

AIPLA

American Intellectual Property Law Association

March 22, 2021

The Honorable Andrew Hirschfeld
Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual
Property and Director of the USPTO
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Via Federal eRulemaking Portal at <https://www.regulations.gov>

**RE: Comments on Notice of Proposed Rulemaking Regarding Disclaimer
Practice in Patents and Patent Applications**

Dear Mr. Hirschfeld:

On behalf of the American Intellectual Property Law Association (AIPLA), allow me to extend our appreciation for the efforts by the U.S. Patent and Trademark Office in preparing the Notice of Proposed Rulemaking (NPRM) regarding disclaimer practice in patents and patent applications. As discussed below, AIPLA supports the Office's proposed revisions to the rules. We have also included a suggestion to clarify the rules regarding disclaimers by parties to a joint research agreement.

AIPLA is a national bar association of approximately 8,500 members that include patent attorneys, patent agents, and other IP professionals who are primarily engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness. AIPLA values its long relationship of working in partnership with the Office to foster innovation.

AIPLA agrees with the Office's proposed revision to 37 C.F.R. § 1.321(d) to permit a terminal disclaimer to be filed by a party to a joint research agreement. This would avoid a

AIPLA Comments on Disclaimer Practice in Patents and Patent Applications

March 22, 2021

Page 2


nonstatutory double patenting rejection where a prior application or patent is not prior art under 35 U.S.C. § 102 to the application in which the disclaimer is being filed. We believe the rule change will eliminate the unnecessary costs and delays from the current petition requirement under 37 C.F.R. § 1.183.

AIPLA views the proposed revision to 37 C.F.R. § 1.321(d) as consistent with the purpose of the CREATE Act. We suggest that the Office clarify the proposed revision to expressly require that each party to a joint research agreement has consented to the disclaimer. Consent is important because disclaimer implicates the rights granted and the legislative history of the CREATE Act supports requiring consent. *See* 150 CONG. REC. S7520-S7522 (2004).

AIPLA agrees with the Office's proposed revision to 37 C.F.R. § 1.321 to explicitly provide that a terminal disclaimer may be filed to obviate a potential nonstatutory double patenting rejection or concern. AIPLA agrees with the Office's proposed revision to 37 C.F.R. § 1.130 to explicitly permit an affidavit or declaration of attribution to overcome the potential rejection or concern. These changes are consistent with the Office's practice of supporting compact prosecution.

We would be happy to further discuss our views on these issues with the Office. Thank you for the opportunity to make these comments and thank you in advance for considering these views.

Sincerely,



Joseph R. Re
President
American Intellectual Property Law Association