit the information, however, even though they may not be required to do so, to strengthen the patent and avoid the risks of an incorrect judgment on their part on materiality or that it may be held that there was an intent to deceive the Office.” [Emphasis Supplied.]

Opposite to the rationale presented the Proposed Revision, the USPTO currently recommends that if a 1.56 Individual has any doubts about whether relevant information should be submitted, then he or she should submit the information in an IDS. MPEP, Section 2004, pages 2000-9 thru 10, second column (Rev. 2, May 2004) states the following:

“10. When in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided. The court in *U.S. Industries v. Norton Co.*, 210 USPQ 94, 107 (N.D. N.Y. 1980) stated 'In short, the question of relevancy in close cases, should be left to the examiner and not the applicant.' See also *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992).”

In light of the risks already acknowledged and emphasized by the USPTO that a 1.56 Individual may face if he or she does not cite relevant information by making judgments on materiality, the USPTO should not force the 1.56 Individual to start making these type of materiality judgments. It is a reality that such materiality judgments will be made if the Proposed Revision is adopted in order to reduce or eliminate time that is needed to prepare a written explanation of relevance for particular information.

Recommendations:

While I am against any written explanation requirement for any English language documents PRIOR to Allowance of a patent application, I believe that it is fair for the USPTO to require written explanations for prior art that is cited AFTER a Notice of Allowance of a patent application.

For any English language documents submitted PRIOR to Allowance of a patent application, the Office should charge fees based on the volume (page count) of prior art documents cited by the patent applicant, similar to its current practice on extra fees charged for patent application page limits and additional patent claims. The reality is that any information relevant to a patent application must be reviewed. And it is evident to any educated person that a cursory review of a document submitted in an IDS consumes less time and effort than a review coupled with the preparation of a carefully worded explanation of a document.

If the extra fees tied to page count of an IDS that the USPTO may charge are in line with the current fees charged for patent application page limits and additional claims, then these flat fees for documents cited in an IDS will certainly be more affordable and reasonable than any legal fees that would be charged a patent applicant for reviewing information and preparing carefully worded explanations of the information for an IDS submission.

In addition to charging extra fees based on page counts for information submitted in an IDS, the USPTO should also adjust the production requirements for cases with a significant amount of prior art cited by the patent applicant/practitioner. The USPTO should give Examiners additional time that has been “purchased” by the patent applicant to review a significant amount of prior art present in any particular case.

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As acknowledged by the USPTO in the Proposed Revision, "a limited amount of time is available for an Examiner's initial examination of the application, which includes at least a mandatory cursory review of each document cited." Giving Examiners additional time based on the extra fees charged to the patent applicant for a threshold number of pages of prior art documents will allow Examiners to conduct their mandatory cursory review of the documents in an IDS while still allowing them to perform a quality examination of a particular patent application.

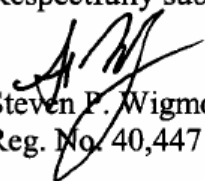
Conclusion:

As stated above, I support the USPTO's goals of efficiency, quality, and innovation. The Proposed Revision, however, runs contrary to those goals. Therefore, I respectfully request that the USPTO to not adopt the Proposed Revision as it currently stands.

Instead of the Proposed Revision, I recommend that the USPTO implement a fee based approach tied to the page count of documents submitted in an IDS. For those patent applicants who pay additional fees tied to page counts of documents submitted in an IDS, the USPTO can give Examiners additional time to perform their mandatory cursory review of the documents which will consume significantly less time and money than a carefully worded explanation of relevance.

If Under Secretary Dudas or any of his subordinates would like to discuss with me any of the issues or recommendations that I present in this letter, please call me at my Atlanta office number of 404-572-2884. Please note that the information and opinions expressed in my letter are my personal views and they do not necessarily reflect the positions or views of my employer.

Respectfully submitted,


Steven P. Wigmore
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