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Submitter Information

Name: Steven Hoffberg
Address:
Hoffberg & Associates
29 Buckout Road
West Harrison, NY, 10604
Email: steve@hoffberglaw.com
Phone: (914) 949-2300
Fax: (914) 400-2486

General Comment

Sir:

I am a practicing patent attorney.

This request for comments seeks comments on various forms, including SB-08, the information disclosure form. This forms seeks redundant information, i.e., patent/publication number. applicant/inventor, and issue/publication date. In fact, patent/publication number is unambiguous, and should be sufficient. When an applicant has a list of patent numbers, and seeks to fill out the form, this requires a lookup for each, taxing the USPTO's own servers, which are under stress and frequently fail under normal load (especially Private PAIR). I recommend that the form be amended to require only the patent or publication number, and avoid the redundant information lookup.

Further, the requirements of the USPTO require upload of foreign patent references and non-patent literature, where copies are already within the possession of or readily available to the USPTO. This, in turn, incurs a massive unnecessary applicant burden in acquiring, converting to EFS compliant format, and uploading the references, and then the USPTO archiving and maintaining an IFW bloated with potentially hundreds of such references. Further, copies from a digital library may be higher resolution and avoid grey-screening artifacts that are common in uploaded PDFs.

The SB-08 form also lacks a certification checkbox that the IDS is being filed within a time window in which there is no other fee or certification required. While it is also possible to file with no certification, the form and

its interpretation would be clearer if the required alternate is an available option.

Finally, while the fillable-SB-08 form is reasonably useful, there should be an HTML webform alternate to simply upload a list of patents and publications (without arbitrary limitation on the number of items listed), which may then be entered into the official record without undue information transfer. To the extent that a PFD form is required for OBM approval, the form could have a large text box which accepts reasonably formatted text which can then be extracted by the USPTO using its own tools.

Further, in various cases within my own practice, I perform one or more searches against reliable databases, and harvest the results for submission within an IDS. It would appear that it would be more efficient for both applicant and examiner if, for searches against USPTO-accessible databases, that the query itself be providable to the Examiner, which can then be executed, aggregated with the Examiner's own searches, or executed against different databases. Currently, there is no way to submit a proposed class or Boolean-defined search, and no reasonable way to convey what search results represent.

This is complicated by the fact that rules 56, 97 and 98 do not impose a time-constraint on relevance, and may penalize an applicant for disclosing information only after it becomes relevant to the examination. That is, the rules require that an applicant, to avoid penalty, disclose irrelevant information for consideration by the Examiner, in the event that it might later become relevant. Further, there is no way to code disclosure to the extent that it relates to various issues or to no pending issue. I recommend that the rules of practice be amended to indicate that information that does not relate to any current issue is not required to be disclosed, and that applicant has an absolute right, regardless of stage of prosecution and without penalty, to submit information that becomes relevant to the prosecution within 3 months of knowledge of the relevance.

The current IDS regime potentially imposes massive burden on Applicant and Examiner with little demonstrable value added to the prosecution, especially when the time consumed reviewing information that may not yet be material could be better allocated to other tasks that result in better (e.g., valid) patents. With the AIA and IPRs, the USPTO has admitted that many patents it issues are invalid as a result of examiner failure to identify and/or apply prior art, yet the USPTO has apparently taken no steps to improve examination to reduce its mistakes. The IDS process is core to that issue, and simple re-approving the same form, implementing the same process, defeats this opportunity to systematically improve patent quality by addressing its root causes.

Respectfully submitted,
Steven M. Hoffberg
Reg. 33,511