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has found a reference which appears to have some pertinent disclosure, the applicant must now screen through all other references of record to assure himself or herself that such pertinent disclosure is not found in any other reference of record. Moreover, the applicant must make representations about comparison between one reference and other references. Despite the proposed "safe harbor" of proposed Rule 1.56(f), these additional representations are bound to be questioned in litigation, thus further adding to the burden and cost of patent litigation.

The explanation required by proposed Rule 1.98(a)(3)(iv) may be useful to examiners in resolving the real issues of patentability to be addressed in an application. The information to be provided in a "non-cumulative description" has no utility whatsoever in dealing with the real issues, but is used only to determine whether or not one should allow entry of a prior citation. The burden on applicants provides little or no benefit to the PTO.

If the requirement for a "non-cumulative description" is not deleted in its entirety, then the same should be applied only in those cases where the explanation under Rule 1.98(a)(3)(iv) is the same, or substantially the same, for two or more references. The case pointed out in the explanation of the proposed rule changes at 71 Fed. Reg. 38816, where "documents could be merely cumulative notwithstanding the presence of two different explanations," addresses a theoretical problem. It presupposes that an applicant would deliberately waste his or her own time and money to propose different explanations for documents which the applicant believes to be cumulative.

It is additionally respectfully submitted that the requirement for a "correlation" of specific teachings to "corresponding specific claim language" of portions of the specification under proposed Rule 1.98(a)(3)(iv)(B) should be clarified to state that the requirement for a correlation is satisfied by a statement that the specific features showing the teachings are believed "pertinent to" specific claim language. The purpose of an explanation is to point the examiner to those teachings which are relevant to the claim language. The applicant should not be forced to admit that teachings in the reference "correspond" to language in the claims. Additionally, the rule should include a provision that the explanation in an Information Disclosure Statement does not constitute "admitted prior art," or an admission as to what the reference, properly considered as a whole and without benefit of hindsight, would have taught to a person of ordinary skill in the art. Such an explanation necessarily is composed in hindsight in order to select those teachings of the reference which appear to be pertinent.

Proposed 37 C.F.R. § 1.291(b)(3) should be modified to provide an additional option where an applicant received unsolicited information and provided consent to a protest under § 1.291(b)(3)(ii), but the third party did not file a protest. In that circumstance, the applicant should be permitted to submit the third party information as a protest on behalf of the third party regardless of whether the information meets the requirements of § 1.291(c). The option to submit the third party information as a protest provided by proposed Rule 1.291(b)(3)(iii) only allows the applicant to submit the third party information as a protest on behalf of the third party if the third party information meets the requirements of § 1.291(c). An



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applicant who receives a massive third party citation and exercises the requirement to provide consent may be placed in an untenable position if the third party does not file a protest. Either the applicant must wade through all of the information provided by the third party and compose a proper Information Disclosure Statement (assuming that he or she could do so while still meeting the requirements for non-cumulativeness), or else allow the patent to issue without the examiner ever being placed in possession of the information received from the third party.

It is respectfully requested that the foregoing comments be considered.

Respectfully submitted,

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