

**RESPONSE TO THE OCTOBER 28, 2016 FEDERAL REGISTER NOTICE<sup>1</sup>  
ON REVISION OF THE DUTY TO DISCLOSE INFORMATION IN PATENT  
APPLICATIONS AND REEXAMINATION PROCEEDINGS**

ROBERT A. ARMITAGE – CONSULTANT, IP STRATEGY & POLICY

Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
Alexandria, VA 22313-1450

Under Secretary Lee:

Thank you for the opportunity to provide comments in response to the Notice of Proposed Rulemaking relating to the duty to disclose information in patent applications and reexamination proceedings. The United States Patent and Trademark Office is to be commended for initiating this rulemaking effort in 2011<sup>2</sup> and resuming it with this second opportunity to provide comments. As detailed below, this effort by the Office holds the potential to be of singular importance to the operation of the patent system.

While the 2011 *Therasense*<sup>3</sup> decision of the Federal Circuit was a motivating force behind the present effort at rulemaking, that decision represents only one of several factors that the Office should take into account any effort to modernize the regulations addressing its duty of disclosure. The comments below focus on the implications of three such factors.

The first of these three factors is the enactment of the Leahy-Smith America Invents Act.<sup>4</sup> It provides a set of compelling reasons to rethink the duty from the ground up, independently from any *Therasense*-related considerations.<sup>5</sup> Of particular note is its limitation on prior art to publicly accessible information, abolishing the former dependence on dates of inventions in the determination of the scope and content of applicable prior art. The AIA took major steps toward rendering patentability determinations dependent solely on publicly available information.

Second, the duty to disclose is closely tied to the quality objectives that the Office has established.<sup>6</sup> Perversely, the current formulation of the duty encourages *quantity* over *quality* in

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<sup>1</sup> Fed. Reg. 81:74987-89 (Oct. 28, 2016)

<sup>2</sup> The earlier notice of proposed rulemaking was published in the Federal Register (76 Fed. Reg. 43631) on July 21, 2011. Comments were due on September 19, 2011.

<sup>3</sup> *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011) (*en banc*).

<sup>4</sup> Pub. L. No. 112-29, 125 Stat. 284 (2011).

<sup>5</sup> Commenting on the implications of the AIA on the duty of disclosure at the time of its enactment, I noted, “the USPTO can and should rethink the duty of disclosure placed upon patent applicants, particularly with respect to information available to the public. ... A proper reworking of the USPTO’s own rules on disclosure is needed to end the era in which over-loading the examiner with information, and then under-analyzing this information overload as to possible relevance to the patent examination, is the best way to protect the applicant’s interests.” Robert A. Armitage, *Understanding the America Invents Act and Its Implications for Patenting*, AIPLA Q.J. 40:1, 131 (2012).

<sup>6</sup> See Robert A. Armitage, *Advancing Patent Quality across the IP Community*, “What Would A Zero-Based Patenting Paradigm Look Like?”,

the information patent applicants provide to patent examiners during the patent examination process. The current incentives to *over disclose* and *under explain* items of prior art results in an applicant-examiner dialogue that is less productive and less candid than it would be if the duty were formulated to optimally serve the interests of patent examiners, inventors, and the broader public.

Third, any new rulemaking on information disclosures will apply in an era when IT will be increasingly dominated by artificial machine intelligence and cognitive computing capabilities. The availability of these new IT capabilities suggest a rethinking of a disclosure regime that was initially written out when accessing and communicating information often meant searching the cabinets containing a library's card catalog and discussing the results on a rotary-dial telephone.

### ***A Ground-Up Rethinking Of The Duty To Disclose Should Be Undertaken By The Office***

The current 37 C.F.R. § 1.56 or “Rule 56” derives from a rule that was originally conceived and promulgated in 1977.<sup>7</sup> Because the major consequences of the “important to a reasonable examiner” materiality standard under this 1977-vintage rule were largely unintended, the 1992 version of the Rule 56 switched to a definition of materiality that turned in part on *prima facie* unpatentability.<sup>8</sup> It was the standard that reminded in force when the Federal Circuit's *Therasense* decision defined the type of *material misconduct* that merited the mandatory unenforceability sanction whenever misconduct arose from an intent to deceive.

Whatever the justification for the courts to hold patents unenforceable for the intentional omission of material information or material misrepresentations, it does not logically follow that such a justification should form the framework for amending Rule 56's disclosure requirements. Indeed, it arguably makes no sense for the Office to look backward at court decisions to determine the nature of a rule that might best assure patent examinations are accomplished with accuracy, completeness, and efficiency.

Rather, any new Rule 56 should be forward-looking. It should be based on the dominance of the three factors summarized above. In brief, by setting *Therasense* aside, a new Rule 56 should simply define those disclosure practices that will best support more *accurate, complete, and efficient patentability determinations* in the decades of the 2020's and 2030's.

In particular, it is vital for the Office to put into context the dramatic changes to the patent system in the forty years since 1977. The 20<sup>th</sup> century U.S. patent system was

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[https://law.duke.edu/sites/default/files/centers/cip/patentqualityconf/slides\\_robert-armitage\\_fundamental-predicate-reforms.pdf](https://law.duke.edu/sites/default/files/centers/cip/patentqualityconf/slides_robert-armitage_fundamental-predicate-reforms.pdf).

<sup>7</sup> See 42 Fed. Reg. 5593 (Jan. 28, 1977). The 1977 incarnation of Rule 56 was modeled after an SEC disclosure obligation with respect to information material to investors. It was in part intended in part to preclude inundating investors with *unimportant* information *i.e.*, *TSC Industries, Inc. v. Northway, Inc.*, 426 U.S. 438, 449 (1976), “An omitted fact is material if there is a substantial likelihood that a reasonable shareholder would consider it important in deciding how to vote.” Unfortunately, the implementation of identical standard, *mutatis mutandis*, by the Office in the 1977 Rule 56 encouraged disclosure of information that was entirely inconsequential to patentability, since such information was deemed to nonetheless be regarded as nonetheless material.

<sup>8</sup> See 57 Fed. Reg. 2021 (Jan. 17, 1992).

characterized by a highly subjective law on patentability, in which many types of patentability-related information were not publicly available. Moreover, the patent examination process was a secret dialogue between applicant and examiner with no public input permitted before a patent issued. Often, the only public inkling a patent was being pursued for a claimed invention came with the grant of the patent on the invention. Public input into the patenting process post-issuance was equally meager, particularly compared to the comprehensive post-issuance review process that is now available for all patents issued under the AIA' first-inventor-to-file principle.

The non-transparency, subjectivity, unpredictability, and complexity that were the hallmark of this 20<sup>th</sup> century patent system's patentability requirements made an accurate, complete, and efficient patentability determination by a patent examiner highly dependent on the patent applicant being forthcoming with both patentability-relevant information that was not publicly accessible and with publicly accessible information that otherwise could be impossible for the patent examiner to uncover from even the most diligent search of the Office's mostly manually searchable collections of items of prior art. It was understandable that a 1992 duty of candor would be ensconced in rulemaking in a didactic manner, lecturing the patent applicant on the necessity to be forthcoming with information disclosures that, without which, the secret process of examining patent applications could not hope to come to an accurate conclusion.

Today, patentability is determined based on criteria that were designed by the AIA to be as transparent, objective, predicable, and simple as possible. The process of patent examination is not simply public, but immediate, contemporaneous public access to most patent application files is available through the Internet. Pre-grant submissions of prior art by members of the public are not just permitted—they must be considered by patent examiners before issuing a patent. Post-grant review by the Office's administrative patent judges assures that public input can result in the prompt correction of any error in a patentability determination by a patent examiner once a patent has been issued.

In brief, every premise that motivated the Office's efforts in the 1970's, 1980's, and even 1990's in drafting the original versions of Rule 56 has now been turned on their head.

Just as important, advances in information technology continue to erode the role of patent applicant as a preferred, much less unique, source of publicly accessible information relevant to patentability, particularly with respect to items of possible relevant prior art. Today, relevant information that can be readily gleaned from highly sophisticated electronic searching abilities.

Moreover, as noted above, any new Rule 56 will operate in an era of vastly more competent information technology capabilities. Artificially intelligent machine translations and cognitive searching capabilities will increasing mean that machines will be the most intelligent and comprehensive agents for searching, analyzing, and reporting on the significance of items of relevant prior art to patent examination.

For all these reasons, as the Office looks to reformulate Rule 56 obligations in the form of a new rule for the 2020's and 2030's, it should discard its historic and increasingly obsolete focus on applicant disclosures being needed to secure access to items of prior art that might not otherwise come before the patent examiner. It should take seriously the need dissuade patent

applicants from submitting to patent examiners more than a relatively few items of prior art likely to bear on the patentability of the invention being claimed. Lastly, and perhaps most importantly, it should provide incentives for patent applicants to make *intelligent* disclosures, specifically disclosures that identify the possible relevance of items of information being submitted.

***The Overarching Objective For Applicant Disclosures Of Items Of Prior Art Should Be To Afford Patent Examiners An Understanding Of The Possible Relevance Of Each Item***

One comment<sup>9</sup> to the Office made in connection with the 2011 notice—and summarily rejected by the Office in its latest Federal Register notice<sup>10</sup>—proposed addressing these emerging factors by limiting an applicant’s duty of disclosure to non-public information. The intent of so limiting the duty to disclose was to afford the Office a lever. Should the applicant nonetheless proceed with the non-mandated disclosure of items of prior art, the Office could then require that such disclosures include a concise description of the possible relevance to the patentability of a claim being examined.

The comments below assume that the Office will continue to reject such a limitation on the duty to disclose. Given this premise and consistent with the comments above, the proposals for modifying Rule 56 laid out below focus on an alternative mechanism under which patent applicants will have incentives to make fewer, but more intelligent disclosures of items of prior art than under the current Rule 56.

First, the proposed Rule 56 would limit any required disclosures of items of prior art to those needed for an accurate and complete examination of a patent application. Specifically, absent some possible relevance to the patentability of a claim being examined, the submission of an item of information would be considered *verboten*. Submissions of prior art of no possible relevance lead to inefficiency in patent examination by diverting examining resources to reviewing materials having no bearing on patentability. Such materials lack any potential for making the patent examination process more complete or accurate.

Second, proposed Rule 56 offers incentives that should encourage patent applicants to voluntarily provide a representation to the Office as to the nature of the possible relevance to patentability of any item of prior art submitted to the Office.<sup>11</sup> By identifying the possible

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<sup>9</sup> See comments of Eli Lilly and Company (Sept. 19, 2011), proposing a limitation of the duty to non-public information, available at [https://www.uspto.gov/sites/default/files/patents/law/comments/x\\_ac58-e\\_elililly\\_20110919.pdf](https://www.uspto.gov/sites/default/files/patents/law/comments/x_ac58-e_elililly_20110919.pdf). I was privileged to have represented Lilly in the preparation and submission of these comments on behalf of Lilly.

<sup>10</sup> See 81 Fed. Reg. 74995.

<sup>11</sup> The new paradigm for a reformulated Rule 56 set out below specifically asks the Office to reconsider its response to Comment 18 in the July 21, 2011 notice, “The contemplated required explanation [of the relationship of the prior art to the claimed invention] is not included in this currently proposed rulemaking.” Comment 18 had requested that “the Office should not require applicants to explain or clarify the relationship of the prior art to the claimed invention as suggested by the Office in the previous notice of proposed rulemaking” and further “suggested that, if the Office requires such an explanation, applicants should be given a safe harbor so that such explanation would not be regarded as an act of affirmative egregious misconduct.”

relevance of such item of prior art that is submitted, such quality disclosures will contribute to the efficiency of patent examination, as well as to its accuracy and completeness.

Additionally, in the AIA era, the Office needs a balanced approach to disclosure obligations of all who submit information to the Office. Disclosure duties should be identically formulated for both patent applicants and those appearing before the Office adverse to a patent applicant or a patentee. With the public now empowered to make information disclosures that can result in cancellation of a patent once issued, it is of the utmost important to discourage all forms of fraudulent conduct by patent opposers.

Thus, the dramatically greater role of the public in the patenting process suggests that any new iteration of Rule 56 ought to define obligations of any and all individuals submitting information to the Office in a more comprehensive manner, by speaking equally to patent applicants and non-applicants as they conduct themselves before the Office.

Finally, as noted above, the proposed Rule 56 assumes that the Office might be willing to revisit its position on the non-inclusion in any new rules of a requirement for some explanation of why the submission of an item of prior art could be of possible relevance to patentability. In this regard, the new approach below offers a framework for a new Rule 56 that would differentiate between (1) items of information that are truly *material* to the patentability of a claimed invention being examined, (2) items of prior art that are merely *relevant* to a complete examination (whether or not ultimately material), (3) items of prior art that are of *possible relevance* to a complete examination, and—lastly—(4) items of prior art that are of no possible relevance to the examination of the patent application.

For an item of prior art to be submitted it would need to be of possible relevance to patentability—and patent applicants would have incentives for identifying accurately that possible relevance. By parsing information into these four categories for Rule 56 purposes, the proposal below seeks to end any motivation for prior art *over-disclosure*—by barring non-relevant disclosures—while providing strong incentives against *under-explaining* items of prior art that patent applicants do submit to the patent examiner.

In a dramatic break from the past, this proposed Rule 56 would separate out relevant information for which its non-disclosure or misrepresentation to the Office could be actionable misconduct by its submitter from irrelevant information for which disclosure to the Office could itself be actionable misconduct by virtue of its wrongful submission.

***The “Duty Of Disclosure” Starting Point – The Comprehensiveness Of The Criminal Law And Its Statement Of The Obligations With Respect To Disclosures***

In the post-AIA era of patentability being determined through publicly available information, in which patent examination is typically a public proceeding in which the full patent examination record is contemporaneously (and ubiquitously) made immediately available to the public—and one in which the public has the ability to submit publicly available information to the Office to be considered during examination (and again in post-issuance proceedings) after the patent has issued—the role of the applicant in the patent examination proceeding should be no

different from that of any other individual or organization appearing before, or otherwise having dealings with, any entity within the federal government, in making any submission of any type.

With the end of the 19<sup>th</sup> and 20<sup>th</sup> century systems of examining patent applications in secret in a manner that was devoid of any public input into the pre-issuance or post-issuance patenting processes, there is nothing special about the patent applicant's responsibilities of candor and good faith in such governmental dealings compared to than any other filer, submitter, or communicator.<sup>12</sup>

Congress has enacted a comprehensive criminal statute to which nothing more arguably needs to be added by the Office to define the *disclosure conduct* obligations of those appearing before it. That statute appears in 18 U.S.C. § 1001(a) and states—

[W]hoever, in any matter within the jurisdiction of the executive, legislative, or judicial branch of the Government of the United States, knowingly and willfully—

(1) falsifies, conceals, or covers up by any trick, scheme, or device a material fact;

(2) makes any materially false, fictitious, or fraudulent statement or representation; or

(3) makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry...<sup>13</sup>

This statement of *criminal liability* immediately suggests the form and content for a duty of disclosure to the Office under a new 35 U.S.C. § 1.56(a)—

(a) REQUIREMENTS WITH RESPECT TO DISCLOSURES.—

(1) IN GENERAL.—An individual submitting information in a matter before the Office must not—

(A) falsify, conceal, or cover up by any trick, scheme, or device a material fact;

(B) make any materially false, fictitious, or fraudulent statement or representation; or

(C) make or use any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry.

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<sup>12</sup> The opening of 1992 Rule 56 now (obsoletely) reads more like a fine essay than clear rulemaking and should for that reason alone be jettisoned from any modified rule, *i.e.*, “A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability.” While the foregoing is undeniably true, it is a universal truth as it relates to dealings with instrumentalities of the federal government. The same can now be said for submissions of all types to all governmental bodies before which applicants of all types make petitions seeking some governmental action. Rebuilding Rule 56 from the ground up proceeds from the assumption that this prose can be safely retired.

<sup>13</sup> 18 U.S.C. § 1001(a)

The above obligation with respect to disclosure would fully implement the principle that no special or different standard or other duty for disclosure out to apply to different categories of submitters of information to the Office in connection with any matter or proceeding before the Office. It reflects the post-AIA reality that the public can now play an essentially equal role with patent applicant in the quest for quality patent examination and further reflects that that role may likely grow as new information technology tools come online and continue their exponential improvement in that capability.

***The Office Should Define Materiality In Terms Of Relevancy—With The Two Goals Of Both Assuring Disclosure Of—And Limiting Disclosure To—Possibly Relevant Information***

The Office faces two equally formidable needs in its quest for quality and efficient examination of patent filings. The first challenge is assuring that all possibly relevant information to the patentability of the claimed inventions that it examines can be carefully considered by the patent examiner. The second is that such information not be lost within a sea of information of no possible relevance to patentability that has been submitted for the examiner's consideration.

In the artificial intelligence/cognitive computing chapter of the “Information Age,” the greatest challenge to an accurate and complete examination will not be identifying items of information (such as individual prior art disclosures) themselves, but *intelligently* identifying why a particular item of information is of possible relevance. But another way, it is not the quantity of information that might be produced for an examiner to consider but the useable *quality* of such information being submitted.

As the IT capabilities relentlessly progress over the next several decades—offering startlingly new information technology capabilities—the Office will have an even more critical need for new regulatory tools aimed at assuring that the examination process is not swamped by disclosures of inconsequential prior art whose disclosure is stimulated by a misdirected “duty of disclosure” focused on sanctions for non-disclosures rather than incentives for quality disclosures.

Put in more pedestrian language, a “duty of disclosure” should not encourage—as existing Rule 56 does—submitting prior art haystacks to the Office, but should rather should encourage an *identification* of each of the needles therein and their possible relevance to patentability of any claim under examination. Put yet another way, if the Office is to define a duty of disclosure with respect to prior art, that duty should be two-fold. First, that duty should only permit the disclosure of *possibly relevant* of the prior art—with any submission containing an *identification of the possible relevance*. Second, that same duty should affirmatively bar the disclosure of any information for which the disclosing individual cannot identify any *possible relevance*.

If an accurate, complete, and efficient patent examination were the objective of the patenting process, the second element of that two-part duty would be self-evident. More broadly, it should be self-evident, that all governmental entities conducting business with the

public should have the inherent right to bar the submission of information for which an individual appearing before the entity can ascribe no possible relevance.

Given modern information-generation and information-submitting capabilities—not to mention the “information flooding” practices of some patent applicants in making disclosures to the Office—the time has come for the USPTO to promulgate an admittedly unprecedented rule barring the disclosure during examination of information, particularly items lacking any possible relevance to patentability.

Such a new Rule 56 would start with a definition of *materiality* designed to assure the public that sanctions for patent applicant misconduct could be available in the situation where an invalid patent claim issued—or could have issued—based on the non-disclosure or misrepresentation information that, had it been properly before the examiner, would have permitted a new ground of rejection to have been made with respect to the claim. Otherwise, it would be triggered by relevance to the examination of a claim being considered by the patent examiner.

The proposed text for such a *relevance*-based *materiality* standard is as follows, *i.e.*, a new Rule 56(a)(2):

(2) MATERIALITY; RELEVANT PRIOR ART.—

(A) RELEVANCE TO AN EXAMINED CLAIM REQUIRED FOR MATERIALITY.—Information or its misrepresentation is not material to the examination of an application for patent unless the information or its misrepresentation is relevant to the patentability of a claim being examined in the application.

(B) RELEVANT PRIOR ART.—An item of prior art that has not previously been considered by the Office during examination of an application is relevant to the patentability of a claim in the application if, taking account any prior art that may already be under consideration by the Office, consideration of the item not previously disclosed would allow the Office to reject the claim as unpatentable on a new ground that could not have been raised without a citation to such item.

(C) MATERIALITY LIMITATION.—Notwithstanding subparagraph (B), information or its misrepresentation is not material to the patentability of a claim in an application if, were such claim to be patented on the application, the claim would not be invalid.

The above definition of materiality and its subsidiary definition of relevant prior art would then permit the drafting of a *duty not to disclose* that would be triggered by the absence of any *possible relevance* to the examination of a claim. This could be accomplished through the following text, as a new Rule 56(b)(1) and (2):

(b) ITEMS OF PRIOR ART NOT TO BE DISCLOSED.—

(1) IN GENERAL.—An individual who submits one or more items of prior art to the Office in connection with the examination of a patent application must limit such a submission of prior art to items for which such individual has a good faith belief that each submitted item is possibly relevant to the patentability of at least one claim being examined in the application.

(2) POSSIBLE RELEVANCE.—An individual item of prior art is of possible relevance to the patentability of a claim under paragraph (1) if a reasonable possibility exists that such item could qualify as relevant to patentability, as set out under subparagraph (a)(2)(B).

***Any New Rule 56 Should Provide Incentives For Patent Applicants To Provide Concise Descriptions Of The Possible Relevance Of Items Of Prior Art Being Submitted.***

The proposed duty not to disclose outlined above should not place patent applicants in the proverbial damned-if-they-do-and-damned-if-they-don't dilemma. The most straightforward manner in which the Office can assure that no such dilemma can exist is through a series of “safe harbor” provisions that would serve the interests of the Office and the public in assuring that disclosed items of information be accompanied by concise descriptions of the possible relevance of each item to patent examination.

In this regard, three such “safe harbor” provisions are essential. The first of the three would provide that a submitter's disclosure of an item of prior art could not violate the disclosure prohibition whenever accompanied by a concise statement setting forth the submitter's good faith belief as to the item's possible relevance to examination. In this way, the submission of an item of information, with a characterization of its possible relevance, would avoid altogether the possibility that the non-disclosure obligation had been breached.

The first of the three “safe harbors” suggests, however, a need for a second one. Submitters will understandably protest that their characterizations of possible relevance could themselves increase exposure to misconduct allegations based upon the potential for generating allegations of misrepresentations.

To obviate such concerns, the second “safe harbor” would provide that the content of such a representation of possible relevance could not be cited in support an allegation of Rule 56(a) misconduct.

Finally, to avoid complaints by patent applicants that such characterizations of possible relevance could be construed as some sort of admission, a third “safe harbor” would apply. Under this last “safe harbor” representations of possible relevance would not admissions as to materiality or even relevance.

These “safe harbors” would comprise a new Rule 56(b)(3)—

(3) SAFE HARBORS.—

(A) NO VIOLATION OF PROHIBITION.—A submitter’s disclosure of an item of prior art shall be deemed not to violate the prohibition on disclosures under paragraph (1) if the submitter’s disclosure of such item is accompanied by a concise statement setting forth the submitter’s belief as to the item’s content that is of possible relevance to the examination of the application in which it is disclosed.

(B) REPRESENTATIONS AS TO CONTENT AND POSSIBLE RELEVANCE.—No representation by a submitter that is made in the manner described under subparagraph (A) may be cited in support of a contention that a disclosure requirement under subsection (a) has been violated.

(C) NO ADMISSION OF RELEVANCE.—No statement made under subparagraph (A) may be cited by the Office or the courts as an admission that an item is material in fact to patentability or otherwise of any relevance in fact to patentability, including as an admission that such item could be relied upon by the Office in support of a rejection of any claim in an application.

With these “safe harbor” *carrots* removing any downside from the providing such concise descriptions of possible relevance, what remains is the upside—in the form of a *stick*. Providing an item of prior art without such a characterization opens the submitter to the prospect of misconduct allegations if the item of prior art is found to be of no possible relevance to the examination of any claimed invention.

A further incentive for making accurate descriptions of possible relevance for items of prior art being submitted is essential for the proposed Rule 56 to work as intended. This further incentive as based on the position taken by the Supreme Court in *Microsoft Corp. v. i4i L.P.*, 564 U.S. 91 (2011).

The Supreme Court in this appeal determined that—in the course of applying the clear and convincing evidence standard to presumptively valid patents—the factfinder should take into account whether the patent examiner previously considered on the merits information being presented by a party challenging the validity of the presumptively valid patent. For prior art *not before the Office*, a jury instruction can be appropriate that the no issue of deferring to the Office’s judgment arises with respect prior art not before the Office.

With this decision in mind, the Office can and should define what prior art the Office considers on the merits in determining patentability. Moreover, the Office should do so by limiting such prior art to three sources.

The first prior art source would be prior art actually cited by the patent examiner in support of the rejection of a claim. The second source would be prior art properly submitted under 35 U.S.C. § 122(e) by members of the public. The third source of prior art before the

Office would be that submitted by the patent applicant containing an accurate description of the possible relevance to the examination of the claims.

By collecting these three limitations together, the Office would create a fairly compelling incentive for submitters to take seriously both the duty not to disclosure and the upsides from carefully, concisely, and accurately laying out for the patent examiner the possible relevance of information for which a duty to disclose may exist. The text for implementing this last incentive could appear in a new Rule 56(d)—

(d) EFFECTS OF INFORMATION DISCLOSURE.—

(1) CONSIDERATION BY THE OFFICE.—For the purposes of this section, no item of prior art shall be deemed to have been considered by the Office in determining the patentability of the claims in an application unless such item was—

(A) relied upon by the Office in support of a rejection of at least one claim in the application;

(B) submitted in the application, by or on behalf of the applicant, together with a concise statement accurately identifying the content of the item that is possibly relevant to patentability; or

(C) submitted to the Office by a third party in connection with the application in a preissuance submission meeting the requirements under 35 U.S.C. § 122(e).

(2) OTHER PROCEEDINGS.—In determining the validity of a patent in a proceeding in which the patent is presumed to be valid, only prior art deemed under paragraph (1) to have been considered by the Office in the application on which the patent issued shall be regarded as having been before the Office in the examination of the patent.

***The Office Should Require An Affirmative Disclosure Of Any Known Prior Art Of Possible Relevance To Patent Examination***

As a final matter, any new Rule 56 should continue to place patent applicants under an affirmative duty to disclose to the Office items of prior art of possible relevance to patent examination. A simple means to this end is to require a statement that the patent applicant has no knowledge of any relevant prior art, except where the patent applicant has submitted with the filing of the patent application one or more items of possibly relevant prior art.

This could accomplished with a new Rule 56(c)—

(c) REQUIRED STATEMENT IN LIEU OF PRIOR ART DISCLOSURE.—Unless a submission in an application has been made at the time the application was filed identifying one or more items of possibly relevant prior art, a statement must be submitted in connection with the filing of the application that the applicant for patent has no knowledge of any relevant prior art.

## *Conclusions*

The present rulemaking efforts presents the Office with an historic opportunity to open a new chapter in the long saga of the duty of candor and good faith before the Office and—for the first time—remove the incentives that have long sustained the plague of over-disclosing and under-explaining prior art that all but makes a mockery of the duty. Moreover, the enactment of the AIA makes an overhaul of Rule 56 more than ripe. The AIA marks the start of a new era in which patentability criteria are to be focused exclusively on publicly accessible information.

Taken as a whole, the approach laid out above is designed to optimize applicant-examiner interactions now that the requirements for patentability have been made more transparent, objective, predictable, and simple. The intent is not just to produce a more efficient patent examination, but one more accurate and complete. Adopting proposed Rule 56 offers a realistic hope to make greater sense out of a forty-year old disclosure system that has sadly come to make progressively less sense, particularly in the context of patenting in the 21<sup>st</sup> century.

Attached: Appendix A, Proposed Revision To § 1.56 Disclosure of Information to the Office.

## **APPENDIX A: Proposed Revision To § 1.56 Disclosure of Information to the Office.**

### **(a) REQUIREMENTS WITH RESPECT TO DISCLOSURES.—**

**(1) IN GENERAL.—**An individual submitting information in a matter before the Office must not—

**(A)** falsify, conceal, or cover up by any trick, scheme, or device a material fact;

**(B)** make any materially false, fictitious, or fraudulent statement or representation; or

**(C)** make or use any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry.

### **(2) MATERIALITY; RELEVANT PRIOR ART.—**

**(A) RELEVANCE TO AN EXAMINED CLAIM REQUIRED FOR MATERIALITY.—**Information or its misrepresentation is not material to the examination of an application for patent unless the information or its misrepresentation is relevant to the patentability of a claim being examined in the application.

**(B) RELEVANT PRIOR ART.—**An item of prior art that has not previously been considered by the Office during examination of an application is relevant to the patentability of a claim in the application if, taking account any prior art that may already be under consideration by the Office, consideration of the item not previously disclosed would allow the Office to reject the claim as unpatentable on a new ground that could not have been raised without a citation to such item.

**(C) MATERIALITY LIMITATION.—**Notwithstanding subparagraph (B), information or its misrepresentation is not material to the patentability of a claim in an application if, were such claim to be patented on the application, the claim would not be invalid.

### **(b) ITEMS OF PRIOR ART NOT TO BE DISCLOSED.—**

**(1) IN GENERAL.—**An individual who submits one or more items of prior art to the Office in connection with the examination of a patent application must limit such a submission of prior art to items for which such individual has a good faith belief that each submitted item is possibly relevant to the patentability of at least one claim being examined in the application.

**(2) POSSIBLE RELEVANCE.—**An individual item of prior art is of possible relevance to the patentability of a claim under paragraph (1) if a reasonable possibility exists that such item could qualify as relevant to patentability, as set out under subparagraph (a)(2)(B).

### **(3) SAFE HARBORS.—**

**(A) NO VIOLATION OF PROHIBITION.—**A submitter's disclosure of an item of prior art shall be deemed not to violate the prohibition on disclosures under paragraph (1) if the submitter's disclosure of such item is accompanied by a concise statement setting forth the submitter's belief as to the item's content that is of possible relevance to the examination of the application in which it is disclosed.

**(B) REPRESENTATIONS AS TO CONTENT AND POSSIBLE RELEVANCE.—**No representation by a submitter that is made in the manner described under subparagraph (A) may be cited in support of a contention that a disclosure requirement under subsection (a) has been violated.

**(C) NO ADMISSION OF RELEVANCE.—**No statement made under subparagraph (A) may be cited by the Office or the courts as an admission that an item is material in fact to patentability or otherwise of any relevance in fact to patentability, including as an admission that such item could be relied upon by the Office in support of a rejection of any claim in an application.

**(c) REQUIRED STATEMENT IN LIEU OF PRIOR ART DISCLOSURE.—**Unless a submission in an application has been made at the time the application was filed identifying one or more items of possibly relevant prior art, a statement must be submitted in connection with the filing of the application that the applicant for patent has no knowledge of any relevant prior art.

### **(d) EFFECTS OF INFORMATION DISCLOSURE.—**

**(1) CONSIDERATION BY THE OFFICE.—**For the purposes of this section, no item of prior art shall be deemed to have been considered by the Office in determining the patentability of the claims in an application unless such item was—

**(A)** relied upon by the Office in support of a rejection of at least one claim in the application;

**(B)** submitted in the application, by or on behalf of the applicant, together with a concise statement accurately identifying the content of the item that is possibly relevant to patentability; or

**(C)** submitted to the Office by a third party in connection with the application in a preissuance submission meeting the requirements under 35 U.S.C. § 122(e).

**(2) OTHER PROCEEDINGS.—**In determining the validity of a patent in a proceeding in which the patent is presumed to be valid, only prior art deemed under paragraph (1) to have been considered by the Office in the application on which the patent issued shall be regarded as having been before the Office in the examination of the patent.