

May 21, 2012

InformationCollection@uspto.gov

Susan K. Fawcett, Records Officer
Office of the Chief Information Officer
United States Patent and Trademark Office

Re: 0651-0031 comment
Patent Processing (Updating)
77 Fed. Reg. 16813 (Mar. 22, 2012)

Dear Ms. Fawcett:

Foley & Lardner LLP is a national, full-service law firm with a vibrant intellectual property practice that includes over 200 intellectual property attorneys and professionals. We appreciate the opportunity to comment on the revision of a continuing information collection required by the Paperwork Reduction Act of 1995. These comments are submitted on behalf of the firm's IP Law and Practice committee, and do not necessarily represent the views of all members of the firm or its clients.

The Federal Register Notice invites comments on

- (a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information;
- (c) ways to enhance the quality, utility, and clarity of the information to be collected; and
- (d) ways to minimize the burden of the collection of information on respondents, e.g., the use of automated collection techniques or other forms of information technology.

With regard to point (b), we note that the Federal Register Notice itself appears to fall short of the requirements of the statute and regulations at issue. The USPTO is required to request comment on the "accuracy of the agency's estimate of the burden of the proposed

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collection of information, including the validity of the methodology and assumptions used.” 5 CFR § 1320.8(d)(1)(ii). Because the Federal Register Notice does not reveal the “methodology” used to arrive at the stated time and cost estimates, the USPTO has not provided the public with a meaningful opportunity to comment on the methodology used.

We find as a general matter that the time estimates set forth in the Federal Register Notice underestimate the time required to submit the information at issue, particularly where the information is substantive. While the estimates may reflect the time required to type up the documents at issue, they do not appear to take into account the full time required “to gather the necessary information, create the documents, and mail the completed request,” as indicated. For example, the estimates do not appear to take into account the time that may be required to investigate underlying facts or confer with the applicant or inventor(s).

With regard to points (a) and (c), we ask that the USPTO take this opportunity to address the unnecessary burdens associated with the Information Disclosure Statement (IDS) rules. The USPTO’s current IDS rules require applicants to submit information already in the USPTO’s possession. The collection of such information is *not* necessary for the proper performance of the functions of the agency, because the agency already has that information. Moreover, the USPTO’s current IDS rules do not take advantage of available automated collection techniques or other information technology systems that would reduce the burdens associated with IDS submissions.

For example, the current IDS rules do not provide an efficient framework for citing information from a co-pending U.S. application that is undergoing parallel examination (“*McKesson*-type” IDS submissions), but require Applicants to submit copies of documents that already are in the USPTO’s possession in connection with the co-pending application. Indeed, the documentation requirements of the current IDS rules stem from the days of paper patent files, and now are obsolete in view of the USPTO’s electronic file system.

The current IDS rules impose unnecessary burdens on both Applicants and the USPTO and require the same documents to be processed at least *three times*:

1. First, when the USPTO issues the first Office Action in Application A and provides copies of non-patent references to the applicant.
2. Second, when the applicant copies the Office Action and references for the IDS submissions in co-pending Application B.
3. Third, when the USPTO scans/uploads the Office Action and references from the IDS submissions for the electronic file of co-pending Application B.

The USPTO should implement straight-forward regulatory fixes that would go far to alleviate these burdens. For example, the USPTO could extend MPEP § 2001.06(b) to co-

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pending U.S. applications, extend 37 CFR § 1.97 to co-pending applications, and/or extend 37 CFR § 1.98 to co-pending U.S. Applications.

The USPTO also should use the new Common Citation Document Application (CCD) tool to reduce the burdens associated with submitting copies of documents cited in co-pending EPO or JPO applications. The CCD tool enables users (including patent examiners) to view the prior art cited by the EPO, JPO and USPTO for the family members of a patent application.

In view of the CCD, the USPTO should modify its IDS rules by extending MPEP § 2001.06(b) to all information available on the CCD, including foreign applications encompassed by the CCD, and/or extending 37 CFR § 1.98 to documents available on the CCD.

The USPTO also should take advantage of free patent databases and should not require Applicants to submit copies of documents that it has ready access to, such as published PCT applications and other foreign patent documents that are freely available on-line. Now that that WIPO maintains a free database with over 10.5 million patent documents including over 2 million published PCT applications, the USPTO should extend 37 CFR § 1.98 to freely available PCT and foreign patent documents

This analysis illustrates several ways in which the USPTO's current IDS rules are contrary to 44 USC § 3506(c) and 5 CFR part 1320, which prohibit the collection of information that is "unnecessarily duplicative of information otherwise reasonably accessible to the agency." As such, the USPTO must revise its IDS rules to alleviate these unnecessary burdens and comply with the Paperwork Reduction Act.

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We appreciate the Patent Office's careful consideration of these comments.

Sincerely,

/Courtenay C. Brinckerhoff/
Courtenay C. Brinckerhoff
Chair, IP Law & Practice
Foley &Lardner LLP