

Commerce, 14th Street and Constitution Avenue, N.W., Washington, DC 20230; and Jesse M. Feder, Office of Policy and International Affairs, U.S. Copyright Office, Copyright GC/I&R, P.O. Box 70400, Southwest Station, Washington, D.C. 20024. Paper submissions should include a version on diskette in PDF, ASCII, Word Perfect (please specify version), or Microsoft Word (please specify version) format. Comments should be sent to both the Department of Commerce and Copyright Office addresses.

Comments submitted in electronic form should be sent to dmca@ntia.doc.gov and crypto@loc.gov. Electronic comments should be submitted in the formats specified above and should be sent to both the Department of Commerce and Copyright Office addresses.

FOR FURTHER INFORMATION CONTACT: Paula J. Bruening, National Telecommunications and Information Administration (202) 482-1816; and Jesse M. Feder, Office of Policy and International Affairs, US Copyright Office, Library of Congress (202) 707-8350.

SUPPLEMENTARY INFORMATION: The National Telecommunications and Information Administration, United States Department of Commerce and the United States Copyright Office, Library of Congress invite interested parties to submit comments on the effects of the Digital Millennium Copyright Act (DMCA) on encryption research and development of encryption technology; the adequacy and effectiveness of technological measures designed to protect copyrighted works; and, protection of copyright owners against unauthorized access to their encrypted copyrighted works.

The objective of Title I of the Digital Millennium Copyright Act was to revise U.S. copyright law to comply with two recent World Intellectual Property Organization (WIPO) Treaties and to strengthen copyright protection for motion pictures, sound recordings, computer software and other copyrighted works in electronic formats. The DMCA establishes a prohibition on the act of circumventing technological measures that effectively control access to a copyrighted work protected under the U.S. Copyright Act. The prohibition, found in Section 1201 of Title 17, U.S. Code, takes effect October 28, 2000, two years from the date of enactment of the DMCA.

The DMCA also makes it illegal for a person to manufacture, import, offer to the public, provide, or otherwise traffic in any technology, product, service,

device, component or part thereof which is primarily designed or produced to circumvent a technological measure that effectively controls access to or unauthorized copying of a work protected by copyright, has only a limited commercially significant purpose or use other than circumvention of such measures, or marketed for use in circumventing such measures.

Despite the general prohibitions of Section 1201, the DMCA permits certain specified activities that include the circumvention of access control technologies in limited circumstances. One such specified activity is good faith encryption research. The DMCA defines "encryption research" as identification and analysis of flaws and vulnerabilities of encryption technologies applied to copyrighted works. This activity must promote understanding of encryption technology or advance the development of encryption products.

The DMCA exempts from the general prohibition certain good faith activities of circumvention when: (a) The person circumventing the protection system lawfully obtained the encrypted copy of the work; (b) circumvention is necessary to conduct the encryption research; (c) the person circumventing the protection system made a good faith effort to obtain authorization prior to the circumvention; and, (d) such circumvention does not constitute copyright infringement or a violation of any otherwise applicable law. The DMCA also lists additional factors to be considered when determining whether a person qualifies for the exemption.

The DMCA also includes several additional exemptions from the general prohibition or circumvention. One such exemption is for security testing. Section 1201(j) of Title 17, U.S. Code permits circumvention of access control technologies in order to test the effectiveness of a security measure. Comments on Subsection 1201(j), the exemption for "security testing," and comments on exemptions other than the exemption for encryption research, are not being solicited by this Notice and will not be considered.

Information collected from responses to this **Federal Register** Notice will be

considered when preparing the required report for Congress.

Kathy D. Smith,
Acting Chief Counsel, National Telecommunications and Information Administration.

Marybeth Peters,
Register of Copyrights, United States Copyright Office.

[FR Doc. 99-13439 Filed 5-26-99; 8:45 am]

BILLING CODE 3510-60-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

RIN 0651-ZA02

[Docket No. 99-0512128-9128-01]

Notice of Public Hearing and Request for Comments on Issues Related to the Identification of Prior Art During the Examination of a Patent Application

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of Hearing and Request for Public Comments.

SUMMARY: The United States Patent and Trademark Office (USPTO) is seeking comments to obtain views of the public on issues associated with the identification of prior art during the examination of a patent application. Interested members of the public are invited to testify at the hearing and to present written comments on any of the topics outlined in the supplementary information section of this notice.

DATES: Public hearings will be held on Monday, June 28, 1999, and Wednesday, July 14, 1999, starting each day at 9:00 a.m. and ending no later than 5:00 p.m. Those wishing to present oral testimony at any of the hearings must request an opportunity to do so no later than June 21, 1999 for the June 28, 1999 hearing, or July 7, 1999 for the July 14, 1999 hearing. Speakers may provide a written copy of their testimony for inclusion in the record of the proceedings no later than August 2, 1999.

To ensure consideration, written comments must be received at the USPTO no later than August 2, 1999. Written comments and transcripts of the hearing will be available for public inspection on or about August 9, 1999.

ADDRESSES: The June 28, 1999 hearing will be held in the Nob Hill Room of the San Francisco Marriott Hotel located at 55 Fourth Street, San Francisco, California. The July 14, 1999 hearing will be held in the Patent Theater located on the Second Floor of Crystal Park 2, 2121 Crystal Drive, Arlington,

Virginia. Those interested in testifying or in submitting written comments on the topics presented in the supplementary information, or any other related topics, should send their request or written comments to the attention of Elizabeth Shaw, addressed to Commissioner of Patents and Trademarks, Box 4, Patent and Trademark Office, Washington, DC 20231. Written comments may be submitted by facsimile transmission to Elizabeth Shaw at (703) 305-8885. Comments may also be submitted by electronic mail through the Internet to elizabeth.shaw2@uspto.gov.

Written comments will be maintained for public inspection in Crystal Park Two, Room 902, 2121 Crystal Drive, Arlington, Virginia. Written comments in electronic form may be made available via the PTO's World Wide Web site at <http://www.uspto.gov>. No requests for presenting oral testimony will be accepted through electronic mail.

FOR FURTHER INFORMATION CONTACT: Lois Boland by telephone at (703) 305-9300, by facsimile at (703) 305-8885, by electronic mail at lois.boland@uspto.gov, or by mail addressed to Commissioner of Patents and Trademarks, Box 4, Washington, DC 20231; or Robert J. Spar by telephone at (703) 305-9285, by facsimile at (703) 308-6919, by electronic mail at bob.spar@uspto.gov, or by mail addressed to Commissioner of Patents and Trademarks, Box Comments-Patents, Assistant Commissioner for Patents, Washington, DC 20231. Inquiries regarding the San Francisco Marriott Hotel should be made to the hotel directly at (415) 896-1600.

SUPPLEMENTARY INFORMATION:

I. Background

One of the key functions of the United States patent examination system is to determine whether a claimed invention is novel and nonobvious. According to United States patent law, a claimed invention is not patentable if prior art teaches or renders obvious the invention. See 35 U.S.C. 102 & 103 (1996). Although the term "prior art" generally describes all information that can be used to show that an invention is not patentable, Section 102 of title 35 of the United States Code provides a full legal definition of what information qualifies as prior art. 35 U.S.C. 102 (a)-(g).

Locating relevant prior art is one of the most important aspects of the patent examining process. During the prosecution of a patent application, such prior art will be evaluated by the

examiner to determine patentability. Moreover, once the patent is issued, the prior art of record will be closely scrutinized by competitors and potential licensees to determine the validity and scope of the patent. In the event of litigation, these prior art documents will be considered by the courts for determinations of the validity and scope of issued patents.

Patent examiners and applicants share the responsibility of ensuring that pertinent prior art is being considered during the examination of a patent application. To this end, the USPTO imposes an obligation on patent examiners to conduct a thorough search of the prior art and on applicants to submit information known to them to be material to patentability. To assist patent examiners in discharging their duty to conduct a thorough search of the prior art, the USPTO provides patent examiners with access to a vast collection of patent documents and nonpatent literature. However, searching prior art in emerging technologies presents challenges. First, the terminology in such fields may not be standardized, which makes it difficult to conduct automated searches based on key terms. Second, prior art information in new technologies is frequently not categorized or indexed in a fashion that facilitates searching and accessibility. Lastly, prior art in certain areas, such as software-related inventions, may not be available through customary or predictable means.

Recently, USPTO has been criticized for not considering the most pertinent prior art during the examination of patent applications. In particular, software-related patents have been criticized for containing too few references to nonpatent literature related to these inventions. While many applicants submit a large number of prior art documents in connection with a filed patent application, the USPTO may not be receiving the kind of valuable nonpatent literature necessary to optimize the quality of patent examination. As the agency charged with issuing valid patents, the USPTO recognizes the importance of obtaining and analyzing the closest prior art to the proper prosecution of a patent application and the validity of an issued patent. For this reason, the USPTO is interested in obtaining public opinion as to whether patent examiners are identifying and applying the most pertinent prior art during the examination of a patent application, and if not, how the USPTO may be equipped to do so.

II. Issues for Public Comment

Interested members of the public are invited to testify and present written comments on issues they believe to be relevant to the discussion below. Questions following the discussion are included to identify specific issues upon which the USPTO is interested in obtaining public opinion.

A. Current Procedures for Obtaining Prior Art

Recognizing the importance of issuing patents that are properly searched and examined, USPTO rules and procedures impose specific requirements on both examiners and applicants for identifying material prior art. These obligations are designed to furnish patent examiners with sufficient information to make appropriate novelty and nonobviousness determinations.

Patent examiners are obligated to conduct "a thorough investigation of the available prior art relating to the subject matter of the claimed invention." 37 CFR 1.104(a) (1998). More specifically, the Manual of Patent Examining Procedure (MPEP) instructs patent examiners that prior art searches include not only the field in which the invention is classified, but also analogous arts. See MPEP § 904.01(c) (July 1998). Moreover, patent examiners are instructed to develop a search strategy that includes United States patents and "other organized systems of literature," and to implement the search strategy manually and by machine. MPEP § 904.01(d).

To assist examiners in obtaining prior art, the USPTO has invested a substantial amount of financial resources to the search and retrieval of a wide variety of prior art documents. Patent examiners can readily search classified paper files, microfilm, and CD-ROMs, comprising United States patents, foreign patent documents, Patent Cooperation Treaty (PCT) publications, as well as a large selection of nonpatent literature, including technical journals, books, magazines, encyclopedias, product catalogues, and industry newsletters. In addition, patent examiners have access to hundreds of in-house and commercial online databases providing convenient access, from their desktop, to millions of United States and foreign patent and nonpatent literature documents.

Emerging technologies, such as telecommunications and the computer-related arts, present challenges in searching and identifying the most relevant prior art. This is often because the best prior art with respect to these new technologies is available as

nonpatent literature months to years before it is available in the form of United States or foreign patents. Accordingly, searching the nonpatent literature in blossoming technologies is vital to patentability determinations. To ensure complete coverage, the USPTO is assembling a larger, more complete nonpatent literature prior art collection in emerging technologies and is working on providing patent examiners with better access to nonpatent literature in new areas of technology.

Concurrent with the examiner's duty to conduct a thorough and complete search of the prior art, applicants have a duty to submit all information known to them to be material to patentability. Specifically, 37 CFR 1.56 provides that information is material to patentability when (1) it establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or (2) it refutes, or is inconsistent with, a position the applicant takes in (i) opposing an argument of unpatentability relied on by the USPTO, or (ii) asserting an argument of patentability. 37 CFR § 1.56 (1998). In addition, this Rule encourages applicants to examine certain types of information, *e.g.*, prior art cited in search reports of a foreign patent office in a counterpart application, to ensure that material information is disclosed to the USPTO. 37 CFR 1.56 (a)(1) & (2).

Applicant's duty to submit material information is important to high quality patent examination because inventors are generally in the best position to be aware of the state of the art and are in possession of, or have access to, the most pertinent prior art. For this reason, the quality of patent examination benefits when applicants assist the examiners in identifying information, particularly nonpatent literature, material to patentability.

B. Questions

The USPTO is interested in ensuring that patent examiners consider the most pertinent prior art during the examination of patent applications. Public comments, including responses to the following questions, are invited to assist the USPTO in identifying any improvements that can be made to ensure that patent examiners are searching and have access to the most relevant prior art in the course of examination of a patent application. The tenor of the following questions should not be taken as an indication that the USPTO has taken a position on or is predisposed to any particular approach to concerns regarding examiner access to pertinent prior art. Your thoughts on

the following topics would be appreciated.

1. Is the most pertinent prior art being considered by patent examiners during examination of patent applications? If not, please include the following in your response:

(a) Provide support for your conclusions and identify the following:

- (i) The area(s) of technology most affected; and
- (ii) The type(s) of prior art most overlooked by the USPTO, including but not limited to United States patents, foreign patent documents, and nonpatent literature.

(b) Identify why you perceive that patent examiners are not considering the most pertinent prior art.

2. Do applicants submit the most pertinent prior art that they are aware of in connection with a filed patent application? If not, please include the following in your response:

(a) Provide support for your conclusions and identify the following:

- (i) The area(s) of technology most affected; and
- (ii) the type(s) of prior art that is not being submitted by applicants, including but not limited to United States patents, foreign patents, and nonpatent literature.

(b) Identify why you perceive that applicants are not submitting the most pertinent prior art.

3. Are the current rules and procedures for obtaining prior art during the examination of a patent application adequate and effective? If not, please include the following in your response:

- (a) Identify aspects of the rules and procedures that do not facilitate the identification of pertinent prior art;
- (b) Discuss any proposed changes to the rules or procedures to improve the identification of pertinent prior art; and
- (c) Discuss potential advantages and hardships that patent applicants and examiners would face if particular changes were adopted.

4. Are prior art searches typically conducted before filing a patent application with the USPTO? If not, please explain. If so, please include the following in your response:

- (a) An identification of the area(s) of technology where it is most likely that a prior art search would be conducted;
- (b) The scope of a proper prior art search (*i.e.*, United States Patents, foreign patents, journal articles, corporate bulletins, as well as other types of nonpatent literature); and
- (c) An identification of databases and Internet resources generally searched or available to applicants and/or the USPTO.

5. Please indicate whether Information Disclosure Statements are

frequently submitted and, if so, which of the following types of prior art documents are included:

- (a) United States patents;
- (b) Foreign patent documents and Patent Cooperation Treaty (PCT) publications; and
- (c) Nonpatent literature, including but not limited to journal articles, conference papers, corporate bulletins, and Internet publications.

If applicable, please explain why any of the aforementioned type(s) of prior art documents are not normally submitted to the USPTO.

6. Should applicants be required to conduct a prior art search and submit corresponding search results, including where they searched, to the USPTO when filing a patent application? If not, should applicants be required to disclose whether or not a search was conducted? Please explain your rationale and discuss any potential advantages and drawbacks.

7. Should applicants be required to submit all prior art relied upon during the drafting of the claims of a patent application? Please explain your rationale and discuss any potential advantages and drawbacks.

8. Should applicants be required to submit all nonpatent literature directed to the same field of invention attributable to, authored by, or co-authored by the applicant? Please explain your rationale and discuss any potential advantages and drawbacks.

9. Please identify any type(s) of nonpatent literature documents applicants should be required to submit to the USPTO in connection with any given patent application (*e.g.*, conference reports, corporate collections, documents relied on in drafting an application, etc.). Please explain your rationale and discuss any potential advantages and drawbacks.

10. If you believe that the most relevant prior art is not being identified during patent examination, please identify any suggestions to obviate this problem. In your response, please:

- (a) Discuss in detail any idea for addressing this problem effectively;
- (b) Explain how the proposal(s) should be implemented;
- (c) Identify who should bear the cost; and
- (d) Indicate any potential advantages and drawbacks for each suggestion.

11. Please discuss any related matters not specifically identified in the above questions. If this is done, parties are requested to:

- (a) Label that portion of the response as "Other Issues";
- (b) Clearly identify the matter being addressed;

(c) Provide examples, where appropriate, that illustrate the matter addressed;

(d) Identify any relevant legal authorities applicable to the matter being addressed; and

(e) Provide suggestions regarding how the matter should be addressed by the USPTO.

III. Guidelines for Oral Testimony

Individuals wishing to testify must adhere to the following guidelines:

1. Anyone wishing to testify at the hearing(s) must request an opportunity to do so no later than June 21, 1999 for the June 28, 1999 hearing, or July 7, 1999 for the July 14, 1999 hearing. Requests to testify may be accepted on the date of the hearing if sufficient time is available on the schedule. No one will be permitted to testify without prior approval.

2. Requests to testify must include the speaker's name, affiliation and title, mailing address, telephone number, and hearing date desired. Facsimile number and Internet mail address, if available, should also be provided. Parties may include in their request an indication as to whether they wish to testify during the morning or afternoon session of the hearing.

3. Speakers will be given between five and fifteen minutes to present their remarks. The exact amount of time allocated per speaker will be determined after the final number of parties testifying has been determined. All efforts will be made to accommodate requests for additional time for testimony presented before the day of the hearing.

4. Speakers may provide a written copy of their testimony for inclusion in the record of the proceedings. These remarks should be provided no later than August 2, 1999.

5. A schedule providing the approximate starting time for each speaker will be distributed the morning of the day of the hearing. Speakers are advised that the schedule for testimony will be subject to change during the course of the hearings.

IV. Guidelines for Written Comments

Written comments should include the following information:

1. Name and affiliation of the individual responding; and

2. If applicable, indications of whether comments offered represent views of the respondent's organization or are the respondent's personal views.

If possible, parties offering testimony or written comments should provide their comments in machine-readable format. Such submissions may be

provided by electronic mail messages sent over the Internet, or on a 3.5" floppy disk formatted for use in either a Macintosh or MS-DOS based computer. Machine-readable submissions should be provided as unformatted text (e.g., ASCII or plain text), or as formatted text in one of the following file formats: Microsoft Word (Macintosh, DOS, or Windows versions); or WordPerfect (Macintosh, DOS, or Windows versions).

Information that is provided pursuant to this notice will be made part of a public record and may be available via the Internet. In view of this, parties should not submit information that they do not wish to be publicly disclosed or made electronically accessible. Parties who would like to rely on confidential information to illustrate a point are requested to summarize or otherwise submit the information in a way that will permit its public disclosure.

Dated: May 21, 1999.

Robert M. Anderson,

Acting Assistant Secretary of Commerce and Acting Commissioner of Patents and Trademarks.

[FR Doc. 99-13440 Filed 5-26-99; 8:45 am]

BILLING CODE 3510-16-P

CORPORATION FOR NATIONAL AND COMMUNITY SERVICE

Submission for OMB Review; Comment Request

The Corporation for National and Community Service (hereinafter the "Corporation") has submitted the following public information collection request (ICR) to the Office of Management and Budget (OMB) for review and approval in accordance with the Paperwork Reduction Act of 1995 (Public Law 104-13, 44 U.S.C. Chapter 35). Copies of these individual ICRs, with applicable supporting documentation, may be obtained by calling the Corporation for National and Community Service, William Ward, (202) 606-5000, extension 375. Individuals who use a telecommunications device for the deaf (TTY-TDD) may call (202) 565-2799 between 8:30 a.m. and 5:00 p.m. Eastern time, Monday through Friday.

Comments should be sent to the Office of Information and Regulatory Affairs, Attn: OMB Desk Officer for the Corporation for National and Community Service, Office of Management and Budget, Room 10235, Washington, D.C. 20503, (202) 395-7316, within 30 days from the date of this publication in the **Federal Register**.

The OMB is particularly interested in comments which:

- Evaluate whether the proposed collection of information is necessary for the proper performance of the functions of the Corporation, including whether the information will have practical utility;

- Evaluate the accuracy of the agency's estimate of the burden of the proposed collection of information, including the validity of the methodology and assumptions used;

- Propose ways to enhance the quality, utility and clarity of the information to be collected; and

- Propose ways to minimize the burden of the collection of information to those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g. permitting electronic submissions of responses.

Type of Review: New approval.

Agency: Corporation for National and Community Service.

Title: Learn and Serve America

Project Description Form.

OMB Number: None.

Agency Number: None.

Affected Public: Educators and other institutional personnel whose organizations receive grant funds from Learn and Serve America.

Total Respondents: 2,100.

Frequency: Annually.

Estimated Time per Respondent: 1 hour.

Estimated Annual Reporting or Disclosure Burden: 2,100 hours.

Total Annualized Capital/startup costs: None.

Total Annualized Burden Costs: None.

Description: The Corporation seeks approval of the Learn and Serve America Project Description Form. The form will ask Learn and Serve America grantees and their sub-grantees to: (1) Identify the frequency and types of student participants in service-learning programs; (2) identify the frequency and types of institutions and organizations sponsoring and collaborating with service-learning programs; (3) specify the types of services being provided to communities by students in service-learning; and (4) describe the local program operations and achievements. The information will be used to: (1) Measure performance in terms set forth in the annual performance plan; (2) prepare descriptions of program activities and achievements with support from Learn and Serve America; (3) inform the Corporation, grantees, educational institutions, and the public