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DISCOVERY BY THE EXAMINER*

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The Manual of Patent Examining Procedure (M.P.E.P.), 4th Edition now has a chapter 2100 on patentability. At present this chapter only contains sections dealing with "Patentable Subject Matter --Microorganisms"¹ and "The Statutory Bars of 'Public Use' and 'On Sale' (35 U.S.C. 102(b))"² but it is the intent of the Patent and Trademark Office to expand its content as future revisions of the M.P.E.P. are issued.³

The "requirement for information" provisions of chapter 2100--if they are upheld on judicial review--portend a significant change in the relationship of the examiner and the applicant in ex parte prosecution. In view of the fact that the Office positions which appear to herald this change have been adopted without public review or comment, it is imperative that members of the patent bar review them critically and express their concerns to the Office. Simply put, although the M.P.E.P. carefully avoids any use of the term, the Office in chapter 2100 is indicating that an examiner has a right of discovery in ex parte prosecution.

Accordingly, the purpose of this article is to discuss the extent to which the Office is attempting to sanction discovery by examiners. In particular, it will explore certain of the ramifications of the "requirement for information" provisions of chapter 2100. It will begin by outlining the requirements for information in ex parte prosecution which are expressly permitted by the rules of practice. It will then review the authority for "discovery" requirements in ex parte prosecution and consider the sanction for failure to meet such a requirement. Some consideration will then be given to the extent and effect of a requirement for information presented under the aegis of chapter 2100. The potential for Office discovery in the prosecution of reissue applications will be briefly examined. Finally, the failure of the Office to seek public review or comment presenting the "requirement for information" provisions of chapter 2100 will be briefly discussed.

A. Requirements for Information in Ex Parte Prosecution

Prior to the publication of chapter 2100 the right of an examiner to require an applicant to present information in ex parte prosecution had been narrowly circumscribed. The only two rules of practice which

*Work performed under the auspices of the U.S. Department of Energy.

¹M.P.E.P. 2105 et seq. (Rev. 3, July 1980).

²M.P.E.P. 2120 et seq. (Rev. July 1980).

³See Instructions Regarding revision No. 3 issued July 1980.

expressly permit such a requirement are 37 C.F.R. Sec. 51.78(c) and 1.175(b). Thus Rule 78(c) provides:

Where two or more applications, or an application and a patent naming different inventors and owned by the same party contain conflicting claims, the assignee may be called upon to state which named inventor is the prior inventor.

It is apparent from this language that the type of information and the circumstances under which it can be required to be provided are narrow indeed.

Rule 175(b) is limited to reissue practice and in that context provides that:

Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object.

Insofar as can be ascertained, the Office in chapter 2100 has for the first time officially espoused the view that an examiner has the right to require an applicant to provide information in ex parte prosecution under circumstances and conditions which are significantly more broad than those set forth in Rules 78(c) and 175(b). Specifically, with regard to issues of patentability under Section 102(b) chapter 2100 states:

As an aid to resolving issues of authenticity, as well as to other related matters of Sec. 102(b) activity, an applicant may be required, or any other party to the proceeding who has access to an application (Sec. 1901.01) may be requested, to answer specific questions posed by the examiner and to explain or supplement any evidence already of record. 35 USC Sec. 132, 37 CFR Sec. 1.104(b): regarding reissue applications, see Sec. 175(b). Information sought should be restricted to that which is reasonably necessary for the examiner to render a decision on patentability.⁴ (Emphasis in the original.)

The "other related matters" include public use or on sale issues.⁵

Logically, insofar as a requirement for information is concerned, there would appear to be no difference between Section 102(b) and any other section of the patent statute. Thus, if an examiner does indeed have the right to require an applicant to answer questions or provide

⁴M.P.E.P. 2123 (Rev. 3, July 1980)

⁵M.P.E.P. 2122 (Rev. 3, July 1980).

other information in ex parte prosecution regarding Section 102(b) issues, he should also have the same right with respect to issues arising under any other portion of the statute. It can therefore reasonably be expected that as chapter 2100 is expanded, so too will be the examiner's right to require various types of information to be provided in ex parte prosecution.

The right to present a requirement clearly implies the right to impose a sanction if the requirement is not met. Otherwise a requirement becomes meaningless. The right to require a party to a judicial or administrative proceeding to answer questions or provide information at the demand of an opposing party or the hearing officer on pain of sanction has a name which the Office has studiously avoided in chapter 2100. It is called discovery.

B. Authority for "Discovery" Requirements in Ex Parte Prosecution

The traditional view is that the Office may not order discovery in ex parte proceedings before it.⁶ This view is predicated on the fact that proceedings before the Office are administrative in nature, and:

Discovery in a federal administrative proceeding is an unusual thing. The Administrative Procedure Act does not permit it and the discovery provisions of the Federal Rules of Civil Procedure are not applicable in the absence of special statutory authorization. Without such statutory authorization or special authorizing regulation, discovery is normally simply not available.⁷

Nonetheless, in the sense that the term is used in this article it is apparent that Rules 78(c) and 175(b) do permit a form of discovery. Before discussing the position taken by the Office in chapter 2100 it is appropriate to first ascertain what authority permits or grants the type of discovery made available by these two rules.

The authority for the rules of practice in the Office is 35 U.S.C. 6, unless otherwise noted.⁸ The only additional authority given for Rule 78 is 35 U.S.C. 112,⁹ whereas the only additional authority given

⁶See, e.g., *Rohm and Haas Co. v. Mobil Oil Corp.*, ___ F.Supp. ___, 201 U.S.P.Q. 80, 83 (D.Del. 1978); and *Ex parte McGuckian*, 202 U.S.P.Q. 398 (Bd.App. 1975).

⁷B. C. Walterscheid, "Interference Discovery (Part I)," 58 J.P.O.S. 3 (1976). See also Davis, 1 *Administrative Law Treatise* Sec. 8.5 at 588, quoted in *Frilette v. Kimberlin*, 508 F.2d 205, 184 U.S.P.Q. 266, 268 (3rd Cir. 1974).

⁸See 37 C.F.R. (July 1, 1980 Rev.) at page 7.

⁹See 37 C.F.R. (July 1, 1980 Rev.) at page 23.

for Rule 175(b) is 35 U.S.C. 251.¹⁰ Neither Section 112 nor Section 251 provide any authority for the making of requirements of the type set forth in these two rules.¹¹ Thus the only basis for granting the right to make such requirements presumably resides in Section 6 which grants the Commissioner of Patents and Trademarks power to ". . . establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office."

¹⁰See 37 C.F.R. (July 1, 1980 Rev.) at page 39.

¹¹35 U.S.C. 112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

11(continued)

Section 251 states:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

The Court of Customs and Patent Appeals (C.C.P.A.) has consistently taken the position that the rules of practice have the force and effect of law when not inconsistent with statute.¹² More importantly, the C.C.P.A. has held that the rule-making authority is not limited to any express grant by statute.¹³ Thus, the rule-making authority encompasses areas about which the patent statute is simply silent.

Since the C.C.P.A. is the court of first authority for the Office, it is readily apparent that a Commissioner may rightly assume that his rule-making authority is quite broad. Traditionally, however, Commissioners have been reluctant to use their rule-making authority to extend the jurisdiction of the Office beyond that which was expressly set forth by statute. Heretofore at least, Rules 78(c) and 175(b) have appeared to be exceptions to this traditional conservatism.

Since the judicial record does not indicate that there has been any challenge to Rule 78(c) or Rule 175(b) on the ground that they are inconsistent with law, it may be assumed that the Commissioner was within his authority in promulgating them.

It is important to note, however, that Rule 78(c) has been narrowly construed. Efforts by the Office to expand the scope of the requirements which can be presented under it have recently been thwarted by the C.C.P.A. This occurred because M.P.E.P. 804.03, which is based on Rule 78(c), states that

. . . the assignee of two or more cases of different inventive entities, containing conflicting claims must maintain a line of demarcation between them. If such a line is not maintained, the assignee should be called on to state which entity is the prior inventor of that subject matter and to limit the claims of the other application accordingly. (Emphasis supplied.) If the assignee does not comply with this requirement, the case in which the requirement to name the prior inventor was made will be held to be abandoned.

Note that the emphasized language is not supported in any way by Rule 78(c).

¹²See e.g., *Norton v. Curtiss*, 433 F.2d 412, 165 U.S.P.Q. 708, 711 (1970); and *In re Rubinfeld*, 270 F.2d 391, 123 U.S.P.Q. 210, 214 (1959), cert. denied, 362 U.S. 903, 124 U.S.P.Q. 535 (1950).

¹³*Norton v. Curtiss*, note 12, *supra*.

It is not surprising therefore that when the Office sought to compel a common assignee to act in accordance with the emphasized language and cancel claims, the C.C.P.A. in the recent case of Margolis v. Banner, Com'r. Pat.¹⁴ declared that language to be invalid.¹⁵ Based on this decision, it is apparent that the C.C.P.A. is not disposed to permit the Office by means of the M.P.E.P. to expand the scope of requirements set forth by the rules of practice.

Unfortunately, there has been almost no judicial interpretation of Rule 175(b) or the M.P.E.P. section relating to it.¹⁶ Unlike the situation with Rule 78(c), the M.P.E.P. section pertaining to Rule 175(b) adds nothing, but instead merely repeats the language of the rule.¹⁷ The dearth of case law pertaining to Rule 175(b) strongly suggests that there has been little or no effort by examiners to require applicants to provide additional information under this provision. It certainly would not appear that examiners have made any concerted attempt to apply sanctions for the failure or refusal of applicants to provide such information if the requirement has on occasion been presented.

Consider now the authority quoted in chapter 2100 for the right of an examiner to require an applicant to answer specific questions posed by the examiner or to explain or supplement any evidence already of record. That authority is stated to be 35 U.S.C. 132 and 37 C.F.R. Sec. 1.104(h) and for reissue applications 37 C.F.R. Sec. 175(b). While Rule 175(b) would appear to provide authority for an examiner to require that "additional information" be provided, it is not at all clear that it

¹⁴599 F.2d 435, 202 U.S.P.Q. 365 (1979).

¹⁵202 U.S.P.Q. at 372.

¹⁶The only discussion of Rule 175(b) which has been found in the published judicial record appears in Rohm and Haas Co. v. Mobil Oil Corp., ___ F.Supp. ___, 201 U.S.P.Q. 80 (D.Del. 1978). After pointing out that the Office may not order discovery, the district court stated:

As to the plaintiff's contention that determination of the issues joined herein requires discovery of facts known only to Mobil, the Court notes that 37 C.F.R. Sec. 1.175(b) authorizes the patent examiner to "require additional information or affidavits or declarations concerning the application for reissue and its object."

201 U.S.P.Q. at 83. The court offered no explanation how, if the Office could not order discovery, an examiner could require an applicant to provide additional information.

¹⁷See M.P.E.P. 1418 (Rev. 2, April 1980).

authorizes him to do so in the form of specific questions required to be answered.¹⁸ At the very least the Office is reading Rule 175(b) more broadly than it has done in the past.

A perusal of Section 132 reveals that the only language therein on which the Office can possibly be relying is "Whenever, on examination any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof" While this language clearly indicates that the Commissioner has authority to present requirements, a plausible contention can be made that it does not itself give the Commissioner that authority. Rather, it suggests that such authority must reside at some other place in the patent statute. This view is endorsed by Federico who in his commentary on the Patent Act of 1952 states that Section 132 is for the purpose of giving notice of a rejection, objection, or requirement.¹⁹ The C.C.P.A. has likewise emphasized that the purpose of Section 132 is to give proper notice to applicants for patent of the rejection, objection, or requirement they must meet.²⁰

To the extent that it can be argued that Section 132 gives statutory authority for making "requirements," that authority is delegated only to the Commissioner. Although he in turn may redelegate such authority,²¹ it is not seen how he can do this other than by establishing appropriate regulations under 35 U.S.C. 6. Aside from Rule 175(b), no rule or regulation has been promulgated which could be construed in any reasonable manner as permitting or authorizing an examiner to present requirements of the type set forth in chapter 2100.²²

Contrary to the assumption implicit in its citation in chapter 2100, Rule 104(b) does not delegate to examiners the Commissioner's power to present "requirements." Rather, all it states is that, in the circumstance wherein an examiner has in fact presented a requirement, he must give the reasons for it and provide such information "as may be useful in aiding the applicant to judge of the propriety of continuing

¹⁸See Section E, infra.

¹⁹p. J. Federico, "Commentary on the New Patent Act," 35 U.S.C.A. at pages 36 and 37

²⁰In re Herrick, 397 F.2d 332, 158 U.S.P.Q. 90 (1968).

²¹In re Dickinson, 299 F.2d 954, 133 U.S.P.Q. 39, 43 (C.C.P.A. 1962).

²²But see the text accompanying notes 30-32, infra.

the prosecution of his application."²³ Whatever the requirement that may have been presented, the authority of the examiner to make that requirement came not from Rule 104(b) but of necessity from elsewhere in the rules of practice.

Moreover, Rule 104(b) cannot be read apart from the context of Rule 104(a) which clearly limits the requirements which can be imposed by an examiner to either matters of form or those sanctioned by either statute or rule.²⁴ Nor can it be otherwise. For if Rule 104(b) permitted any examiner to set forth arbitrarily any requirement he might choose to make, there would be naught but chaos in the prosecution of applications.

The perception that Section 132 and Rule 104(b) could conceivably be argued to permit an examiner to present discovery requirements of the type set forth in chapter 2100 obviously came late to the Office. Were it otherwise, it is difficult to see why the rules of practice fail to cite Section 132 as authority for Rules 78(c) and 175(b). In this context, a point which is also of interest is that the Commissioner's authority for promulgating discovery rules in inter partes interference proceedings is stated to be only 35 U.S.C. 6.²⁵ No mention is made of 35 U.S.C. 132. These failures to cite Section 132 would appear to be convincing evidence that the Office did not until recently come to the conclusion that Section 132 could be argued to provide a proper basis for presenting discovery requirements.

At this point it is appropriate to briefly discuss the only other chapter in the M.P.E.P. which contains any mention of "requirements for information." In April 1980 chapter 2000 concerning duty of disclosure and striking of applications was added to the Manual. It contains a section on "requirements for information" which states that authority for such requirements is provided by 35 U.S.C. 132, and they

. . . are utilized where it appears that more information may be necessary in order for the examiner to reach a proper decision, and where it appears that such information may be available to one or more of the parties.

²³Rule 104(b) states:

The applicant will be notified of the examiner's action. The reasons for any adverse action or an objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant to judge of the propriety of continuing the prosecution of his application.

²⁴See text accompanying note 49, *infra*.

²⁵See 37 C.F.R. (July 1, 1980 Rev.) at pages 7 and 60.

The requirements frequently take the form of written questions directed to those individuals or parties likely to have the desired information or to have access thereto.²⁶

A significant caveat is that chapter 2000 does not authorize such requirements to be presented by an examiner but rather states that they may be presented by the Office of the Assistant Commissioner for Patents.

The practice outlined in chapter 2000 has apparently been followed for some time. Thus, for example, in In re Altenpohl,²⁷ the Commissioner stated:

On January 3, 1975 a "Requirement for Information" was mailed to Counsel for applicant . . . requiring information prior to a determination on the question of "fraud" or "deceptive intention."²⁸

Unfortunately, there is nothing in Altenpohl to indicate what authority was cited for this "requirement."

Assuming arguendo, however, that the authority was presumed to be 35 U.S.C. 132, it is to be emphasized that this form of discovery was--and presently still is--limited to "fraud" situations being investigated by the Office of the Assistant Commissioner of Patents. For the reasons set forth in this article, it is questionable whether the Office could compel a substantive response to a "requirement for information" even in circumstances where "fraud" is alleged.²⁹

In January 1981, the Office proposed a new Rule 365 which would have permitted "requirements for information" to be presented in inter partes protest proceedings.³⁰ After generally unfavorable comments at an oral

²⁶M.P.E.P. 2021.04.

²⁷198 U.S.P.Q. 289 (Com'r. Pat. 1976).

²⁸198 U.S.P.Q. at 304.

²⁹No published opinion has been found in which the authority of the Office to present such a "requirement" in the context of a fraud investigation has been challenged. As a practical matter, this is not surprising in that counsel for an applicant charged with fraud is likely to lean over backwards to supply information to the Office to overcome the charge.

³⁰48 Fed. Reg. 3170 (Jan. 13, 1981).

hearing on April 16, 1981, the proposed rules relating to inter partes protest proceedings were not adopted.³¹ Of interest in the context of the present article is that the Office cited no statutory authority whatever for proposed Rule 365.³² If, as stated in chapters 2000 and 2100 of the M.P.E.P., Section 132 provides authority for presenting "requirements for information," why was it not cited as statutory authority for this proposed new rule?

It is interesting to note that in Margolis, the Office made no attempt to rely on Section 132 or Rule 104(b) to justify the portion of M.P.E.P. 804.03 which the C.C.P.A. held invalid.³³ Several possible explanations can be advanced for this failure. The first is that as of the end of 1978 or early 1979, when the Office arguments were presented in Margolis,³⁴ there had been no decision to contend that Section 132 and Rule 104(b) justified the existence of "requirements" in the M.P.E.P. not sanctioned elsewhere by express language of the rules of practice. Alternatively, the solicitor's office may well have felt that it did not need to or did not want to present the issue to the C.C.P.A. under the facts of Margolis.

One thing is certain. Had the judges of the C.C.P.A. felt that Section 132 permitted the Office to present "requirements" in the M.P.E.P. not expressly sanctioned by specific language of the rules of practice, they could not have rendered the decision they did in Margolis.

While there is no published indication of when the Office came to the conclusion that Section 132 permits an examiner to require an applicant to answer questions presented in ex parte prosecution, this contention was published as early as May 1977.³⁵ The views expressed at that time have been vigorously challenged by the present writer,³⁶ and the challenge has been responded to as follows:

The curious notion that an examiner has no power or jurisdiction to ask questions of an applicant in appropriate circumstances so as to complete his

³¹532 P.T.C.J. D-1 (June 4, 1981).

³²See 48 Fed. Reg. 3162 et seq.

³³See text accompanying notes 14 and 15, supra.

³⁴This time frame is presumed because the opinion in Margolis was dated May 31, 1979.

³⁵G. H. Bjorge, "Editorial Epilogue," 59 J.P.O.S. 336 (1977).

³⁶E.C. Walterscheid, "Insufficient Disclosure Rejections (Part I)," 62 J.P.O.S. 217, 222-27 (1980).

examination, absent a rule or regulation authorizing such requirements for information, amounts to an untenable stultification of the administrative process.³⁷

This response adroitly and neatly avoids the central issue, which is not whether an examiner may ask questions during ex parte prosecution³⁸ but rather whether an examiner has the right in ex parte prosecution to require an applicant to provide specific answers to specific questions on pain of sanction. This writer contends--and will continue to do so in the absence of any showing to the contrary--that a requirement to answer written questions on pain of sanction for failure to do so represents discovery as that term is normally used in the legal sense. Be that as it may, views contra to those of the present writer appear to have carried the day in the Office, as evidenced by chapter 2100.³⁹

The Office has pointed to no judicial opinion which supports its view that Section 132 and Rule 104(b) authorize "requirements for information" of the type set forth in chapter 2100. Indeed, an extensive search has revealed only one opinion which at first glance appears to support the Office position. In In re Brandstadter,⁴⁰ the invention required a computer program for its practice. Speaking with respect thereto, the C.C.P.A. stated

. . . we do not believe it unreasonable for an examiner to require an applicant who has prepared such a program to at least give an appraisal of the amount of time involved in its production or to disclose at least a bare bones flow chart of that program to the Patent Office so that the examiner may determine whether one skilled in the art could produce it without unreasonable experimentation and delays.⁴¹ (Emphasis supplied.)

³⁷See "Editor's Note," 62 J.P.O.S. at 227.

³⁸Clearly, there is no way for an applicant to preclude an examiner from asking any questions he wants during ex parte prosecution.

³⁹The author of the references cited in notes 35 and 37, supra, studiously avoided calling a requirement to answer written interrogatories "discovery," and thereby apparently set the tone for the Office position. It would appear that the Office is of the view that a "requirement for information" is somehow less conducive to objection by an applicant.

⁴⁰484 F.2d 1395, 179 U.S.P.Q. 286 (1973).

⁴¹179 U.S.P.Q. at 294-95.

No citation of authority is given for the right of the examiner to "require" that such information be provided. In the context in which the court used the cited language, however, it is apparent that it was merely holding that there was a reasonable basis for the examiner to question the adequacy of the disclosure pertaining to the amount of time and work involved in the preparation of the computer program, and, in the absence of some showing of what that might be, the examiner had properly made a prima facie case of lack of enablement by reason of undue experimentation. Brandstadter thus is clearly distinguishable from the position taken by the Office in chapter 2100.

The actions taken by individual examiners in the past several years are a rather clear indication that proposals akin to those of chapter 2100 relating to requirements for information had been circulated through the examining groups. Thus, for example, the author in June 1979 as an attorney of record received an Office action in which the examiner cited Section 132 as authority for a requirement that certain specific questions relating to Section 112 and Section 103 issues be answered.⁴² A response in which it was argued that the Office had no authority to require that written interrogatories be answered elicited a new Office action in December 1979 which is instructive. The examiner stated:

At the outset applicants' assertions with respect to the use of interrogatories will be discussed. Firstly, the questions were not posed as interrogatories but as requirements for information. In the strict legal sense interrogatories require written answers under oath. However, such a strict legal interpretation was not intended. As indicated in the last Office action . . . the information may be supplied in any form thought to be most suitable by applicants.

The basis for making such requirements is found in 35 USC 132, 37 CFR 1.104(a) and relevant case law such as Graham v. John Deere, 148 USPQ 459 (S. Ct. 1966) and In re Cook, 161 USPQ 298 (CCPA 1971). As discussed below the information is deemed to be reasonable since the information is material in helping to decide the patentability of the claimed invention under 35 USC 103 and 112, first paragraph.⁴³

A perusal of Graham v. John Deere and Cook reveals that they are no more relevant than Brandstadter. While the Supreme Court in Graham v. John Deere laid great stress on several factual inquiries that must be made in order to determine patentability under Section 103, nowhere did it suggest that this factual inquiry could or should take the form of

⁴²Application Serial No. 824,572, Paper No. 6 mailed June 6, 1979.

⁴³Application Serial No. 824,572, Paper No. 11 mailed December 21, 1979.

discovery in ex parte prosecution. Rather, the term "inquiry" as used therein was clearly in the context of "a systematic investigation."⁴⁴ Although there have been literally hundreds of cases which have cited and relied on Graham v. John Deere, none has been found which interprets that Supreme Court opinion in the manner suggested by the examiner.

Any reliance the Office might attempt to make on Cook is also misplaced. There is no language in Cook that in any way suggests that the Office can properly require discovery in ex parte prosecution.⁴⁵ It can thus be readily seen why the Office did not cite any case law to support the positions it espoused in chapter 2100. There simply is none. Rather, the Office has chosen to embark on a new and totally uncharted course.

C. The Sanction

If it is assumed that a "requirement for information" is properly presented, what then is the sanction for failure to supply the required information? Unfortunately, chapter 2100 is vague on this point. All that is stated is that "if an applicant fails to respond in a timely fashion to a requirement for information, the application will be regarded as abandoned, 35 USC Sec. 133."⁴⁶ Is a failure to respond to

⁴⁴See Webster's New Collegiate Dictionary.

⁴⁵The only language in Cook which appears to have any relevance is the following:

. . .when the examiner sets forth reasonable grounds in support of his conclusion that an applicant's claims may read on inoperative subject matter . . . , it becomes incumbent upon the applicant either to reasonably limit his claims to the approximate area where operativeness has not been challenged or to rebut the examiner's challenge either by the submission of representative evidence . . . or by persuasive arguments based on known laws of physics and chemistry

169 U.S.P.Q. at 302. Phrased somewhat differently, Cook stands for the proposition that, if an examiner has presented reasonable grounds for questioning patentability under Section 112, he has met his burden of proof and has presented a prima facie case which the applicant must either (a) limit his claims to avoid, or (b) rebut. The rebuttal can take the form of "representative" evidence. This, however, is in no way suggestive that an examiner can require an applicant to provide specific answers to specific questions in order to rebut.

⁴⁶M.P.E.P. 2122 and 2123 (Rev. 3, July 1980).

be interpreted literally as a failure to answer at all or as a failure to provide the required information? Clearly, if no answer is filed within the time set for response and no good reason is provided for this failure, then under Section 133 the application does in fact become abandoned.⁴⁷

But what of the situation wherein an applicant responds by simply stating that the required information will not be supplied because applicant believes that the examiner is without authority to present the requirement for information? Obviously, there has been a response but not that which the examiner contemplated. In this circumstance, it is not seen how the examiner has any basis for making a rejection based on this fact alone. Nor is it seen on what basis the examiner could hold the application abandoned, because the response can reasonably be taken as a bona fide attempt to advance the case to final action.⁴⁸

A point of interest is that chapter 2100 uses different language than M.P.E.P. 804.03. It may be recalled that M.P.E.P. 804.03 expressly provides that a failure to comply with the requirement will result in the application becoming abandoned. Needless to say, "respond" and "comply" have quite different meanings, so that a logical argument can be made that a response of the type set forth above would provide no basis whatever for the application to go abandoned. Nonetheless, despite the ambiguity just discussed, in all likelihood the Office will seek to resolve the apparent quandary by arguing that a refusal to provide the

⁴⁷Section 133 states:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴⁸See 37 C.F.R. Sec. 1.111(b). Indeed, in the December 1979 Office action discussed in the text, the examiner acknowledged this to be the case by saying:

Lastly, while applicants have not provided the information which has been required, it would be inappropriate to hold the application abandoned or the amendment non-responsive. Applicants' arguments relating to the legal basis for requiring such information are deemed to constitute a complete response. 37 CFR 1.111. However, the examiner remains of the opinion that the information specified is material in deciding the patentability of the claims.

required information is equivalent to a failure to prosecute the application and hence the application is deemed abandoned.⁴⁹

In the likely event that the posited sequence of events occurs, it will perhaps be too much to hope that the Office will recognize that a holding of abandonment in these circumstances is equivalent to a rejection and hence is appealable. In Margolis the C.C.P.A. ruled that it had jurisdiction even though the issue was purportedly abandonment of the application because it concluded "that the examiner's demands, under threat of abandonment, that petitioners do more than they did amounted to a de facto rejection of petitioners' claims."⁵⁰ Unfortunately, Margolis can rather easily be distinguished on its facts. Initially at least, it can be rather safely assumed that the Office will strenuously argue that abandonment for failure to meet requirements for information can only be petitioned to the Commissioner.⁵¹

D. The Extent and Effect of a Requirement for Information

The circumstances under which chapter 2100 permits an examiner to present a requirement for information are not clear. It does state that "questions involving Sec. 102(b) activity may arise during the patent examination process in a number of ways" and then proceeds to enumerate certain possibilities.⁵² There is nothing, however, to suggest that the examiner is limited to a situation in which a Section 102(b) issue is

⁴⁹Presumably for a failure to prosecute the application. See note 47 supra.

⁵⁰202 U.S.P.Q. at 372.

⁵¹But to the extent the Office seeks to rely on 35 U.S.C. 132 as authority for presenting requirements for information, the interpretation to be given to Section 132 would clearly be an appealable issue.

⁵²Thus, M.P.E.P. 2122 (Rev. 3, July 1980) states:

An applicant or his appointed representative may raise the questions in compliance with the "duty of disclosure" responsibilities of 37 CFR Sec. 1.56 (Chapter 2000). One other than an applicant may present the questions by filing a protest under 37 CFR Sec. 1.29(b) (Chapter 1900), or by petitioning for institution of public use proceedings under 37 CFR Sec. 1.292 (Sec. 720). Additionally, the questions may become manifest from a Recommendation of the Board of Patent Interferences (37 CFR Sec. 1.259) or from an interference record itself, e.g., a specific finding that an actual reduction to practice occurred more than one year prior to the filing date of an application, coupled with evidence of related commercial exploitation.

clearly presented. The only limitation placed on the examiner is that "information sought should be restricted to that which is reasonably necessary for the examiner to render a decision on patentability."⁵³ As will be shown, there is some question as to whether this does in fact constitute a limitation.

What are the duties of the examiner in rendering a decision on patentability? According to the rules of practice:

On taking up an application for examination the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the invention sought to be patented. The examination shall be complete with respect both to compliance of the application with the statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.⁵⁴

Now if the examination must be complete, under chapter 2100 there would appear to be nothing to preclude an examiner from asking questions and requiring them to be answered even where the record is totally devoid of any information which raises a Section 102(b) issue.

Thus, for example, under chapter 2100 an examiner may well argue that it is proper to require that an applicant state the date the invention was first actually reduced to practice since he deems such information "reasonably necessary" to determine whether a patentability issue exists under Section 102(b). While it is to be hoped that a reasonable interpretation of the intent of chapter 2100 would preclude such a "fishing expedition," there is presently no way of knowing how examiners will react to their new-found authority.

The problem resides primarily in the fact that examiners are authorized to require an applicant ". . . to answer specific questions posed by the examiner and to explain or supplement any evidence already of record." If the "and" were not present, it would be clear that any interrogatories presented by an examiner would be required to be limited to evidence already of record. But with the presence of that "and" an examiner is not precluded from acting on the assumption that he may require interrogatories to be answered to fill gaps in an otherwise silent record.

Moreover, even if it is assumed that interrogatories presented under authority of chapter 2100 must be limited to evidence already of record concerning Section 102(b) issues, what determines that they are "reasonably necessary" in order for the examiner to render a decision on

⁵³M.P.E.P. 2122 and 2123 (Rev. 3, July 1980).

⁵⁴37 C.F.R. Sec. 1.104(b) (July 1, 1980 Rev.)

patentability? The answer to that question logically runs afoul of the duty of candor which every applicant has to the Office.

Indeed, there are a variety of persons, including the applicant, who "have a duty to disclose to the Office information they are aware of which is material to the examination of the application."⁵⁵ Information is deemed material "where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent."⁵⁶

Is there a difference between "material information" and "information . . . which is reasonably necessary for the examiner to render a decision on patentability"? If so, what is the difference? If not, does a requirement for information presented by a examiner imply that the duty of candor has not been met? If "reasonably necessary" information is different than "material" information, by what authority can an examiner require an applicant to supply information which the duty of candor does not require him to supply? In view of the ever increasing emphasis which the Office is placing on the duty of candor,⁵⁷ these are questions of considerable import to all who have dealings with the Office or who may be subjected to judicial review of their dealing with the Office. Unfortunately, chapter 2100 provides little guidance as to how they are likely to be answered. In view of the failure of the Office to seek public input on "requirements for information" there is nothing in the published record to indicate that such questions were ever considered when chapter 2100 was drafted.

Yet another aspect of the right of an examiner to require that information be provided in ex parte prosecution which should be troublesome to every practitioner before the Office is the manner in which such information is likely to be treated by the Office. It would appear that a primary purpose of a requirement for information is to seek to have an applicant provide "admissions" of the type defined by the case law of In re Nomya⁵⁸ and In re Hellsund.⁵⁹ That being the case, it would be in the clear interest of any applicant who elects to attempt to provide such required information to be exceedingly careful of the wording used in responding.

⁵⁵37C.F.R. Sec. 1.56(a) (July 1, 1980).

⁵⁶id.

⁵⁷As evidenced by M.P.E.P. chapter 2000 added in the April 1980 revision.

⁵⁸509 F.2d 566, 184 U.S.P.O. 607 (C.C.P.A. 1975).

⁵⁹474 F.2d 1307, 177 U.S.P.Q. 170 (C.C.P.A. 1973).

Consider the following situation. The examiner states that to permit him to ascertain if there are Section 102(b) issues which may affect patentability, the applicant is required under chapter 2100 to answer the following questions:

1. When was the claimed invention reduced to practice?
2. When was the claimed invention deemed "complete by applicant or his assignee?"

In support of his requirement, the examiner states that the basis for presenting these questions is the following language from chapter 2100:

Although the test of an "actual" reduction to practice may be applicable to Sec. 102(b) activity, as where the nature of a particular invention requires development over a considerable period of time . . . , the better test is whether or not an invention is "complete."

The test for "completeness" of an invention is basically a matter of evaluating the subjective intent of an inventor, as manifested by the objective factual circumstances surrounding the development of the invention⁶⁰

It is important to bear in mind that these two questions require considerably more than a disclosure of facts known to the applicant. Thus, any answer as to when actual reduction to practice occurred requires a legal conclusion. Can an examiner require an applicant to present a legal conclusion? Unfortunately, if he can, any answer presented by an applicant is likely to be binding under the authority of Nomiya, regardless of whether there is a statutory basis for it.⁶¹ However, it is to be noted that the duty of candor is not "meant to require disclosure of information concerning the level of skill in the art for purposes of determining obviousness."⁶² By analogy, it can reasonably be argued that the duty of candor does not require an applicant to state when the claimed invention was first actually reduced to practice.

Nor is it seen how the duty of candor can require an applicant to provide information based on his subjective intent such as would of necessity be required to answer the second question regarding when the

⁶⁰M.P.E.P. 2125.01 (Rev. 3, July 1980).

⁶¹See E. C. Walterscheid, "Meeting the Duty of Candor Without Making an Admission Against Interest," 60 J.P.O.S. 717 (1978).

⁶²955 O.G. 1056.

invention was "completed." Nonetheless, issues such as these are likely to become commonplace for applicants if examiners make any concerted effort to present requirements for information under chapter 2100.

Finally, questions arise as to the effect of requirements for information on compact prosecution. May an examiner make a final rejection predicated on answers provided by an applicant in response to a requirement for information? Phrased somewhat differently, will an applicant have a right to "explain" his answers if the interpretation placed on them by the examiner is different than that intended by him? Based on the answers provided in response to one requirement for information, can the examiner then set forth an entirely new requirement for information?⁶³ If so, this would seem to be the antithesis of compact prosecution.

The foregoing comments do not represent an exhaustive or even a detailed delineation of the ramifications of requirements for information of the type said to be permissible in chapter 2100. They do, however, give some indication of the nature of the problems inherent in requirement for information in ex parte prosecution.

E. Requirements for Information in Reissue Prosecution

As has been previously noted,⁶⁴ Rule 175(b) appears to permit an examiner to require that "additional information" be provided in the prosecution of a reissue application. Indeed, it can be argued that this rule closely approximates what might be termed traditional discovery in that it permits the examiner to require that the "additional information" be provided in the form of affidavits or declarations. Unfortunately, it provides no indication whatever as to how specific the examiner may require the "additional information" to be. Although the Office in chapter 2100 cites Rule 175(b) as authority for requiring that specific questions be answered in reissue examination,⁶⁵ the language of the rule may just as easily be interpreted as merely authorizing that a certain general type of information can be required in order for the

⁶³This is not as unlikely or as far-fetched as it may appear at first glance. Thus, during 1978 and 1979 the present writer as an attorney of record was presented with a series of interrogatories by a Group 220 examiner who required that they be answered under the purported authority of Section 132. A decision was made to answer the questions while at the same time arguing that the examiner had no authority to present the requirement. The net result was a whole new series of questions based on the answers given to the first series. A flat refusal to answer the second series resulted in no sanction.

⁶⁴See text accompanying note 18, supra.

⁶⁵See M.P.E.P. 2122 and 2123 (Rev. 3, July 1980).

examiner to decide on patentability of the reissue application. In the absence of any case law on the point, the position taken by the Office in chapter 2100 may reasonably be questioned.

Be that as it may, if Section 175(b) does indeed authorize the imposition of discovery requirements in reissue prosecution, it can be assumed that the scope of inquiry permitted is quite wide. Thus, for example, in a reissue proceeding a protestor may rely on the following kinds of information, in addition to prior art documents:

- (1) Information demonstrating that the subject matter to which the protest is directed was publicly "known or used by others in this country . . . before the invention thereof by the applicant for patent" and is therefore barred under 35 U.S.C. 102(a) and/or 103.
- (2) Information that the invention was "in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States: (35 U.S.C. 102(b)).
- (3) Information that the applicant "has abandoned the invention" (35 U.S.C. 102(c) or "did not himself invent the subject matter sought to be patented" (35 U.S.C. 102(f)).
- (4) Information relating to inventorship under 35 U.S.C. 102(g).
- (5) Information relating to sufficiency of disclosure or failure to disclose best mode, under 35 U.S.C. 112.
- (6) Any other information demonstrating that the application lacks compliance with the statutory requirements for patentability.
- (7) Information indicating "fraud" or a "violation of the duty of disclosure" under 37 CFR 1.56(a) may be the subject of either a protest under Sec. 1.291(a) or a petition to strike the application under 37 CFR 1.56(d).⁶⁶

In principle at least, the examiner under Rule 175(b) would seem to have authority to require information of the same variety that a protestor may submit. The problems that can potentially arise with regard to a requirement for information of the type set forth in item (2) above have already been explored. Needless to say, similar problems may arise with regard to the various other items of information.

⁶⁶M.P.E.P. 1901.02 (Rev. 1, January 1980).

A point which seems not to have been realized to any significant degree by reissue applicants, protestors, or examiners is that a protest in conjunction with the use of Rule 175(b) constitutes a potentially very strong discovery mechanism in a reissue proceeding. Thus, while the mere filing of a protest does not automatically give a protestor the right to argue the protest before the Office, "the Office has, and may, determine that further participation by a protestor beyond the mere filing of a protest is beneficial to, and of assistance to, the Office in its examination of the application."⁶⁷ Accordingly, if a protestor can convince an examiner that certain requirements for information are appropriate in the prosecution of a reissue application, those requirements for information can be presented under Rule 175(b). In effect, a protestor by this technique achieves the capability of obtaining discovery in the reissue prosecution even though it is done indirectly through the examiner.

While there is no indication that Rule 175(b) has been used to any significant extent to date, the increasing militancy of the Office with respect to requirements for information, as evidenced by chapter 2100 of the M.P.E.P., is likely to produce a substantial increase in the use of this rule in reissue proceedings. Simply put, discovery in reissue proceedings is no idle threat. As a consequence, it may well be a consideration in any determination to seek reissue.

F. The Failure of the Office to Seek Public Review or Comment

A fundamental concern to everyone who must deal in any capacity with the Patent and Trademark Office is how without public review and comment it has authorized examiners to present requirements for information which are essentially nothing less than discovery requirements in ex parte prosecution. Regardless of the position taken by the Office, the requirements for information which an examiner is authorized to make in chapter 2100 represent a significant departure from past Office practice and one which should have been made only after a great deal of public input.

The Patent and Trademark Office is an office of the Department of Commerce⁶⁸ and as such is subject to the following requirements for rule making.⁶⁹ A general notice of proposed rule making must be published in the Federal Register which includes (a) a statement of the time, place, and nature of public rule making proceedings; (b) reference to the legal authority under which the rule is proposed; and (c) either the terms or substance of the proposed rule or a description of the subjects and issues involved. In addition, all interested persons must

⁶⁷M.P.E.P. 1901 (Rev. 1, January 1980).

⁶⁸35 U.S.C. 1.

⁶⁹5 U.S.C. 553.

be given an opportunity to participate in the rule making through submission of written data, views, or arguments. After consideration of the relevant data thus presented, the agency is required to give a concise general statement of the basis and purpose for any rule which is adopted.

Why was this practice not followed with regard to the substantive changes set forth in chapter 2100? Simply put, because the Office elected to consider them not as substantive changes in the rules of practice but instead as merely an interpretative pronouncement concerning existing rules. In so doing, it avoided the intent if not the letter of the Administrative Practice Act.

While there can be little doubt that the Commissioner is within his authority in interpreting the rules of practice he has promulgated, there can also be little doubt that any such interpretation must be consonant with the intent and purpose of the rule so interpreted. It is simply not seen how "discovery" requirements in ex parte prosecution are consistent with the intent and purpose of Rule 104(b).⁷⁰ While discovery is arguably permitted by Rule 175(b), there is no indication that the purpose of that rule as originally promulgated was to permit an examiner to require that written interrogatories be answered in ex parte practice.⁷¹

Discovery of the type contemplated by the "requirement for information" provisions of chapter 2100 represents too important a change in ex parte practice to be authorized merely by a purported interpretation of certain of the existing rules of practice. If the Office believes that the time has come for discovery in ex parte prosecution, let it set forth proposed rules for that purpose under the Commissioner's rulemaking authority and let the issues raised by such proposed rules be subject to detailed public comment and review. While applicants have a duty of candor to the Office, the Office, in turn, has a duty of candor to the public.

⁷⁰See text accompanying notes 23-25, supra.

⁷¹See text accompanying note 17, supra.