



American Intellectual Property Law Association

December 22, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
*Attn: Matthew Sked, Legal Advisor
Office of Patent Legal Administration,
Office of the Associate Commissioner
for Patent Examination Policy* *Via email:*AC58.comments@uspto.gov

Re: Comments of the AIPLA on Notice of Proposed Rulemaking regarding Revision of the Duty to Disclose Information in Patent Applications and Reexamination Proceedings, 81 Fed. Reg. 74987, 10/28/2016.

Dear Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views on the Office's Notice of Proposed Rulemaking regarding Revision of the Duty to Disclose Information in Patent Applications and Reexamination Proceedings ("Notice").

AIPLA is a national bar association of approximately 14,000 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Moreover, our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

We agree with the Office's goal of harmonizing the materiality standard underlying the duty of disclosure and the Federal Circuit's "but-for" materiality standard underlying the inequitable conduct doctrine. As the Notice correctly indicates, a unitary materiality standard is simpler for the patent system as a whole. And we commend the Office for its modifications to the previously proposed rules regarding the duty of disclosure in light of the comments and suggestions it received.

AIPLA, however, still has concerns and suggestions with respect to some aspects of current proposed rules in the Notice, as set forth below.

Consistency between the USPTO and the Courts

We note that while the proposed rules adopt the “but-for” test to determine whether a reference is material, they are not consistent with the test for inequitable conduct as it is applied by the courts. In addition to “but-for” materiality, the “but-for” test applied by the courts requires a specific intent to deceive the Office with respect to knowledge of information and knowledge of the materiality of the information.

To further harmonize the rules with the inequitable conduct analysis being used by the courts, we believe that the rules should clarify that inequitable conduct occurs before the Office only when the evidence indicates a specific intent to deceive, that is to say, a deliberate concealment of known material information.

Cumulative Information

In response to previous comments that the rules should maintain existing language regarding cumulative information, the Office declined to specifically state in the proposed rules that cumulative information is not material. In the Notice, the Office states that information which is merely cumulative to information already on the record would not be material under the “but-for” standard. 81 Fed. Reg. at 74991.

While we agree with the Office’s position in this regard, in order to prevent confusion, we believe that the rules should still expressly state that cumulative information does not need to be submitted to the Office. Such a statement would provide more assurance to applicants that there is no requirement to submit cumulative information. In practice, such an affirmative statement in the rules could result in fewer submissions of cumulative information which would reduce the burden on the examiners.

Possible Amendment to 37 C.F.R. §1.130

As a convenience to applicants and to eliminate references that are not prior art under the America Invents Act (AIA), we recommend amending 37 C.F.R. §1.130 to allow an affidavit or declaration to be filed at any time, not just after a claim in an AIA application or patent has been rejected. This amendment would allow an applicant to cite information that may appear to be relevant on its face along with evidence establishing that the information is not, in fact, prior art under the AIA.

By proactively submitting the evidence along with the information prior to a first action on the merits, the applicant can potentially avoid a rejection based on the information. Further, without the ability to proactively submit a 37 C.F.R. §1.130 affidavit or declaration showing that the information is not prior art, there is no opportunity under the current rules to submit the evidence associated with the affidavit or declaration to establish that the information is not prior art under the AIA if the examiner fails to make a rejection based on the information.

Thus, the proposed amendment to 37 C.F.R. §1.130 would save examination time and provide a more complete file wrapper with information and evidence regarding a grace period exception under the AIA. Applicants, however, should not be required to submit information that is clearly excluded under one of the Section 102(b) exceptions.

Pre-AIA and Post-AIA Differences

Satisfying the duty of disclosure under the pre-AIA and post-AIA laws is different because the law has changed with respect to what is and is not prior art.

Under pre-AIA law, information published or otherwise made public less than one year before filing is not prior art, while under post-AIA law, it is prior art, subject to certain exceptions. The current Notice does not distinguish between these two different sets of laws. Under pre-AIA law, applicants may submit, even proactively, declarations under 37 C.F.R. §1.131 “swearing behind” or under 37 C.F.R. §1.132 establishing that one or more listed authors did not contribute to the inventive concepts (i.e., a Katz declaration) or establishing that the information disclosed was the invention of the listed inventors.

AIPLA supports the ability for an Applicant to submit a 37 C.F.R. §1.130 affidavit or declaration in response to a rejection under post-AIA law, but also to do so proactively even before a rejection can be made.

“But-For” Standard

Of particular concern to AIPLA is how the Office will apply a “but-for” standard with respect to post-AIA prior art law.

Proposed rule 37 CFR §1.56(b) states that: “Information is but-for material to patentability if the Office would not allow a claim if the Office were aware of the information....” For example, it is not clear from the proposed rules how the “would not allow the claim” standard would be applied to post-AIA information that is just an inventor-originated work disclosing the claimed invention and nothing more. The issue could arise with respect to potential additional and related evidence (e.g., declaration, affidavit or evidence of attribution or authorship in the information itself) that could qualify the information as an exception to prior art under post-AIA Section 102(b) if the Office were also aware of the evidence.

AIPLA urges that the rules be revised to clarify the manner in which the Office will deal with the duty of candor for potential prior art references that may be subject to the exceptions to prior art under AIA Section 102(b). Specifically, the rules should clarify how the Office will view the duty of candor obligations where inventor-originated prior art that is exempt under AIA Sections 102(b)(1)(A) and 102(b)(2)(A) is not presented during original prosecution as a result of mistake or ignorance, but is provided in a post-issuance court or USPTO proceeding.

It is our position that a failure to submit this kind of post-AIA inventor-originated information should not constitute a violation of the duty of candor where there may be

evidence that a Section 102(b) exception applies and that the failure was due to mistake or ignorance.

Egregious Misconduct

We believe that the rules could be improved by providing more clarity as to what constitutes “egregious misconduct.”

We note that the Office has modified the previously proposed rule language by moving the language regarding affirmative egregious misconduct from the definition of the materiality standard for disclosure of information in 37 CFR §1.56(b)(2) and 37 CFR §1.555(b)(2), as previously proposed, to 37 CFR §1.56(a) and 37 CFR §1.555(a), respectively. Nevertheless, to further avoid confusion, we suggest that the parts of the rules related to egregious misconduct should be included under 37 CFR §11.18, rather than 37 CFR §1.56. Rule 11.18 addresses misrepresentation of material facts and is therefore a better place for also addressing egregious misconduct. In this regard, by its title 37 CFR §1.56 is directed to “Duty to disclose information material to patentability,” and by its title 37 CFR §1.555 is directed to “Information material to patentability in ex parte reexamination and inter partes reexamination proceedings.” Egregious misconduct therefore does not naturally fit under the titles of Rules 1.56 and 1.555.

Potential Future Changes to Duty of Disclosure Rules

The Office has recently indicated that it is exploring how best to utilize available electronic resources to provide examiners with information. *See* “Request for Comments and Notice of Roundtable Event on Leveraging Electronic Resources to Retrieve Information from Applicant’s Other Applications and Streamline Patent Issuance,” 81 Fed. Reg. 59197 (August 29, 2016). For example, the Office has indicated that it is considering the development of a system that utilizes Global Dossier and the Office’s internal databases to automatically provide examiners with the information from counterpart foreign and domestic parent applications. *Id.* at 59199.

We think that, in conjunction with its consideration of such automatic information systems, the Office should also carefully consider how the duty of disclosure rules would be modified by these automatic citations. We agree that the ability to automatically provide examiners with information from related applications has the potential to improve examination efficiency. However, such systems are much more likely to be accepted by applicants if there is an assurance that the system can be relied upon to satisfy applicant’s duty of disclosure with respect to a particular kind or source of prior art. For example, 37 CFR §1.56 and 37 CFR §1.555 might be amended to clarify that the duty to disclose prior art from related applications is deemed satisfied if the applicant uses a USPTO system to automatically cross-cite information from related applications. Additionally, the Office must develop a form that identifies in the record those references which have been cross cited and considered by the examiner.

Conclusion

The AIPLA fully supports the Office's goal of harmonizing the materiality standard underlying the duty of disclosure and inequitable conduct doctrine. We believe that the proposed rules are a significant step in this direction, but we also think that the proposed rules should be improved to address the concerns described above. Thank you for allowing AIPLA the opportunity to provide comments on the Notice.

Sincerely,



Mark L. Whitaker
President
American Intellectual Property Law Association