

From: Sergey Vernyuk [mailto:SV@etblaw.com]
Sent: Tuesday, May 31, 2016 1:28 PM
To: Information Collection
Subject: 0651-0031 Inquiry

Dear Sir or Madam,

On May 23, 2016, the USPTO published a notice of proposed collection and comment request in the Federal Register (81 Fed. Reg. 32298). This request concerned various forms. I am a registered practitioner with the USPTO and regularly prosecute patent applications. While I am affiliated with Emerson Thomson Bennett, LLC, these comments represent my personal views.

1. The EFS-Web IDS form (PTO/SB/08a) includes several Certification Statements before the signature. I propose that this form be revised to also include the certification statement of 37 C.F.R. §1.704(d)(1) (to avoid patent term reduction). In my prosecution experience submitting IDSs, I either make no certification, make the certification included in the IDS form (§1.97(e)), or make the certification of §1.704(d)(1). In the first two scenarios, the IDS form is adequate because it includes them as options. For the last scenario, I must create and attach a separate page just for the certification of §1.704(d)(1). If the IDS form was revised to include this certification, I would rarely (if ever) have any need to attach any separate certification statement. I imagine this would apply to most practitioners also.
2. Further with regard to the EFS-Web IDS form (PTO/SB/08a), the "03-15" version includes a reference to CFR 10.18 in the SIGNATURE section. Part 10 of 37 CFR was replaced several years ago by Part 11, and this reference in the form is no longer valid and should be updated.
3. Further with regard to the EFS-Web IDS form (PTO/SB/08a), this auto-load form has red boxes around certain fields (e.g., in the U.S. PATENTS section: Patent Number, Issue Date, and Name of Patentee or Applicant of cited Document). Presumably, the red boxes indicate the mandatory fields, where the other fields are encouraged to be filled out but not mandatory. If my understanding of the red boxes is correct, then I suggest moving the red box from the "Name of Patentee or Applicant of cited Document" field to the "Publication Date" field in the FOREIGN PATENT DOCUMENTS section. 37 C.F.R. §1.98(b) indicates the mandatory information to be provided for various IDS submissions. For foreign patent documents, §1.98(b)(4) requires the country identification, a document number, and the publication date; the patentee or applicant identification is not required. The current form suggests, incorrectly, that the one field is mandatory and that the other field is permissive; in reality, the opposite is true per the rule.
4. I propose that the Statement Under 37 CFR 3.73(c) form (PTO/AIA/96) be revised to remove the "Type of Assignee, e.g., corporation, partnership, university, government agency, etc." field. §3.73 does not require the assignee to indicate its "type." Also, if the assignee is the original applicant (and the PTO/AIA/82 power of attorney is filed), the assignee does not have to provide its "type." It is unclear why the USPTO would want to know the assignee type for assignees that take over prosecution as applicants but not for assignees that are the initial applicants. Requesting this information from the assignee is yet one additional item of information that must be obtained from the assignee. If the

USPTO does not really need this information (as evidenced in cases when the assignee is the original applicant), the collection burden can be reduced by removing this field from form PTO/AIA/96.

The above revisions would enhance the utility and clarity of the information collections, reduce unnecessary collections, and minimize the burden of the collection of information. Thank you for your consideration,



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