



CHRISTOPHER R. LEWIS
DIRECT DIAL: 610-993-4238
EMAIL: crlewis@ratnerprestia.com

February 10, 2005

Box Comments—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Robert A. Clarke

Re: Comments Regarding Interim Rules 37 C.F.R. § 1.71(g)(1)(ii), and
37 C.F.R. § 3.11(c)

Dear Mr. Clarke:

As amended, 37 CFR § 1.71(g)(1)(ii) requires "A concise statement of the field of the claimed invention." We propose amending this interim rule to read:

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

For the reasons expressed below, we believe that the proposed revision is what was intended by the PTO.

35 U.S.C. § 103(c)(2)(B) specifies, as one of three conditions for deeming certain subject matter as having been owned by the same person, that the claimed invention must have been made as a result of activities undertaken within the scope of the joint research agreement. As confirmed by the Federal Register, Vol. 70, No. 7, January 11, 2005, at page 1820, a purpose of Rule 1.71(g)(1) is to allow the PTO 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 the new law. Therefore, the PTO will need to have certain information about the invention and about the joint research agreement to make this determination.

The field of the claimed invention is self-evident from the text of the patent application. On the other hand, the interim rules do not necessarily allow the PTO to be provided with the needed information regarding the scope of the joint research agreement. Rule 1.71(g)(1) gives an applicant the option of either recording at least certain information about the joint research agreement or amending the specification to provide the information set forth in subsections (i) and (ii) of the interim rule. The fact that these are alternative options is further evidence that the PTO meant to require a concise statement of the scope of the joint research agreement in Rule 1.71(g)(1)(ii).



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For these same reasons, we feel that the last phrase of 37 CFR sec. 3.11(c) be amended from "a concise statement of the field of the claimed invention" to "a concise statement of the scope of the joint research agreement."

Respectfully submitted,

RatnerPrestia

/s/

Christopher R. Lewis

CRL/lrb