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Attention: Hiram H. Bernstein

IBM Corporation Comments in response to "*Revision of the Materiality to Patentability Standard for the Duty To Disclose Information in Patent Applications*," 76 Fed. Reg. 43631 (July 21, 2011)

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IBM thanks the United States Patent and Trademark Office ("Office") for the opportunity to provide our views regarding the proposed revision to the standard of materiality for the duty to disclose information to the Office during patent prosecution. IBM supports the Office's goal of harmonizing the materiality standards applicable to the duty of disclosure and the inequitable conduct defense, as this will promote clarity and simplicity for patent practitioners. We also agree with the Office that proper application of the standard for materiality set forth in *Therasense* should reduce the incentive for applicants to submit marginally relevant information that would not be useful to the Office or the public. Our comments below address the cross-citation of prior art and prosecution event information between "related" cases, and our view that the Office should obtain this information internally and explicitly relieve applicants of the obligation to submit such information to the Office.

The standards for materiality applied by the courts prior to *Therasense* placed undue burdens on applicants during patent prosecution. An area of particular concern was created by the Federal Circuit's decision in *McKesson Info. Solutions, Inc. v. Bridge Med., Inc.*, 487 F.3d 897 (Fed. Cir. 2007), which many viewed as requiring applicants to cross-cite prior art and prosecution event information between "related" patent applications, including potentially those identified as related by the applicant and those claiming priority, directly or indirectly, to the same parent application ("sibling" applications, and/or applications in the same "family"). Thus, whenever any related applications are identified, many applicants routinely submit supplemental information disclosure statements (IDS's) cross-citing prior art and prosecution event information between these related applications after every office action. In many cases

examiners do not acknowledge that they have considered this information on the IDS form, indicating that they do not find this information useful.

To the extent any requirement to disclose such information survives *Therasense*, and more generally to assist applicants and the Office in identifying material information, we believe the burdensome practice of applicants routinely submitting such supplemental IDS's is unnecessary and problematic. This information should be readily – and far more promptly – available within the Office. As described further below, we believe the Office should obtain this information internally and ensure applicants are relieved of the burden of submitting such information by making clear that the Office does not need nor wish to receive it from them.

Under current patent office practice rules (e.g. Manual of Patent Examining Procedure (MPEP) § 609.02), the examiner of a continuation, divisional or continuation-in-part (CIP) application is responsible for considering prior art from a domestic parent application – the applicant need not submit this information to the Office in a separate IDS. We urge the Office to extend this practice to include cross-citations of prior art and prosecution event information for all applications in the “family,” including international parent applications. We suggest that an automated process enabled by the Office's internal databases and tools for notifying examiners of relevant events (such as office actions, submission of an IDS, notices of allowance, etc.) during prosecution of family member applications would be ideal, and should not place an undue burden on the Office as the information is readily available and this would be an extension of existing practice. Applicants would accordingly be relieved of an unnecessary burden and examiners would avoid piecemeal examination engendered by supplemental IDS's.

IBM further urges the Office to extend automatic cross-citation to all “related” applications identified by the applicant. We recognize that if the Office assumes this responsibility, applicants may not be sensitive to the increased Office workload that could result from unnecessarily identifying applications as “related,” and examiners could once again be flooded with marginally relevant information. We therefore request the Office provide guidance regarding the appropriate scope of applications that applicants should identify as related for the purpose of such automatic cross-citation. We suggest that, in addition to family members, related cases could properly be limited to those explicitly referenced by applicants in the specification under 37 CFR § 1.77(b)(2) “Cross-reference to related applications.” We recommend the Office collaborate with the patent community to develop a mutual understanding of the appropriate scope of related applications. We defer to the Office as to the optimal means, such as a public roundtable, wiki, examiner/applicant guidance or additional rulemaking.

We believe automatic cross-citation is also appropriate for counterpart applications concurrently prosecuted in non-US jurisdictions. This practice would not only serve as an appropriate extension of automatic cross-citation for domestic family members to international family members, but would also enhance work-sharing between patent offices.

Finally, IBM supports the Office's intent "to explore ways to encourage applicants to submit information...that would be helpful and useful in advancing examination." We encourage the Office to continue working with the patent community to develop efficient, targeted mechanisms to enable information sharing and provide assistance to examiners.

### Conclusion

IBM thanks the Office for providing the public an opportunity to comment on its proposed revision to the materiality standard for the duty to disclose information. We remain committed to work with the Office in developing improvements to the patent procurement process to promote efficiency and patent quality.

Respectfully submitted,

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