From: Rob Sterne [e-mail address redacted]
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To: aia_implementation
Cc:[e-mail address redacted] Gongola, Janet
Subject: Supplemental examination

RGS Comment #3 (see disclaimer in RGS Comment #1)
Ms. Gongola:
My colleague Sal Bezos and I appreciate the opportunity to provide comments for the Group 2 Proposed Rule Makings. We have reviewed AIA Sec. 12 relating to Supplemental Examination, and would like to provide some comments. These comments are provided in order to raise potential issues for consideration by the USPTO while drafting the rules and regulations, and not to encourage any particular view or outcome. As such, these comments do not necessarily reflect our individual views or the views of our firm - - Sterne, Kessler, Goldstein & Fox, PLLC - - or its clients.
It is appreciated that 35 U.S.C. 257 ends up drawing a distinction between inequitable conduct and fraud. Inequitable conduct is a sensitive topic for patent practitioners, given the pitfalls that may lead to a finding of the same where there is high materiality but low intent. Such a case, however, does not necessarily rise to the level of fraud.
35 U.S.C. 257 requires that the USPTO refer matters where material fraud may have occurred to the Attorney General for further action ("If the Director becomes aware … that a material fraud on the Office may have been committed … the Director shall also refer the matter to the Attorney General"). While it is appreciated that the USPTO does not have the same dedicated resources available to the Attorney General for investigations of fraud, care should be taken in deciding which matters to refer. Overzealous reporting may have a chilling effect on use of Supplemental Examination, which is a useful tool for remedying "inadvertent" matters of inequitable conduct (high materiality / low intent).
On the other hand, where material fraud is likely to exist, the USPTO should provide increased scrutiny in its review. Examiners handling supplemental examinations should be trained in spotting issues suggesting material fraud. It would be detrimental for this proceeding to encourage unscrupulous applicants to deliberately withhold material information during prosecution with the express intent of curing only after issuance and only as necessary.
To facilitate this process, some argue that patent owners seeking supplemental examination be required to provide information, under oath, regarding the date when they first became aware of the defect leading to a request for supplemental examination. This need not be an exact date, and perhaps a statement indicating awareness sometime "after issuance" could be treated as sufficient. Statements indicating awareness sometime "before issuance" can require additional explanation of reasons why the defect was not earlier rectified.
Moreover, a request to correct a patent via supplemental examination should be complete. This means that a patent owner should not attempt to correct only a few errors known to him or her, but should affirmatively state that the supplemental examination request is filed in an attempt to correct all errors known to the patent owner at the time of filing of the request. Such declaration would likewise facilitate the USPTO's fraud-awareness efforts, and at a minimum provide further evidence of any fraudulent intent that can be cited in later litigation, as needed.
Allowing patent owners to remedy such matters of potential inequitable conduct may have the effect of reducing the size and scope of information disclosure statements that flood the USPTO every day. Patent practitioners often cite numerous documents to the Office out of an abundance of caution, increasing pressures on examiners tasked with evaluating the relevance of these submissions. This has been referred to by the Office as "pathological disclosure." Proper implementation of supplemental examination is an essential piece of the puzzle to facilitate the reduction of USPTO backlog and the burden placed on examiners dealing with large information disclosure statements. It is important that this tool remain available without being considered overly burdensome or downright dangerous to use.
Thank you
Robert Greene Sterne and Salvador M. Bezos