

# New Matter

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## Fall 2006

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## A Farewell Message From Immediate Past President Paul H. McDowall

Dear Colleagues:

In reflecting upon the fastest 12 months of my career as a patent lawyer, I will remember the time I served the Association as President. Having been an active member of the Association for almost 20 years, having the opportunity to lead, however briefly, has been very fulfilling.

Highlights of my brief tenure include appointing and organizing several "Special Committees" including the Past MIPLA Presidents, the Patent Agents, and the IP-Law Students Committees. I thank each member of these committees for helping increase participation and fellowship among the members of the Association. I hope that my successor, Catherine Klima-Silberg, finds value in continuing participation of these committees in the upcoming year. Know that I wish Catherine only

the very best during her tenure at the helm of the Association.

I thank the members of the board of directors of the Association for so ably contributing to the success of the past year. I challenge the members of the Association to help increase participation in Association events and to cultivate fellowship among and between patent lawyers, IP lawyers, patent agents, and law students. I ask that every member of the Association join at least one committee for 2006-2007 fiscal year; preferably, as Chair or Co-Chair, and remain active so that in the future the Association includes diverse members fully prepared to lead us forward.

Very truly yours,

Paul Haven McDowall  
2005-2006 MIPLA President

## President's Letter

I am very honored to have been selected to serve as the 2006 - 2007 MIPLA President. It is exciting to serve in such a role and I sincerely appreciate the opportunity. I thank Paul McDowall for his excellent leadership in the past year as President, and in years past on the Board.

This year we have a number of new Committee Chairs and many new Board members. This will undoubtedly provide for new growth opportunities for MIPLA.

This year will also be one of change to our website with the launching of our completely revised website at its new address. I thank Tim Czaja and Eduardo Drake for their efforts over the year, and I thank Peter Malen for his involvement over the upcoming year. Given the information provided and the ability to communicate with fellow MIPLA members, the MIPLA website will be an invaluable resource for our members and our community.

I know the committees have many plans for events and meetings. I look forward to seeing the high quality committee meetings and round table discussions not only

continue, but expand, and I encourage you to attend these meetings. Many committees have been quite busy already by holding monthly discussions on the many proposed rule changes by the PTO, as well as preparing and submitting comments to the Patent Office. I understand that Tim Bianchi, Tim Czaja, Peter Forrest, Greg Gardella, Brad Pederson, Mark Skoog, and several others were instrumental in putting the comments together and getting the appropriate approvals for their proper submission, and I thank them for their effort.

I hope that you consider becoming active in one or more Committees, and attending at least one of the MIPLA events. It will undoubtedly provide opportunities to learn something new, network, meet new friends, see old friends, and will allow you and our organization to continue to grow.

Sincerely,

Catherine Klima  
2006-2007 MIPLA President

# Dodging A Bullet - Getting Out From Under Your Own Art In Australia

*This article was originally published in the March 2006 issue of Intellectual Property Today.*

## Introduction

It is not unusual for an inventor to make an improvement or modification to an invention subsequent to the first publication of the invention, and it is often the case that the improvement or modification is of marginal patentability over the original or "main" invention.

The availability of a grace period under US law has meant that it may still be possible to pursue protection for the improvement or modification, provided that a US application directed to the improvement or modification is filed within 12 months of the publication of the main invention.

However, problems often arise when seeking corresponding protection for the improvement or modification in foreign jurisdictions. Specifically, it is not unusual in foreign jurisdictions to have a situation arise in which the main invention is cited as prior art against the improvement or modification.

This article offers a solution that is available in Australia when such a situation arises.

## Overcoming an Obviousness Rejection Based on Applicant's Own Publication

It is, of course, preferable to traverse the obviousness rejection if possible. However, assuming this is not possible the solution is to convert the later Australian application (which is directed to the improvement or modification) to be a "Patent of Addition" based on the earlier Australian application/patent (which is directed to the "main" invention).

The relevant provision(1) reads as follows:-

*Where:*

*(a) a patent for an invention (in this Chapter called the main invention) has been applied for or granted; and*

*(b) the applicant or patentee (or a person authorised*

*by the applicant or patentee) applies for a further patent for an improvement in, or modification of, the main invention; and*

*(c) the application for that further patent is made in accordance with the regulations;*

*the Commissioner may, subject to this Act and the regulations, grant a patent of addition for the improvement or modification.*

Importantly for the present scenario, it is further provided(2) that:-

*Objection cannot be taken...in respect of an application for a patent of addition, and a patent of addition is not invalid, merely because the invention, so far as claimed, does not involve an inventive step, having regard to the publication or use of the main invention during the prescribed period.*

"Prescribed period" is defined(3) as follows:-

*The prescribed period is the period that commences on the priority date of the claim of the specification of the main invention and ends immediately before the priority date of the relevant claim of the specification of the patent of addition.*

The result is that publication of the main invention in the window of time between the priority date of the main Australian application/patent and the priority date of the later Australian application is excluded from the prior art base for the purpose of assessing obviousness.

Thus, in essence, the main invention ceases to be prior art, for obviousness, against the improvement or modification. The *quid pro quo* is that the term of the Patent of Addition is tied to the term of the main patent, and some patent term will be sacrificed in adopting this strategy.

Note that there is no restriction on when an application (or patent) may be converted from a normal application

(or patent) to a Patent of Addition. Thus, the conversion may be made during the prosecution of the later application in response to a rejection based on the publication of the main invention. The only restriction on timing is that the initial or "main" application (or patent) must be in force at the time that the later application (or patent) is converted to be a Patent of Addition.

A small collateral benefit for the applicant resides in the fact that no maintenance fees are payable in relation to a Patent of Addition. The Patent of Addition is deemed to be maintained as long as the main Patent is maintained. In the event that the main patent is later abandoned or revoked, maintenance fees will again become payable in relation to the Patent of Addition. However, the term of the Patent of Addition remains linked to the term of the main patent and the forfeited term is not regained.

A Patent of Addition need not be more limited in scope than the main Patent. Put differently, the claims of the Patent of Addition need not be within the scope of the claims of the main Patent. Thus, a Patent of Addition may be used to broaden the scope of the main Patent. In a most extreme example, the Patent of Addition could be broader than the main Patent by complete omission of a claimed feature, with the omission constituting the improvement or modification(4). Having said that, it

should be borne in mind that the improvement or modification will still need to be novel over the main invention, and it may be difficult to make an argument that the broader claim is not anticipated by the publication of the main invention.

### Summary

Converting the later Australian application to be a Patent of Addition has the effect of disqualifying the publication of the main invention as prior art for the purposes of assessing the obviousness of the improvement or modification.

The *quid pro quo* is that there will be some loss of patent term.

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- (1) Section 81
  - (2) Section 25
  - (3) Regulation 2.4
  - (4) see *Hughes Tool Company v Ingersoll-Rand Company Limited* [1977] FSR 406

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## **File At Your Own Risk: The New Rules For Petitions To Make Special**

*By Richard Billion of Schwegman Lundberg Woessner & Kluth PA*

New rules for making Petitions to Make Applications Special became effective on August 25, 2006. The new rules are referred to as the Accelerated Examination Procedure. The Accelerated Examination Procedure covers all but a few of the Petitions to make special. According to the USPTO, the Accelerated Examination Procedure is designed to give Applicants quality patents in less time. In exchange, the patent examiner receives "...more focused and detailed information and the closest prior art from the Applicants." The USPTO policy sounds great, but the new procedure shifts mounds of work from the patent examiner to the patent prosecutor. Along with this shift, the patent prosecutor takes on a large amount of responsibility. This will be

costly for clients and costly to the patent practitioner, in terms of potential exposure to claims of fraud or malpractice. The new Accelerated Examination Procedure also limits the applicant's flexibility during prosecution. The bottom line is that the patent practitioner needs to learn the new rules so that when questions regarding petitions to make special arise, the practitioner can weigh the risks associated with making an application special with the potential upside and advise the client appropriately.

There are only two reasons for a petition to make special that are outside the Accelerated Examination Procedure: the health of the applicant, or when the petition to make

special results from the Patent Prosecution Highway. All other petitions to make special are governed by the new Accelerated Examination Procedure. Under the Accelerated Examination Procedure, the application must be filed electronically and must be accompanied by a petition to make special which is a USPTO form (PTO/SB/28). Form PTO/SB/28 requires:

- A statement that applicant will agree to make an election without traverse in a telephonic interview;
- A statement that applicant will agree to have an interview when requested by the examiner;
- A statement that applicant will agree not to separately argue the patentability of any dependent claim during any appeal;
- A statement that a pre-examination search was conducted; and
- An accelerated examination support document (ESD).

The last two requirements of the Form PTO/SB/28 shift a lot of the Examiner's burden to the shoulders of the patent practitioner. The Pre-examination Search requires a statement that a pre-examination search was conducted and must include:

- An identification of the field of search by U.S. class and subclass and the date of the search, where applicable; and
- For database searches,
  - the search logic or chemical structure or sequence used as a query;
  - the name of the file or files searched;
  - the database service; and
  - the date of the search.

The pre-examination search must also be more extensive than a normal patentability search. The pre-examination search must involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source and includes such a justification with this statement. [See Part I, (8) (A) of Notice in Federal Register on June 26, 2006].

The pre-examination search requirement is just a minor shift in the workload when compared to the last requirement of the Form PTO/SB/28. AE support

document requires a very extensive treatment of the art found in the search. The AE support document must include:

- An information disclosure statement (IDS) citing each reference deemed most closely related to the subject matter of each claim
- An identification of where each limitation disclosed in the references is found
- A detailed explanation of how each claim is patentable over the reference
- A concise statement of utility of the invention
- A showing of support for each claim limitation in specification and any parent application, including any means-plus-function limitations
- An identification of any cited references that may be disqualified as prior art under 35 U.S.C. 103(c).

The AE support document also must be updated for any amended or newly added claims that are not encompassed by the previously-filed AE support document.

In addition, the applicant is limited to 20 claims (3 of which may be independent) at the time of filing and the claims must be directed to a single invention. The patent practitioner must respond to office actions within one month or the application goes abandoned. The responses must be filed electronically, and are limited to the rejection(s), objection(s) and requirements made by the Examiner. The Office will treat any amendments (including after-final amendments and RCE submissions) as not being fully responsive if the amendment: exceeds the 3/20 claim limit; presents claims to a non-elected invention; presents claims not encompassed by the pre-examination search; or presents claims requiring an updated AE support document, which is not submitted.

If the patent practitioner does everything right, the stated goal of the Accelerated Examination Procedure is to get a disposition of the patent application in 12 months. The kicker is that there is no guarantee. Even if the practitioner complies with the rules and the process goes beyond 12 months, the practitioner or applicant can not petition or force the USPTO to meet the stated goal.

The Accelerated Examination Procedure seems risky with no real guarantee that a patent will emerge in a one year time frame. Therefore, patent practitioners

need to carefully consider the risks associated with the Accelerated Examination Procedure before deciding to make an application special.

For additional information consider the following internet links:

- <http://www.uspto.gov/web/offices/com/sol/og/2006/week29/patchng.htm>

- <http://www.uspto.gov/web/patents/accelerated/>

*About the Author: Rich Billion is a registered patent attorney and shareholder in Schwegman Lundberg Woessner & Kluth PA. He can be contacted at [rbillion@slwk.com](mailto:rbillion@slwk.com) or 612-373-6977.*

## **Adventures In Lobbying: Exchanges With U.S. Senators Coleman And Dayton Regarding Proposed Changes To Continuation Practice**

*By Eduardo Drake of Schwegman Lundberg Woessner & Kluth PA*

Patent reform has been in the air for a while now. As a patent attorney, I've generally had the attitude of just accepting whatever rules and laws are in place or coming down the pike and focusing my energy on adapting to maximize the interests of my clients. Sure, I've scratched my head and grouched with colleagues about changes, but nothing more, until last March.

I ended my role as spectator then by writing a letter to our U.S. Senators Coleman and Dayton regarding the proposed continuation rule changes, hoping to stir the pot and draw their attention to the issue. The appended replies suggest that my letter didn't have an impact, but I thought it would be useful to share it with you so that you might leverage one or more aspects of my text in your own letters and thus ultimately play some role, if only a small one, in actually shaping the future of our patent system.

The text of the letter that follows expresses my own personal views, and not necessarily those of my firm, partners, or clients.

Honorable Senator:

I'm a shareholder in the intellectual property law firm of Schwegman, Lundberg, Woessner & Kluth in Minneapolis, one of the leading IP law firms in Minnesota and in the nation. I'm writing today to draw your attention and influence to an issue that is vital not only to U.S. small business, but to American competitiveness in the new knowledge-intensive global economy. The issue is proposed rules changes and generally reform in the U.S.

Patent and Trademark Office.

Patents and intellectual property generally are of more importance today than they have ever been in all of human history. Studies conducted by organizations, such as the Brookings Institution, have shown that the vast majority of the value of knowledge-based businesses is made of intangible assets such as patents, trademarks, copyrights. While these studies are useful and illuminating, one need only look at the gap between the market value of businesses and their book values to understand that intangibles are critical to the wealth of businesses and thus the wealth of our nation. As global trends of outsourcing continue and manufacturing and service sector jobs are moved to regions of the world with lower labor rates, our ability to grow the wealth of the nation will depend on our ingenuity not only to maintain our current position in the food chain, but to find ways to move up to even higher levels.

In this challenging environment, it shouldn't come as a surprise that Americans are rising to the occasion and innovating at an unprecedented rate. Just ask the Patent Office. They have reams of data on the increases in patent filings in recent years. Indeed, patent filings are at an all time high. Unfortunately, rather than viewing the increased filings as evidence of the strong and quickening pulse of America ingenuity, investment, and industry, the patent office leadership is viewing the increased filings with the eyes of 9-to-5 bureaucrats facing a mounting workload. To be sure, any enterprise that faces increased demands for its services must adapt, and most would embrace increased demand and grow

to meet it. Yet, the current Patent Office leadership views itself as "under siege," and is actively working to limit, rather than reinforce, the ability of American innovators to secure their innovations.

Consider, for example, that the Patent Office leadership is actively campaigning to limit the ability of innovators to reinforce patent protection for their most valuable innovations, the ones most likely to be knocked off by foreign and domestic competitors. Specifically, for decades, American innovators have been able to address the inherent uncertainties of our patent process by investing in continuation applications. It is common upon filing a patent application that an applicant and patent examiner will effectively come to a negotiated settlement on the scope of patent rights to be granted. However, even in the best of circumstances, the negotiated settlement is based on factors such as limited information about preexisting technology, limited technical and/or legal understanding of the patent examiner and/or attorney, limited temporal and financial resources of the patent applicant, and/or limited knowledge about the commercial value of the invention. Access to continuation applications gives American innovators an option to make additional investments in patent protection in response to new information and thus to reinforce their patent protection.

Specifically, in the name of reduced workload, the Patent Office leadership is seeking to limit the right of American businesses to invest in reinforced patent protection by giving the Patent Office full discretion to determine whether such applications are necessary. Giving bureaucrats, well-meaning as they might be, the right to decide when further investment in patent protection is warranted or not, is not the right way to encourage innovation and wealth creation in our country. Indeed, the Patent Office has trouble enough examining applications on their merits, without taking on the new task of determining which filed applications are necessary. American innovators are fully capable of making their own business decisions regarding when to invest in a continuation application.

In making its case for this change to limit application filings, the Patent Office trumpets that the change will help reduce the backlog of pending patent applications by slowing its growth. However, it's important to understand that the growth of the backlog isn't the

problem; the backlog is evidence of a vibrant and bustling army of innovators adding wealth to our nation. The problem is that the Patent Office hasn't increased its capacity to service the American people and our demonstrated eagerness to not only innovate, but invest in protecting these innovations. As further support of its case, the Patent Office leadership declares that examination of continuation applications is a waste of resources that could be applied to new applications. This thinking shows that they don't appreciate that a continuation application represents an additional investment in a given technology and that such investment signals the value of that technology. In my view, it makes sense that more resources should be expended to protect innovations with higher value. Moreover, to the extent that application fees fund examination, it's not the patent offices resources that are being wasted, it's the patent applicant's resources. And who's a better judge of how to invest business resources: the Patent Office or American innovators that have created the wealthiest nation on earth? Furthermore, to the extent the Patent Office believes that American businesses are being foolish in pursuing continuation applications, it can discourage this foolishness by raising the fees for continuation applications, rather than adding a new layer of bureaucracy to assess whether these continuations are necessary.

In closing, I note that the Patent Office leadership is seeking this "labor-saving" rule change in a rush manner without a full study or even discussion of the full impact on American global competitiveness, specifically seeking the rule change without real public hearings or any congressional input. The Patent Office proposes to cut off comment on this issue on May 3rd and implement the rule change soon afterward. At the very least, someone with influence should stand up and say: Wait a minute: The Patent Office's job is not to tell the American public that patent applications aren't welcome or necessary, but rather to do all that it can, as part of the Department of Commerce, to effectively process these applications and facilitate the economic growth and prosperity of our nation.

Respectfully submitted,

Eduardo E. Drake  
Registered Patent Attorney, Concerned U.S. Citizen



June 21, 2006

Mr. Eduardo Drake  
1885 Hampshire Lane  
Golden Valley, Minnesota 55427

Dear Mr. Drake:

Thank you for contacting me regarding copyright legislation that may be considered in Congress.

As new technologies are developed at an ever-increasing pace, it is important for Congress to craft laws which balance the rights of those who hold copyrights for the new technologies against the interests of consumers who have legally purchased products incorporating these technologies. Without equal protections for producers and consumers, the entrepreneurial spirit may be stifled and personal freedoms may be infringed upon. As copyright legislation comes before the Senate for consideration, I will keep your concerns in mind.

My best regards.

Sincerely,

Mark Dayton  
United States Senator

From: [Opinion@coleman.senate.gov](mailto:Opinion@coleman.senate.gov)  
[mailto:[Opinion@coleman.senate.gov](mailto:Opinion@coleman.senate.gov)]

Sent: Monday, April 10, 2006 2:56 PM

To: Eduardo Drake

Subject: Re: www\_email

Dear Pastor and Mr. Drake : [I'm not a pastor, but play one on TV; I think I checked the wrong box on a Coleman's website]

Thank you for taking the time to contact me concerning, H.R. 2795, the Patent Reform Act of 2005.

On June 8, 2005, Representative Lamar Smith (R-TX) introduced H.R. 2795 to fundamentally reform U.S. patent law. As you may know, patents and trademarks

help drive America 's high-tech economy. The Patent and Trademark Office (PTO) serves a critical role in the promotion and growth of new innovative products in the U.S.

I believe that any reform should shorten pendency, improve quality, and modernize the PTO. That is why on May 12, 2005, I introduced legislation (S. 1020, the COMPETE Act of 2005) to modernize and improve the federal patent and trademark process. My legislation would prevent the current diversion of patent fees to the general budget by allowing the PTO to collect in fees only what it is appropriated to spend.

I appreciate hearing from you and hope you will not hesitate to contact me on any issue of concern to you.

Sincerely,

Norm Coleman  
United States Senate

Honorable Senator Coleman:

Thank you for your reply. Please note that I am not a pastor, but a registered patent attorney. If I understand your message correctly, your legislation proposes to end fee diversion by eliminating collection of fees beyond actual operation expenses of the Patent and Trademark Office. I'm in full support that fee diversion should end, since its a back-door tax on American innovation.

However, this legislation you describe does not appear to address the concern raised in my letter that the current Patent Office leadership is seeking to reduce pendency by reducing the options for American innovators to protect their most valuable inventions. In essence, the patent office leadership is taking the position that the surge in demand for its services is bad, and that it knows better than the innovators when filing patent applications, specifically continuation applications, on their technology is warranted. Congress has authorized the filing of such continuations for decades, and the Patent Office leadership is now seeking to limit the scope of this authorization by imposing significant bureaucratic hoops for innovators to jump through.

This issue has nothing to do with fee diversion, and

everything to do with a myopic view that increased patent filings are a problem rather than a growth opportunity for America.

I urge you to follow up with the patent office leadership and ask them why it wants to take on the role of deciding when American innovators can file Congressionally-authorized continuation applications to protect their most valuable innovations, instead of fully focusing its energy on expanding its capacity to meet the growing demand for quality patent applications. Defeating the demand

of innovators is not the answer; meeting the demand is.

Respectfully,

EDUARDO E. DRAKE  
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## MIPLA's Comments On Proposed Changes To IDS Requirements

*By Intellectual Property Law Revisions Committee, Greg Gardella, Chair*

**Via Electronic Mail: [AB95.comments@uspto.gov](mailto:AB95.comments@uspto.gov)**  
**Confirmation by Facsimile: (571) 273-7707**

Honorable Jon W. Dudas  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark  
Office  
Mail Stop Comments—Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Attn: Hiram H. Bernstein, Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent  
Examination Policy

Robert J. Spar, Director  
Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent  
Examination Policy

Re: Comments on Notice of Proposed Rulemaking  
entitled "Changes to Information Disclosure  
Statement Requirements and Other Related  
Matters," 71 Fed. Reg. 131 (July 10, 2006)

Dear Under Secretary Dudas, Mr. Bernstein, and Mr.  
Spar:

The Minnesota Intellectual Property Law Association  
(MIPLA) is grateful for the opportunity to comment on  
the Notice of Proposed Rulemaking entitled "Changes  
to Information Disclosure Statement Requirements and

Other Related Matters" (the Proposed IDS Rules).

MIPLA is an independent organization affiliated with  
the Minnesota State Bar Association (MSBA). MIPLA  
has nearly 700 members representing all aspects of  
private and corporate intellectual property practice, as  
well as the academic community. MIPLA represents a  
wide and diverse spectrum of individuals, companies,  
and institutions involved directly or indirectly in the  
practice of patent law before the United States Patent  
and Trademark Office.

### General Comments

The Proposed IDS Rules create substantial incentives  
for applicants to remain purposefully uninformed of the  
prior art and thus are likely to degrade, not enhance,  
the quality of patent examination. While we understand  
and empathize with the goal of the PTO to improve the  
quality of patent examination by shifting to applicants  
where appropriate certain duties associated with the  
examination of patent applications, care should be taken  
to avoid incentivizing applicant behavior that prevents  
the PTO from achieving that goal. The enlarged  
disclosure duties outlined by the Proposed IDS Rules  
encourage applicants to avoid educating themselves  
regarding the prior art, as by conducting pre-filing  
patentability studies. In particular, applicants will readily  
understand that if they perform patentability studies they  
will be much more likely to find more than 20  
references or references of more than 25 pages that  
require consideration, which in turn may trigger the duty  
to provide Identifications, Correlations, and

Noncumulative Descriptions for a significant number of references. The PTO's other proposed rules concerning Examination Support Documents (ESDs)(1) substantially amplify this incentive. The net effect of the Proposed IDS Rules and proposed rules concerning ESDs is that applicants who conduct pre-filing searches are likely to find it necessary to provide Identifications, Correlations, Non-cumulative Descriptions, and ESDs for a substantially greater number of references. Accordingly, we respectfully submit that the Proposed IDS Rules are likely to cause many applicants to avoid pre-filing patentability investigations or otherwise inquiring as to the state of the art, which will result in substantially fewer relevant references being disclosed to the PTO. The PTO should withdraw the Proposed IDS Rules in favor of a revised set of rules that shifts a less burdensome set of duties onto applicants.

#### Specific Comments

##### 1) The Proposed IDS Rules Should Be Applied Only to New Applications Filed after the Effective Date of the Rules

Application of the Proposed IDS Rules to all applications pending as of the Effective Date of the rules would impose significant additional disclosure requirements without notice sufficient for applicants to have taken steps to mitigate the potentially prejudicial and burdensome effect of the Proposed IDS Rules. In particular, where applicants have submitted before the effective date more than 20 references or references longer than 25 pages in connection with a pending application, the Proposed IDS Rules would trigger the additional duties to provide an Explanation, Non-cumulative Description and/or Patentability Justification even though the references were submitted long before the Office even proposed the new rules. Each of the foregoing disclosure duties is not only costly to discharge but potentially prejudicial given the likelihood that the Explanations, Non-cumulative Descriptions and Patentability Justifications will fuel charges of inequitable conduct where, with the benefit of focused hindsight, a litigant believes that an applicant should have characterized or described a reference differently

While the comments in the Notice of Proposed Rulemaking suggest that an applicant could "withdraw" an IDS already on file in an existing case for purposes of attempting to comply with the proposed limits on cited

references (71 Fed. Reg. No. 131 at page 38813, col. 3), there are no provisions in the existing Rules or in the Proposed IDS Rules that provide for such a request. This omission creates a procedural vacuum which in turn causes substantial uncertainty as to what effect, exactly, a request to withdraw a reference would have. Substantial ambiguities include whether references may be "withdrawn" after they have already been considered by the examiner, whether pending the Office's decision on a request to withdraw references an applicant's disclosure duties could change due to an intervening Office Action or Notice of Allowance, and whether a request to withdraw a reference could form the basis of a charge of inequitable conduct before the Office.

Moreover, attempting to apply the new rules to pending applications will divert substantial PTO resources away from other quality enhancing initiatives. For each pending application PTO personnel would have to review the references submitted and determine whether one or more of the disclosure duties has been triggered, an effort that is likely to require hundreds of thousands of personnel hours. The public is better served by focusing the PTO's limited resources elsewhere, in particular on the recruiting and training of talented examiners.

Accordingly, it is submitted that the Proposed IDS Rules should be amended to provide that the disclosure requirements of Proposed Rule 98(a)(3) apply only to new applications filed after the effective date of the rules.

##### 2) Alternatively, the PTO Should Apply the Proposed IDS Rules only to Information Disclosure Statements Filed After the Effective Date or to Applications in which No Office Action on the Merits Has Been Issued as of the Effective Date

If the PTO declines to adopt the foregoing suggestion to apply the Proposed IDS Rules only to new applications filed after the effective date of the rules, the PTO should consider one of the following intermediate measures. First, the Proposed IDS rules could be applied to only those IDSs filed after the effective date of the rules. This proposal would substantially mitigate the aforementioned burden on applicants while circumventing the expenditure of limited PTO resources on enforcement of the Proposed IDS Rules to previously filed IDSs.

As a second alternative, the PTO could apply the Proposed IDS Rules to only those applications in which no office action on the merits has been issued as of the effective date. This would mitigate the burden on applicants who have already received an office action and need to submit additional references in connection with claim amendments. Where such applicants have already submitted 20 references they will be unfairly burdened with the additional duty of preparing Explanations and Non-cumulative Descriptions for all cited references. Conversely, where an applicant has not received an office action as of the effective date, only an Explanation for each such reference would be required. Accordingly, as a second but less desirable alternative the PTO could apply the Proposed Rules to only those applications in which no office action on the merits has been issued as of the effective date.

### 3) Filing a Continuation Application for the Purpose of Submitting References in Compliance with the Rules Should Presumptively Qualify as Good And Sufficient Cause for Filing a Second or Further Continuation

Especially if the Proposed IDS Rules are applied to all applications pending as of the effective date of the rules, the Proposed Continuation Rules(2) should be amended to provide that filing of a continuation application for the purpose of complying with the Proposed IDS Rules should not be counted against any limit imposed by the Office on the number of continuation applications that may be filed by an applicant. Where applicants cannot proffer a patentability justification for newly discovered art (e.g., the art anticipates some or all pending claims), the Proposed IDS Rules leave applicants no choice but to file a continuation application to submit the reference. Filing a continuation application to submit prior art references should thus be considered a sufficient showing that the “arguments, evidence or amendments could not have been submitted during the prosecution of the prior filed application” under Proposed Rule 1.78(d)(1)(iv).(3) The Proposed Continuation Rules should be amended accordingly.

This issue highlights the need for the PTO to clarify when filing a continuation application meets the “could not have been presented earlier” test set forth in Proposed Rule 1.78(d)(1)(iv). In particular, the PTO should provide examples of circumstances which would ordinarily satisfy the test together with contrasting

examples of circumstances which would not be expected to satisfy the test. Additionally, the PTO could provide factors which will be considered in determining whether an applicant has made the showing required by Proposed Rule 1.78(d)(1)(iv).

### 4) To Eliminate the Incentive for Examiners to Avoid Considering References by Arbitrarily Deeming Them “Cumulative,” the Proposed IDS Rules Should Be Amended to Provide that Examiner Must Consider All References Where No More than 20 References are Submitted

Proposed Rules 97(i)(1), 98(a)(3)(vii)(C) and 98(c) provide Examiners an incentive to arbitrarily deem references “cumulative” and thereby avoid having to consider them. Such a cumulateness finding by the Examiner under Proposed Rule 98(c) made in connection with an office action would force the applicant to provide both an Explanation and a Non-cumulative Description because the IDS would be resubmitted after a first action on the merits (a reality which is acknowledged in the Notice’s comments on Proposed Rule 98(c)). This, in turn, would give the applicant a strong incentive to submit fewer references in order to control the costs associated with preparing the required Explanations, Non-cumulateness Descriptions and/or Patentability Justifications. Examiners will presumably understand that aggressive application of the cumulateness provision of Rule 98(c) will lessen their workload by i) forcing applicants to provide Explanations, etc. where such disclosures would not be otherwise required, and ii) discouraging applicants from citing the full 20 references ostensibly permitted by the Proposed IDS Rules. It is respectfully submitted that incentivizing examiners to behave in this manner will impair the quality of patent examination. Accordingly, Proposed Rule 98(c) should be amended to provide that an examiner may not refuse to consider as cumulative any references where a total of 20 or fewer references have been submitted.

Furthermore, the PTO should clarify the standard for cumulateness that is to be applied in connection with Proposed Rule 98(c). The Proposed IDS Rules provide that noncumulateness may be shown, for example, by identifying a “feature, showing or teaching that is not found in any other document of record(4).” While this provides some context, several ambiguities remain. For

instance, it is unclear whether existing case law concerning cumulateness in the context in inequitable conduct will govern the determination of cumulateness under Proposed Rule 98(c). Similarly, it is unclear whether the discussion of cumulateness in MPEP 609.04(a) is intended to apply to cumulateness under Proposed Rule 98(c).

#### 5) The Page Limit of Proposed Rule 98(a)(3)(B) Should be Removed

We further note that the 25 page limit (see Proposed Rule 98(a)(3)(B)) may impose an unwarranted and substantial burden on a relatively large number of applicants. The Office proffers as a justification for the Proposed Rules the statistic that in 85% of applications allowed in a six-week period the majority of applicants submitted fewer than 20 references. However, the PTO has furnished no statistics concerning the fraction of applicants that submit references having more than 25 pages. In many technical areas references are often longer than 25 pages. Perhaps a majority of applicants will be required to provide Identifications, Correlations, and Non-cumulative Descriptions for at least several submitted references. Especially when viewed through the prism of the incentives created by the Proposed IDS Rules (in particular, the incentive to remain uninformed of the prior art so as to avoid the substantial disclosure duties), we submit that Proposed Rule 98(a)(3)(B) should be amended to remove the trigger based on reference page counts.

#### 6) Transitional Issues Concerning Information Disclosure Statements that Are Already on File as of the Effective Date

If the Office decides notwithstanding the foregoing to promulgate the Proposed IDS Rules in substantially unamended form, two measures should be adopted in order to smooth the transition. First, the provisions regarding reference page limits should not be applied to pending applications, as that would permit an examiner to interrupt prosecution on a reference due to its page count. Secondly, the new rules should not be applied to pending cases in which restriction requirements have been issued because IDSs for such applications may have included prior art for multiple distinct inventions, thus rendering the new 20 reference limit unfair and unduly burdensome.

### Conclusion

MIPLA submits that the Proposed IDS Rules are likely to degrade the quality of patent examination due to the applicant behavior they encourage. Because the burdens hoisted on applicants by the Proposed Rules are substantial, many applicants will avoid fully educating themselves – and thus the PTO – as to the state of the art. If the PTO nevertheless decides to promulgate the Proposed IDS Rules, they should be applied only to applications or IDSs filed after the effective date. The freedom of examiners to deem references cumulative (and thus avoid considering them) should be curtailed. The page count limitation should be removed as unduly burdensome to a large percentage of applicants. Lastly, as a transitional measure the Proposed IDS Rules should not be applied to pending applications involving previously issued restriction requirements.

Thank you for your kind consideration of these comments and suggestions. If the Office desires to discuss any of the foregoing issues in further detail, the committee responsible for formulation of these comments can be reached at [lawrevisions@lists.statebar.gen.mn.us](mailto:lawrevisions@lists.statebar.gen.mn.us).

Sincerely,

Greg H. Gardella  
Chairman  
Intellectual Property Law Revisions Committee of the  
Minnesota Intellectual Property Law Association  
On behalf of the  
Minnesota Intellectual Property Law Association

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(1) See proposed Rule 261 in the Notice of Proposed Rulemaking Entitled “Changes To Practice for the Examination of Claims in Patent Applications,” 71 Fed. Reg. 61 (January 3, 2006).

(2) Notice of Proposed Rulemaking Entitled “Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims,” 71 Fed. Reg. 48, January 3, 2006.

(3) Id.

(4) See Proposed Rule 98(a)(3)(5).

# Minnesota Inventors Hall Of Fame: Applications Wanted

*By Robert Gutenkauf of Gray Plant Mooty Mooty & Bennett PA*

The Minnesota Inventors Hall of Fame is seeking applications for induction into the Hall of Fame. Potential inductees should have a strong Minnesota connection and have made inventions that have substantially contributed to the economic vitality of Minnesota or the well-being of its citizens. The Hall of Fame website is [www.minnesotainventors.com](http://www.minnesotainventors.com). Please see this website to view past inductees. The website lists these qualifications for induction:

- A candidate is one who is an innovator, a creator, a solver of problems.
- A candidate is one who has made a significant contribution to the betterment of life - especially here in Minnesota.
- The impact of the candidate's contribution in the general economic sphere in terms of capital injected, business generated or jobs created.
- The impact in the social sphere in terms of improved quality of life through greater convenience, saving of time, better health, safety, superior products, etc.

- Most likely, the candidate's inventions will have had a significant impact in both economic and social areas.

- A candidate's contributions may be measured in terms of patents, but the number of patents, if any, is secondary to considerations of economic and social impact.

- A candidate regards himself/herself as a Minnesotan and is so recognized by others.

- A candidate has strong Minnesota ties through any one or more of birth, education, long residence, employment, family relationships, or the like, but contributions for which he/she is honored need not be made in Minnesota.

Nominations can be made through the website or can be mailed to the Hall of Fame. For questions or assistance in preparing a nomination please contact Jim Young at 612-330-0495 or Bob Gutenkauf at 612 632-3086.

# Will IDS Rule Changes Increase Need For Translations?

*By Jeffrey Nadeau*

The PTO claims that its proposed new IDS rules will "promote innovation and spur economic growth". However, the Office's real goal is to streamline the examination process by placing more responsibility on the shoulders of the practitioner. Such a shift in responsibility is not necessarily inappropriate, but the bottom line is that more costs will be borne by the client to perform this work. This could curtail investment in intellectual property, not promote it. It could also encourage applicants to avoid a thorough search of the prior art if it leads to excessive numbers of references. Also, foreign references may end up being avoided altogether. The correlation requirements of the new rules (see Proposed Rule 98(a)(3)(iv)) would call for the practitioner to identify the specific feature, showing or

teaching of the document that caused it to be submitted, identify the portion of the document where it may be found, and correlate the specific feature, showing or teaching to specific claim language or language in the specification in support of the claimed invention at a level of specificity commensurate with such feature, showing, or teaching. This cannot be done without actually reading through the document, thus necessitating translation of foreign references, whereas an abstract would have sufficed to satisfy the old rule. As patent translation is not inexpensive, it is called for only when absolutely necessary. In addition, the quality of the translation is likely to become more of an issue.

Assuming the Office promulgates the new rules and

this challenge becomes a reality, how can the patent profession minimize the cost burden that will surely be placed on the client? Since the most cost-effective use of a practitioner's skill is in the crafting of a strong patent portfolio, not in the correlating of prior art for the benefit of the examiner, this would seem like a task best suited for outsourcing either to an in-house resource or to a third party.

Regarding patent translation services, which are typically outsourced, one possible solution would be to pay for a review and correlation of the foreign document in the form of a summary by a bilingual expert, notwithstanding any possible Rule 56 conflicts. It would be much less expensive to pay by the hour for a review instead of by the word for a translation. This way, the IDS requirement could be met with regard to foreign references without it resulting in excessive costs. Currently, the majority of translations of patents and related documents is contracted by large firms who use

translation agencies. Smaller clients will not be able to afford this expense.

Regarding correlation and non-cumulative descriptions in general, it would seem logical to use the least expensive resources possible for this arguably less specialized work. The question is whether most practitioners have the resources in house or whether they would (or must) do it themselves. The law of supply and demand may require them to lower their prices for this portion of the work, thus reducing their overall effectiveness. Is there an opportunity for a patent searching/correlating agency here?

Comments on this topic are welcome.

*About the Author: Jeffrey Nadeau is a patent agent and a freelance German - English technical/patent translator. He can be reached at [duff2beat@msn.com](mailto:duff2beat@msn.com) or by phone at 952-201-9001.*

## Member News

**Spring Alumni CLE Symposium  
sponsored by  
Hamline University School of Law  
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**"Protecting Your Clients' Content: The IP Challenges of Music, Media and Business Practice in Cyberspace"**

This Spring Alumni CLE Symposium will take a practical look at Internet-related intellectual property issues faced by lawyers with clients in the entertainment industry, as well as any business with an active online presence. Speakers will discuss recent court rulings related to Internet content, including employment law issues related to online postings, trade secrets, third party software and other digital media. The symposium also will cover strategies to address how best to manage clients' publishing, advertising, and media production in a rapidly changing world.

For more information, please contact Hamline Law Alumni Director Susan Hayes Stephan at 651-523-2338 or [sstephan01@hamline.edu](mailto:sstephan01@hamline.edu).

**John Beard Joins Faegre & Benson  
to Lead Trademark Practice**

Senior trademark attorney John Beard has joined the law firm of Faegre & Benson, where he will head the firm's global trademark practice. Beard will be a partner in the firm's Minneapolis office and a senior member of the firm's nationally recognized Intellectual Property group. Prior to joining Faegre & Benson, Beard was a senior vice president at the Minneapolis intellectual property law firm Merchant & Gould. He is a former chair of that firm's trademark practice.

**New Saint Paul Intellectual Property Law Firm**

Keith Campbell, Anna Nelson, and Brian Whipps are pleased to announce the formation of CAMPBELL NELSON WHIPPS, LLC in Saint Paul, Minnesota. See [www.cnwiplaw.com](http://www.cnwiplaw.com) for more information.

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