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November 25, 1992

CONFIDENTIAL/LEGAL OPINION **VIA FACSIMILE**

Cabinet MOUTARD
35, Avenue Victor Hugo
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Boite Postale 11
F-78960 Voisins-le-Bretonneux
FRANCE

Re: Gaultier - USSN 07/964,639
Design for "DIALOG TERMINAL"
Our reference: Gaultier=1

Dear Colleagues:

Thank you for your telefaxed communications of November 23 and November 24, 1992.

I certainly hope that my handwritten note sent to you by facsimile on November 23 (at the foot of your letter of November 5) was not confusing, because we must reiterate that the Rules in the U.S.A. are so structured that **WE ABSOLUTELY SHOULD NOT MAKE ANY CHANGES WHATSOEVER IN THE DECLARATION AFTER IT IS SIGNED.** It is therefore our intention to file the declaration which Mr. Gaultier signed on November 4, 1992, **as is** (without any changes), but to explain in our transmittal letter that it was executed on November 4, 1992, and that his name is incorrectly typed.

We have thoroughly studied your facsimile letter of November 23, 1992, and are fully aware of the difficulties. Even before your letter, we have been well aware that our rules seem very strange to foreign patent applicants and foreign patent agents, and especially our French colleagues. In this regard, you should perhaps be made aware of the fact that this is not the first time that this problem has occurred.

You state in your letter of November 23 that it "should not be impossible" for us to make the changes, but in fact the U.S. Patent Office rules make such alteration very problematic and difficult. We will now quote from the various regulations which control these matters.

Attention is first invited to 37 CFR 1.52(c), the second and third sentences of which read as follows:

> Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under Section 1.67(c). After the signing of the oath or declaration referring to the application papers, amendments may be made in the manner provided by Sections 1.121 and 1.123 through 1.125.

Sections 1.121 and 1.123-1.125 relate to the filing of amendments, and do not permit alteration of signed declarations.

Section 1.67(c), referred to in the quotation above, reads as follows:

> A supplemental oath or declaration meeting the requirements of Section 1.63 must also be filed if the application was altered after the oath or declaration was signed or if the oath or declaration was signed (1) in blank; ... .

Rule 52(c) thus clearly states that if changes are made, a supplemental oath or declaration is required under Section 1.67(c), and this latter section states that such a supplemental oath or declaration must be filed if the application was altered after signing of the original oath or declaration. <u>As the oath or declaration is part of the application, if we were to alter it in any way then the rules would require a supplemental oath or declaration which would then need to be signed by the applicant in any event</u>.

Moreover, we must be cognizant of the duty of disclosure under Section 1.56(a) which states in part:

> . . . . Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the [Patent and Trademark] Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. . . . . , no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct.

Alteration of a declaration after its execution so as to make it appear as though it was complete when executed could very well be determined to be bad faith or intentional misconduct, which could result in the patent being held to be invalid and/or unenforceable.

In addition to the Code of Federal Regulations (CFR), prosecution and conduct are also regulated by the Manual of Patent Examining Procedure (MPEP). In this regard, MPEP Section 602.01 is entitled "Oath Cannot Be Amended" and the first two sentences read as follows:

> **The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed.** If the wording is not correct or if all the required affirmations have not been made or it it has not been properly subscribed to, a new oath or declaration must be required.

This section then continues to explain that there are some few cases where a deficiency in an oath or declaration can be corrected by a supplemental paper without the necessity of a new oath or declaration, but the type of situation referred to is not one in which the oath or declaration was physically modified itself after its execution and before its filing.

In the immediately preceding section (MPEP 602), one of the pertinent statutes is quoted, i.e. 18 USC 1001, which reads as follows:

> Whoever, in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be fined not more than $10,000 or imprisoned not more than five years, or both.

The alteration of a declaration or oath after it has been executed could be considered such a criminal act, if done in such a way as to conceal the fact that any alterations were made after execution.

Lastly, we must inform you of certain provisions appearing in 37 CFR Part 10, which deals with attorneys and agents who practice before the United States Patent and Trademark Office. Every paper we file in the United States Patent and Trademark Office must be signed by us, and when we submit the applicant's declaration it will be submitted with a transmittal letter which we will sign. Thirty-seven CFR 10.23 defines misconduct on the part of a patent attorney as follows:

> (a) A practitioner shall not engage in disreputable or gross misconduct.
>
> (b) A practitioner shall not:
> ...
>
> (c) Conduct which constitutes a violation of paragraphs (a) and (b) of this Section includes, but is not limited to:
>
> ...

> (2) Knowingly giving false or misleading information or knowingly participating in a material way in giving false or misleading information, to
>
> ... (ii) The [Patent and Trademark] Office
>
> ... .
>
> ...
>
> (10) Knowingly violating or causing to be violated the requirements of Section 1.56 ... of this sub-chapter.
>
> (11) Knowingly filing or causing to be filed an application containing any material alteration made in the application papers after the signing of the accompanying oath or declaration without identifying the alteration at the time of filing the application papers.

We are confident that you now will realize, based on the authorities presented above, that we are absolutely prohibited from altering any declaration after it has been executed. We could also do legal research and provide you with case law precedent in addition to the authorities quoted above, but such further effort would seem unnecessary.

We hope that you thus understand that we cannot take the steps requested in your letter of November 23, 1992. As indicated above, we will file the declaration as received. The Patent and Trademark Office may (and probably will) then make a further requirement, and perhaps the client will then be less angry when the requirement comes from the Patent and Trademark Office.

We will keep you informed.

Sincerely,

Sheridan Neimark

SN:jec