

Subject: Interim Rule Jan. 11, 2005

Dear "BOX COMMENTS"

(Attention Rob Clarke)

COMMENT 1 "Field of the Invention":

Interim rule 1.71(g)(1) does not appear to provide the information that is stated to be the basis for the rule.

The rule requires an amendment to indicate "the following information" (i) date of joint agreement executed and (ii) concise statement of field of the claimed invention.

In the alternative, if "such information" is recorded in the assignments records, location (the reel and frame number) may be provided.

First of all, of course, the invention is defined by the claims.

As for the stated goal "[a] concise statement of the field of the claimed invention must also be provided because this information is necessary 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)," the USPTO has ample information to determine the "field of the invention." The claims clearly define the invention. The title is also directed to the invention. The specification can contain other information, but also describes the invention. It is respectfully submitted that examiners and attorneys and those skilled in the art should be able to determine the field of the claimed invention from the patent application.

The information the PTO is missing is a copy of the joint agreement (which appears to be the intended subject of the location/reel/frame mentioned (I understand new Rule 3.11 includes the requirement for a field of invention)). If a joint agreement has not been recorded, the "field of the invention" does not provide any information as to the joint agreement. It only provides information about the invention, which is adequately described in the application. Thus, meeting the requirement of the rule will not provide any information as to to determine whether "the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement". The subject of the joint research agreement is still missing.

Will the PTO record a mere date of joint agreement and a field of the invention statement?

It appears that to meet the PTO stated goal, a concise statement of the subject matter of the joint agreement should be provided (if the joint agreement is not recorded). However, the current rule is not related to meeting the PTO stated goal.

Further, to Rule 3.11, again, the concise statement of the field of the invention requirement is unnecessary in view of the other application filing requirements.

Filing a joint agreement provides information. Amending to provide a "field of the claimed invention" likely provides no new information.

COMMENT 2:

Separate from the above, can you provide examples of the field of the invention. If claims are drawn to a composition of matter comprising A, B and C, is an adequate field of the invention "a composition of matter"? Adding anything other than what is in the claims may create estoppel.

COMMENT 3: Finality

The comments states indicate an examiner may refuse entry of an amendment if it is not accompanied by a terminal disclaimer as such an amendment may necessitate reopening prosecution. I understand the point if there are no inventors in common and there are no assignees in common. However, if there are inventors in common or assignees in common, then compact prosecution, and the PTO examiner guidelines as set forth in MPEP 804, dictate that the examiner should have made the ODP rejection earlier. That is, a ODP rejection was not necessitated by amendment, but was present all along and should have been made if the examiner was following PTO guidelines.

Respectfully submitted,

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