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From: Russell H. Walker

Sent: Saturday, September 09, 2006 12:42 AM

To: AB95 Comments

Subject: Comment on 71 FR 38808 proposed rulemaking

Please see the attached comment in PDF format regarding the proposed Changes to Information Disclosure Statement Requirements and Other Related Matters (71 FR 38808, July 10, 2006).

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September 8, 2006

Via email only to [AB95.comments@uspto.gov](mailto:AB95.comments@uspto.gov)  
Without Hardcopy Confirmation

Mail Stop Comments  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: Changes to Information Disclosure Statement Requirements and Other Related Matters  
Published for Comment at 71 FR 38808 (July 10, 2006)

Dear Sir:

I am a registered patent attorney, and I vigorously oppose the ill-considered proposed changes to Information Disclosure Statement ("IDS") requirements published at 71 FR 38808. I believe that the proposed changes would greatly harm, rather than protect, the public's interest in ensuring that patent examination be thorough, would decrease, rather than increase, the quality of patent examination, and would only serve to provide fodder for infringers during litigation so that they might increase the costs of patent enforcement following issuance and have greater opportunity to confuse the courts and a jury at trial. The proposed rules would also serve to drive up the already-substantial legal expense to independent inventors of obtaining a patent.

The duty of disclosure is well stated in 37 C.F.R. § 1.56. In fact, it is so well-stated that this section of the patent regulations bears repeating in full because the proposed changes seem to have forgotten the purpose of this duty:

**§ 1.56 Duty to disclose information material to patentability.**

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit

information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
  - (i) Opposing an argument of unpatentability relied on by the Office, or
  - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and

- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

57 FR 2034, Jan. 17, 1992, as amended at 65 FR 54666, Sept. 8, 2000.

The emphasis of the present duty of disclosure is correctly upon ensuring that all information material to patentability is placed before the patent examiner during prosecution so as to ensure that the public's interest, that only valid patents are issued, is protected. In contrast, the proposed rules emphasize streamlining of the examination process for the purpose of "efficiency."

The submitter of an IDS, who is usually, if not always, the patent attorney who has prepared the application, is entrusted with meeting not only that attorney's duty of disclosure but also the duty of disclosure of "[e]ach inventor named in the application" and of "[e]very other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." Often, in the case of a "continuation-in-part" or divisional application with extensive prior prosecution, the submitting attorney may not be the attorney who prepared or prosecuted the parent application, and who therefore may not fully appreciate the materiality of previously-submitted references or even that previously-known but not previously-material references now become material because of newly-added matter or when subsequent arguments or amendments are presented.

The submitting attorney may not fully appreciate at the time of submission whether a particular phrase in a reference may cause it to be material at the time of submission or later during the prosecution of the application. Any conscientious attorney religiously counsels inventors and assignees regarding the seriousness and importance of the duty of disclosure, and urges all persons having a duty of disclosure under Rule 56 to freely disclose material prior art to the Office prior to and during prosecution so that the examination of the application can be thorough and so that the strongest possible patent can be obtained, unclouded by prior art discovered subsequent to issuance. The "Background and Rationale" published with the proposed rules, by suggesting that it might somehow be a violation of the provisions of 37 C.F.R. § 10.18 for an attorney to submit prior art considered material by an inventor or assignee but perhaps not by the attorney, presents the attorney with an impossible dilemma that will be exploited to the fullest by infringers during post-issuance enforcement.

The proposed rules will also strike fear into the heart of any reasonable attorney and inventor and will cause attorneys to consider the wisdom of advising any patent search at all prior to or subsequent to filing a patent application, instead urging studied ignorance rather than discovery of prior art that can be placed before the Office.

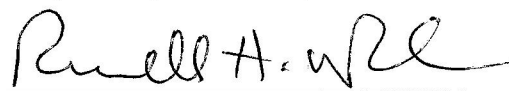
The proposed rules will thus restrict the material prior art presented to the examiner, who might not be as aware of the same prior art or its significance as the inventor or assignee, and can only serve to ensure that all material prior art is not before the examiner during prosecution.

I have been fortunate to always have had scrupulously-honest clients who took and still take the duty of disclosure very seriously, and I have had cases where prior art discovered during preparation of the application, and even after substantial prosecution had begun, was submitted to the Office with the full understanding that the prior art would cause allowance to be denied or would cause the scope of possible claims to be greatly reduced. The studied ignorance of the prior art that the proposed rules will cause can only ensure that the validity of issued patents will sharply decline, and the burden of rigorous examination will then pass to the courts during enforcement as the Office sheds its duty to examine prior art. The Office, with its specialized expertise, is better suited to examine patent applications in view of the prior art than are the courts.

If the Office's concern is that the submission of more than 25 prior art references will increase the burden upon examiners and somehow decrease their efficiency, fine, charge a fee for each additional reference over 25, much as a "jumbo" application now incurs additional filing fees if the length of the application is over 100 pages. Such a fee structure would address the real problem, namely, providing sufficient staffing at the Office to thoroughly examine applications in a timely manner. And, in view of the fact that the Patent and Trademark Office is not funded by the taxpayers but instead by fees paid by applicants and patentees, perhaps the Office could be more vigorous in seeing that all fees paid by applicants and patentees go to improving the quality and thoroughness of examination rather than in funding the public debt burden.

Regardless, examination should never become a "rubber stamp" procedure in which the primary goal is "efficiency" rather than thoroughness, and in which the examination of patent applications and issuance of patents becomes simply a clerical process. The public interest demands that the quality and thoroughness of examination be maintained, if not raised, and, in order for this goal to be achieved, it is essential that submission of prior art be encouraged, rather than discouraged.

Respectfully submitted,



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