

**PENNSYLVANIA INTELLECTUAL PROPERTY FORUM**

201 NORTH JACKSON STREET • MEDIA • PENNSYLVANIA • 19063

PHONE: (610) 891-0668 • FAX: (610) 891-0655

EMAIL: IPFORUM@YARBROUGHDLAW.COM

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Mail Stop Comments - Patents

Commissioner for Patents

United States Patent And Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

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 Mr. Commissioner:

In the Federal Register Notice dated September 12, 2003, the U.S. Patent and Trademark Office requested public comments regarding the above identified Notice of Proposed Rulemaking. Presented herein are the comments of the Pennsylvania Intellectual Property Forum ("Pennsylvania IP Forum"). The Pennsylvania IP Forum is an organization of patent practitioners and intellectual property attorneys located principally in Southeastern Pennsylvania. While some of us represent large entities, all of us represent individual inventors and small entities. Large entities already have significant advocates in Washington. Our purpose in making these comments is to provide a voice to individual inventors and small entities that otherwise would not be heard.

The Pennsylvania IP Forum appreciates the opportunity to offer comments on the rule and practice changes proposed by the Office. We believe that several of the proposed changes would adversely affect the patent prosecution process in terms of time and cost and respectfully request consideration of the following issues presented below. In particular, as representatives of the majority of patent applicants, namely small inventive entities, there is particular concern with regard to the atmosphere of increasing inflexibility on the part of the Office, as well as the alarming sense of a shift in burden during prosecution review from examiners to applicants.

Everyone who works with the Patent and Trademark Office realizes that it is a large organization serving many constituencies. To administer the law fairly to all, uniform laws and rules are a must. However, a tension exists between the need to apply laws uniformly and the need to apply laws justly. The former requires rules,

the latter requires sound discretion. We recommend that the Patent and Trademark Office avoid hard-and-fast rules where those rules are not absolutely required to make administration of the law uniform. Below, please find our comments with regard to specific proposed rule changes.

**(1). Proposed Rule Change 37 C.F.R. §1.6 requires clarification.**

The commentary in the PTO "Discussion of Specific Rules" at p. 53820 states that "drawings with detail" should not be submitted by fax. It would be helpful if the PTO could quantify what is meant by the term "detail" or alternatively, state what type of drawing is safe to be submitted by fax (e.g. simple block diagram or flow-chart).

**(2). Proposed Rule Change 37 C.F.R. §1.17 requires further correction.**

Rule 1.17 proposes expensive petition fees, all of which would be an increased hardship for small inventive entities. To cure this pernicious effect, we suggest that this rule be amended to provide that the petition fees shall apply only to large entities and that no petition fee shall be charged to any small entity.

**(3). Proposed Rule Change 37 C.F.R. §1.53 should not be adopted as proposed.**

Rule 1.53 is amended to require that a petition and fee be filed if the PTO issues a notice that an application is incomplete. The provision further states:

In the absence of a timely (1.118(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

Our difficulty with the proposed amendment stems from the situation where an error may appear in the specification; for example: a page may inadvertently omitted from the background section, a pagination error may make it appear that a page has been left out of the application, a figure may be omitted, or a numbering error may make it appear that a figure has been omitted. Current PTO practice is to notify the applicant of the apparent error and to provide the applicant with the opportunity to submit new information to correct the error. If the applicant chooses to submit, for example, new pages or new figures to correct the error, then the filing date becomes the date of correction. If the applicant chooses not to supplement the application, the applicant retains the original filing date and review proceeds on the application as filed. The applicant is required eventually to correct

the application by removing references to the omitted pages, by correcting the pagination, or by correcting the figure references.

Under the proposal, the option to proceed with the application as filed and to retain the original filing date apparently is eliminated. This is a draconian result in, for example, the situation of a numbering error in the figures. We recommend that the option to proceed with the application as filed be retained consistent with current PTO policies.

We further recommend that the requirement for a petition and fee be required only if the applicant elects to submit new pages of the specification or new figures and thereby accepts a new filing date.

**(4). Proposed Rule Change 37 C.F.R. §1.57 is rigid and inflexible; incorporation by reference should be liberal and open.**

The number of pages in each patent application is creeping upward, with some applications reaching hundreds of pages. One cause of such massive patent applications was a series of Federal Circuit decisions effectively expanding the enablement requirement to include disclosure of prior art. The disclosure of the prior art in the patent application does nothing in itself to advance the art and is merely a regurgitation of what others have done before. Nonetheless, applicants believe that substantial prior art must be included in each patent application to satisfy the rulings of the Federal Circuit. Each massive application must be fully reviewed, eating up inordinate examiner time and adding to the PTO's backlog and costs of review. The need for ever-larger applications also renders the preparation of patent applications ever more expensive, putting the patent process out of reach for all but the richest of inventors and assignees.

Applicants could dispense with much of the bulk of the giant patent applications by incorporating prior art by reference for purposes of enablement. We recommend that the following should be considered as incorporated by reference for all purposes in each application automatically, without resort to specific incorporation by reference language and that the distinction between "essential" and "non-essential" material be deleted:

(a). all disclosure in provisional, utility, PCT and foreign applications from which the application in question descends;

(b). all disclosure in U.S. and foreign patents referred in the specification of the application in question and all other documents identified in the specification and in existence at the time of filing; and

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(c). all disclosure in references included in an Information Disclosure Statement filed at the same time as the application in question.

The reasons given in PTO "Discussion of Specific Rules", p. 53827 for rejecting liberal incorporation by reference relate to § 112 paragraph 6 means-plus-function claims. The preamble indicates that the applicant may create means-plus-function claims that are unpatentably broad through inadvertent incorporation by reference.

In response, we believe that the benefit to the applicants and to the patent office of addressing the enablement problem through incorporation by reference outweighs any concern about inadvertent enlargement of means plus function claims. We also believe that a duly adopted regulation that provides specifically for incorporation by reference will overcome the reluctance of the Federal Circuit to look beyond the four corners of the patent application for means in a means plus function claim. Finally, we believe that means plus function claims coupled with the equivalents taught in the incorporated references may overcome some of the damage done by the Festo decisions.

In short, we recommend that each document should be presumed to be incorporated by reference unless the applicant states that it is not incorporated by reference. If an applicant is concerned that one or more references may render a means plus function claim too broad, then the applicant specifically can reject incorporation of the document.

Under the proposed rule as discussed in the preamble, defective incorporations by reference will incorporate nothing unless corrected during prosecution. Our problem with this approach is that if the teachings of a reference are not part of the application until a technically perfect incorporation is entered, then any post-filing correction to the incorporation by reference adds new matter. The original filing date therefore will be lost and the consequences for a technically imperfect incorporation by reference are very great. This is an unnecessary and overly technical result that adds nothing to the efficiency of the patent review process.

The PTO "Discussion of Specific Rules" at page 53828 states that the PTO is concerned that excess examiner resources will be used to correct defective incorporations by reference. The need to correct incorporations by reference, and hence the burden on examiners, is eliminated completely if all references are presumed incorporated and if mechanistic and rigid rules of incorporation are eliminated. We recommend that if a reference to an item of prior art is adequate to

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identify the item, the incorporation should be effective. For example, a reference to a U.S. or foreign patent number should be an effective incorporation by reference, whether or not the name of the inventor or the date of issuance is provided. Similarly, the name of the inventor and the issue date should adequately identify the incorporated reference, even if the patent number is omitted. For non-patent literature, a standard bibliographic reference should be sufficient.

**(5). Proposed Rule Change 37 C.F.R. §1.105 should not be adopted in any form.**

The changes to Rule 1.105 will have a detrimental impact on patent prosecution by creating confusion and additional burden on the part of both the Office and applicants, resulting in increased costs and time delays. The PTO proposes to require applicants to provide the "technical information known to applicant concerning the interpretation of the related art, the disclosure, the claimed subject matter, other information pertinent to patentability, or the accuracy of the examiner's stated interpretation of such items". The format for this requirement is much more expansive than that currently in existence and would not only require the applicant to produce specific documents, but also to reply to interrogatories and stipulations in the form of statement with which the applicant may agree or disagree.

Interrogatories and stipulations are proposed to be used to elicit information as to numerous legally based categories of information. As any litigator will attest, the crafting of interrogatory questions or statements for stipulation is one that requires a fair amount of time, training and skill in considering the formulation of such and the significance of the verbiage of both the questions and consequences of the answers. This expanded requirement for information places the examiner, who may not be legally trained, in the role of one presumed to be experienced in litigation.

The proposed amendment would further create the onerous task on the part of an applicant to formulate a carefully prepared reply which would anticipate all aspects of the potential impact of such a response in any later patent litigation which may arise. Calling for an applicant to stipulate to admissions or to respond to interrogatories as to his/her "interpretation", "intentions", "opinions", "rationale", "analysis" or "knowledge" as to, among other things, related art, examiner accuracy in his or her interpretations, evidentiary issues surrounding patentability conditions and technical attributes associated with the knowledge and skill of a person of ordinary skill in the art, shifts the burden of examination to the applicant. Further, the information requested may well require a legal conclusion, something a lay person is not qualified to provide, or revelation of trade secrets or other confidential business information.

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The PTO "Discussion of Specific Rules" at page 53832 suggests that the Office believes this change to be necessary because the collection of such information is "highly burdensome" and "particularly wasteful" of examiner resources. However, such requirements for information place a substantial burden on the applicant and the threshold under which such discovery tactics may be employed, "to elicit information reasonably necessary to examination", is so low as to create a practice fraught with opportunity for abuse and regular use by examiners.

Presently a requirement for information in the form of production of specific documents under 1.105 accompanying an action on the merits has the same 3 month time period as the action on the merits, while a requirement separate from an action on the merits generally has a two month time period. Do these same time period requirements apply to interrogatory and stipulation responses as well? This is not clear in the present wording of the proposed change.

Also, there is no mechanism suggested in the proposed change to Rule 1.105 for requesting clarification from the examiner as to an interrogatory or stipulation which is vague, ambiguous or objectionable. Further, what is the consequential outcome if the examiner deems an applicant's answer to be incomplete or in some other manner inadequate? Is the answer then deemed to be untimely or a failure to reply resulting in the abandonment of the application? Can a supplemental answer be filed in response to the examiners indication as such? If this rule should be adopted, there needs to be a mechanism for an applicant to request clarification.

Further, is an answer by an applicant to an examiner's requirement for information under 37 CFR 1.105 in the form of interrogatories and/or stipulations deemed to be a "response" or is it deemed to be a "reply"? And would a supplemental answer be construed as a "supplemental reply" for purposes of the proposed changes to Rule 1.111?

Presently, MPEP 704.14 expressly sets forth that the examiner must consider the information submitted, and that it is never appropriate to deny considering information that is submitted, in response to a 37 CFR 1.105 requirement. How then do the proposed changes to Rule 1.111 prohibiting the consideration of supplemental replies as a matter of right except in certain limited circumstances, comport with MPEP 704.14 and affect responses to a 37 CFR 1.105 requirement? The new rule appears to be internally inconsistent with the present rules.

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The proposed changes to 37 CFR 1.105 should not be adopted. In the alternative, if the rule changes are adopted, an answer to a 37 CFR 1.105 requirement should not be considered a reply for purposes of Rule 1.111. See below for further comments on 37 CFR 1.111.

**(6). 37 C.F.R. §1.111 should remain as presently written and supplemental replies should be allowed.**

First, as set forth above, if adopted, submissions under rule 1.105 should not be considered "replies." Applicants should be allowed to supplement these submissions.

Second, as proposed, Rule Change 37 C.F.R. 1. 1.111 is absolutely antithetical to the PTO's stated objective of improving patent quality because it prevents supplemental "filings" historically employed to provide key items such as new art (with distinctions), declarations and other information designed to assist the examiner in dealing with the application.

**(7). 37 C.F.R. §1.213 is unduly cumbersome.**

Rule 1.213 requires an actual inquiry consistent with 10.18(b) before filing a request for non-publication. Presumably, this would require the practitioner to write to the client and confirm that 1) no foreign application has been filed and 2) that the client does not intend to file any application and obtain a written response before filing a non-publication request. This is unduly cumbersome. There should be an exception where a single written statement from a client that, by default, all U.S. applications should be filed with a non-publication request and that the client understands that there are limitations on filing foreign applications.

**(8). 37 C.F.R. §1.704 thirty (30) day time period should be modified.**

The Rule 1.704 thirty (30) day safe harbor time period for filing an information disclosure statement after allowance for foreign search reports should be modified. Given mail delays and delays by foreign associates, many such search reports will not arrive until after the 30 days have elapsed. This requirement should be changed to 30 days after the U.S. practitioner or U.S. inventor has received the search report as long as it is within the three months in which the references may be filed.

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In conclusion, the members of the Pennsylvania IP Forum appreciate the opportunity to comment on the proposed rules for implementing the 21st Century Strategic Plan in patent practice and would be pleased to further assist the Office in any manner necessary to consideration of the issues raised above . In advance of your courtesy and cooperation, we extend to you our appreciation.

Very truly yours,

Robert J. Yarbrough  
PTO Reg. No. 42,241  
Chairman,  
Pennsylvania Intellectual Property Forum

The following members of the Pennsylvania Intellectual Property Forum concur in the foregoing comments:

William A. Bonner, Esquire, PA Atty. ID No. 10,263

Stuart S. Bowie, Esquire, PTO Reg. No. 22,652

Brian P. Canniff, Esquire, PTO Reg. No. 43,530

Gerry J. Elman, Esquire, PTO Reg. No. 24,404

Lawrence Husick, Esquire, PTO Reg. No. 38,374

Robert S. Lipton, Esquire, PTO Reg. No. 25,403

Deborah A. Logan, Esquire, PTO Reg. No. 54,279

Kenneth N. Nigon, Esquire, PTO Reg. No. 31,549

Ash Tankha, Esquire, PTO Reg. No. 33,802

Laurence A. Weinberger, Esquire, PTO Reg. No. 27,965

Patricia A. Wenger, Esquire, PTO Reg. No. 42,218

Mark A. Young, Esquire, PTO Reg. No. 48,669