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Mr. Matthew Sked
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Mail Stop Comments – Patents
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By Email only to: AC58.comments@uspto.gov

Dear Mr. Sked:

I write solely in my personal capacity as someone who advises patent practitioners on ethical issues and litigates patent cases. These views are not those of my employer or my clients.

I have one broad concern and several more specific ones.

The USPTO Should Interpret the Patent Act Correctly and not Give False Security to Practitioners.

At a broad level, I agree uniformity is a good thing. However, there will not be uniformity because of the different claim constructions given in litigation than in proceedings before the Office. I also agree with the USPTO that it need not follow the Federal Circuit's definition of materiality (or anything else) from *Therasense*. However, it seems incongruous for the agency, as the entity charged by Congress with implementing the Patent Act, to adopt a definition that it rejected. Given that uniformity will not exist, what does the USPTO believe is required by the Patent Act of applicants?

More troublesome, however, is the real likelihood that the narrow definitions from *Therasense* will be rejected by the Supreme Court. The Supreme Court has in recent years routinely rejected the Federal Circuit's rigid, cabined interpretations of the Patent Act. While no one knows what the future holds, today's practitioner's conduct may be judged by a more stringent standard than suggested in *Therasense* and proposed here. That has happened with eligibility, obviously. Given that the Supreme Court could hold that the Patent Act requires more than avoiding intentionally obtaining a patent that you know you shouldn't get, and given that that interpretation will likely be applied to all issued patents, and given the USPTO's statement that it

hopes that the new definition will result in less disclosure, one can see a trap for the unwary practitioner. This may give practitioners a false sense of security.

My more specific comments relate primarily to “who” is covered by these rules. They don’t make sense.

Rule 1.56 Makes Sense as to Who is Covered; Rule 1.555 Does Not.

As written, Rule 1.56 applies to “[e]ach individual associated with the filing and prosecution of a patent application,” and is further narrowed by subsection (c) which requires “substantive involvement.” The rule ties the individual to substantive involvement in prosecution or filing.

Rule 1.555, in contrast, is (I think) unintentionally broad. It states that the duty is owed by “the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner.” The way this is worded, every attorney and other person “associated with” the patent owner must disclose material information, even if the person has no involvement whatsoever in the reexamination. I believe if the sentence were written much like 1.56(c) is, this would clear this up: “The persons who owe a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are every person who is substantively involved in the reexamination and who is associated with the patent owner, including each attorney or agent who represents the patent owner in the proceeding.”

Who, in Both Rules, can Commit “Affirmative Egregious Misconduct?”

The amendment to Rule 1.555 seems to limit who can commit “affirmative egregious misconduct” to the patent owner and those who act “on behalf of” the patent owner. Rule 1.56 is not so limited, and is also written in the passive voice.

These differences and wordings raise three questions.

First, as noted above, the definition for reexamination would seem to allow for a patent to be held unenforceable due to conduct by every person “associated with” a patent owner, whether that person was involved in the reexamination, or not. Granted, it likely won’t be affirmative egregious misconduct if the person wasn’t involved, but having a clear definition may help.

Second, under Rule 1.555, can someone other than “the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner” in a reexamination commit affirmative egregious misconduct? Presumably so; but is that the intent of the Office? Again, the comment in the prior paragraph may make this an academic point, but the way the rule is worded the person doesn’t need to be substantively involved in prosecution (and, as noted above, presumably substantive involvement is what was intended).

Third, when read *in pari materia*, Rule 1.56 is broader than Rule 1.555, since Rule 1.56's "affirmative egregious misconduct" prong is not limited in the same way as Rule 1.555. When read together, under Rule 1.56 a person's conduct can result in non-issuance of a patent even if that person was not acting on behalf of the patent owner. This seems harsh and unintended. My suggestion would be to make the two provisions in the different rules have the same scope, and affirmative egregious conduct "by or on behalf of the patent owner" probably is reasonably clear and meaningfully limited in scope.

A Closing Thought: Uniformity.

In closing, as noted at the outset, uniformity can be a good thing. To that end, the USPTO has rules that relate to the same general concept – candor and disclosure – but which cover different groups of people. While there may be a policy basis to make the distinctions the rules make, I am not able to guess them.

For example, in addition to the differences discussed above, I note that Section 42.11 – the "rule 11" of IPR -- applies to "parties and individuals involved" in an IPR. Section 42.11 does not require "substantive involvement," just "involvement." Further, because it includes "parties," it creates the same problem discussed above with respect to Rule 1.555: everyone who works for a "party" apparently is covered by 42.11, even if that person has nothing to do with the IPR. As a final example of the varying coverage of these somewhat related rules, Section 42.51(b)(1)(iii) – the obligation in IPR to disclose inconsistent information -- requires disclosure by "inventors, corporate officers, and persons involved in the preparation or filing of the documents or things." Again, substantive involvement is not required, merely "involvement," but "parties" are not subject to this rule.

It may be helpful to strive toward a single definition in these different rules is my point in closing. These create practical problems and potential traps and needless litigation.

Glad to provide further information if I can.

Very truly yours,

/s

David Hricik