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November 30, 2016

TO: Matthew Sked  
Legal Advisor, Office of Patent  
Legal Administration, Office of the  
Associate Commissioner for Patent  
Examination Policy

Re: Comments in response to "Revision of the Duty To  
Disclose Information in Patent Applications and  
Reexamination Proceedings," Docket No.:  
PTO-P-2011-0030, RIN 0651-AC58, published at  
81 FR 74987 (2016)

Dear Mr. Sked:

I have been a registered practitioner in private practice since 1994. I am involved in IP focused BAR organizations and I am founder of Neifeld IP Law, PC. However, these comments are my own.

The Office requested comments *inter alia* on a proposed change to rule 1.56(b) that would redefine what information is "material" to patentability.

Existing rule 1.56(b) states in pertinent part that:

(b) Under this section, information is material to patentability when ... (1)  
It establishes, by itself or in combination with other information, a *prima facie*  
*case of unpatentability of a claim*; ... A *prima facie* case of unpatentability is  
established ... *before any consideration is given to evidence which may be*  
*submitted in an attempt to establish a contrary conclusion of patentability.*

Propose rule 1.56(b) states that:

(b) Information is but-for material to patentability if the Office *would not*  
*allow a claim* if the Office *were aware of the information*, applying the  
preponderance of the evidence standard and giving the claim its broadest

reasonable construction consistent with the specification.

There is an ambiguity in the propose rule. Compare the existing rule's express statement that the information is material "*before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability*" to the propose rule's lack of such an express statement. The "before" language in existing rule 1.56(b) is consistent with the concept of a *prima facie* case. The proposed rule, due to omission of the "*prima facie*" and "before" recitations suggests that the policy of the PTO would be to interpret "material" to include "*consideration ... [of] evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.*" This is rebuttal evidence on this issue of materiality. However, that inference is not express in the proposed rule. Therefore, the public is not certain whether a reference upon which a claim was rejected is "material" if in fact that rejection is not proper due to facts not yet considered.

For example, take the situation in which the Office rejects a claim based upon a publication. Subsequently, the patent applicant submits a 37 CFR 1.130 declaration that disqualifies that publication from being prior art. The publication is material under existing rule 1.56(b). Is the publication material under proposed rule 1.56(b)? Assume that publication was not submitted during patent application prosecution and then the resulting patent is involved in a PTAB proceeding. Would the PTAB consider the applicant's failure to disclose that publication either application prosecution or during the PTAB proceeding a violation of its rule proposed rule 1.56(b) or the PTAB's rule 42.11(a)? I believe the answer to these questions are not clear from the proposed rule. To flip the issue, is a patent applicant under a duty to disclose to the Office a publication derived from the inventor named in the patent application, when that publication is disqualifiable under rule 37 CFR 1.130?

A duty to disclose such a publication during application prosecution would appear to be economically inefficient because the publication is not prior art and therefore ultimately of no value to the PTO.

You may consider one option to address this concern is by way of a policy notification in a final rule package, stating how the PTO may interpret the rule to mean something other than what it actually expresses. However, a comment in a final rule providing a general policy statement is not legally binding, and an agency cannot apply or rely upon a general statement of policy as law. *See Unwired Planet, LLC v. Google Inc.*, 2015-1812 (Fed. Cir. 11/21/2016) ("General policy statements, however, are not legally binding and, without adopting a policy as a rule through rulemaking, an 'agency cannot apply or rely upon a general statement of policy as law.'" citing earlier cases.)

I suggest you amend the proposed rule to specify that the test for materiality depends upon all information, whether or not submitted to the Office. For example, consider further amending proposed rule 1.56(b) as shown below:

(b) Information is but-for material to patentability if the Office would not allow a claim if the Office were aware of the information *and all rebuttal information*, applying the preponderance of the evidence standard and giving the claim its

broadest reasonable construction consistent with the specification

This proposal contains no time limitation to when the Office became aware of "the information" and "all rebuttal information." and this proposal is not limited to whether "the information" and "all rebuttal information" was submitted to the Office.

Very truly yours,  
Rick Neifeld, Neifeld IP Law, PC

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