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January 5, 2021

Re: Comments in response to the Notice of proposed rulemaking, 37 CFR Part 1 [Docket No. PTO-P-2020-0015] RIN 0651-AD46, “Disclaimer Practice in Patents and Patent Applications,” published at 85 FR 86518 (12/30/2020) on behalf of the Patent and Trademark Office (hereinafter “Office”)

Dear PTO Officials:

The Office requested comments on the Notice of proposed rulemaking, 37 CFR Part 1 [Docket No. PTO-P-2020-0015] RIN 0651-AD46, “Disclaimer Practice in Patents and Patent Applications,” published at 85 FR 86518 (12/30/2020) (herein after “Notice”).

The Notice specifies that comments “must be submitted through the Federal eRulemaking Portal at <https://www.regulations.gov>. To submit comments via the portal, one should enter docket number PTO-P- 2020-0015 on the homepage and click “search.” The site will provide search results listing all documents associated with this docket. Commenters can find a reference to this notice and click on the “Comment Now!” icon, complete the required fields, and enter or attach their comments. My comments will be submitted using that process.

I am a patent attorney, and I have been practicing patent law for over 25 years. I have a great deal of experience with both patent prosecution and practice before the Board (now the PTAB) in interferences and PTAB AIA petitions including IPRs and PGRs. I am very familiar with the law and practice relating to disclaimers, including terminal disclaimers. My comments follow.

Before commenting on the specific issues raised in the Notice, I copy in 37 CFR 1.321 for easy reference, from the official site, [www.ecfr.gov](http://www.ecfr.gov):

§1.321 Statutory disclaimers, including terminal disclaimers.

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in §1.20(d).

(b) An applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the applicant or an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in §1.20(d).

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either §1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only

for and during such period that said patent and the patent, or any patent granted on the application, which formed the basis for the double patenting are not separately enforced. [58 FR 54510, Oct. 22, 1993, as amended at 61 FR 42807, Aug. 19, 1996; 70 FR 1824, Jan. 11, 2005; 70 FR 54266, Sept. 14, 2005; 77 FR 48822, Aug. 14, 2012; 78 FR 11059, Feb. 14, 2013]

Now I comment on the Notice.

The Notice, at 85 FR 86518 left column states in part:

Currently, 37 CFR 1.321(d) limits the ability of parties to a joint research agreement to file a terminal disclaimer *to overcome a nonstatutory double patenting rejection* to instances where the reference application or patent had previously been applied as prior art or was available as prior art against the subject application or patent and the reference application publication or patent had been excepted or disqualified respectively as prior art under 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii). [Emphasis supplied.]

I point out that 37 CFR 1.321(d) does not limit the filing to be “to overcome a nonstatutory double patenting *rejection*.” Instead, 1.321(d) provides a right to “*obviate double patenting* based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either §1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement.” 1.321(d). In other words, the imposition of a double patenting *rejection* is not a precondition in rule 1.321(d) for the filing of a terminal disclaimer.

The Notice, at 85 FR 86518 left column states that:

...37 CFR 1.321(d) does not provide for the filing of such a terminal disclaimer where the reference is not prior art under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e) and therefore cannot be excepted or disqualified as prior art as set forth in 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii).

The double negative in the foregoing statement makes it both difficult to comprehend and difficult to compare to rule and statute. However, I perform the comparison below in order to interpret what the Notice intends to mean.

The foregoing quote from the Notice begins “37 CFR 1.321(d) *does not* provide,” whereas what 37 CFR 1.321(d) *does* provide, is that:

...when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either §1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement,

the terminal disclaimer must comply with the four standard requirements (signature; identification of term being disclaimed, identify ownership; and pay a fee), to be effective to obviate double patenting based upon the disqualified prior art. This passage provides that a terminal disclaimer can obviate a double patenting based upon information that “was disqualified as prior art as set forth in either §1.104(c)(4)(ii) or (c)(5)(ii).” 37 CFR 1.321(d) therefore specifies that a terminal disclaimer can avoid double patenting based upon prior art disqualified as set forth in either §1.104(c)(4)(ii) or (c)(5)(ii). Which begs the question what information can be disqualified as prior art under 37 CFR 1.104(c)(4)(ii) and (c)(5)(ii). I address that question in the following paragraphs.

37 CFR 1.104(c)(4)(ii) states that:

(ii) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) on the basis of a joint research agreement under 35 U.S.C. 102(c) [if the applicant takes certain actions.]

35 USC 102(a)(2) states that:

(a) A person shall be entitled to a patent unless- ... (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

35 USC 102(b)(2)(C) states that:

(b) Exceptions. - ... (2) Disclosures appearing in applications and patents.-A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if- ... (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

Therefore, 35 USC 102(a)(2) provides for a US patent publication that describes a claimed invention to be prior art from when US patent publication was “effectively filed.” A US patent publication is a disclosure. And 35 USC 102(b)(2)(C) excepts a disclosure from being prior art under 35 USC 102(a)(2) if that disclosure was information in a US patent publication “owned by the same person or subject to an obligation of assignment to the same person” as the owner of the claimed invention.

Returning to 37 CFR 1.104(c)(4)(ii) with that analysis in mind, this regulation allows a “joint research agreement under 35 U.S.C. 102(c)” to substitute for the condition that the US patent publication be “owned by the same person or subject to an obligation of assignment to the same person” as the owner of the claimed invention, in order for that US patent publication’s disclosure to be disqualified from prior art.

37 CFR 1.104(c)(5)(ii) states that:

(ii) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application pending on or after December 10, 2004, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, on the basis of a joint research agreement under 35 U.S.C. 103(c)(2) in effect prior to March 16, 2013 [if the applicant takes certain actions.]

And “35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013” were provisions that provided for non published information to be available to defeat the right of a claimant to a patent on an invention. These provisions 102(e), (f), or (g) however precluded commonly owned inventions from defeating the right of a claimant to a patent on an invention. Therefore, just like 1.104(c)(4)(ii), this 1.104(c)(5)(ii) provision allows a “joint research agreement under 35 U.S.C. 102(c)” to substitute for the condition that the information available under 35 U.S.C. 102(e), (f), or (g) and “owned by the same person or subject to an obligation of assignment to the same person” as the owner of the claimed invention, in order to preclude that 102(e), (f), or (g) information from defeating the right of a claimant to a patent on the claimed invention.

In summary, what the current version of 37 CFR 1.321(d) does provide, is the ability of a member to a joint research agreement to have post-AIA 102(b)(2) and pre-AIA 102(e), (f), and (g) unpublished information shared during a joint research agreement to members of the agreement to preclude that information from being available to defeat that member’s right to a patent on a claimed invention.

With that understanding in mind, return to the statement in the Notice, at 85 FR 86518 left column, that:

...37 CFR 1.321(d) does not provide for the filing of such a terminal disclaimer where the reference is not prior art under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e) and therefore cannot be excepted or disqualified as prior art as set forth in 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii).

I note that this statement is arguably inaccurate. It is arguably inaccurate because 1.321(d) specifically references (c)(5)(ii), which incorporates exclusion of 102(f) and 102(g) material. And at least 102(g) material is deemed by the courts to be “prior art.” Whether one refers to 102(f) information as “prior art” or not (and courts draw such a distinction), it is also information available to defeat one’s right under pre-AIA 102 and 103 to a claimed invention. Therefore, current 37 CFR 1.321(d) does in fact include the right to file a terminal disclaimer “where the reference is not prior art under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e),” because such a right exists for both 102(f) and (g) information.

The Notice at 86519, left column states:

Currently, 37 CFR 1.321(d) limits the ability of parties to a joint research

agreement to file a terminal disclaimer to overcome a nonstatutory double patenting rejection to instances where the reference application or patent had previously been applied as prior art or was available as prior art against the subject application or patent and the reference application publication or patent had been excepted or disqualified respectively as prior art under 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii). \*\*\* For example, a reference is not prior art where the effective filing date of the claimed invention in the subject application or patent is the same as or before the effectively filed date of the reference.

The example at the end of this passage implies that 37 CFR 1.321(d) does not apply when the reference is not “prior art.” 37 CFR 1.321(d) states that it applies to “double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either §1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement.” And 37 CFR 1.104(c)(4)(ii) and (c)(5)(ii) refer to “Subject matter which ...[would or does qualify] as prior art” thereby limiting 37 CFR 1.321(d) to apply only to double patenting based upon a reference that would qualify as “prior art.”

The policy providing patents may be invalid for double patenting is not limited to reference patents that are “prior art,” and the policy of promulgating law relating to joint research agreements was to alleviate the concern of double patenting invalidity to entice legal entities to conduct joint research, it further’s beneficial public policy to expand 37 CFR 1.321(d) to apply to reference patent publications regardless whether they qualify as “prior art.”

The Notice at 86519, left column to top of middle column states:

Currently, 37 CFR 1.321(d) limits the ability of parties to a joint research agreement to file a terminal disclaimer to overcome a nonstatutory double patenting rejection to instances where the reference application or patent had previously been applied as prior art or was available as prior art against the subject application or patent and the reference application publication or patent had been excepted or disqualified respectively as prior art under 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii). \*\*\* Another example where the reference is not prior art under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e) is where the inventive entities are the same for the reference and the subject application or patent.

For the same reasons just mentioned, the policy providing patents may be invalid for double patenting based upon non-prior art patents, and the policy of promulgating law relating to joint research agreements being to alleviate the concern of double patenting invalidity to entice legal entities to conduct joint research, it further’s beneficial public policy to expand 37 CFR 1.321(d) to apply to reference patent publications regardless whether the inventive entities are the same.

I support changed to the terminal disclaimer rule in the foregoing respects.

The Notice, at 86520, left column, states:

The USPTO is further proposing to revise 37 CFR 1.321 such that it will

no longer be applicable to an owner of a sectional interest in a patent.

I see no policy basis to make this proposed change; it affects no identified actual fact pattern. Therefore, amending the rule to refer to it would be a waste of time and require additional reading on the part of the public, to understand rule 1.321.

The Notice, at 86520, middle column, states:

Consistent with the proposed change to explicitly permit the preemptive filing of a terminal disclaimer before a nonstatutory double patenting rejection is made, the USPTO is also proposing to revise 37 CFR 1.130 in an analogous manner. Specifically, in addition to the current practice in which an affidavit or declaration of attribution or prior public disclosure under the AIA is not filed until after rejection, the proposed change will explicitly permit an applicant or patent owner to file this type of affidavit or declaration to overcome a potential rejection of a claim over the reference, as is the current practice.

I favor this change since it will promote efficiency in prosecution in a substantial number of pending and future applications.

In summary, I favor the proposed changes, except for the proposed changed dealing with sectional interest.

Very truly yours,  
/RichardNeifeld/  
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Printed: January 5, 2021 (3:28pm)

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