

UNITED STATES PATENT AND TRADEMARK OFFICE

The BAR
Association of the
District of Columbia

1225 19th Street, NW, Suite 800
Washington, DC 20036-2489 USA

Statement of the Bar Association of the
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concerning

INTERIM RULE

*Changes To Implement the Cooperative Research and
Technology Enhancement Act of 2004*

70 Fed. Reg. 1818, January 11, 2005

The Bar Association of the District of Columbia ("BADC"), Patent, Trademark & Copyright Section ("PTC Section") appreciates the opportunity to present the following testimony to the United States Patent and Trademark Office's (PTO) Interim Rule on *Changes To Implement the Cooperative Research and Technology Enhancement Act of 2004*, 70 Fed. Reg. 1818, January 11, 2005 ("CREATE Act Interim Rules").

The BADC is one of the senior intellectual property bar associations in the United States uniquely situated in the nation's capital having a broad cross-section of members from government, industry and private practice, with some members specializing in patents who are involved primarily in patent procurement, some



Executive Vice-President
MARYEVA CANDON, Esq.
mcec@badc.org

Membership Services Coordinator
LINDSAY E. CAMPBELL
lc@badc.org

202-223-6600
fax 202-293-3388
www.badc.org

entirely in litigation and counseling, some with a mixed practice and others who may participate in patent procurement issues by advising others on strategy. Since members frequently represent applicants for patent matters before the PTO, they are thus interested in the Interim Rule. The interest of the PTC Section of the BADC is entirely pro bono to help advance the patent profession. The views expressed herein only represent those of the PTC Section of the BADC, and not those of the BADC or of its Board of Governors.

The PTC Section of the BADC is appreciative of the promptness of the actions of the PTO to seek an early implementation of the statute, and notes with appreciation the participation of key leaders of this rulemaking process at a roundtable that was sponsored by our organization on January 12, 2005. A variety of points were raised at that meeting and various comments have been or are being filed.

The PTC Section of the BADC congratulates the PTO for its early efforts to supply regulations due to the retroactive and immediate effective date of the statute upon its enactment on December 10, 2004. However, the PTC Section of the BADC is concerned with the rush to implement such regulations and, as a result, the inability to avail itself of the rulemaking process with the traditional notice and comment period. This is because many of the regulations that have been implemented do not appear to be mandated by statute.

For instance, there does not appear to be any statutory wording that compels double patenting, and thus statutory disclaimer, regulations such as 37 C.F.R. §§ 1.109 & 1.321 (d). Additionally, there does not appear to be any statutory wording that compels amendment to the specification to include "(i) [t]he date the joint research agreement was executed; and (ii) [a] concise statement of the field of the claimed invention[,]"¹ or "the location where (*i.e.*, by reel and frame number) such information is recorded." 37 C.F.R. § 1.71(g)(1). The

¹ Section 1.71(g)(1)(ii) does not require the concise statement of the field of the invention to be consistent with or the same as the definition of the claimed invention in the joint research agreement. Without such further requirement, it is unclear how the PTO can 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)." 7- Fed. Reg. 1818, 1820 (Jan. 11, 2005).

PTO has indicated that this specific information is needed "to determine the applicability of the 'safe harbor' provision of 35 U.S.C. [§] 103(c)" 70 Fed. Reg. 1818, 1820 (Jan. 11, 2005). However, like the procedures for 35 U.S.C. § 103(c) prior to the CREATE Act, a statement by applicants *or their representative(s) of record* should be sufficient evidence to establish the applicability of the provision because of their paramount obligation of candor and good faith to the PTO.

The PTC Section of the BADC thanks the PTO for their consideration of this statement.

Respectfully submitted,

/s/

Susan M. Dadio
CHAIR - PATENT, TRADEMARK &
COPYRIGHT SECTION, BAR ASSOCIATION
OF THE DISTRICT OF COLUMBIA

1225 19th Street, N.W., Suite 800
Washington, DC 20036
(202) 223-6600

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