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VIA E-MAIL (ab76comments@uspto.gov)

Box Comments—Patents  
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Request for Comments Regarding Interim Rule to Implement the Cooperative  
Research and Technology Enhancement (CREATE) Act of 2004  
70 Fed. Reg. 1818 (January 11, 2005)

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Dear Mr. Commissioner:

The U.S. Patent and Trademark Office, in a Federal Register Notice provided at 70 Fed. Reg. 1818, requested public comments regarding the above-identified Interim Rule. I am a patent practitioner and my comments follow.

The Interim Rule Should be Amended to Provide Full Notice to the Public of Prior Art that Can  
Be Disqualified under the CREATE Act

The interim rule should be amended to give the public notice whether a patentee is entitled to disqualify some prior art pursuant to the CREATE Act and, if so, what prior art is disqualified. Such notice, to be complete, must include the names of the parties to a joint research agreement, the date the joint research agreement was executed and a description of the scope of the joint research agreement (e.g., in the form of a concise statement of the scope of the joint research agreement to which a patentee can be held or a notice of the reel and frame number where the joint research agreement is recorded). Preferably, the notice will be conveniently available to the public by being placed in the specification itself.

An example elucidates the benefit of such notice. Suppose a competitor is concerned over a patentee's patent. The competitor may have in his possession certain prior art that invalidates the troublesome claims of the patent on obviousness grounds. The prior art qualifies as prior art under one or more of 35 USC §§ 102(e), (f) and (g). The competitor is entitled to know if he has grounds for a good-faith belief in the invalidity of the claims. That is, the competitor is entitled to know, swiftly and easily, whether the patentee can disqualify some or all of the prior art

making up the competitor's invalidity argument. Moreover, the competitor is entitled to know whether the patentee can later amend the specification by a certificate of correction.

To give the public notice and prevent patentees from disqualifying prior art that the public has come to rely on, 37 CFR § 1.71(g) should be amended to read as follows.

- (g)(1) In order to preclude subject matter developed by another person that qualifies as prior art only under one or more subsections (e), (f) and (g) of 35 USC § 102 when such subject matter was made by or on behalf of parties to a joint research agreement that was in effect on or before the date a claimed invention was made, the specification shall disclose or be amended to disclose:
  - (i) The names of the parties to the joint research agreement (35 U.S.C. 103(c)(2)(C));
  - (ii) The date the joint research agreement was executed; and
  - (iii) Either the frame and reel number where the joint research agreement is recorded or, if the joint research agreement is not recorded, a concise statement of the scope of the joint research agreement.
- (2) Any amendment under paragraph (g)(1) of this section must be entered prior to issuance of the application into a patent.

Three features of the proposed rule stand out. First, proposed 37 CFR § 1.71(g)(2) requires the amendment to be *entered*—not merely filed—prior to issuance of the application into a patent. This feature requires applicants to amend the specification if they wish to rely on the CREATE Act regardless of whether the U.S. Patent and Trademark Office rejects a claim during examination. The feature also gives applicants the incentive to file amendments early and prevents late filing of amendments that disrupt the patent printing process.

The second salient feature is actually an absence of a feature—there is no authorization for a certificate of correction if the amendment pursuant to 37 CFR § 1.71(g)(1) is not entered prior to patenting. If any correction of the patent is required because of an applicant's late filing of the amendment, the correct procedure is reissue, for two reasons. First, the amendment alters the scope of the claims and affects the public by disqualifying certain prior art. Second, the public should enjoy the intervening rights set out in 35 USC § 252, and reissue is the only appropriate procedure that grants intervening rights. (Why should the public enjoy intervening rights? Because the public may have relied on disqualifiable prior art to form a good-faith belief in the invalidity of the claims.)

The third and final feature of the proposed rule is that it allows an applicant to avoid averring to the scope of the joint research agreement—an averment that may result in an expensive, ancillary fight during litigation of the resultant patent. By recording the joint research agreement, a patentee allows the joint research agreement to speak for itself and avoids characterizing the agreement. The public, in turn, can easily look up the recorded agreement and is therefore given full notice.

At a Minimum, 37 CFR § 1.71(g)(1)(ii) Should Be Amended to Require a Concise Statement of the Field of the Joint Research Agreement

If the U.S. Patent and Trademark Office declines to amend the interim rule as I suggest above, then the U.S. Patent and Trademark Office ought to amend interim rule 37 CFR § 1.71(g)(1)(ii) to read as follows:

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

The U.S. Patent and Trademark Office's interim rule requires applicants to provide a concise statement of the field of the *claimed invention*. The field of the claimed invention does little to help the U.S. Patent and Trademark Office “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).” To determine that, the U.S. Patent and Trademark Office must know what the invention is and what the joint research agreement covers. The former reveals itself by a reading of the claims in the application. The latter, however, is not readily ascertained by the U.S. Patent and Trademark Office without asking applicants. Accordingly, the U.S. Patent and Trademark Office should amend 37 CFR § 1.71(g)(1)(ii) as above to learn from applicants the information necessary to determine whether the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

Conclusion

Thank you for the opportunity to comment on the interim rule. If there are any questions regarding these comments, contact me without hesitation.

Sincerely,

/s/

Collin A. Webb