

Subject: Changes to 37 CFR 1.105

I am writing in response to the Notice of Proposed Rulemaking by the PTO published in the Federal Register Vol. 68, No. 177 beginning at page 53816. In this email, I wish to address 37 CFR 1.105. In the Notice, the PTO proposed several changes to Rule 1.105. I would like to propose an additional change.

In its current form, and in the form proposed by the PTO, Rule 1.105 allows examiners to direct requests for information to "applicants." Under the Rules, the term "applicant" means "named inventor." I propose that Rule 1.105 be amended to recognize that in many situations, the named inventors have no rights in an application, and may be explicitly excluded from prosecution. In particular, I propose that Rule 1.105 should be directed to "applicants, or to the assignee if the assignee has excluded the rights of the applicants."

It is common practice for applicants to assign their rights in patent applications. Such an assignment may be from an employee to an employer, for example, or from a consultant to a client. Often, a patent application is assigned again, creating a further separation between the owner and the application. In these situations, the assignee typically wishes to exclude the applicant from prosecution of the application.

The PTO already recognizes that an assignee may wish to take control of a patent application. Rule 3.73(b) dictates how an assignee may act on its own in a patent application. Many assignees, when filing a statement under Rule 3.73(b), also expressly exclude the applicants' rights and authority in the application. The assignees choose to exclude the applicants to ensure that the assignee has total control of prosecution of the application and to eliminate the applicants' access to information about the confidential patent prosecution process.

Once the applicants have been excluded by the assignee, the PTO's relationship is exclusively with the assignee. Thus, once an application has been assigned and the assignee excluded the applicants, a request for information under Rule 1.105 cannot be properly directed to the applicants. The PTO should not direct such requests to the applicants, because the applicants can no longer act in the application. In some cases, the assignee may have some continuing authority over the application (e.g., employee-employer relationships). However, this cannot be presumed by the PTO, and the assignee should not be forced to abandon the application because it has no authority over an applicant-assignor.

Thus, Rule 1.105 should be amended to permit an assignee to alone respond to a request for information. I trust that the able staff of the Office of Patent Legal Administration can develop appropriate language. However, I would also be pleased to recommend changes to Rule 1.105 to address the situation where the applicants have no rights in the application.

-scs

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