

**From:** Bobby Soltani  
**Sent:** Thursday, January 05, 2017 1:12 PM  
**To:** AC58.comments <AC58.comments@uspto.gov>  
**Subject:** Comments on Proposed Rule Changes

Dear Mr. Sked,

Attached are my personal comments on the proposed rule changes published October 28, 2016 in the Federal Register (81 Fed. Reg. 74,987) relating to the duty to disclose information to the Office.

Although the deadline to submit comments was December 27, 2016, I am nevertheless submitting these comments today in case it is possible for them to be considered.

Please feel free to contact me if you need any additional information from me.

Thank you.

Bobby Soltani

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January 5, 2017

**VIA EMAIL ONLY**  
AC58.comments@uspto.gov

Mail Stop Comments - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Matthew Sked, Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy

Dear Mr. Sked,

In response to the request for comments regarding the proposed rulemaking published on October 28, 2016, in the Federal Register (81 Fed. Reg. 74,987) applying to 37 CFR Part 1 “Revision of the Duty To Disclose Information in Patent Applications and Reexamination Proceedings,” I would like to provide the following comments. I generally view favorably the efforts by the PTO to harmonize the materiality standard for the duty of disclosure to the standard set forth by the Federal Circuit in *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (2011). With regard to §§ 1.56(b) and 1.555(b), however, I am concerned that the proposed rules do not align with the “but-for” materiality standard established in *Therasense*; specifically, I believe that the rules as proposed could be interpreted so as not to require a causal link between a submitted reference and action by the Patent Office, creating uncertainty on the part of practitioners, particularly with respect to cumulative information or even irrelevant information.

In *Therasense*, the Federal Circuit explained that “[w]hen an applicant fails to disclose prior art to the PTO, that prior art is but-for material if the PTO would not have allowed a claim had it been aware of the undisclosed prior art.” *Therasense*, 649 F.3d at 1291. The but-for materiality standard is a test of actual causation—to satisfy the standard, a reference must be reasonably expected to cause a rejection of a claim. However, the proposed rule could be interpreted such that no causation is required. Specifically, the proposed rule 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.” 81 Fed. Reg. 74996. This language overlooks the fact

that, during prosecution, a claim may be disallowed for any number of reasons. Thus, a strict logical reading of the proposed rule indicates that any information is but-for material as long as a claim is under rejection. Put in other terms, when a claim is rejected over a first reference, a practitioner could reasonably believe i) the Office could be made aware of an irrelevant second reference and ii) the Office may nevertheless maintain the rejection with respect to the first reference. Because the Office would be aware of the second reference and still not allow the claim, that second reference would satisfy the proposed Rule 56 language regarding materiality (the Office would not allow the claim if the Office were aware of the second reference; the standard is therefore satisfied, despite the irrelevance of the second reference). This is clearly not the intent of the proposed rule.

I appreciate the statement by the Office that cumulative or irrelevant information would not satisfy the proposed rule. 81 Fed. Reg. 74991 (“Information that is merely cumulative to information already on the record would not be material under the but-for standard”). However, I respectfully submit that this interpretation appears to rely on an implied causality that is not strictly required by the proposed rule (despite clearly being required under *Therasense*). As the Office is aware, practitioners often err on the side of disclosure. While this is generally to the benefit of the public and the Office, the currently proposed rules may lead some practitioners to begin disclosing cumulative or irrelevant information, creating further burden on examiners and complicating prosecution histories. To prevent this, the Office should revise the rule to explicitly require causality between a material reference and a rejection of a claim. For example, the proposed rule may be revised to state that “Information is but-for material to patentability if knowledge of the information would cause the Office not to allow a claim.” This relatively minor revision to the proposed rule would more closely align with the holding of *Therasense* and create an explicit requirement for causality between submitted information and corresponding disallowance.

Best regards,

/ Bobby Soltani /

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Bobby Soltani  
Reg. No. 54,459