From: Brian Schar [e-mail address redacted]
Sent: Thursday, September 15, 2011 5:14 PM
To: AC58.comments
Subject: Comments regarding 76 CFR 43631, Revision of the Materiality to Patentability Standard for the Duty To Disclose Information in Patent Applications

Dear Director Kappos:

I write this short message in response to the proposed rulemaking set out at 76 CFR 43631. The comments herein are solely my own, and are not necessarily those of my employer.

I strongly agree with the goal of conforming USPTO prosecution practice to the standard set forth in Therasense, Inc. v. Becton, Dickinson & Co., ___ F.3d ___, 2011 WL 2028255 (Fed. Cir. 2011) (en banc). Harmonizing USPTO practice with patent litigation practice will provide practitioners with a single clear and unified standard that makes sense both on the front end of patent prosecution and the back end of patent litigation. As a result, costs and uncertainties in patent litigation will decrease. Consequently, I agree with the proposed rules, which are simple, clear and sensible.

I would propose an addition to the proposed rules that is in conformance with Therasense, and which would lighten the workload on applicants and Examiners alike. Specifically, an express repudiation could be made of one of the more extreme consequences of McKesson Information Solutions, Inc. v. Bridge Medical, Inc., 487 F.3d 897 (Fed. Cir. 2007): that of citing in an IDS in a first application Office Actions from one or more different, related applications. The Examiners have access to PAIR in the same manner as practitioners, and can easily determine which if any applications are related to a particular application undergoing examination. Citing Office Actions from other related U.S. cases simply adds to the workload outside and inside the USPTO, and provides neither material nor non-cumulative information. An express statement that Office Actions from related cases are not material is all that would be necessary to end that practice.

Another timesaving proposition along those lines would be to eliminate the requirement to provide copies of English-language patent applications and issued patents from the major patent-granting entities that make those documents readily accessible on line. For example, PCT applications, EPO documents, and UK, CA and AU patents and applications are all readily available for free via the internet. Citation of material foreign documents would of course still be required.

Thank you for your proactive leadership in aligning the USPTO with the standard set forth in Therasense.

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