February 10, 2005

VIA E-MAIL (ab76comments@uspto.gov)
Box Comments—Patents
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Commissioner for Patents
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Interim Rule and Request for Comments Regarding
Changes to Implement the Cooperative Research and
Technology Enhancement (CREATE) Act of 2004
70 Fed. Reg. 1818 (January 11, 2005)

Dear Mr. Commissioner:

The U.S. Patent and Trademark Office (USPTO), in a Federal Register Notice provided at 70 Fed. Reg. 1818, requested public comments regarding the above-identified Interim Rule. The USPTO invited comments, among other things, on "whether the collection of information is necessary for proper performance of the functions of the agency" and "ways to minimize the burden of the collection of information to respondents."

Presented herein are my personal comments. I appreciate the opportunity to offer comments on the rule and practice changes proposed by the USPTO in the subject notice.

As a preliminary matter of housekeeping, I note that the interim rulemaking does not amend 37 C.F.R. § 1.17(i) to list the fee payment pursuant to 37 C.F.R. § 1.71(g)(2). If this fee structure is ultimately adopted and made final, 37 C.F.R. § 1.17(i) should be amended.

In more substantive matters, I have two, alternative comments. First, 37 C.F.R. § 1.71(g)(1) should be amended to allow applicants to take advantage of the provisions of 35 U.S.C. § 103(c)(2) without imposing additional procedural requirements. Alternatively, if that view is not adopted, 37 C.F.R. § 1.71(g)(1)(ii) should at least be amended to require a concise statement of the field of the *joint research agreement*, rather than of the claimed invention. Each of these views is discussed in turn below.

1. 37 C.F.R. § 1.71(g)(1) Should not Impose Requirements beyond the Statute

I suggest that the USPTO amend interim rule 37 C.F.R. § 1.71(g)(1) to read as follows:

> (1) If the specification discloses or is amended to disclose the names of the parties to a joint research agreement for purposes of 35 U.S.C. § 103(c)(2), applicants must state on the record that:
>
> (i) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made; and
>
> (ii) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

This suggested rule would be less burdensome on applicants and the USPTO than the interim rule because the suggested rule requires no more than the statute. In contrast, in addition to the requirement of 35 U.S.C. § 103(c)(2)(C) to disclose in the application the names of the parties to a joint research agreement, the interim rule requires that the specification contain or be amended to contain either the date the joint research agreement was executed and a concise statement of the field of the invention or the location where such information is recorded in the USPTO.

The stricter requirements of the interim rule are said to be "necessary to determine whether 'the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement' as required by 35 U.S.C. 103(c)(2)(B)." 70 Fed. Reg. 1818, 1820. Yet there is no reason why the USPTO needs to make such a determination because it could simply rely on a statement by applicants that the conditions for disqualification of art under 35 U.S.C. § 103(c)(2) are met. After all, applicants or their representatives possess the best knowledge of the nature and existence of a joint research agreement, and their statement to that effect is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO. Reliance on applicants' statements is nothing new; indeed, it is already standard procedure in the USPTO to credit applicants' statements regarding common ownership. See, e.g., MPEP § 706.02(l)(2)(II) (8th Ed., 2nd Rev., May 2004).

2. Alternatively, 37 C.F.R. § 1.71(g)(1)(ii) Should at least be Amended to Require a Concise Statement of the Field of the Joint Research Agreement

If the USPTO declines to amend the interim rule according to Comment 1, then the USPTO should amend interim rule 37 C.F.R. § 1.71(g)(1)(ii) to read as follows:

> (ii) A concise statement of the field of the joint research agreement.

As presently worded, the interim rule requires a concise statement of the field of the claimed invention. However, the scope of the claimed invention is already readily available to the USPTO and, in any event, is only half of the necessary information.

As noted above, the stated purpose of the "concise statement of the filed of the claimed invention" is "to determine whether 'the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement' as required by 35 U.S.C. 103(c)(2)(B)." 70 Fed. Reg. 1818, 1820. In order to make this determination, the USPTO must know what the invention is and what the joint research agreement covers. The former is readily ascertainable by reading the claims in the application. The latter, however, is not readily ascertainable by the USPTO without asking applicants. Therefore, one would expect the USPTO to require applicants to disclose the scope of the joint research agreement. Instead, the interim rule requires applicants to provide a concise statement of the field of the *claimed invention.*

To meet the avowed purpose of determining whether the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, the USPTO should amend 37 C.F.R. § 1.71(g)(1)(ii) as suggested above.

Conclusion

I appreciate the opportunity to comment on the proposed rules for implementing the CREATE Act in patent practice, and would like to thank the U.S. Patent and Trademark Office for providing this opportunity. The views expressed herein are my own and may not reflect the views of my employer and/or professional associations with which I am affiliated.

If there are any questions regarding these comments, do not hesitate to contact me.

Sincerely,

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