



*Office of the Assistant General Counsel,  
Intellectual Property and Licensing*

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Mr. Jon W. Dudas  
Deputy Under Secretary of Commerce for Intellectual Property and  
Deputy Director of the United States Patent and Trademark Office  
2121 Crystal Drive, Suite 904  
Arlington, Virginia 22202

Dear Jon,

IBM continues to support the efforts of the U.S. Patent and Trademark Office (US PTO) to improve the quality of the examination process as a part of implementing the US PTO's 21st Century Strategic Plan. As a part of improving examination, the US PTO has proposed certain amendments to Rule 105.

IBM continues to believe that Rule 105 can be a useful tool for entering valuable factual information into the file history. In that regard, IBM supports the increased use of Rule 105 to gather such factual information. However, the proposed amendments contemplate requesting certain information that may not advance the mutual interest of the Office and applicants and may have significant unintended consequences.

For this reason, IBM urges the Office to conduct public hearings before adopting any such changes. IBM's position on Rule 105 in general and on several amendments proposed by the US PTO is summarized in more detail in the attached comments.

Best Regards,

  
David Kappos  
Assistant General Counsel  
Intellectual Property & Licensing

## IBM COMMENT ON PROPOSED RULE 105

IBM applauds the US Patent and Trademark Office (US PTO) for proposing changes to increase the use of Rule 105 to improve the quality of the examination process. Since its introduction, the Rule has not been used effectively. In fact, in a recent poll by IBM with respect to its patent application filings, we were not able to find a single example of a Rule 105 request.

While the US PTO proposal includes a number of constructive measures, IBM believes that further revision is needed so that the Rule will strike an appropriate balance between an examiner's need for information and an applicant's concern that inquiries may be unwarranted and burdensome.

To achieve this balance, IBM believes that certain principles should guide the use of the Rule.

First, Rule 105 should enable an examiner to request factual information when the applicant either controls or has superior knowledge or access to relevant information (see examples below). In this way, Rule 105 can serve the interests of efficiency by requiring applicants to provide information that they should have ready access to, and that should be much easier for them to provide than for the examiner to gather.

Second, to avoid inhibiting its use, Rule 105 should not require prior supervisory approval, although the examiner should substantiate, on the record, lack of success in finding such information independently. Including support on the record helps ensure that the examiner has evaluated the application and claims, and has framed a specific inquiry rather than a *pro forma* request. It is suggested that the US PTO promulgate guidelines to direct examiners in making Rule 105 requests in accordance with the revised Rule.

Third, the US PTO should precisely describe what information may be sought under Rule 105 and such information should be limited to the knowledge of the inventors and legal counsel working with the inventors in preparation and/or prosecution of the application.

The revised Rule 105 should operate in conjunction with Rule 56, so that art submitted under Rule 105 will be deemed disclosed to the US PTO under Rule 56.

Examples of appropriate inquiries include:

- (i) Information that helps ensure that the examiner searches and examines the "right" invention, preferably prior to the first official action on the merits. This can include a request for background information or references to the specification that could elucidate the meaning of claim terms. Identifying structure or steps that correspond to a functional claim limitation fall into this category. Similarly, inquiries seeking to clarify "results-obtained" limitations in claims should be authorized. Identifying "utility" if not evident from the specification also fits in this category of information that helps enable the

examiner conduct a proper review. An examiner should be able to request linkage between identified claim terms and the drawings and/or specification. In addition to improving examination efficiency, clarifying ambiguity benefits the public by providing a more certain claim scope.

- (ii) Information that identifies *known* databases, publications, conferences, or names of others *known* to be working in the field. While the applicant should not be required to interpret or stipulate to the level of ordinary skill in the art, database, publication, and like information can be useful to the examiner and not burdensome to the applicant in helping the examiner understand the level of skill.
- (iii) Information that provides a showing of what is new matter in a CIP, or support for new features in an amended claim. This will improve examination by better enabling the examiner to identify which, if any, filing date applies to different claims. This information should be easier for the applicant to determine than the examiner. It will also save time and expense for both parties in any later litigation.

Examples of requests that are *not* appropriate would include:

- (a) Inquiries concerning unannounced products or products plans or any other confidential information.
- (b) inquiries directed to a company as a whole or to individuals in the company who are neither inventors nor counsel. This clarification will avoid unreasonable burden and potential liability on applicants.
- (c) Inquiries eliciting legal conclusions, such as “what the level of skill in the art” is. It is the examiner, not the applicant, who should apply the law to the facts. Rule 105 should be a mechanism for gathering factual information, not a general means for securing admissions or stipulations that would require inordinate time and expense by the applicant (or counsel), and likely yield minimal sanitized results.
- (d) Inquiries eliciting “applicant’s interpretation of the distinctions among claims” or “applicant’s interpretation for the intended breadth of claim terms”. These should be clear from the patent application. If a claim term is unclear, factual inquiries (as noted above) are appropriate.
- (e) Requests that are of an omnibus nature. For example, requesting specification support for *all* means-plus-function limitations (where the corresponding structure may be clear for some of the limitations) should not be authorized. Along this line, the US PTO proposal would allow requests for “other information pertinent to patentability”; this is too open-ended and may lead to unlimited burden on applicants.

We recognize the argument that existing rejections are a sufficient or more apt mechanism to address Rule 105 issues. IBM believes that the purpose for Rule 105 is to gather information that may avoid or substantiate a rejection, while rejections provide legal conclusions made by the

examiner based on available information. Rejections do not provide a vehicle for the examiner to specifically request information. Without Rule 105, an examiner may reject without having sufficient information or the applicant may respond without information useful to the examiner. IBM believes that appropriate use of Rule 105 would complement existing rejections and improve examination quality.

It is possible that seeking needed information for quality examination may add a mini-cycle to the examination process, although such additional time may be minimized by conducting the Rule 105 review in conjunction with any "restriction" review and action and by implementing a shortened response period for the applicant to reply to the Rule 105 request. If pendency time is lengthened due to an examiner making a Rule 105 request, the examiner should not be penalized. The improved patent quality is worth any short delay that results.

With proper balance, a Rule 105 revision in accordance with the principles outlined above would be a constructive step toward improving patent quality without imposing undue burden on applicants.