Subject: Changes to Implement the CREATE Act; Fed. Reg. Vol. 70, No. 7, 1-11-05, pp. 1818-1824

Dear Mr. Clarke:

As currently written 37 CFR 1.109(b) could be interpreted as authorizing a double patenting rejection even if the applicant doesn't invoke 35 USC 103(c)(2). Based on the Discussion in the Federal Register notice and on the text of 37 CFR 1.321(d) I gather that such an interpretation would be inconsistent with the intent of Congress and the PTO.

Moreover, 37 CFR 109(b) could be interpreted as not authorizing a double patenting rejection unless both the "other patent" and the application under examination were made as a result of activities within the scope of the joint research agreement. Such an interpretation could exempt from double patenting those situations where the "other patent" was made before the joint research agreement was signed, even though 35 USC 103(c)(2) was intended to apply to such situations, as seen from the fact that 35 USC 103(c)(2) only requires that the "claimed invention" was made under the joint research agreement and does not require that the "subject matter" was made under the joint research agreement

Therefore I recommend amending 37 CFR 109(b) as follows:

After the first occurrence of "non-commonly owned patent" insert -- disqualified under 35 U.S.C. 103(c) --.

Strike "and in the other patent".

*The views expressed above are the current personal thoughts of the author only. They should not be attributed to any of the author's clients.

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