

"CREATE" Act PTO Interim Rule Public Comments requested by PTO by 2/10/05

These are purely personal and *pro bono* comments.

We have found the following confusing surprises in the PTO's 1/11/05 Federal Register comments/interpretations accompanying the Interim Rules for the recently passed "CREATE" act, for which we are having difficulty getting clarifications solid enough for us to risk patent validity on.

First, these official PTO Interim Regulations comments on this new statute (a statute which almost everyone thought, and mostly still thinks, only related to *JOINT RESEARCH AND SEPARATE ENTITY* patent applications, NOT COMMONLY OWNED applications) has the following PTO comment buried in the Federal Register, WITHOUT EXPLANATION, that suggests that 103(c)(1) can now be read to apply to ANY pending patent application, even though the 1999 statutory change only covered 102(e)/103 rejections on *commonly owned* subject matter and was specifically NOT made retroactive.

"Since the CREATE Act also includes the amendment to 35 U.S.C. 103(c) made by section 4807 of the American Inventors Protection Act of 1999 (see Pub. L. 106-113, 113 Stat. 1501, 1501A-591 (1999)), the change of 'subsection (f) or (g)' to "one or more of subsections (e), (f), or (g)" in 35 U.S.C. 103(c) **is now also applicable to applications filed prior to December 29, 1999, that were pending on December 10, 2004.**"
[Emphasis supplied]

IF the above PTO interpretation of a (surprise) retroactive effect on the PRIOR 103(c) law is correct, it will desirably save applicants the cost of no longer having to file continuations to get *pre-11/29/00* applications [not subsequently re-filed] allowed over [the relatively common] 102(e)/103 rejections on one's own earlier-filed patent applications. HOWEVER, if this above PTO interpretation of retroactive effect is held WRONG by the CAFC, I believe there could be quite a few *invalid patents* as a result of depending on this PTO interpretation, because PTO docket and examiner case priority management is such that a substantial number of such *pre-11/29/00* applications are still pending in the USPTO after more than 5 years! [An inexcusable but very relevant docket situation.] What actual statutory language [not just "legislative history"] is this alleged retroactivity change in the prior non-retroactive legislation based?

ALSO, how can the PTO take the position, based solely on mere alleged "legislative history" [which Courts now normally give little or no credence to, except in cases of ambiguous actual statutory language], i.e., NOT based on anything actually IN this statute, that the "recapture doctrine" will prevent reissues to "capture" NEW claims that could NOT be "captured" under the prior law? "RE-capturing" something that was never even ATTEMPTED to be captured (because it was ILLEGAL to capture) is not even logical English, much less the basis of the judicially created "recapture doctrine." Does the PTO take the position that a mere statement by some Congressman in the Congressional Record can overrule CAFC case law?

Also, it seems to me that what the PTO SHOULD be commenting on re both above retroactivity-related issues, but has not, is that: (1) reissue "*intervening rights*" statutory protection clearly *does* apply to these retroactively "recaptured" claims, and (2) disabusing the authors of this apparent "stealth retroactivity" provision for *commonly*-owned patent applications of any idea that what may have been "inequitable conduct" under the 1999 or earlier law for intentionally not disclosing to the PTO known and material earlier-filed commonly owed applications is NOT "*cured*" by EITHER this alleged retroactivity OR by reissues?

ALSO, why does this same PTO FR commentary accompanying the interim rules for using this new law say they will require a separate written statement on a separate sheet signed by the applicants or assignees [instead of the attorney]? I cannot seem to find that added requirement anywhere in the PTO interim rules themselves.

Finally, it is noted that in the current ABA Committee discussion of these interim rules a key observation by others was that it is not seen why these interim rules need to impose so many onerous paperwork and filing burdens on applicants in order to obtain the benefit intended by Congress for this new statutory amendment of 103(c), especially since the similar prior amendment of this same statute did not, requiring only a simple attorney statement of common ownership, which could be essentially the same for joint research. Since the PTO has no more intent or capability to review and investigate joint research allegations than joint ownership allegations there is no logical reason to impose all of these additional paperwork and other burdens on this similar amendment, other than clarification that both parties signatures are needed on the terminal disclaimer form for overcoming judicial double-patenting rejections in these cases.

Please explain in detail in the FR Comments on the Final rules the basis for the three above surprises in PTO comments and statutory interpretations. Applicants cannot risk obtaining invalid patents waiting for possible CAFC clarifications.

Thank you,

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