

From: [Sergey Vernyuk](#)
To: [AC58.comments](#)
Subject: Comments on Proposed Rule - RIN 0651-AC58
Date: Friday, December 02, 2016 1:32:59 PM

Dear Sir or Madam,

On October 28, 2016, the USPTO published a proposal in the Federal Register (81 Fed. Reg. 74987) to amend §1.56 and 1.555 (duty of disclosure). While I am affiliated with Emerson Thomson Bennett, LLC, these comments represent my personal views.

I generally support the proposed revision. While I agree that the rules do not need to explicitly reference *Therasense* by name, I also agree that the standards should be linked such that there is only one standard to follow.

I support the comments discussed under Comment 4 (81 Fed. Reg. at 74991), which suggested leaving language stating that information is not material when it is merely cumulative to information already on the record. The USPTO agreed with this statement in its response to the comments, but the deletion of that language from the rule could encourage arguments in litigation that cumulative information *can* be material after the amendment. Therefore, I suggest adding a sentence to § 1.56(b) and §1.555(b) accordingly.

The USPTO's response to Comment 12 (81 Fed. Reg. at 74993) states that existing § 1.555(b) "limits the types of information that could be considered in reexamination to patents and printed publications." This appears to be an oversimplification of existing §1.555(b). Existing §1.555(b) defines information material to patentability, in part, as: 1) patents or patent publications that establish a prima facie case of unpatentability, or 2) information that refutes or is inconsistent with a position taken by the patent owner. In other words, existing §1.555(b)(1) *is* limited to just patents or printed publications, but existing §1.555(b)(2) *is not* limited to just patents or printed publications. But see MPEP 2280.

I agree that the proposed revision should not state that the material information is limited to just patents or printed publications. For example, as in existing §1.555(b)(2), a patent owner should disclose information that refutes the patent owner's position or assertions, even if that information is not a patent or printed publication. More importantly, new claims are regularly added, or existing claims amended, in reexaminations. Such amendments must be evaluated for compliance with 35 U.S.C. § 112. See MPEP 2258(II)(A). Because information material to patentability is not limited to just prior art (see MPEP 2001.04 (information materiality includes information on enablement)), the patent owner should (especially for new or amended claims) have a duty to disclose material information even if it's not a patent or printed publication.

Thank you for your consideration of my comments.

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