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DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Revision of the Duty To Disclose Information in Patent Applications and Reexamination Proceedings

The USPTO proposes to amend Rule 56 (37 CFR 1.56) to impose a “but for” materiality standard. That is, if the information would have, or should have, resulted in a rejection of a claim, it should be disclosed for consideration by the Examiner. An intended goal is to make judicial and administrative disclosure rules consistent. However, to be truly consistent, the “but for” materiality test need to go further—that the information, when considered under the proper interpretation of the claims, would have rendered the claim obvious or anticipated in view of the prior art under the appropriate section of 35 USC sec. 102, 103. That is, when a Court is tasked with determining whether an applicant has properly complied with its obligations under Rule 56, I propose that the invalidation of a claim as being obvious or anticipated is a predicate, and that the Court not be compelled to consider whether, even though a claim as properly construed by it is valid, inequitable conduct might nevertheless have occurred because a hypothetical reasonable examiner might have made a rejection under an interpretation of the claims that is not legally correct, i.e., the “broadest reasonable construction”.

By leaving open the “broadest reasonable construction” of the claims, the very overdisclosure sought to be curbed by the rule is nevertheless encouraged, since there is no legal bound to the “broadest reasonable construction”. Further, by requiring disclosure of information required under a broadest reasonable construction of the claims, but not for validity, compels administrative inefficiency, especially where there is no requirement for the Examiner to actually enunciate the construction of the claims being applied in any case, and while the broadest reasonable construction of the claims is being evolved. For example, if an Examiner cites a new reference in a Final rejection, that raises a new “broadest reasonable construction” of the claim language, and this new construction invokes a body of prior art known to Applicant, but not previously believed to be relevant, how can Applicant appropriately respond? The duty of disclosure is “retroactive”, based on facts then unknown to Applicant, and the ability to actually comply with the duty of disclosure administratively limited; further, at the same time that Applicant has a duty to disclose such information, it may be arguing that the claim interpretation by the Examiner is incorrect. While the proposed rule does impose an obligation with respect to then-pending claims, rule 37 CFR 1.97 imposes temporal obligations that are inconsistent. To best effect the goals of proposed rule 37 CFR 1.56, rule 37 CFR 1.97 should be amended to permit cost-free disclosure (e.g., within 3 months of becoming aware) of information after a duty of disclosure for that information is triggered.

I therefore further propose that the “broadest reasonable construction” of a claim be limited to the actual meaning/construction of a claim, when the administrative record clearly supports a more

nuanced interpretation. For example, a clear and unequivocal disclaimer or claim construction on the record (supported by the application and claim language) should be respected to constrain the “broadest reasonable construction” of a claim to permit examination of a claim as though it covers subject matter that it could not actually cover. Therefore, the duty of disclosure would be limited to the issues actually in the case at the time of disclosure, and not theoretical issues which are not actually invoked by the claims. The respect for clear, definite, and supported claim limitations as factually proven on the administrative record is not inconsistent with governing case law or administrative practice, and would tend to result in reduced incentives for overdisclosure, a clearer administrative record providing clarity as to what the claim encompasses (and what it does not encompass), and logical and pragmatic consistency in patent practice.

The Notice of Proposed Rulemaking does indeed address this issue; however, it is believed that the USPTO has discretion to formulate its own duty of disclosure. The issue ultimately arises from the word “reasonable”, which is distinct from “actual”. While it is true that during prosecution, the range of meaning of the claim language considered by the Examiner should be broad, as the issues of the case evolve, the claim interpretation should also evolve, and an objective standard of “broadest reasonable construction” that only looks to the specification, and not to the administrative record, to find the meaning of the claim is in error. After all, the purpose of a detailed written administrative record is to assist in understanding the claims, and the failure to explicitly permit that understanding to evolve will lead to overdisclosure, perverse incentives, and spurious claims of inequitable conduct based on a disparity between the issues as agreed between Applicant and Examiner, on one hand, and the abstract “broadest reasonable construction of the claims in view of the specification” on the other. The USPTO has the ability to confront this issue, and should take this opportunity to do so.

The Notice states in response to Comment 14: “The Office would utilize all available evidence when making determinations of materiality or affirmative egregious misconduct, including rebuttal evidence.” That is, there is recognition that the state of the administrative record is admitted as pertinent to the inquiry; however, the use of word “materiality” raises confusion, as to whether materiality is to the actual scope of the claim, the objective “broadest reasonable construction” of the claim, or the then-outstanding interpretation of the claim on the administrative record. Further, it is rare that the Office takes any action whatsoever regarding “determinations” under Rule 56. Rather, these determinations are more often made by a Court, under its inherent authority, seeking to apply what it believes the duty of disclosure to be. Therefore, the interpretation should be made intrinsic to the rule itself, and not provided as non-binding guidance in a proposed rules packet.

The proposed rule change does not address the temporal sequence of disclosure implied by Rules 97 and 98, 37 C.F.R. sec. 1.97, 1.98. According to these rules, a monetary sanction is imposed for submission of prior art after certain time periods (37 CFR 1.97 (a))—regardless of whether the reference was reasonably believed to be material to prosecution at any particular time.

Therefore, the fact that the claim interpretation standard is not bounded by correctness (as determined by an actual claim interpretation according to law), and the disclosure rules require disclosure of materials that might become material in the future based on evolution of the issues in

an application, will only modestly curb incentives to over-disclose.

Further, the disclosure rules appear to require submission of “references”, and the disclosure rules themselves require information, such as a “date” (37 CFR 1.98(b)(5)), that may be unavailable, uncertain, contested, or incorrect. However, in many cases, the IDS conveys results of a search. A search is typically conducted in two phases: (a) a query defined against a database; and (b) the results are screened. However, in many cases, the screening requires significant discretion, and the apparent risks of under-inclusion of references from the response to the query so high, that for purposes of an IDS, the screening is minimized. However, when the Examiner receives the IDS, the results are often merged and sorted, such as by issue date, and have lost all underlying organization. Therefore, I propose the radical change that instead of encouraging disclosure of search results without rationale, a mechanism be provided to satisfy Applicant’s disclosure requirement by submission of a defined query against a defined database available for use by the Examiner. An examiner armed with one or more reasonably defined queries can then sort, subset, rank, etc., the results, apply the same query against other available databases, modify the query, etc. Likewise, Applicant’s duty of disclosure should be deemed satisfied if the Examiner has executed a search against a database which includes the same results as might have been obtained, had applicant submitted the search parameters.

I do not propose that a particular reference known to be material can be disclosed by way of search parameters, and an obligation to disclose particular references known by application would still apply. For example, references applied against corresponding claims in foreign prosecution should be disclosed. Likewise, material which suggests applicant’s experimental use prior to the respective bar date should be particularly disclosed to permit full consideration of the issues by the Examiner. However, by permitting parametric disclosure of materials that might be listed do to general relevance to the topics of the case, the burden on the examiner to undertake full review and consideration of large volumes of unclassified information would be alleviated. Further, parametric disclosure would permit an efficient communication between Applicant and Examiner of what elements of the invention are deemed important, but not necessarily limiting. These elements of the search could, indeed, be negotiated between applicant and inventor.

Another aspect of Rule 56 not particularly addressed in the proposed rules is the incessant disclosure of office actions from copending US patent applications. The USPTO has internal databases available to examiners. It would seem that the mere disclosure of the application number or publication/patent number of another US application should be sufficient to convey to the Examiner that the entire file should be reviewed, including cited references. Similarly, other patent applications naming the same inventor(s) should be automatically encompassed in the review by the Examiner, without need for distinct disclosure.

Another issue is the disclosure that tends to occur when a related application is in litigation. Typically, an application with such a related litigation will come to include the entire history of the litigation, include all pleadings, motions, expert reports, discovery, etc. Much of this information is available on PACER. Therefore, I propose that the disclosure of materials from a civil action per permitted by way of a proper citation of the US Federal District Court docket number.

It is believed that a careful review of the types of information which applicants tend to disclose by the USPTO will lead to other simplifying strategies that will reduce the volume of disclosure, and make the information available to the Examiner more efficiently handled, as a set of “objects” to be rationally included in a global examination strategy. This, in turn, would incentivize a return of the information disclosure process under 37 CFR 1.56 to a minimum of particularly disclosed items/references which are material to the issues actually under consideration by the Examiner at the time of consideration.

In general, there are two bodies of “inequitable conduct” law: the first, derived from the existence of Rule 56, and the second, a common law doctrine evolved by the Courts, to make the patent system consistent with equitable principles, antitrust and unfair competition law doctrines, etc. The USPTO has no ability to change the common law, but can establish best practices that it believes promote efficient, effective, and reliable examination.

With respect to 37 CFR 1.555, a somewhat different issues arise, and it is believed that the duty of disclosure should be different. In a reexamination proceeding, the underlying patent is permitted a presumption of validity. Likewise, there may be *res judicata* issues regarding claim interpretation, and inconsistencies between legal privilege for counsel, and other non-disclosure obligations, and the objective duty of disclosure. For example, outside counsel of a party may be in confidential possession of materials from an adversary that could trigger the duty of disclosure. The issue, and others, need to be fully considered when promulgating an amendment to 37 CFR 1.555. While the current state of the law might favor the proposed rule, this law is in a state of flux, and mandating a duty of disclosure that may prove contradictory with other concerns is unwise. I therefore propose that the proposed amendment to 37 CFR 1.555 be severed from 37 CFR 1.56, to permit the community of interested parties to address that separately. By opening the duty of disclosure beyond patent and printed publications, the proposed duty of disclosure can become nebulous, leading to vast disclosure of information tangentially material to the actual issues of the reexam.

These comments reflect the personal views of the author, and are not intended to be on behalf of any organization or third party.

Very truly yours,

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