

February 9, 2005

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999700-0306Box Comments - Patents, Commissioner for  
Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450Re: Attention Robert A. Clarke  
Changes to Implement CREATE Legislation  
Due February 10, 2005

Sir:

Please consider the following comments in revising the interim rule dated January 10, 2005. Our comments are enumerated as in the Federal Register Notice 70 Fed. Reg. 1818-24 (Tuesday, January 11, 2005). The views expressed in this letter are those of the undersigned attorneys and do not necessarily represent the position of any attorney at Foley & Lardner or any of its clients.

**Signature Requirement**

According to the interim rule, the statement required to invoke the 35 U.S.C. § 103(c) safe harbor must be signed either by the applicant or the assignee of the entire interest as provided under 37 C.F.R. § 3.71(b). It is respectfully submitted that the signature requirement is burdensome and should be relaxed such that an attorney of record may sign such a statement, much like invoking the current version of 35 U.S.C. § 103(c) safe harbor that was in effect before December 10, 2004.

**Rule 71(g)(1)(i)**

The interim rule requires identification of the date of the joint research agreement was executed, because this information is necessary to determine whether the "joint research agreement ... was in effect on or before the date the claimed invention was made" as required by 35 U.S.C. § 103(c)(2)(A). It is respectfully submitted that this information is unnecessary and will allow the public to gain unnecessary information and to glean information concerning the date of invention. It is respectfully submitted that a certified statement by an attorney of record or an assignee of the entire interest or each applicant certifying this fact should be sufficient. Similarly, to antedate a reference as a prior invention, a Rule 131 declaration allows one to redact information such as the date of invention. In this case, the declaration signed by each inventor and may be affixed to evidence with redacted dates of invention. It is respectfully submitted that a similar process could be in effect here to prevent unnecessary disclosure of information concerning the date of invention in the public record.



Box Comments - Patents, Commissioner for Patents  
February 10, 2005  
Page 2

**Rule 109(a)**

According to the interim rule, Rule 130(b) was rewritten as Rule 109(a) “with a few changes for clarity.” It is respectfully submitted that the USPTO is an agency under 5 U.S.C. § 553, and as such, any changes which are substantive should only be applied prospectively. Along these lines, it is noted that the PTO considered this interim rule as relating “solely to the procedures to be followed in prosecuting a patent application.” 70 Fed. Reg. at 1821, col. 3. For the record, it is respectfully noted that conspicuously absent from the exemplified procedural changes were the additions to Rule 109.

In conclusion, please consider these comments when revising the interim rule.

Respectfully submitted,

/s/

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Sean A. Passino

/s/

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Stephen B. Maebius

SEAP/SBM/clh