From: Tammi.Murray [e-mail address redacted]
Sent: Tuesday, October 11, 2011 4:06 PM
To: AC58.comments
Cc: [e-mail addresses redacted]
Subject: Comment on Proposed Rule Changes

Dear Mr. Bernstein:

Attached is the comment of Washington State Patent Law Association on the proposed rule change published July 21, 2011, in the Federal Register (76 FR 18,408). The deadline to submit comments was September 19, 2011; however, Washington State Patent Law Association was kindly granted an extension of time, until October 11, 2011, to submit their comments.

Thank you.

Amanda Carmany-Rampey Ph.D.
Associate

Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attention: Hiram H. Bernstein, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy

VIA EMAIL ONLY
AC58.comments@uspto.gov

Dear Mr. Bernstein,

In response to the request for comments regarding the proposed rulemaking published on July 21, 2011, in the Federal Register (76 FR 18,408) applying to 37 CFR Part 1 "Revision of the Materiality to Patentability Standard for the Duty To Disclose Information in Patent Applications," the Washington State Patent Law Association ("WSPLA") desires to provide the following comments. WSPLA generally views favorably the efforts by the U.S.P.T.O. to harmonize the materiality standard for the duty of disclosure to the standard set forth by the Federal Circuit in *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F3d 1325 (2011). It is the opinion of WSPLA that §§ 1.56 (b)(1) and 1.555 (b)(1) set forth a workable standard for determining materiality of information. Further, it would be beneficial to practitioners to have a single, uniform standard.

With regard to §§ 1.56 (b)(2) and 1.555 (b)(2), however, WSPLA is concerned that while the rules specify that information is material if the applicant engages in affirmative egregious misconduct before the Office as to the information, neither the *Therasense* opinion nor the proposed rule clearly define the boundaries of "affirmative egregious misconduct." *Therasense* and the U.S.P.T.O. have provided guidance on what sorts of activities do not constitute affirmative egregious misconduct, but have given little guidance on what sort of affirmative conduct constitutes affirmative egregious misconduct. Greater clarity would be a benefit to practitioners.

Thank you,
/ Peter J. Knudsen /
President, WSPLA

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