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**To:** AB95 Comments

**Subject:** Comments Regarding RIN 0651-AB95 Notice of Proposed Rulemaking

September 8, 2006

The attached file contains comments regarding the proposed rulemaking entitled "Changes to Information Disclosure Statement Requirements and Other Related Matters."

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Comment Concerning Proposed Rule Making RIN 0651-AB95  
"Changes to Information Disclosure Statement Requirements and Other Related Matters"

September 8, 2006

Department of Commerce  
Patent and Trademark Office  
37 CFR Part 1

Comments by  
Gary S. Williams, Reg. 31,066

**I. Brief Summary of Recommendations:**

- 1) Change § 1.98(a)(3)(ii), § 1.98(a)(3)(v) and § 1.98(c), and all related provisions, to require the identification of potentially cumulative references, as opposed to prohibiting the citation of cumulative references.
- 2) Change § 1.98(a)(3)(iv) to reduce the risk of § 1.98(a)(3)(iv) explanations having an adverse impact on patent enforceability.
- 3) Change § 1.98(a)(3)(iv)(B), "correlation," to make correlations exemplary and to clarify that correlations are not admissions against interest, or alternately to eliminate this requirement.
- 4) Change § 1.98(a)(3)(i)(C) to exclude documents meeting any of the exceptions of paragraphs (a)(3)(viii)(A) and (a)(3)(viii)(C) from the 20 document threshold.
- 5) Change § 1.97(c) to clarify the operation of these rules after filing a Request for Continued Examination.

**II. Overview**

The goals of any changes to the IDS rules should include preservation of the original goals of rule 1.56, improving the efficiency of patent application examination, and preserving the integrity and enforceability of patents that have been prosecuted in good faith. The proposed rules, can be improved in several ways to reduce the potentially huge burden that will be placed on some applicants, avoid needless risk to the integrity and enforceability of patents that have been prosecuted in good faith, to better serve the "full disclosure" goal of rule 1.56, and even to induce more meaningful and useful explanations from applicants than the current proposal.

This comment is based on the assumption that the USPTO has a vested interest in the integrity and enforceability of the patents that it issues, as well as a vested interest in not subjecting the attorneys and patent agents licensed by the USPTO to frivolous charges of inequitable conduct. This comment is also based on the assumption that the USPTO would give serious consideration to a revised version that largely accomplishes what the proposed rules would accomplish, but at a small fraction of the cost to applicants.

This comment is also based on extensive patent prosecution experience, on thousands of patent applications, over a period of more than twenty years.

In what ways will the proposed rules compromise the integrity and enforceability of patents? The proposed rules require applicants to make several types of subjective judgments, each of which will inevitably be challenged during litigation, and which will result in a large increase in the complexity and expense of litigating the enforceability of asserted patents. For the reasons explained below, the number of patents held unenforceable will increase dramatically, and the number of patent attorneys and agents whose reputations and careers are tarnished by accusations or holdings of inequitable conduct will also increase dramatically. In addition, applicants will expend significant resources trying to avoid the patent enforceability problems and the inequitable conduct charges that will arise from simple compliance with the proposed rules.

For example, the proposed rules require applicants to make subjective judgments about which of several documents to cite when all appear to disclose information relevant to the same claim elements. This will be a common situation. In a typical application in which over twenty prior art documents have been identified, several documents will disclose information relevant to the same claim elements, although each will differ in many other respects. If the applicant cites only one of these documents, the integrity of the resulting patent will be compromised. Why? Because during enforcement of the patent, the defendants will inevitably second guess the selection of the cited document and the exclusion of the other documents from the IDS. They will claim that applicants made these choices in bad faith. Inevitably, the defendants will find portions of the uncited documents that allegedly disclose material information not found in the cited documents. (If you question this, please consider the many times that you have heard a surprising or clever analysis of a story, book, Bible passage or the like.) Unless safe harbor provisions are added to the proposed rules, juries and judges are likely to view the applicant's deliberate decision to exclude such documents from the IDS as gross negligence, at best, and as a deliberate flouting of rule 1.56 at worst.

In another example, the proposed rules require applicants to identify the specific features, showings or teachings that cause a document to be cited, and representative portions of the document where these features, showings or teachings are found. However, the proposed rules provide no safe harbor against accusations, made in litigation after issuance of the patent, that the applicant failed to cite other features, showings, teachings or document portions that the alleged infringers find to be even more relevant to one or more elements of the issued claims. The alleged infringers will accuse the applicants and counsel of inequitable conduct for attempting to hide the most relevant portions of the cited documents. In some cases, the accusations will be at least partially true (e.g., other portions of the cited documents may, at least in hindsight, be highly relevant to one or more claim elements not identified in the applicants § 1.98(a)(3)(iv) explanation).

To summarize, subjective judgments concerning cumulativeness, and concerning the § 1.98)(a)(3)(iv) explanation, made during prosecution will inevitably differ from subjective judgments made by others, after issuance of the patent. In many cases, it will be difficult or

impossible to fully understand the perspective of the applicant when making these subjective judgments, even when made fully in good faith, but with more limited resources than the resources expended in litigation. Once additional facts and perspectives not considered by the applicant are disclosed to a judge or jury, many of those subjective judgments will appear to have been poorly made choices.

To avoid hindsight accusations of inequitable conduct resulting from the subjective judgments required by the proposed rules, at least some applicants will attempt to anticipate the accusations and second guessing that will occur after issuance, thereby expending many times the resources anticipated by the USPTO. The result will be that applicants will find reasons to assert that no documents are cumulative, and to provide such exhaustive listings of features, showings, teachings and document portions that the intent of the proposed rules will be entirely subverted. To avoid post-issuance charges of inequitable conduct, applicants will feel compelled to find reasons for asserting that documents are not cumulative, and therefore will need to prepare the § 1.98(a)(3)(iv)(A) identifications for all such documents. An excess of information, in the form of excessively long and detailed identifications, will be just as unhelpful to USPTO examiners as the lack of disclosure information is today. Careful reading of the identifications will be so time consuming that Examiners will find them unhelpful, putting us right back where we started prior to issuance of the proposed rules. However, exhaustive identifications will decrease litigation risk.

Whether or not you believe my predictions, as expressed above, I believe you will find that the changes suggested below will substantially address these concerns, while at the same time making it easier for applicants to submit information under § 1.98 that will be more useful to examiners than the information they will receive under the current proposal.

### **III. § 1.98(a)(3)(iv) Explanation is Onerous and Subjects Applicants to Needless Litigation Risk**

While the § 1.98(a)(3)(iv) explanation is the centerpiece of the proposed rules, as written the explanation will subject applicants to inequitable conduct challenges despite good faith compliance. In addition, the § 1.98(a)(3)(iv)(B) correlation requirement is tantamount to a requirement that applicants make irreversible admissions against interest in order to comply with the requirement that they cite all potentially material documents. However, while an identified feature of a document may "correlate" to an identified element of one or more claims, the identified feature may differ from the identified claim element in ways that are relevant to patentability. Since the goal of the correlation requirement is to assist Examiners in the examination process, but not to undermine the integrity of issued patents, the correlation requirement should be amended to include a "no-admission" clause, similar to § 1.97(h). Furthermore, the addition of a no-admission clause to § 1.98(a)(3)(iv)(B) will produce more honest and succinct correlations, which in turn will be more useful to Examiners.

To make the process of producing correlations less burdensome, and more informative to Examiners, I further suggest revising the proposed rules to state that "a correlation may be

exemplary and need not be exhaustive." It would also be helpful to state that "a correlation may include negative correlations and points of distinction between the identified features, showings, teachings or representative portions and specific claim language or specific portions of the specification."

One additional comment is that the term "claim language" in § 1.98(a)(3)(iv)(B) requires a level of specificity that may be inappropriate in many circumstances, because what the explanation needs to say, to be useful to the Examiner, is which specified features, showings or teachings of the document correlate and which do not correlate to specified claims. I therefore suggest changing "claim language" to "claims or claim language," thereby leaving it up to the submitter to determine the proper level of specificity for the correlation.

Alternatively, I would ask that the USPTO consider eliminating the correlation requirement altogether. Until just recently, the patent rules have never required an applicant to identify the features of a reference that correlate to claim elements, and instead required applicants to explain the most important distinctions between the pending claims and the teachings of the cited references. Inevitably, the correlation requirement will cause applicants to identify correlations that they will later regret, based on a more thorough review of the cited references and new perspectives on the scope of the claims. Do the goals of the USPTO, to expedite examination when the number of cited documents exceeds a threshold, require the use of such a blunt tool as the correlation requirement?

To further the goals of the proposed rules, while substantially reducing its negative impact, I suggest making the following changes.

Alternative 1. Change § 1.98(a)(3)(iv) as follows:

(iv) *Explanation:* An explanation must include:

(A) *Identification:* Identification of specific feature(s), showing(s), or teaching(s) that caused a document to be cited, and a representative portion(s) of the document where the specific feature(s), showing(s), or teaching(s) may be found. The identification of specific feature(s), showing(s) or teaching(s), and the identification of representative portion(s) of the document shall not comprise an admission by the applicant that the identified specific feature(s), showing(s) or teaching(s) anticipate or make obvious any claims, claim elements or claim limitations in the pending claims. Furthermore, so long as the identified specific feature(s), showing(s) or teaching(s), and the identified representative portion(s) form a reasonable basis for citation of the document, the non-identification of other feature(s), showing(s), teaching(s) or representative portion(s) of the document shall not be a violation of § 1.56.

(B) *Correlation:* A correlation of the specific feature(s), showing(s), or teaching(s) identified in paragraph (a)(3)(iv)(A) of this section to corresponding specific claims or claim language, or to a specific portion(s) of the specification that provides support for the claimed invention, where the document is cited for that purpose. A correlation may be exemplary and need not be exhaustive. A correlation may include negative correlations and points of distinction between the identified feature(s), showing(s), teaching(s) or representative portion(s) and specific claims, claim language or specific portions of the specification. The correlation shall not comprise an admission by the applicant that the identified specific feature(s), showing(s) or teaching(s) disclose, teach, anticipate or make obvious any claims, claim elements or claim limitations in the pending claims.

Alternative 2. Change § 1.98(a)(3)(iv) as follows:

(iv) *Explanation:* An explanation must include:

(A) *Identification:* Identification of specific feature(s), showing(s), or teaching(s) that caused a document to be cited, and a representative portion(s) of the document where the specific feature(s), showing(s), or teaching(s) may be found. The identification of specific feature(s), showing(s) or teaching(s), and the identification of representative portion(s) of the document shall not comprise an admission by the applicant that the identified specific feature(s), showing(s) or teaching(s) anticipate or make obvious any claims, claim elements or claim limitations in the pending claims. Furthermore, so long as the identified specific feature(s), showing(s) or teaching(s), and the identified representative portion(s) form a reasonable basis for citation of the document, the non-identification of other feature(s), showing(s), teaching(s) or representative portion(s) of the document shall not be a violation of § 1.56.

(B) *Correlation:* A correlation of the specific feature(s), showing(s), or teaching(s) identified in paragraph (a)(3)(iv)(A) of this section to corresponding specific claims or claim language, or to a specific portion(s) of the specification that provides support for the claimed invention, where the document is cited for that purpose. The correlation shall not comprise an admission by the applicant that the identified specific feature(s), showing(s) or teaching(s) disclose, teach, anticipate or make obvious any claims, claim elements or claim limitations in the pending claims.

Alternative 3. Change § 1.98(a)(3)(iv) as follows:

(iv) *Explanation:* An explanation must include:

(A) *Identification:* Identification of specific feature(s), showing(s), or teaching(s) that caused a document to be cited, and a representative portion(s) of the document where the specific feature(s), showing(s), or teaching(s) may be found. The identification of specific feature(s), showing(s) or teaching(s), and the identification of representative portion(s) of the document shall not comprise an admission by the applicant that the identified specific feature(s), showing(s) or teaching(s) anticipate or make obvious any claims, claim elements or claim limitations in the pending claims. Furthermore, so long as the identified specific feature(s), showing(s) or teaching(s), and the identified representative portion(s) form a reasonable basis for citation of the document, the non-identification of other feature(s), showing(s), teaching(s) or representative portion(s) of the document shall not be a violation of § 1.56.

~~(B) *Correlation:* A correlation of the specific feature(s), showing(s), or teaching(s) identified in paragraph (a)(3)(iv)(A) of this section to corresponding specific claim language, or to a specific portion(s) of the specification that provides support for the claimed invention, where the document is cited for that purpose.~~

#### **IV. Cumulative References – Public Disclosure vs. Clutter**

The prohibition in § 1.98(c) against citing cumulative documents suffers from several serious problems. First, the prohibition undercuts a primary objective of § 1.56, which is disclosure of all potentially material references known to the applicant and other § 1.56(c) persons. Making a public record of all such documents is important, even if the Examiner is unable to review them all, because it provides a foundation or starting point for any analysis of the validity of the issued claims.

Second, any determination of what is cumulative is highly subjective. It is indisputable that if you have a set of three documents that each have similar features, showings or teachings about a

common set of items, different attorneys will consider different documents in the set to be more relevant than the others. Differences in perspective, experience, and the advantages of hindsight, will render subjective determinations of cumulativeness made during prosecution vulnerable to challenge. While the non-cumulative description requirement only applies to documents disclosed after the first period, the prohibition in § 1.98(c) applies to all time periods.

Third, future litigants defending infringement charges will challenge the applicant's failure to cite references that are, in their view, potentially material to patentability. They will think of new and ingenious reasons why these uncited references would be considered to be material by at least some Examiners. Sometimes they will be right, even if these reasons were unknown to the applicant and their counsel during prosecution.

Since the goal of the proposed rules is to provide meaningful assistance to the Examiner, and to expedite examination without undermining the integrity and enforceability of issued patents, I suggest replacing the non-cumulative explanation with an identification of potentially cumulative documents, and adding a safe harbor provision to encourage full disclosure. The following are an example of these suggested changes.

Change § 1.98(a)(3)(ii) as follows:

(ii) All documents cited in an information disclosure statement submitted during the time period defined in § 1.97(c) require the explanation in compliance with paragraph (a)(3)(iv) of this section ~~and the non-cumulative description in compliance with paragraph (a)(3)(v) of this section~~, except for documents meeting one of the exceptions of paragraphs (a)(3)(viii)(B) and (a)(3)(viii)(C) of this section. A cumulative document description in compliance with paragraph (a)(3)(v) of this section is required for potentially cumulative documents cited in an information disclosure statement submitted during the time period defined in § 1.97(c), where "potentially cumulative documents" are documents that, in the best judgment of the submitter, are substantially equal in relevance to the pending claims.

4) Replace § 1.98(a)(3)(v) with the following:

(v) Cumulative description: A cumulative description requires identification of all documents that, in the best judgment of the submitter, are substantially equal in relevance to the pending claims. An explanation in compliance with § 1.98(a)(3)(iv) must be submitted for each of the documents identified in a cumulative description. Submitting a cumulative description prepared in good faith, but later found to be over-inclusive or under-inclusive, shall not be a violation of § 1.56.

These proposed changes are exemplary. If these or similar changes are adopted, other conforming changes to the proposed rules will be required.

## **V. Clarification of Applicable Time Period after RCE**

While this seem like a minor point, filing an RCE with an IDS, after receiving a notice of allowability or notice of allowance, returns the application to pre-allowance prosecution. § 1.97(c) should be revised to indicate that the second time period includes the time period subsequent to the filing of an RCE. If § 1.97(c) is not so modified, an applicant will be prohibited from submitting references for which neither of the § 1.97(e) certifications can be

made. For example, if there is a late discovery that a § 1.56(c) individual knew of a reference, but did not appreciate its significance (e.g., because he or she was unaware of changes made to the claims during prosecution), the current proposed rule changes will put the applicant in the position of being unable to submit a compliant IDS that cites the reference.

Change § 1.97(c) as follows:

(c) *Second time period:* After the period specified in paragraph (b) of this section, and before the earlier of the mailing date of a notice of allowability or a notice of allowance under § 1.311 for an application, or of a Notice of Intent to Issue a Reexamination Certificate (NIRC) for a reexamination proceeding. When a Request for Continued Examination (RCE) under § 1.114 is filed in an application, the second time period shall include the period after the filing of the RCE, even if the RCE is filed after the mailing date of a notice of allowability or a notice of allowance under § 1.311, and before the mailing date of a subsequent notice of allowability or notice of allowance under § 1.311 where the mailing date of the subsequent notice of allowability or notice of allowance is after the filing date of the RCE.

## **VI. Clarification of How to Apply Twenty Document Threshold Test**

As currently written, the proposed rules exclude certain documents from the additional explanation requirements. Since these documents are outside of the additional explanation requirements, including them in the twenty document threshold test of § 1.98(a)(3)(i)(C) is internally inconsistent and may result in the additional explanation of § 1.98(a)(3)(iv) being required when an applicant submits as few as one or two documents beyond those cited in the search reports of foreign patent offices. This is also inconsistent with the intent and intended scope of the proposed rules. The change suggested below is believed to be consistent with the intent of the drafters of the proposed rules.

To make the rules more internally consistent, I suggest changing § 1.98(a)(3)(i)(C) as follows:

(C) All of the documents, if more than twenty documents are submitted, calculated cumulatively but excluding documents meeting any of the exceptions of paragraphs (a)(3)(viii)(A) and (a)(3)(viii)(C) of this section.

## **V. Why are U.S. Office Actions in Related Applications treated different from Foreign Search Reports?**

Foreign search reports and examination reports and the documents cited therein are exempted from new proposed rules if they meet the requirements of paragraph 1.98(a)(3)(viii)(A). The question is why U.S. office actions in related applications are treated differently from foreign search and examination reports. The distinction does not seem logical. In both cases, the documents being cited are brought to the attention of the applicant by a competent search authority working on a related patent application. If this analysis is accepted by the USPTO, then § 1.98(a)(3)(viii)(A) should be changed as follows:



(viii) *Exceptions:* (A) Compliance with paragraph (a)(3)(iv) of this section is not required for documents cited within a time frame set forth in § 1.97(b) that result from a foreign search or examination report, or a U. S. office action on a related application, where a copy of the report or office action is submitted with the information disclosure statement.