

**From:** [George Spencer](#)  
**To:** [AC58.comments](#)  
**Subject:** Comment concerning Proposed Change to Rule 56  
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To:  
United States Patent and Trademark Office  
Commissioner for Patents  
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This is a comment concerning the proposed change to Rule 56 (37 CFR 1.56).

As announced, an individual under a duty of candor and good faith dealing with the Office must disclose material “under the but-for materiality standard as defined in paragraph (b)” and that paragraph says that “Information is but-for material to patentability *if the Office would not allow a claim if the Office were aware of the information*” (emphasis supplied). That gives rise to this question: how can one determine in advance whether the Office would or would not allow a claim if the information were made known to the Office? There are over 8,500 patent examiners and for any given case there must exist any number of items of information - and I am not thinking of a reference which clearly shows exactly what is claimed and which would justify a rejection under Section 102 - which, if shown to those 8,500 examiners, would cause some of them to allow a claim under consideration and some who would not.

I realize that the Office does not want to be flooded with irrelevant or possibly even with marginally relevant references but as a matter of precaution one would need to be careful about making a decision not to disclose an item of information that could, by at least some examiners, be relied on to reject a pending claim. In my lengthy experience as a practitioner before the Office (you may guess at how long by my Registration Number 18038!) I have often seen claims rejected over references found by the examiner – not references supplied by the applicant - that could not reasonably be deemed to meet the but-for materiality standard. It would appear, therefore, that not submitting a not overly relevant reference that might, in retrospect, be considered to meet the but-for standard could violate proposed Rule 56.

In view of the foregoing, it is not apparent how the proposed rule gives an effective guideline as to whether or not to submit a given piece of information or, as expected by the Office, the incentive to submit marginally relevant information is reduced.

Note: this comment is not intended to represent the opinion of any one else.

Respectfully submitted.  
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