

From: Anne Barschall [e-mail address redacted]  
Sent: Wednesday, September 07, 2011 3:51 PM  
To: AC58.comments  
Subject: COMMENTS RE: DUTY OF DISCLOSURE

Dear Sir or Madam,

Patent prosecution is conducted on a shoe string budget. Clients are constantly pressuring practitioners to reduce costs. New applications are increasingly being drafted in India, to further reduce costs.

This cost pressure results inherently from the part of the product cycle in which patent prosecution occurs. At the time of invention, the commercial value of new concepts is unknown. R&D is a very small part of the total expense of bringing a product to market. Manufacturing, advertising, sales, and distribution are all much more substantial investments.

By contrast, at the time of patent litigation, value of a patent is well known. The other, more substantial costs, are already sunk. At this time, it is easy for management to justify a team of a dozen or more highly trained & skilled people, at costs of millions of dollars. This team can do massive prior art searches, comb through business records, and depose witnesses nearly ad infinitum.

As a prosecutor, I feel that litigators are essentially shooting at a rubber ducky in a bathtub with machine guns, and I'm the rubber ducky. Given the adversarial and high budget nature of the patent litigation process, it seems virtually impossible to avoid frivolous or nearly frivolous allegations of inequitable conduct.

The United States seems to be alone, or nearly alone, in having a duty of disclosure requirement. Practitioners from other countries find this provision of US law horrifying -- and express deep sympathy to US prosecutors for the burden of having to put ourselves personally in the line of fire in this area. It is also often difficult to educate ex-USA practitioners and inventors on this topic, further exposing US patents to attack in courts.

Yet, so far, there seems to be little interest in harmonizing US law with the rest of the world in this area.

I would like the USPTO to consider this as a prime area for harmonization.

Respectfully submitted,

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