PTO 2004-0629

[Translation of Spanish Letter]

FROM:
Heath W. Hoglund

DATE:
November 12, 2003

TO:
Mr. Hiram Bernstein

RE:
Comments on proposed regulations known as Changes in favor of the Implementation of the 21st Century Strategic Plan of the United States Patent and Trademark Office

Dear Mr. Bernstein:

I, the undersigned, respectfully submit comments on the Notice of Proposed Regulations, Federal Register, Volume 68, No. 177, September 12, 2003. The submitted comments are directed specifically toward the proposed amendments to 37 C.F.R. §1.105.

1. First General Comment: Requests for Privileged and Confidential Information

It is requested that Rule 105 include a statement clarifying that privileged and confidential information may not be requested under Rule 105.

According to what is currently established and under the proposed amendments, Rule 105 seems to be sufficiently ample and far-reaching so as to cover privileged information such as commercial secrets, legal work, information protected under attorney-client privilege, or any confidential information that is not typically simple to obtain through an agency. The courts are clear in that an agency, as a rule, cannot request any information without having presented significant reasons specifically detailing the type of information requests and why such information is necessary. For example, in order for an agency to be able to obtain a document which is protected by the confidentiality of an attorney with his client, said agency must follow Rule P.26(b)(3) of the Civil Federal Procedure and demonstrate that there is an important need to obtain said information. On the contrary, Rule 105 gives much less weight to a "reasonable need" to obtain said information.

One option is to request that a clarification be added to the rule, explaining that a complete response to a request for information would consist of the fact that the required information is a commercial secret, a legal work, protected by attorney-client privilege, or confidential, and thus

exempt from being made public.

Another additional alternative is to require that an applicant be permitted to submit, in response to a request for information, a statement that the information is confidential under one of the aforementioned (or other recognized) standards, and is impartial (for example, is not decided by the examiner working on the application), an effective and confidential mechanism for determining if in fact the information is protected and should be exempt from being requested.

The clarification of the rule which is being requested has a greater relevance due to the fact that all information being provided during fulfillment is available to the public in general when an application is being converted to a patent, and presently, there is no mechanism for providing confidential and protected information to an examiner while an application is being worked on, in such a way that the confidentiality and protection of the information are assured.

2. Second General Comment: Resolution of Disputes

Inevitably, disagreements will arise between applicants and examiners concerning the extent of interrogatories and ambiguous stipulations. It is requested that a first mechanism to resolve said disagreements in a just and impartial manner be provided in Rule 105. Preferably, said mechanism would be much faster than a request to the commissioner, which would cause a considerable delay in the fulfillment of a request. Of course, an applicant could in any case make a request to the commissioner if so desired (before or after the first mechanism).

3. Third General Comment: Inadequate Change of The Burden of Evidence

It is requested that Rule 105 include a statement clarifying that information requests not be used to impose a burden on the applicant to demonstrate the first intent which his invention can be patented.

Some aspects of the proposed amendments to Rule 105 could be used by an examiner to eliminate the *prima facie* burden falling on an examiner to prove that an invention cannot be patented, and absent this, require the applicant to prove that his invention can be patented.

For example, a first official response from the examiner could include a request that the applicant indicate the differences that can be patented between the declarations in question and the documentation presented regarding already known previous inventions. This would be equivalent to the order that the applicant (i) determine the extent and content of this proof, and (ii) determine the differences between the proof and the declarations in question. If the examiner does not present proof of these factors, the order would be equivalent to a request so that the applicant could revise the declarations. Regardless, it is well established and recognized in the MPEP §2142 that "(the) examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." In accordance with this, the use of the rule

would clearly be inappropriate.

4. Fourth General Comment: Concrete Solutions

It is requested that Rule 105 include a statement clarifying that requests for information not be made unless the required information is "reasonably necessary" for examining or handling a matter properly in a patent application. Although the rule currently determines that requests for information must be reasonably necessary for handling a matter in an application, the required language would place much more importance on reasonable necessity as a preliminary requisite for a request for information.

5. Fifth General Comment: Specification Supported in the Record

It is requested that Rule 105 include a statement that the record support the proposition that that the information being requested in particular is reasonably necessary to examine the application in further detail.

If the record does not need to demonstrate that the information is reasonably necessary, an adequate revision of such request (for example, a request to the commissioner) could at most be decided arbitrarily.

Respectfully,
[signature]
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