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Author :	Mr. Matthew Grumbling
Organization :	
Mailing Address :	
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Comment :

Sirs: First, let me commend the USPTO for its quick response to the passage of the CREATE Act. I offer only a couple of comments for your consideration.

As I understand it, Congress intended the Act to encourage collaborative research agreements by making the protections of 35 USC section 103(c) available to resear collaborators, thereby extending the incentives of the patent system to a class of applicants that was previously ineligible for obtaining a patent. It seems reasonable then, that the rules that the USPTO enacts pursuant to compliance with the Act sho advance, or at least not hinder, that intent.

Regarding 37 C.F.R. Section 1.71(g)(1)(ii), the rule currently requires a "concise statement of the field of the claimed invention." I submit that a recitation of the fie the invention is unnecessary, as such should be readily discernable from the claims themselves. However, it may be desirable to require a brief description of the field the joint research agreement. The rule should be amended to either delete section 1 (g)(1)(ii) or change it to require the field of the joint research agreement.

The latter seems more in keeping with the intent of the rules. In the latter case, however, the USPTO should interpret the field of the joint research agreement libe unless there is evidence in favor of a more limited interpretation. Too strict or formalistic an application of this rule could result in endless amendment of the specification as the claims evolve through the course of prosecution. Inventors may forego collaboration if they feel that the administrative burdens or the uncertainty o patent process outweigh the benefits of collaborative efforts.

Regarding section 1.71(g)(1)(i), it should be sufficient for the specification to state the joint research agreement was entered into by the parties prior to the date of invention. This would parallel the requirement of section 1.131, wherein the declar need only declare that the evidence shows invention prior to the effective date of th applied reference. (In section 1.131, actual dates may be redacted from copies of notebook pages submitted in support of the declaration.) The rationale for not requ hard-and-fast dates in Rule 131 declarations should inure to applicants under sectio 1.71(g)(1)(i) as well. Additionally, requirements for excessive disclosure could act discourage entry into joint research agreements, which would be contrary to the int of the Act.