

November 24, 2003

The Honorable James E. Rogan
Under Secretary of Commerce for Intellectual Property
And Director of the U.S. Patent and Trademark Office
Mail Stop Comments - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attn: Hiram Bernstein

Re: Notice of Proposed Rulemaking “Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan”, 68 Fed. Reg. 53816 (September 12, 2003)

Dear Director Rogan:

Intellectual Property Owners Association (IPO) supports the efforts of the Patent and Trademark Office (PTO) to improve the patent application and examination process generally, and supports quality enhancement, patent pendency reduction, and the use of information technology to simplify the patent application process. IPO appreciates the opportunity to comment on changes in procedures that are being considered by the PTO before they are implemented.

In such regard, IPO supports the majority of the PTO proposed changes. IPO has concerns with some of the proposed changes, however, to the extent such changes are unclear, or to the extent such changes are not believed to provide a net benefit to the PTO, applicants, and the public with respect to the overall patent system.

SECTION 1.105: REQUIREMENTS FOR INFORMATION.

IPO strongly opposes this proposed rule change in its current form. We agree that some types of information which might be requested under a well-defined section 1.105 could be helpful to the Office in conducting high quality, timely, and cost effective examinations. The section as proposed, however, would place expensive, unreasonable burdens on patent applicants and add to the cost of patent litigation in the courts.

Our concerns are based primarily on the requirements for the production of various types of information regarding an applicant’s “knowledge,” “opinions,” “intentions” and “interpretations” in response to interrogatories and requests for stipulations that go beyond the applicants’ existing duties under section 1.56 to provide information

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known to the applicants and material to patentability. The proposed rule has the very real potential for increased likelihood of unsupported allegations of inequitable conduct in patent litigation.

In addition, because the answers provided by applicants would be subject to estoppel assertions, an applicant would be under pressure to do extensive research as to the potential implications of any answers provided, significantly increasing the costs for applicants. The rulemaking commentary states that certain information may be “highly burdensome” for the Office to collect during examination, but there is no explanation of why the information would not be similarly highly burdensome for applicants to collect. To the extent that interrogatories would call for legal conclusions, rather than purely factual information, the authority for non-attorneys to use such interrogatories is problematic. Also, the proposed rule makes no provision for protecting confidential or trade secret information.

We note that the Federal Trade Commission has recently released a report calling for more use of examiner inquiries under section 1.105 and reformulation of section 1.105 to permit follow-up. The FTC has also recommended that upon an examiner’s request applicants should be required to submit statements of relevance regarding their prior art references. Proposed section 1.105 and the FTC recommendations would make fundamental changes in patent examination practice. At a minimum, we urge the Office to conduct public hearings before adopting any such changes, to permit a full airing of views and exploration of the consequences of the changes.

COMMENTS ON OTHER SPECIFIC PROPOSALS:

Section 1.19 -- Document Supply Fees

The proposed change in Section 1.19(b)(3) discussed in the comments (page 53823, third column) does not appear to be reflected in the indicated revised rule (page 53848, second column).

Section 1.57 -- Incorporation by Reference

Proposed new section 1.57(a) is indicated as intending to allow for addition of subject matter to an application specification where such subject matter has been “inadvertently” omitted from the application specification but is “completely contained” in a priority document, where the application contains a claim to the priority document which is present on the date of receipt of the application. The proposed rule raises potential issues with respect to having to prove whether any particular omission was “inadvertent” at the time of filing of the application. Further, potential issues are also raised as to whether such rule would allow for

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correction of non-obvious (based on the filed application itself) translational and/or typographical errors which distinguish the filed application disclosed subject matter from the priority document, which corrections may not be consistent with precedential case law. Clarification is needed.

Section 1.98 -- Content of information Disclosure Statement

To the extent the Office is proposing a format requirement intended to facilitate OCR scanning of US patent numbers and US patent application publication numbers explicitly so that such document could be made electronically available to the examiner to facilitate searching and retrieval of such references, it is proposed that the requirement for providing paper copies of such references be dropped for IDS filed in all applications, rather than just those identified in 1.98(e). Further, it is also proposed to eliminate the requirement that applicants provide paper copies of cited pending US applications where such applications have been scanned by the USPTO and are readily electronically available to the examiner.

Section 1.115 -- Preliminary Amendments


The proposed changes section 1.115(b) are confusing with respect to what subject matter constitutes part of the “original disclosure”, as opposed to an “originally filed specification, including claims, and drawings”. The proposal appears to be to substitute a requirement to accept a legal fiction (that preliminary amendments filed on or prior to an application filing date are part of the “original disclosure” whether referenced in the oath/declaration or not), in exchange for the Office dropping the requirement that an applicant go through a petition procedure in order to file a substitute oath/declaration specifically referencing any such preliminary amendment which adds subject matter which is deemed not to be otherwise supported by the original specification/claims/drawings.

It is noted that the same issues would in any event need to be addressed under the proposed rule that are faced under existing practices with respect to preliminary amendments. Namely, unless the amendment is specifically referenced in the applicants’ oath or declaration, a determination must still be made whether the preliminary amendment introduces new matter relative to the version of the specification actually referenced in the oath or declaration, and if so, a newly executed oath or declaration would be required where the applicant wishes for the “new” subject matter (relative to the version of the application prior to incorporating the preliminary amendment) to be maintained in the application. As long as the Office retains the requirement that a new oath be filed when appropriately needed, adoption of such legal fiction in accordance with the proposed rule changes in order to facilitate the application and examination process does not seem to be objectionable. It is suggested, however, that where it is determined that the subject

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matter is not otherwise sufficiently supported by the original specification referenced in the existing application oath or declaration, applicants also be expressly provided with the option to cancel such preliminary amendment, if desired, rather than to submit a new oath/declaration in all circumstances. It is also noted that for clarity, the second sentence of proposed section 1.115(b) should be amended to read “If such a preliminary amendment submitted on or prior to the filing date of an application is determined...”

Sincerely,

A handwritten signature in black ink, appearing to read "John K. Williamson". The signature is written in a cursive style with a large initial "J" and "W".

John K. Williamson