

Comments on proposed 37 CFR §1.57

If you are going to have a rule on incorporation-by-reference, bulk incorporations should be expressly authorized (e.g. "All published documents, and all US applications cited anywhere in this application, are expressly incorporated herein by reference in their entirety"). It is not clear under the proposed rule if an incorporation must be separately stated for each document. Bulk incorporation, if desired by an applicant, is equally capable of conveying an applicant's intent, as are separate incorporations, and is more efficient.

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§1.57(a) is a good idea, but should be expressly made effective only for applications filed on or after the effective date of the rule. Retroactive application of this rule would add matter to currently pending applications in violation of 37 CFR §132(a).

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§1.57(b)

The proposed incorporation-by-reference rule, 37 CFR 1.57, should not require more than the minimum amount of information needed for a skilled person to uniquely identify the document.

As a matter of common sense, and experience, errors are as likely to occur in typing non-essential information as they are to occur in typing the minimum information, therefore a requirement for more than the minimum for unique identification is not justified by a likelihood of improved data integrity.

The citation standard of 37 CFR 1.98 (b) (1)-(b) (5) is unduly burdensome in requiring much more than the minimum.

For US and foreign published patent documents, country code and publication number are sufficient. First publication is presumed unless a kind code or equivalent is provided. Inventor name, title and/or date are useful only in cases where a typographical error in the publication number was made. Otherwise they are completely redundant of information carried in the country code and publication number.

For most periodical publications, publisher, authors, titles and issue dates are not required. The journal, its year (or volume) and the page number are usually sufficient to uniquely identify the document. The complete article beginning on that page is presumed if multiple pages are not listed. Therefore identification of pages beyond the first page

are not needed, unless less than the complete article is provided. Title and author are needed only to correct an error or if multiple articles occur on the same page. In publications where page numbers are not sequential from issue-to-issue, the publication date is needed. The publisher is usually unknown to the person citing a periodical article.

For texts, author, title, relevant pages, publisher and year are usually needed, but very rarely the publisher location. Well known texts usually do not require publisher and publisher location.

For pending US patent applications the serial number is sufficient if it includes the series code. Filing date is needed for unique identification only if no series code is provided. Inventor and title are redundant except in the case of error.

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37 CFR §1.98(b) (1)-(5)

The incorporation by reference standard should not be tied to rule 1.98. A citation under 1.98 (b) (1)-(5) may reasonably require more detailed date information than is needed to uniquely identify the document since the examiner needs a basis to determine if a document is prior art. Even so, inventor/author names and titles are typically unnecessary and should not be required. Publisher, except in the case of texts, is usually unnecessary and is often unknown. Therefore rule 1.98(b) should also be amended to ease the burden to applicants when documents are not listed due to failure to provide bibliographic information required under current 1.98, but unnecessary to identification and dating of the document.

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