

March 5, 2012

The Honorable David J. Kappos
Undersecretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: oath_declaration@uspto.gov

**Re: Comments on Notice of Proposed Rulemaking
Changes to Implement the Inventor's Oath or Declaration Provisions
of the Leahy-Smith American Invents Act, 77 Fed. Reg. 982 (January 6, 2012)**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) is pleased to present the following comments on the proposed rulemaking regarding "Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith American Invents Act" ("AIA"), which was published in the January 6, 2012, issue of the Federal Register, 77 Fed. Reg. 982 (the "proposed rules").

AIPLA is a U.S.-based national bar association whose approximately 15,000 members are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property. Our members practice or are otherwise involved in patent law and other intellectual property law in the United States and in jurisdictions throughout the world.

Based on AIPLA's review of the proposed rules, it appears that the United States Patent and Trademark Office (USPTO) has interpreted the AIA in a manner that would essentially maintain existing rules governing the requirements for an oath or declaration, with only limited modifications to the current policies. We believe that such a restrictive interpretation is inconsistent with the legislative history of the AIA and denies the United States a unique opportunity for advances in policy and practice.

Specifically, AIPLA believes that the proposed rules fail to take advantage of provisions in the AIA which permit "assignee filing" in a manner that would make the U.S. patent system substantially consistent with all other patent systems world-wide. AIPLA believes that an enhanced assignee filing policy would provide the United States with an opportunity to achieve "procedural harmonization" of its system with the rest of the world and, in this manner, lay a solid foundation for building toward substantive patent law harmonization. The proposed rules fail to implement the clear language in 35 U.S.C. § 118, or account for the express legislative intent underlying that provision to allow an assignee to fully participate in the patent application process, including wholly acting as the "applicant."

Additionally, by maintaining the current oath and declaration policies, the proposals would perpetuate the existing problems that the AIA was intended to solve, and they will continue to plague users of the U.S. patent system. Applicants, especially corporations, encounter significant difficulties in obtaining inventors' signatures in satisfaction of the current oath and declaration requirements, even where the inventors have employment contracts or have already assigned their rights to their inventions. This problem is aggravated when an inventor resigns, retires, or takes a new job with another corporation, particularly where the parting is under difficult circumstances. Even when inventors remain within the same company but are reassigned to a different geographical location, there often are problems with contacting them and obtaining their signatures on documents.

AIPLA respectfully submits that the proposed rules, rather than making the situation easier for the applicant (which was the purpose and intent of these provisions of the AIA), make it even more complex and difficult for applicants. The proposed rules will increase the hardship on applicants as the first-inventor-to-file law goes into effect and as additional pressure is placed on applicants to get applications filed as early as possible. The proposed rules will provide further impediments to applicants rather than improving the administrative burden on them.

AIPLA believes that the proposed rules should be amended to achieve the true "assignee filing system" contemplated by 35 U.S.C. § 118 and to create "procedural harmonization" with the rest of the world. Accordingly, the implementing rules should reflect the following major principles.

1. The inventor and the applicant may be two separate entities. There is no statutory requirement that the applicant must be an inventor. This is only stated in current Rule 1.41. The very first sentence of 35 USC § 118 as amended by the AIA establishes a broad power of an assignee to file an application.¹ The new 35 USC § 115(a) simply requires the "naming of an inventor" and the "execution of an oath or declaration in connection with the application." The required statements in an oath or declaration under new 35 USC § 115(b) include a statement that "the application was made or was authorized to be made by the affiant or declarant."²

¹ The new 35 U.S.C. § 118 provides: "A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent."

² 35 USC § 115(b)(2) adds a second requirement for a statement that "such individual believes himself or herself to be the original inventor or an original joint inventor..." but further flexibility for assignee filing is provided in subsection (e), which provides that the individual "may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statement separately."

“Similarly, existing 35 USC § 111 requires an application to be made by the inventor “or authorized by the inventor,” (emphasis added) and only requires the filing of an oath or declaration “pursuant to 35 USC § 115.” The securing of such broad rights for assignees is exactly what Congress intended.³

2. Each named inventor must have a particular “document” submitted. Under the AIA, this “document” can be an oath or declaration, a substitute statement (which is not an oath or declaration), or a combined declaration/assignment. There is no requirement that one document, such as an oath or declaration, contain the names of all of the inventors. Of course, all of the inventors must be named, but this does not necessarily have to be done in a single oath or declaration document.

While AIPLA agrees that naming of the inventors at an early stage is very important, we also believe that there is a much more user-friendly way to accomplish that than through a requirement to file an oath or declaration on the filing date. For example, an ideal place to “name” the inventor(s) would be in the Application Data Sheet (ADS) under 37 CFR § 1.76. The applicant or registered representative submitting the ADS is under a strong duty to provide accurate and well-founded statements to the USPTO. The ADS submitted by the applicant is a single document that will permit naming of all of the inventors at the earliest possible time in the prosecution of an application.

³ The House report on the AIA states the following:

“The U.S. patent system, when first adopted in 1790, contemplated that individual inventors would file their own patent applications, or would have a patent practitioner do so on their behalf. It has become increasingly common for patent applications to be assigned to corporate entities, most commonly the employer of the inventor. In fact, many employment contacts require employees to assign their inventions to their employer.

“Current law still reflects the antiquated notion that it is the inventor who files the application, not the company-assignee. For example, every inventor must sign an oath as part of the patent application stating that the inventor believes he or she is the true inventor of the invention claimed in the application. By the time an application is eventually filed, however, the applicant filing as an assignee may have difficulty locating and obtaining every inventor’s signature for the statutorily required oath. Although the USPTO has adopted certain regulations to allow filing of an application when the inventor’s signature is unobtainable, many have advocated that the statute be modernized to facilitate the filing of applications by assignees. (emphasis added)

“The Act updates the patent system by facilitating the process by which an assignee may file and prosecute patent applications. It provides similar flexibility for a person to whom the inventor is obligated to assign, but has not assigned, rights to the invention (the “obligated assignee”).

“Section 115 of title 35 is amended to allow a substitute statement to be submitted in lieu of an inventor’s oath when either the inventor (i) is unable to submit an oath, or (ii) is both unwilling to do so and under an obligation to assign the invention. If an error is discovered, the statement may later be corrected. A savings clause is included to prevent an invalidity or unenforceability challenge to the patent based on failure to comply with these requirements, provided that any error has been remedied. Willful false statements remain punishable, however, under Federal criminal laws.

“Section 118 of title 35 is also amended to make it easier for an assignee to file a patent application. The amendment now allows obligated assignees—entities to which the inventor is obligated to assign the application—to file applications, as well. It also allows a person who has a sufficient proprietary interest in the invention to file an application to preserve that person’s rights and those of the inventor.”

The applicant is in the best position to decide who is to be named as an inventor, based on a legal analysis of what it takes to be an inventor of the claimed subject matter. The USPTO on its own should not raise inventorship issues. To the extent that another inventor challenges inventorship, such issues are best handled through a derivation action or a court action.

Further, once the "document" is submitted for each named inventor who has assigned his or her patent rights, no further documents are needed from that inventor for any subsequent step in the application process, including any continuation-in-part, reissue or reexamination. Adding, deleting, or changing inventors can be done with a supplemental ADS. No other documents are needed. No further oath or declaration is required. No petitions need be filed.

Finally, the proposed rules eliminate the requirement for a reissue oath or declaration to include a statement that all errors arose without any deceptive intent, consistent with the AIA. However, they still require supplemental reissue oaths for identification of the errors throughout the reissue process where all errors previously identified in the reissue oath or declaration are no longer relied upon as a basis for the reissue. There is no requirement for the latter in the AIA, nor is it clear what purpose such supplemental oaths or declarations serve, given the elimination of the "without any deceptive intent" language. AIPLA respectfully submits that these proposed rules interpret the AIA to conform to the old rules and miss the opportunity for a liberalized interpretation of the oath and declaration requirements, as envisioned by the AIA.

3. The oath or declaration should simply state what is required by the AIA. The new 35 USC § 115(b) requires a statement by the declarant that the named individual is an original inventor and is filing or has authorized such filing. While 35 USC § 115(c) permits the Director to require additional information, AIPLA believes that nothing further should be required. For example, there should be no requirement of reviewing the application or claims, and no recitation of a duty of disclosure. Such duty rests on all who participate in the application process, whether or not they have signed an oath or declaration.

4. The oath or declaration may be submitted at any time prior to the notice of allowance. 35 USC § 115(f) expressly provides a deadline late in prosecution for filing the requisite oath, declaration, substitute statement or assignment, and indicates an intention to depart from current practice. AIPLA recognizes that thorough and efficient prosecution of an application will require naming of the inventors at an early stage, preferably at the time of filing. 35 USC § 115(a) requires that the application for patent "shall include, or be amended to include, the name of the inventor...." However, the need for having the inventors' names at the start of prosecution can be addressed by requiring the naming of all inventors in the ADS. The "naming" need not be solely through an oath or declaration.

Any concern about causing delay of prosecution can be addressed in a number of ways. For example, the first Office action can indicate that such "document" is missing and can remind the applicant that the document must be provided before a notice of allowance can be sent. Should it still not be provided at the time of the notice of allowance, a notice of allowability can be issued, still setting the three-month time limit for payment of issue fee, but providing a non-extendable one-month term to submit the document. Applicants can file a continuation or RCE if they need more time for submission of the "document."

5. The “substitute statement” should be used liberally in lieu of an oath or declaration.

The substitute statement created under 35 USC § 115(d) provides the applicant a vehicle for complying with subsection (a) “in lieu of executing an oath or declaration” and for purposes of providing a “document” needed for the naming of the inventor. The substitute statement is required for an applicant who wants to file on behalf of a missing inventor, or an inventor who refuses to sign the declaration.

AIPLA submits that the filing of a “substitute statement,” which is “in lieu of the oath or declaration,” merely requires an explanation of why the inventor is not able to file the oath, and should not require a petition. Again, the AIA says nothing about filing a petition, and it says nothing about an oath or declaration. The proposed rules, in defining the “supplemental statement” as an “oath or declaration” signed by a third party, and in requiring the filing of a “petition,” are contrary to the express provisions of the AIA.

6. With respect to filing by other than an inventor under 35 USC § 118, no documents should be required in the case of assignment or obligation to assign, and no petition should be required in the case of a showing of sufficient proprietary interest. New 35 USC § 118 applies in cases where there is an actual assignment or obligation to assign (as by employment agreement), or a proprietary interest (under common law or the like).

This section is not necessarily related to the filing of the oath or declaration. For example, a company may have had an assignment from an inventor but was unable to get an oath or declaration. The company may therefore submit the “substitute statement” under 35 USC § 115(d). On the other hand, it may be that an inventor has signed an oath or declaration and left the company before assigning the invention. 35 USC § 118 would then apply.

AIPLA believes that, under new § 118, no documents should be required in order to perfect the right of an assignee/owner to file the patent application, either in the case of assignment or obligation to assign. An application filed by the assignee/owner, plus an oath or declaration by the inventor(s), should be sufficient. In the case where the application is to be filed by a person claiming to have sufficient proprietary interest under new § 118, it is likely that the Office would want to have documents that present “proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.”

However, the AIA does not indicate that any petition must be filed in connection with these documents. They are simple statements and only sufficient evidence is needed. There is no need for the USPTO to review these documents in order to determine whether or not they are sufficient. The USPTO is not in a position to take discovery, nor to determine what is or what is not adequate under such circumstances. It is up to the applicant to be sure that he or she adequately provides the information, and, if there is any challenge, such challenge shall be in the court where the facts can be reviewed, proven, and evidence evaluated. AIPLA is recommending a new Rule 1.43 to implement this scheme.

7. Powers of attorney should only be signed by applicants, not inventors. It is basic that an applicant's representative makes submissions on behalf of the applicant-owner/assignee (even if the applicant-owner is an inventor), and not on behalf of the inventor as such. Thus, once one of the three key documents is submitted with respect to an inventor (i.e., the declaration, the substitute statement, or the combined assignment and declaration), the USPTO from that point forward should be interacting only with the applicant. This would include interaction with the applicant in respect of the filing of continuations, divisionals, C-I-P's, and even reissue and reexamination requests. To the extent that the duty of disclosure requires follow-up concerning additional information from the inventor that might be needed by the Office, it is the applicant's responsibility to obtain and submit all of that information. When filing C-I-P's, whether there are more or fewer inventors than originally involved, there is no need to obtain any power of attorney from original inventors for whom documents have been submitted. They are out of the picture (unless they remain as applicants), and it is the applicant that is controlling the prosecution and paying the attorney. Any powers of attorney should be required only from the applicant.

8. A liberalized applicant filing policy will support greater harmonization. The approach to filing discussed above will permit the U.S. to be like every other country in that filling out a PCT Request Form will no longer require a statement that the "inventor" is the "applicant for U.S. only." This will provide procedural harmonization of U.S. law with the rest of the world. The carveout required for obtaining an oath or declaration from the inventor under the PCT rules can be addressed through different carveouts unique to U.S. law, other than requiring the inventor to be an applicant. For example, this can occur where the inventor is under a continuous duty to disclose known material information.

9. Excessive and burdensome fees can be avoided by a liberalized applicant filing policy. AIPLA notes that there is a new \$3,000 fee for filing an oath or declaration after the filing date and a \$1,700 fee for change of inventorship. The accompanying explanation for the charges states that this is compensation for potential delays in the processing of applications and for the loss of late filing fees. AIPLA respectfully submits that modifying the proposed rules in accordance with the foregoing principles would not only eliminate unnecessary expenses, it would also minimize administrative burdens on the office that might justify such large fees. AIPLA has already submitted comments to that effect, in response to the PPAC fees Notice.

Attachments

For the convenience of the Office, given the significant time limits that exist for implementing the new rules, AIPLA has endeavored to prepare specific recommendations on the proposed rules and, where applicable, include specific suggestions for amending the proposed rules. These additional recommendations and comments are consistent with the above-stated principles which would bring about such "procedural harmonization" to U.S. law and administrative relief to applicants.

Attachment I provides a discussion of AIPLA's recommendations with respect to each Proposed Rule in the Federal Register Notice. The discussion consists of a succinct statement of AIPLA's recommendation for each Proposed Rule, a red-line markup of the Proposed Rule indicating, where appropriate, AIPLA's recommended changes, and an explanation of the reasoning behind the AIPLA recommendation.

For convenience, **Attachment II** provides the succinct statement of AIPLA's recommendation for each Proposed Rule, plus a "clean copy," where appropriate, of each Proposed Rule as it would read if the AIPLA recommendation were adopted.

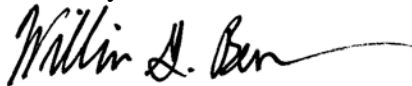
Attachment III provides a number of suggestions regarding Forms.

Conclusion

AIPLA respectfully submits that, in the interests of all users of the U.S. patent system, the USPTO should take advantage of the opportunity that AIA provides for us in connection with achieving procedural harmonization with the rest of the world in connection with the oath or declaration and facilitating the dual purpose (reward and invention disclosure) of the patent system.

AIPLA looks forward to working with the USPTO and commenting further should the opportunity arise.

Sincerely,

A handwritten signature in black ink, appearing to read "William G. Barber". The signature is written in a cursive style with a long, sweeping underline.

William G. Barber
AIPLA President

Attachment I

Section-by-Section Discussion of AIPLA Recommendations on the Proposed Rules

Attachment I herein provides a discussion of AIPLA's recommendation with respect to each Proposed Rule in the Federal Register Notice. The discussion consists of a succinct statement of AIPLA's recommendation for each Proposed Rule, a red-line markup of the Proposed Rule indicating, where appropriate, AIPLA's recommended changes, and an explanation of the reasoning behind the AIPLA recommendation.

For convenience, **Attachment II** provides the succinct statement of AIPLA's recommendation for each Proposed Rule, plus a "clean copy," where appropriate, of each Proposed Rule as it would read if the AIPLA recommendation were adopted.

Attachment III sets out some AIPLA suggestions regarding Forms.

Rule 1.1(e).

AIPLA Recommendation: Proposed Rule should not be adopted.

The Notice proposes to amend 37 CFR 1.1(e). The present wording of Rule 1.1(e) is:

Patent term extension. All applications for extension of patent term under 35 U.S.C. 156 and any communications relating thereto intended for the United States Patent and Trademark Office should be additionally marked "Mail Stop Patent Ext." When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

The proposed new wording is:

Patent term extension. All applications for extension of patent term under 35 U.S.C. 156 and any communications relating thereto intended for the United States Patent and Trademark Office should be additionally marked "Mail Stop Hatch-Waxman PTE." When appropriate, the communication should also be marked to the attention of a particular individual, such as where a decision has been rendered.

As a preliminary matter, the Notice states that it relates to the inventor's oath or declaration, yet the subject matter of Rule 1.1(e) (filing of correspondence relating to patent term extension) does not relate to the inventor's oath or declaration. Therefore the inclusion of proposed Rule 1.1(e) in the instant Notice is misplaced.

The proposed rule does not change the actual workflow within the Office, other than to change the specific wording that mailroom personnel are to look for when sorting certain incoming mail, and to incur training costs for mailroom personnel to do so. Given the Office's current concerns about whether its revenues will cover its costs of operation, it seems that incurring costs for a change as proposed here, with no apparent benefit to the Office, is not prudent.

Further, the proposed rule will impose on applicants the cost of revising their own internal procedures and systems, as well as retraining personnel, to use the marking "Mail Stop Hatch-Waxman PTE" instead of the current marking "Mail Stop Patent Ext." This seems to be a change with no apparent benefit to applicants, and no apparent benefit to the Office as well.

Moreover, the Notice does not provide the actual underlying reason for this proposed rule change. While the Notice speaks of the importance of mail stop markings in assisting the mailroom personnel of the Office in sorting mail, it does not explain why the wording "Mail Stop Hatch-Waxman PTE" better facilitates the mail sorting process.

Rule 1.4(e).

AIPLA Recommendation: Proposed Rule should not be adopted.

The Notice proposes to amend 37 CFR 1.4(e). The present wording of Rule 1.4(e) is:

Correspondence requiring a person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent by that person.

The proposed new wording is:

Correspondence requiring a person's signature and relating to payment by credit card in patent cases or registration to practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent by that person.

As a preliminary matter, the Notice states that it relates to the inventor's oath or declaration, yet the subject matter of Rule 1.4(e) (manner of making payment by credit card) does not relate to the inventor's oath or declaration.

Currently, there are a number of ways for applicants to make credit card payments, including:

- ⤴ the EFS-Web patent e-filing system
- ⤴ the EPAS (Electronic Patent Assignment System) patent assignment recordation system
- ⤴ the RAM (Revenue Accounting and Management) system for payment of maintenance fees
- ⤴ the OEMS system for ordering certified copies of patent applications
- ⤴ the Central Fax Number (571-273-8300) by use of Form PTO-2038
- ⤴ first-class mail under 37 CFR 1.8 by use of Form PTO-2038
- ⤴ Express Mail under 37 CFR 1.10 by use of Form PTO-2038
- ⤴ hand delivery by use of Form PTO-2038

Since it is impossible to submit “an original handwritten signature personally signed in permanent dark ink” through EFS-Web, EPAS, RAM, or OEMS, the proposed rule would thus make it impossible for applicants to make credit card payments through any of these e-commerce systems. Likewise, it is impossible to submit “an original handwritten signature personally signed in permanent dark ink” through the Central Fax Number, and hence the proposed rule would also make it impossible for applicants to make credit card payments by credit card through the Central Fax Number. Implementation of this proposed rule would therefore only permit credit card payments when using first-class mail, Express Mail, or hand delivery.

USPTO now imposes a \$400 penalty on any applicant that files a patent application by means other than EFS-Web. Under the proposed rule, this would mean that any applicant seeking to file a patent application with fees paid by a credit card would be forced to incur the \$400 penalty since the only means for paying by credit card would be first-class mail, Express Mail, or hand delivery.

The Notice also explains that the proposed rule would make it more difficult for an applicant having “a change of purpose” to obtain a refund from a credit card payment in a case where the applicant used a virtual signature rather than a handwritten signature. Is the Office's concern being addressed here with Form PTO-2038, rather than with online e-commerce systems? If so, then the proposed rule, which would make the e-commerce systems unavailable to applicants, is overbroad.

Rule 1.31.

AIPLA Recommendation: Proposed Rule should be adopted.

Rule 1.32.

AIPLA Recommendation: Proposed Rule should be adopted.

Rule 1.33.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

The Notice proposes to amend the first sentence of Rule 1.33(a) to read:

When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing.

It is suggested instead that the first sentence read:

When filing an application, a correspondence address must be set forth in an application data sheet (§ 1.76).

The reason for this alternative language is that the Office has already made clear in this Notice that the application data sheet ("ADS") is the proper way to communicate bibliographic data (e.g., a foreign priority claim). AIPLA agrees that the ADS is the correct and best way to communicate the inventor list. The same is true for the correspondence address. It is noted that Form PTO/SB/14 (Application Data Sheet) already has a field for the correspondence address (for which the Best Practice is the use of a customer number).

Rule 1.41.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

Currently, Rule 41(a) reads:

A patent is applied for in the name or names of the actual inventor or inventors.

The Notice proposes to leave this portion of the rule unchanged. Section 4(b) of the AIA, however, amends 35 USC § 118 to read:

A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

Where a Statute and a Rule conflict, it is the Statute that prevails and not the Rule. Therefore, proposed Rule 1.41 should not be adopted; however Rule 1.41 should read:

§ 1.41 Applicant for patent.

(a) A patent is applied for in the name of an applicant ~~in the name or names of the actual inventor or inventors.~~

(1) The inventorship of a nonprovisional application is that inventorship set forth in the application data sheet together with any supplemental application data sheet oath or declaration as prescribed by § 1.63, except as provided for in §§ 1.53(d)(4) and 1.63(d). ~~If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(i), supplying or changing the name or names of the inventor or inventors.~~

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by § 1.51(c)(1). If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(c), unless applicant files a paper including the processing fee set forth in § 1.17(q), supplying or changing the name or names of the inventor or inventors.

~~(3) In a nonprovisional application filed without an oath or declaration as prescribed by § 1.63 or in a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name and residence of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or § 1.53(c) are filed.~~

~~(4)~~(3) The inventorship of an international application entering the national stage under 35 U.S.C. § 371 is that inventorship set forth in the application data sheet together with any supplemental application data sheet first submission of an executed declaration under PCT Rule 4.17(iv) or oath or declaration under § 1.497, except as provided in § 1.63(d). If no application data sheet ~~neither an executed declaration under PCT Rule 4.17(iv) nor executed oath or declaration under § 1.497~~ is filed during the pendency of the national stage application, the inventorship is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92*bis*.

(b) Unless the contrary is indicated, the word "applicant" when used in these sections refers to a person to whom the inventor or inventors has assigned or is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor or inventors on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties, or the inventor or joint inventors ~~who are applying for a patent~~, or to the person mentioned in §§ 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent and related correspondence, including fees, to the Office on behalf of the applicant ~~inventor or inventors~~ and provide a correspondence address pursuant to § 1.33(a), but an oath or declaration (§ 1.63) can only be made in accordance with § 1.64 and amendments and other papers must be signed in accordance with § 1.33(b).

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

Rule 1.42.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

Proposed Rule 1.42 is just as burdensome upon the applicant as current Rule 1.42. Proposed Rule 1.42 fails to implement the applicant's right, as provided by the AIA, to proceed with a "substitute statement" in the situation covered by proposed Rule 1.42 rather than with an executed oath or declaration. Proposed Rule 1.42 should be adopted provided it is amended to allow an applicant to proceed by means of the substitute statement as set forth in the AIA. This comment offers changes to the proposed rule so as to permit use of the substitute statement, and is intended to permit legacy Rule 1.42 practice and legacy Rule 1.43 practice for any applicant that cannot or does not wish to make use of the substitute statement. Specifically, proposed Rule 1.42 should be amended as follows:

§ 1.42 When the inventor is deceased or legally incapacitated.

(a) In the case of the death or legal incapacity of the inventor, the legal representative (e.g., executor, administrator, guardian, or conservator) of the deceased or incapacitated inventor, the assignee, or a party to whom the inventor is under an obligation to assign the invention or party who otherwise shows sufficient proprietary interest in the matter may execute the oath or declaration under § 1.63, provided that the oath or declaration complies with the requirements of § 1.63(a) and (b) and identifies the inventor who is deceased or legally incapacitated. A party who shows sufficient proprietary interest in the matter executes the oath or declaration on behalf of the deceased or incapacitated inventor.

(b) A party to whom the inventor is under an obligation to assign the invention or a party who otherwise has sufficient proprietary interest in the matter taking action under this section must do so by way of a petition that is accompanied by the fee set forth in § 1.17(g) and a showing, including proof of pertinent facts, either that:

(1) The deceased or incapacitated inventor is under an obligation to assign the invention to the party; or

(2) The party has sufficient proprietary interest in the matter to execute the oath or declaration pursuant to § 1.63 on behalf of the deceased or incapacitated inventor and that such action is necessary to preserve the rights of the parties.

(c) In the case of an inventor who is deceased, or is under legal incapacity, the applicant may provide a substitute statement in lieu of executing an oath or declaration under § 1.63. A substitute statement under this subsection shall:

(1) identify the individual with respect to whom the statement applies;

(2) state that the inventor

(i) is deceased; or

(ii) is under legal incapacity;

(3) be signed by a person professing knowledge of the facts, and

(i) be sworn; or

(ii) contain an acknowledgment that any willful false statement made in such statement is punishable under Section 1001 of Title 18 by fine or imprisonment of not more than 5 years, or both.

(4) The substitute statement shall be examined to determine whether on its face it appears to satisfy subsections (1)-(3) and shall be placed in the application file, but in the absence of intervention by a third party or by the legal representative (e.g., executor, administrator, guardian, or conservator) of the deceased or incapacitated inventor, shall not be examined for sufficiency of any proof of the pertinent facts. In the event of intervention, the Director may require additional information or proof of the pertinent facts.

(d) If the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative or assignee upon proper intervention pursuant to this section.

Rule 1.43.

AIPLA Recommendation: A New Rule should be adopted.

An additional new rule is needed to set forth the procedure by which certain non-inventor entities may show standing to be an applicant. The Notice subsumes legacy Rule 1.43 into Rule 1.42, and proposes to reserve Rule 43. It is suggested that a new Rule 1.43 set forth the new procedure.

Section 118 establishes two categories of applicants: (a) applicants who are assignees or whose inventors are under an obligation to assign; and (b) applicants who are not assignees or whose inventors are not under an obligation to assign, but who have sufficient proprietary interest to "make an application for patent on behalf of and as agent for the inventor." From the statute it may be seen that a non-assignee applicant is required to present certain "proof," while an assignee applicant is not so required. This proposed rule addresses the means for providing proof of entitlement to file the application only in those limited cases relating to non-assignees. The proposed rule does not require any such statement for an applicant who is filing on the basis of an assignment or an obligation to assign.

New Rule 1.43 should be added as follows:

§ 1.43 Applicant's statement pursuant to 35 USC § 118.

(a) A natural or juristic person, to whom the inventor has not assigned and is not under an obligation to assign the invention, who has sufficient proprietary interest in the matter and wishes to make an application for patent on behalf of and as agent for the inventor pursuant to 35 USC § 118, shall file an applicant's statement in the application.

(b) The applicant's statement under paragraph (a) shall:

(1) identify the person wishing to make an application on behalf of and as agent for the inventor;

(2) state that the person has sufficient proprietary interest in the matter;

(3) provide proof of the pertinent facts thereof;

(4) make a showing that such action is appropriate to preserve the rights of the parties;

(5) state the name and address of the real party in interest;

(6) be signed by a person professing knowledge of the facts, and

(i) be sworn; or

(ii) contain an acknowledgment that any willful false statement made in such statement is punishable under Section 1001 of Title 18 by fine or imprisonment of not more than 5 years, or both;

and

(7) include the fee set forth in § 1.17(g);

(c) The person identified in subparagraph (b)(1) shall be listed as an applicant in the application data sheet, along with that person's address.

(d) The applicant's statement shall be examined to determine whether on its face it appears to satisfy subsections (1)-(5) and shall be placed in the application file, but in the absence of intervention by a third party or by an inventor or by a legal representative of an inventor, shall not be examined for sufficiency of any proof of the pertinent facts. In the event of such intervention, the Director may require additional information, a further showing, or further proof of the pertinent facts.

Rule 1.47.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

Proposed Rule 1.47 is just as burdensome upon the applicant as the current Rule 1.47. Proposed Rule 1.47 fails to implement the applicant's right, as provided by the AIA, to proceed with a "substitute statement" in the situation covered by proposed Rule 1.42 rather than by "execut[ing] the oath or declaration". Proposed Rule 1.47 should be adopted provided it is amended to allow an applicant to proceed by means of the substitute statement set forth in the AIA. This comment offers changes to the proposed rule so as to permit use of the substitute statement, and is intended to permit legacy Rule 1.47 practice for any applicant that cannot or does not wish to make use of the substitute statement. Specifically, proposed Rule 1.47 should be amended as follows:

§ 1.47 When an inventor refuses to sign or cannot be reached.

(a) If an inventor or legal representative thereof (§ 1.42) refuses to execute the oath or declaration under § 1.63, or cannot be found or reached after diligent effort, the assignee of the nonsigning inventor, a party to whom the inventor is obligated to assign the invention, or a party who otherwise shows sufficient proprietary interest in the matter may execute the oath or declaration under § 1.63. A party who shows sufficient proprietary interest in the matter executes the oath or declaration on behalf of the nonsigning inventor.

(b) If a joint inventor or legal representative thereof (§ 1.42) refuses to execute the oath or declaration under § 1.63 or cannot be found or reached after diligent effort, the remaining inventor(s) may execute the oath or declaration under § 1.63 on behalf of himself or herself and the nonsigning inventor.

(c) Any oath or declaration executed pursuant to this section must comply with the requirements of § 1.63(a) and (b) and be accompanied by a petition that:

(1) Includes the fee set forth in § 1.17(g);

(2) Identifies the nonsigning inventor, and includes the last known address of the nonsigning inventor;

(3) States either the inventor or legal representative cannot be reached after a diligent effort was made, or has refused to execute the oath or declaration under § 1.63 when presented with a copy of the application papers, with proof of the pertinent facts; and

(4) For a party to whom the nonsigning inventor is under an obligation to assign the invention, or has sufficient proprietary interest in the matter acting under paragraph (a) of this section, a showing, including proof of pertinent facts, either that:

(i) The nonsigning inventor is under an obligation to assign the invention to the party; or

(ii) The party has sufficient proprietary interest in the matter to execute the oath or declaration pursuant to § 1.63 on behalf of the nonsigning inventor and that such action is necessary to preserve the rights of the parties.

(d) If an inventor refuses to execute the oath or declaration under § 1.63, and is under an obligation to assign the invention, or cannot be found or reached after diligent effort, the applicant may provide a substitute statement in lieu of executing an oath or declaration under § 1.63. A substitute statement under this subsection shall:

(1) identify the inventor with respect to whom the statement applies, including the last known address thereof;

(2) state that

(i) the inventor refuses to execute the oath or declaration and the inventor is under an obligation to assign the invention; or

(ii) the inventor cannot be found or reached after diligent effort;

(3) be signed by a person professing knowledge of the facts, and

(i) be sworn; or

(ii) contain an acknowledgment that any willful false statement made in such statement is punishable under Section 1001 of Title 18 by fine or imprisonment of not more than 5 years, or both.

(4) The substitute statement shall be examined to determine whether on its face it appears to satisfy subsections (1)-(3) and shall be placed in the application file, but in the absence of intervention by a third party or by the individual, shall not be examined for sufficiency of any proof of the pertinent facts. In the event of intervention, the Director may require additional information or proof of the pertinent facts.

(e) The Office will publish notice of the filing of the application in the Official Gazette, and may send notice of filing of the application to the nonsigning inventor at the address(es) provided in the petition or substitute statement under this section. The Office may dispense with this notice provision in a continuing application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

(f) A nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under § 1.63. The submission of an oath or declaration by a nonsigning inventor or legal representative after the grant of a petition under this section or after the filing of a substitute statement under this section will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

Rule 1.48.

AIPLA Recommendation: Proposed Rule should be adopted.

Rule 1.53.

AIPLA Recommendation: Proposed Rule should be adopted.

Rule 1.55.

AIPLA Recommendation: Proposed Rule should be adopted.

This would establish the Application Data Sheet as the correct place to present a foreign priority claim.

Rule 1.63.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

Rule 1.63 defines the required content of an inventor's oath or declaration. Section 4 of the AIA allows for a substantial reduction in the required content of the oath or declaration and allows for a reduction in the number of situations where an inventor's oath or declaration would be required. Proposed Rule 1.63, however, does not take advantage of the changes offered by the AIA, but rather clings to requiring the current content for the inventor's oath and declarations. In addition, proposed Rule 1.63 still requires an inventor's oath or declaration in each situation required under current practice (despite the AIA permitting otherwise). That is, proposed Rule 1.63, fails to implement one of the purposes of the AIA, which is to ease administrative burdens.

Number of required "magic words." The AIA sets forth the minimum requirements for the content of an inventor's oath or declaration. Prior to the AIA, the "short form" Declaration contained 171 required "magic words." The AIA, however, only requires 62 "magic words." Proposed Rule 1.63, however, still requires all of the current 171 "magic words." Proposed Rule 1.63 should be amended so as to require no additional language beyond the 62 "magic words" set forth in the Act.

How the inventor list is communicated. Current Rule 1.63 requires that the oath or declaration identify each inventor. The AIA, however, has no such requirement that an oath or declaration identify inventors other than the particular inventor who is signing that oath or declaration. The AIA lists the elements that constitute a statute-compliant oath or declaration. The identification of "each inventor" in that list is not required by the AIA. Despite this, proposed Rule 1.63 continues to impose a requirement that a single oath or declaration identify "each inventor." Proposed Rule 1.63 should be amended to delete any requirement that a single oath or declaration identify any inventor other than the particular inventor signing that oath or declaration. As discussed elsewhere in these comments, AIPLA suggests that the Application Data Sheet (ADS) be employed as the means by which the applicant communicates the inventor list to the Office.

Single oath/declaration or multiple oaths/declarations. Current Rule 1.63 requires a single oath/declaration even if there are multiple inventors, and that all of the inventors sign that single oath/declaration. The AIA, however, permits that, except when a substitute statement is filed, "each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute *an* oath or declaration in connection with the application." (Emphasis added.) The use of "each" and "an" in the AIA indicates that if there are multiple inventors, the number of signed oaths or declarations may be as many as the number of inventors. Proposed Rule 1.63 should be amended to eliminate the requirement that a single oath/declaration be employed.

Applicant's choice of "substitute statement" or oath/declaration. Current Rule 1.63 states that there "shall" be an oath or declaration. The AIA, however, provides that, as to each inventor, the applicant may choose whether to file an oath or declaration or a "substitute statement." Proposed Rule 1.63 should be amended to allow for the option of applicant filing a substitute statement instead of an oath or declaration, as set forth in the AIA.

No requirement for recordation. Prior to the AIA, it was possible for a filer to combine declaration and assignment language into a single document for signature by an inventor. It was within the discretion of the filer to make use of such a document as a declaration for purposes of filing a patent application, as an assignment for purposes of recordation with the USPTO, or both, or neither. It was further within the discretion of the filer to choose *when* to make use of such a document for either of these purposes. This dual-purpose document could be signed by an inventor regardless of whether the inventor was *required* to do so under some prior obligation to assign. Nothing in current Rule 1.63 requires recordation of such a document as a precondition for use of the document as an inventor's declaration for purposes of the filing of a patent application.

The AIA at Section 4(e) provides that:

An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) [the inventor declaration language] in the assignment executed by the individual, in lieu of filing such statements separately.

On first reading it may not be obvious why the AIA contains this provision. That is, it is may not be obvious why Congress would go to the trouble to say that a filer may do something that filers were already able to do prior to the AIA, and indeed had already done many times prior the AIA. It is, however, an axiom of statutory construction that a statutory provision must be construed to have some effect rather than no effect. The sole effect that can be given to such a provision is to constrain actions of the Office; the effect is that the Office cannot make rules impeding the use of such dual-purpose documents.

Proposed Rule 1.63, however, does impede the use of such dual-purpose documents. More specifically, proposed Rule 1.63(c)(1) states:

An assignment may also include the oath or declaration required by this section if:

- (i) The assignment contains the information and statements required under paragraphs (a) and (b) of this section [the inventor declaration language]; and
- (ii) A copy of the assignment is filed in the application and recorded as provided for in part 3 of this chapter.

This would deny to the filer the discretion to use the document for its purpose as an inventor's declaration except in the special case where the document is also recorded with the USPTO as an assignment.

This aspect of the proposed rulemaking goes against longstanding practice. As mentioned above, it has always been possible to prepare a single document containing both assignment language and declaration language, and then to choose *later* when to make use of the assignment language or the declaration language, if at all. There are real-life situations where one might wish to use the document for only one of the two purposes but not both.

As a first example, it might develop that the signed document (containing both declaration language and assignment language) is a nullity so far as the assignment language is concerned, because of some *previous* assignment that was signed by the inventor to a different assignee, or arising out of some prior legal obligation that had only recently come to light. In such a situation, the required recordation contemplated by this proposed rule would harm the public as well as the applicant by needlessly cluttering the Abstract of Title with a misleading recordation, would harm the applicant by forcing the applicant to waste a \$40 fee to record the document, and would harm the applicant by forcing the applicant to spend the professional time to carry out the recordation process.

As a second example, an applicant can save money by recording multiple assignments at once, for example, if the assignments are all against the same property and to the same assignee. To save this money the filer might wish to "save up" the assignments for some time (perhaps years) until they are all in hand for recordation. Perhaps it might turn out that a first one of the assignments is needed in the near term for use as an inventor's declaration, while some second assignment might not be needed for use as a declaration at all and might not get signed until long after the initial formal examination of the application had been completed. Yet under proposed Rule 1.63(c)(1), the filer would be required to split up those recordations (thus at least doubling the cost thereof) so that the first document could serve its dual function as an inventor's declaration.

The Notice does not explain *why* the prior flexibility available to the filer (as to whether and when to make use of a dual-purpose document for its assignment purpose, for its declaration purpose, or both) is proposed to be taken away from the filer. In the absence of any such explanation in the Notice as to why such flexibility should be taken away, in the face of the language of the AIA that seems to function only as a constraint on the Office's freedom to take away the ability and timing of the use of such dual-purpose documents, and given that there are legitimate circumstances in which one might wish to make use of such flexibility as to use and timing, proposed Rule 1.63 should not take away that flexibility. The language in proposed Rule 1.63 that would take away that flexibility should be eliminated.

Proposed Rule 1.63 should not be adopted; however Rule 1.63 should read:

§ 1.63 Oath or declaration.

(a) ~~A nonprovisional application for patent filed under 35 U.S.C. 111(a) or which entered the national stage under 35 U.S.C. 371 shall include, or be amended to include, an oath or declaration. The~~ An oath or declaration under this section filed as part of a nonprovisional application must:

(1) Be executed (i.e., signed) in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;

(2) Identify ~~each~~ the inventor by ~~his or her~~ full name, including the family name, and at least one given name without any abbreviation together with any other given name or initial (except for a middle initial);

(3) Identify the application to which it is directed;

(4) Include a statement that the person executing the oath or declaration believes the named inventor ~~or joint inventors~~ to be the original inventor or an original joint inventor ~~inventors~~ of ~~the~~ a claimed invention in the application for which the oath or declaration is being submitted; and

(5) State that the application was made or was authorized to be made by the inventor;

~~(6) State that the person making the oath or declaration has reviewed and understands the contents of the application for which the oath or declaration is being submitted, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and~~

~~(7) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.~~

(b) ~~Unless such information is supplied on~~ The patent application must include, or be amended to include, an application data sheet in accordance with § 1.76, except in the case of a national stage of an international patent application, the oath or declaration must also identify for each inventor a mailing address where the inventor customarily receives mail, and residence, if the inventor lives at a location different from the mailing address.

(c) (1) An assignment may also include the oath or declaration required by this section if:

(i) The assignment contains the information and statements required under paragraphs (a) and (b) of this section; and

(ii) A copy of the assignment is filed in the application ~~and recorded as provided for in part 3 of this chapter.~~

(2) Any reference to an oath or declaration under § 1.63 includes an assignment as provided for in this paragraph.

(d) (1) A newly executed inventor oath or declaration under § 1.63 is not required under § 1.51(b)(2) and § 1.53(f) or § 1.497(a) in an application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed application, provided that:

(i) An executed oath or declaration in compliance with this section was filed in the earlier-filed application;

(ii) A copy of such oath or declaration, showing the signature or an indication thereon that it was executed, is submitted in the continuing application; and

(iii) Any new inventors named in the continuing application provide an executed oath or declaration in compliance with this section.

(2) If applicable, the copy of the executed oath or declaration submitted under this paragraph must be accompanied by a statement signed pursuant to § 1.33(b) requesting the deletion of the name or names of the person or persons who are not inventors in the continuing application.

(3) If the earlier-filed application has been accorded status via a petition under § 1.42 or § 1.47, the copy of the executed oath or declaration must be accompanied by a copy of the decision granting the petition in the earlier-filed application, unless all inventors or legal representatives subsequently joined in the earlier-filed application. If one or more nonsigning inventor(s) or legal representative(s) subsequently joined in the earlier-filed application, the copy of the executed oath or declaration must be accompanied by a copy of the executed oath or declaration filed by the inventor or legal representative to join in the application.

(e) An oath or declaration filed at any time pursuant to 35 U.S.C. §115(h)(1) will be placed in the file record of the application or patent, but may not be reviewed by the Office. Any request for correction of the named inventorship must comply with § 1.48 in an application and § 1.324 in a patent.

Comment. The Manual of Patent Examining Procedure (MPEP) should make clear that the former (pre-AIA) required language for an oath or declaration (former 37 CFR § 1.63) is a superset of the post-AIA required language for an oath or declaration (new 37 CFR § 1.63). That is, the MPEP should make clear that legacy oaths and declarations satisfy the new rule. This includes, but is not limited to, legacy Form PTO/SB01 and PTO/SB01a. This will provide guidance to OPAP and DO/EO/US as to whether to accept legacy oaths and declarations.

Rule 1.64.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

Proposed Rule 1.64 should be adopted, except that it needs to be corrected as shown in the marked-up text below to reflect that under the AIA a single oath or declaration document is not required. This rule may rarely be invoked, given that under the AIA a substitute statement will generally be permitted as a way to deal with situations where an inventor cannot or will not sign a declaration.

§ 1.64 Person making oath or declaration.

(a) ~~The~~ Any oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by ~~all of the~~ an actual inventor ~~inventors~~ except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

(b) If the person making ~~the~~ an oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.47, or 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased or legally incapacitated inventor, the oath or declaration shall also state that the person is a legal representative ~~and, unless such information is supplied on an application data sheet in accordance with § 1.76, the residence and mailing address of the legal representative.~~

Rule 1.67.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

Although not required by the AIA, proposed Rule 1.67 continues the current practice of requiring all inventors to sign a single oath or declaration. AIPLA agrees with proposed Rule 1.67, except that it needs to be corrected as shown in the marked-up text below to reflect that under the AIA a single oath or declaration document is not required.

§ 1.67 Noncompliant oath or declaration

(a) Where an oath or declaration does not comply with a requirement of 35 U.S.C. § 115, or a requirement of § 1.63 or § 1.162, the Office may require, or the inventors and applicants may submit, an oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier-filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§ 1.42 or § 1.47) may be corrected with ~~an oath or declaration~~ one or more oaths or declarations in compliance with 35 U.S.C. § 115 and § 1.63 or § 1.162 each signed by its respective inventor or applicant. ~~all the inventors or applicants.~~

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§ 1.42 or § 1.47) may be corrected with one or more oaths or declarations ~~an oath or declaration~~ in compliance with 35 U.S.C. § 115 and § 1.63 or § 1.162 identifying the entire inventive entity but each signed only by the respective inventor or applicant ~~inventor(s) or applicant(s)~~ to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(b) in an oath or declaration may be corrected with a supplemental application data sheet in accordance with § 1.76.

(b) No new matter may be introduced into a nonprovisional application after its filing date, even if an oath or declaration is filed to correct deficiencies or inaccuracies present in an ~~the~~ earlier-filed oath or declaration.

Rule 1.76.

AIPLA Recommendation: Proposed Rule should be adopted except for section (d).

Proposed Rule 1.76 says, among other things, that a supplemental application data sheet (ADS):

Must be titled "Supplemental Application Data Sheet," include all of the section headings listed in paragraph (b) of this section, include all appropriate data for each section heading, be signed in accordance with § 1.33(b), and identify the information that is being changed, with underlining for insertions of text, and strike-through or brackets for deletions of text.

To understand the extremely burdensome nature of this requirement for a Supplemental ADS, one must consider what is encompassed by "all of the section headings" and "all appropriate data for each section heading." Quoted below are the seven section headings, along with the "appropriate data for each section heading."

(1) Applicant information. This information includes the name, residence, mailing address, and citizenship of each applicant (§ 1.41(b)). The name of each applicant must include the family name, and at least one given name without abbreviation together with any other given name or initial. If the applicant is not an inventor, this information also includes the applicant's authority (§§ 1.42, 1.43, and 1.47) to apply for the patent on behalf of the inventor.

(2) Correspondence information. This information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see § 1.33(a)).

(3) Application information. This information includes the title of the invention, a suggested classification, by class and subclass, the Technology Center to which the subject matter of the invention is assigned, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (e.g., utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. The suggested classification and Technology Center information should be supplied for provisional applications whether or not claims are present. If claims are not present in a provisional application, the suggested classification and Technology Center should be based upon the disclosure.

(4) Representative information. This information includes the registration number of each practitioner having a power of attorney in the application (preferably by reference to a customer number).

(5) Domestic priority information. This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. §§ 119(e), 120, 121, or 365(c).

(6) Foreign priority information. This information includes the application number, country, and filing date of each foreign application for which priority is claimed, as well as any foreign application having a filing date before that of the application for which priority is claimed.

(7) Assignee information. This information includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application.

It is commonplace for an ADS to be five or more pages in length. If a Supplemental ADS were to be required to contain everything that was in the previous ADS, this ensures that the Supplemental ADS will be at least as many pages in length.

Often a Supplemental ADS is changing a single word or a single number or a single line of text in one field of one of these seven section headings. Therefore, it is very burdensome to require that the applicant reproduce the other six section headings, along with the entire recitation of data within each of the other six section headings. This requirement needs to be eliminated. Most Supplemental ADSs are expected to be less than one page in length.

It should be appreciated that if this comment is adopted, not only would its adoption save enormous amounts of time and effort for applicants, but it would also save enormous amounts of time and effort for Office personnel who would be saved from having to waste time scouring six other section headings, and six other sets of data, to look to see if any changes are being indicated. Office personnel would only need to look at a Supplemental ADS that, typically, would be less than one page in length.

Many years ago, before e-filing was possible, the Office promulgated guidelines for ADSs that used "double colons" to indicate section headings and individual fields within the sections. The "double colon" ADS was intended to be scanned for OCR (optical character recognition) purposes by Office personnel. We assume that the language in proposed Rule 1.76 calling for the Supplemental ADS to contain every piece of information that was in the previous ADS is left over from the days of the "double colon" ADS, with the notion that the Supplemental ADS would be OCR scanned in its entirety, just as the preceding ADS would have been OCR scanned.

In the present day, we believe that no ADS is ever OCR scanned at the USPTO. Some computer-readable ADSs (as mentioned above) are auto-loaded into Palm, but it is believed that all other ADSs, and all supplemental ADSs, are hand-keyed by Office personnel. Therefore, it serves no purpose to require that a supplemental ADS reproduce every item of data in the preceding ADS, since this only forces Office personnel to wade through large amounts of unchanged information to try to catch the one or two items that are actually intended to change.

Proposed Rule 1.76(d) would set forth an order of precedence as to which document would control with respect to bibliographic data as between an ADS and other documents such as oaths or declarations. The present comment suggests that the ADS be treated as the authoritative communication in all cases. As such, Rule 1.76(d) should simply be deleted, because the most recent ADS will always control, in relation to any previous ADS or other document.

Comment: The Manual of Patent Examining Procedure should suggest that although the inventor list in the international application can control, the applicant is encouraged to prepare and e-file a computer-readable ADS in the first e-filing submission, so as to auto-load the bibliographic data into USPTO's systems. In the event of the filing of such an ADS, the ADS is more recent and is thus controlling as to the inventor list. The Manual should suggest that the party preparing the Application Data Sheet (or the party who will sign the Application Data Sheet, if this is not the same as the party preparing the Application Data Sheet) circulate the draft ADS among the inventors, so as to permit each inventor to review the inventor list and other information for accuracy.

The Manual should indicate that whenever an inventor list changes (e.g., due to claim amendments or due to the filing of a divisional application), the change of inventorship may be communicated to the USPTO by means of a Supplemental Application Data Sheet.

Rule 1.78.

AIPLA Recommendation: Proposed Rule should be adopted.

Proposed Rule 1.78 will require that domestic benefit claims, just like foreign priority claims, be communicated in an ADS.

Rule 1.497.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

Proposed Rule 1.497, like proposed Rule 1.63 (discussed above), incorrectly tries to force all of the signatures into a single document, and incorrectly tries to force the inventor list to be set forth in that single document. The AIA requires no such thing.

The problems imposed upon applicants by these incorrect requirements would often include more burden upon an applicant in an international application than upon an applicant in a 35 U.S.C. § 111(a) application. However difficult it is for a Section 111(a) applicant to locate all of the inventors and secure their signatures on documents, it is usually far more difficult to do so in a national-phase case because another 18 to 30 months will have passed since the application was filed. During those 18 to 30 months, inventors may leave the employ of the assignee, die, or disappear. Where a change in the inventor list becomes necessary (perhaps due to a preliminary amendment to the claims at the time of U.S. national-phase entry), it may be difficult or impossible to locate all of the inventors for a new set of signatures.

In its discussion of proposed Rule 1.41(a)(4), the Notice recognizes the importance of facilitating the correction of the inventor list in a national-phase application. Proposed Rule 1.41(a)(4), however, would largely fail in its purpose if the Office does amend proposed Rule 1.497 as discussed herein. With the changes indicated below in a marked-up version of proposed Rule 1.497, it would be possible to efficiently correct the inventor list at the time of national-phase entry. Without these changes, it will often be difficult or impossible to do so in any efficient manner.

Proposed Rule 1.497 should not be adopted in its proposed form, but should be amended as follows:

§ 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. §371 pursuant to § 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1, the applicant must file an oath or declaration in accordance with § 1.63.

(b) One or more oaths or declarations ~~An oath or declaration~~ will be accepted as complying with 35 U.S.C. § 371(c)(4) and § 1.495(c) for purposes of entering the national stage under 35 U.S.C. § 371 if each ~~it~~:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the application to which it is directed;

(3) Identifies ~~each~~ the inventor to which it pertains;

(4) States that the person executing the oath or declaration believes himself or herself to be an ~~the named inventor or inventors to be the~~ original inventor or an original joint inventor of a claimed invention in the application;

(5) States that the application was made or was authorized to be made by the inventor; and

(6) Where the oath or declaration is not made by the inventor, complies with the applicable requirements of §§ 1.42 and 1.47.

(c) If the oath or declaration meeting the requirements of § 1.497(b) does not also meet the requirements of § 1.63, an oath or declaration in compliance with § 1.63 or a supplemental application data sheet will be required in accordance with § 1.67.

Rule 3.31.

AIPLA Recommendation: Proposed Rule should not be adopted. An acceptable alternative could be adopted.

Proposed new required check box in recordation cover sheet. Filers are accustomed to the present Office requirement that any document affecting title (including but not limited to an assignment) that is to be recorded at the Office must be accompanied by a recordation cover sheet. There is no requirement that the recordation cover sheet be prepared or signed by a registered practitioner and indeed the majority of recordation cover sheets are signed by persons who are not registered practitioners.

Initial examination of patent applications is carried out by the Designated Office/Elected Office group (DO/EO/US) within PCT operations (for entries into the U.S. national phase from international patent applications) and by the Office of Patent Application Processing (OPAP) for other U.S. patent applications. The vast majority of patent recordations are carried out purely electronically, by means of the EPAS system. Such electronic recordations have nothing to do with the process of e-filing of a patent application, and do not require any action by the OPAP or DO/EO/US. That is, in the vast majority of cases, OPAP and DO/EO/US never see what is recorded and have no reason to look whether recordation did or did not occur in a particular application.

As mentioned above, it is currently possible to include both declaration and assignment language in a single document for signing by an inventor. In cases where a filer has chosen to use such a signed document for both purposes, it has been routine that the document is filed in the application file (for its purpose as a declaration) and is recorded (for its purpose as an assignment). In the past there has been no reason for Assignment Branch personnel to know or care whether the document being recorded was or was not being concurrently used as a declaration. In the past there has been no reason for DO/EO/US or OPAP to know or care whether the document that has been filed as a declaration was or was not being concurrently recorded with the Assignment Branch. The scrutiny by DO/EO/US or by OPAP of a document that has been filed as a declaration has, in the past, been limited to inspection to see whether all 171 "magic words" are present.

Proposed Rule 3.31 imposes a new burden upon applicants when an applicant chooses to use a document once as an assignment and a second time as an inventor's declaration. More specifically, proposed Rule 3.31(h) states:

The assignment cover sheet required by § 3.28 must contain a conspicuous indication of an intent to utilize the assignment as the required oath or declaration under § 1.63 of this chapter.

Absent from the Notice is any explanation why such a check box has not been needed in the past when an applicant has made use of such a dual-purpose document, and yet is apparently needed now.

Prior to the advent of e-filing of patent applications and e-filing of assignments for recordation (which as mentioned are two very distinct activities directed to different groups within the USPTO), and prior to USPTO's recent imposition of a \$400 penalty for filing of a patent application by other than electronic means, the usual mode for filing of a U.S. patent application was on paper. In those days it was commonplace to include an assignment and its recordation cover sheet in the same envelope with the rest of the patent application (including the declaration). Experienced filers knew that the Office mail room would separate the assignment and its recordation cover sheet from the rest of the papers and would send the assignment and cover sheet to the Assignment Branch for recordation, and so would include an extra copy of any dual-use assignment/declaration.

In this way, when DO/EO/US or OIPE (Office of Initial Patent Examination, precursor to today's OPAP) received the application file minus the documents that had been sent to the Assignment Branch, the document intended to serve as a declaration would be in the file and would not get overlooked.

Perhaps proposed Rule 3.31(h) is intended to avoid the risk that DO/EO/US or OPAP might overlook the declaration in the (increasingly rare) case where (a) a filer is filing on paper, and (b) the filer has chosen to use a dual-purpose document for both assignment and declaration and (c) the filer has chosen to include papers for recordation in the same envelope with the application file and (d) the filer has chosen to provide only a single copy of the dual-purpose document in the envelope.

There are many reasons why these four conditions are very rarely satisfied simultaneously. First, it is rare that anyone files on paper any more, both because of the widespread adoption of patent e-filing and because of the newly imposed \$400 penalty for non-electronic filing. Second, not every application that is paper-filed is assigned. Third, not all filers choose to use dual-purpose assignment/declaration documents. Fourth, the vast majority of assignments are e-filed, not included in paper-filing envelopes. Fifth, some who paper-file and who choose to include papers for recordation with the paper-filed application provide two distinct copies of the dual-purpose document, thereby leaving a copy of the document (for declaration purposes) in the file even after the to-be-recorded documents have been separated out for dispatch to DO/EO/US or to OPAP.

As mentioned above, the vast majority of recordation cover sheets are signed by persons who are not registered practitioners. What's more, the vast majority of recordation cover sheets are employed in electronic filings (in the EPAS) system, in a procedure that has no functional or temporal linkage with the patent application process performed by DO/EO/US or by OPAP. The person who is preparing a recordation cover sheet for e-filing is, in many corporations or patent firms, not the same person who prepared and e-filed the patent application. The person who is preparing a recordation cover sheet for e-filing is thus likely to have no idea whether anyone "intended to utilize the assignment as the required oath or declaration." The two activities (e-filing the recordation and e-filing the patent application) are likely to be separated by some days or weeks, and are likely to be carried out by different persons. These two persons may or may not even have the same employer; there are corporations that do their own assignment recordations, so as to save money as compared with having the recordation carried out by the outside firm that files the patent application.

Proposed Rule 3.31(h) would impose upon the person who is e-filing the recordation (a person who is likely not a registered practitioner) a burden of arriving at a legal conclusion as to (a) whether the document does or does not contain all of the "magic words" required if it is to serve as a declaration, and (b) whether the filer of the patent application "intended to utilize" the assignment as a declaration of inventorship. Such a legal conclusion could be reached only if that person were in possession of detailed facts regarding the circumstances of the filing of the patent application, an activity that may have happened in a different state or a different country and at some temporal remove from the time of the e-filing of the recordation.

It seems unreasonable to impose this cost and burden to reach legal opinions upon every filer of every assignment, given that the risk being guarded against almost never happens in real life. Proposed Rule 3.31(h) should not be adopted, or in the alternative it should be tailored so that its burden is imposed only upon those whose filing activity gives rise to that risk. An example of a tailored Rule 3.31(h) would be the following:

In the case where an assignment cover sheet required by § 3.28 is included in a non-electronic application filing submission in which a single document in the submission is being relied upon both as an assignment to be recorded and as the required oath or declaration under § 1.63 of this chapter, the assignment cover sheet must contain a conspicuous indication of an intent to utilize the single document for both purposes.

Importantly, such a tailored rule would be inapplicable to, and would impose no burden upon, filers who carry out the recordation in a separate recordation process from the application filing process. It would likewise be inapplicable to and would impose no burden upon those who e-file their patent applications.

The Office has, from time to time, suggested that it might someday find a way to combine the EPAS and EFS-Web systems so that a single e-filing activity could accomplish both the filing of a patent application and the e-filing of an assignment for recordation. If and when the Office accomplishes this task, the Office can readily incorporate functions in the e-filing system that will permit EO/DO/US and OPAP to see such a dual-purpose document (perhaps by means of an appropriate document description indexing term) notwithstanding the routing of an (electronic) copy of the dual-purpose document to the assignment recordation system. No rulemaking is needed for such a function to be built in to such a not-yet-designed system.

Rule 3.73.

AIPLA Recommendation: Proposed Rule should be adopted in an amended form.

Proposed Rule 3.73 is said in the Notice to make it easier for a registered practitioner to sign a statement under (proposed) Rule 3.73 for purposes of filing a Power of Attorney on behalf of an assignee. The Notice puts forth the view that “patent practitioners who signed statements under § 3.73(b) merely on the basis of having been appointed in a power of attorney document have done so improperly.” Indeed the proposed Rule 3.73 does contain new language expressly permitting a registered practitioner to sign such statements.

A further difficulty with current Rule 3.73 is that as construed by Office personnel, it requires the assignee or registered practitioner to hand-key at least one reel and frame number, and sometimes a multiplicity of reel and frame numbers, into an Office form (Form PTO/SB/96). All too often, when one is hand-keying numerical data from one source to another destination, typographical mistakes are made. The practitioner signing the statement risks a proceeding by the Office of Enrollment and Discipline alleging that the practitioner has attempted improperly to gain control over the application.

Yet another difficulty with current Rule 3.73 is that the hand-keying of a multiplicity of reel and frame numbers, required by Office personnel when Form PTO/SB/96 is being completed, is a very time-consuming and thus expensive process. What's more, the registered practitioner is forced to spend time proofreading to compare the reel and frame numbers in the source document (either a Notice of Recordation or an Abstract of Title) with the reel and frame numbers that have been hand-keyed into the Form PTO/SB/96 or equivalent. This takes time and costs money.

Still another difficulty is that Form PTO/SB/96 has a limited amount of room for reel and frame numbers. As such, it is often necessary to spill over to an attached page to provide a place where the remaining reel and frame numbers may be hand-keyed.

It should also be appreciated that whenever an assignee files a Rule 3.73 statement, Office personnel presumably check the statement for accuracy before signing the Form N570 recognizing the Power of Attorney. Office personnel thus must print out an Abstract of Title and must juxtapose the Abstract of Title with the Rule 3.73 statement. Office personnel must then proceed character by character to check to see whether the reel and frame numbers are correct. Only after such a character-by-character scrutiny can Office personnel sign the Form N570.

All of these difficulties would be eliminated if the underlined text (see marked-up version of proposed Rule 3.73 below) were to be added to proposed Rule 3.73. The idea is that rather than force the practitioner to read the reel and frame numbers from the Abstract of Title or Notice of Recordation, and to hand-key the reel and frame numbers into the Form PTO/SB/96 or equivalent, and to then proofread the accuracy of the hand keying, the practitioner could instead attach the source document to the Form PTO/SB/96 or equivalent, and then check a box saying "see attached Abstract of Title" or "see attached Notice of Recordation." This saves the need to copy and hand-key the information, and saves the need to proofread the accuracy of the hand-keying.

This approach also saves Office personnel from having to do the character-by-character scrutiny of the Rule 3.73 statement. Instead, Office personnel can simply bring up an Abstract of Title on a computer screen, and take a quick look to see that the same Abstract of Title was attached to the Form PTO/SB/96 or equivalent. In the case where what was attached was a Notice of Recordation, Office personnel can simply bring up an Abstract of Title on a computer screen, and take a quick look to see that it only shows one reel and frame number, and that the reel and frame number match in the Abstract of Title what is in the Notice of Recordation. In either case only a quick look is needed, because the Office personnel do not need to do the character-by-character scrutiny to check for mistyping by the registered practitioner.

Proposed Rule 3.73 should not be adopted; however Rule 3.73 should read:

§ 3.73 Establishing right of assignee to request or take action in a trademark or patent matter.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)

(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number). If the reel and frame number appears in an Abstract of Title, the Abstract of Title may be attached to the statement and the statement may refer to "the Abstract of Title attached hereto." If the reel and frame number appears in a Notice of Recordation, the Notice of Recordation may be attached to the statement and the statement may refer to "the Notice of Recordation attached hereto."

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee; or

(iii) Being signed by a patent practitioner of record pursuant to § 1.32 of this chapter.

(3) In any one application or proceeding, a subsequent statement must provide a complete chain of title. If the complete chain of title appears in an Abstract of Title, the Abstract of Title may be attached to the subsequent statement and the subsequent statement may refer to "the Abstract of Title attached hereto."

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission is by an assignee of less than the entire right, title, and interest (e.g., more than one assignee exists), the Office may refuse to accept the submission as an establishment of ownership unless:

(i) Each assignee establishes the extent (by percentage) of its ownership interest, so as to account for the entire right, title, and interest in the application or patent by all parties including inventors; or

(ii) Each assignee submits a statement identifying the parties including inventors who together own the entire right, title, and interest and stating that all the identified parties own the entire right, title, and interest.

(3) A statement under paragraph (b) of this section from a prior application for which benefit is claimed under 35 U.S.C. §§ 120, 121, or 365(c) in a continuing application may have effect in the continuing application if the inventorship of the continuing application is the same as the prior application or one or more inventors from the prior application have been deleted in the continuing application, and a copy of the statement under paragraph (b) of this section from the prior application is filed in the continuing application.

(4) Where two or more purported assignees file conflicting statements under paragraph (b) of this section, the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application.

Attachment II

Summary of AIPLA Recommendations On The Proposed Rules

Attachment I provides a discussion of AIPLA's recommendation with respect to each Proposed Rule in the Federal Register Notice. The discussion consists of a succinct statement of AIPLA's recommendation for each Proposed Rule, a red-line markup of the Proposed Rule indicating, where appropriate, AIPLA's recommended changes, and an explanation of the reasoning behind the AIPLA recommendation.

For convenience, **Attachment II** herein provides the succinct statement of AIPLA's recommendation for each Proposed Rule, plus a "clean copy," where appropriate, of each Proposed Rule as it would read if the AIPLA recommendation were adopted.

Attachment III sets out some AIPLA suggestions regarding Forms.

Rule 1.1(e).

Proposed Rule 1.1(e) should not be adopted.

Rule 1.4(e).

Proposed Rule 1.4(e) should not be adopted.

Rule 1.31.

Adopt proposed Rule 1.31.

Rule 1.32.

Adopt proposed Rule 1.32.

Rule 1.33.

Proposed Rule 1.33 should not be adopted. However, the first sentence of current Rule 1.33(a) should be amended to read:

When filing an application, a correspondence address must be set forth in an application data sheet (§ 1.76).

Rule 1.41.

Proposed Rule 1.41 should not be adopted; however Rule 1.41 should read:

§ 1.41 Applicant for patent.

(a) A patent is applied for in the name of an applicant.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the application data sheet together with any supplemental application data sheet.

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by § 1.51(c)(1). If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(c), unless applicant files a paper including the processing fee set forth in § 1.17(q), supplying or changing the name or names of the inventor or inventors.

(3) The inventorship of an international application entering the national stage under 35 U.S.C. § 371 is that inventorship set forth in the application data sheet together with any supplemental application data sheet. If no application data sheet is filed during the pendency of the national stage application, the inventorship is that inventorship set forth in the international application, which includes any change effected under PCT Rule *92bis*.

(b) Unless the contrary is indicated, the word "applicant" when used in these sections refers to a person to whom the inventor or inventors has assigned or is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor or inventors on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties, or the inventor or joint inventors, or to the person mentioned in §§ 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent and related correspondence, including fees, to the Office on behalf of the applicant and provide a correspondence address pursuant to § 1.33(a), but an oath or declaration (§ 1.63) can only be made in accordance with § 1.64 and amendments and other papers must be signed in accordance with § 1.33(b).

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

Rule 1.42.

Proposed Rule 1.42 should not be adopted; however Rule 1.42 should read:

§ 1.42 When the inventor is deceased or legally incapacitated.

(a) In the case of the death or legal incapacity of the inventor, the legal representative (e.g., executor, administrator, guardian, or conservator) of the deceased or incapacitated inventor, the assignee, or a party to whom the inventor is under an obligation to assign the invention or party who otherwise shows sufficient proprietary interest in the matter may execute the oath or declaration under § 1.63, provided that the oath or declaration complies with the requirements of § 1.63(a) and (b) and identifies the inventor who is deceased or legally incapacitated. A party who shows sufficient proprietary interest in the matter executes the oath or declaration on behalf of the deceased or incapacitated inventor.

(b) A party to whom the inventor is under an obligation to assign the invention or a party who otherwise has sufficient proprietary interest in the matter taking action under this section must do so by way of a petition that is accompanied by the fee set forth in § 1.17(g) and a showing, including proof of pertinent facts, either that:

(1) The deceased or incapacitated inventor is under an obligation to assign the invention to the party; or

(2) The party has sufficient proprietary interest in the matter to execute the oath or declaration pursuant to § 1.63 on behalf of the deceased or incapacitated inventor and that such action is necessary to preserve the rights of the parties.

(c) In the case of an inventor who is deceased, or is under legal incapacity, the applicant may provide a substitute statement in lieu of executing an oath or declaration under § 1.63. A substitute statement under this subsection shall:

(1) identify the individual with respect to whom the statement applies;

(2) state that the inventor

(i) is deceased; or

(ii) is under legal incapacity;

(3) be signed by a person professing knowledge of the facts, and

(i) be sworn; or

(ii) contain an acknowledgment that any willful false statement made in such statement is punishable under Section 1001 of Title 18 by fine or imprisonment of not more than 5 years, or both.

(4) The substitute statement shall be examined to determine whether on its face it appears to satisfy subsections (1)-(3) and shall be placed in the application file, but in the absence of intervention by a third party or by the legal representative (e.g., executor, administrator, guardian, or conservator) of the deceased or incapacitated inventor, shall not be examined for sufficiency of any proof of the pertinent facts. In the event of intervention, the Director may require additional information or proof of the pertinent facts.

(d) If the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative or assignee upon proper intervention pursuant to this section.

Rule 1.43.

New Rule 1.43 should be added as follows:

§ 1.43 Applicant's statement pursuant to 35 USC § 118.

(a) A natural or juristic person, to whom the inventor has not assigned and is not under an obligation to assign the invention, who has sufficient proprietary interest in the matter and wishes to make an application for patent on behalf of and as agent for the inventor pursuant to 35 USC § 118, shall file an applicant's statement in the application.

(b) The applicant's statement under paragraph (a) shall:

(1) identify the person wishing to make an application on behalf of and as agent for the inventor;

(2) state that the person has sufficient proprietary interest in the matter;

(3) provide proof of the pertinent facts thereof;

(4) make a showing that such action is appropriate to preserve the rights of the parties;

(5) state the name and address of the real party in interest;

(6) be signed by a person professing knowledge of the facts, and

(i) be sworn; or

(ii) contain an acknowledgment that any willful false statement made in such statement is punishable under Section 1001 of Title 18 by fine or imprisonment of not more than 5 years, or both;

and

(7) include the fee set forth in § 1.17(g);

(c) The person identified in subparagraph (b)(1) shall be listed as an applicant in the application data sheet, along with that person's address.

(d) The applicant's statement shall be examined to determine whether on its face it appears to satisfy subsections (1)-(5) and shall be placed in the application file, but in the absence of intervention by a third party or by an inventor or by a legal representative of an inventor, shall not be examined for sufficiency of any proof of the pertinent facts. In the event of such intervention, the Director may require additional information, a further showing, or further proof of the pertinent facts.

Rule 1.47.

Proposed Rule 1.47 should not be adopted; however Rule 1.47 should read:

§ 1.47 When an inventor refuses to sign or cannot be reached.

(a) If an inventor or legal representative thereof (§ 1.42) refuses to execute the oath or declaration under § 1.63, or cannot be found or reached after diligent effort, the assignee of the nonsigning inventor, a party to whom the inventor is obligated to assign the invention, or a party who otherwise shows sufficient proprietary interest in the matter may execute the oath or declaration under § 1.63. A party who shows sufficient proprietary interest in the matter executes the oath or declaration on behalf of the nonsigning inventor.

(b) If a joint inventor or legal representative thereof (§ 1.42) refuses to execute the oath or declaration under § 1.63 or cannot be found or reached after diligent effort, the remaining inventor(s) may execute the oath or declaration under § 1.63 on behalf of himself or herself and the nonsigning inventor.

(c) Any oath or declaration executed pursuant to this section must comply with the requirements of §1.63(a) and (b) and be accompanied by a petition that:

(1) Includes the fee set forth in § 1.17(g);

(2) Identifies the nonsigning inventor, and includes the last known address of the nonsigning inventor;

(3) States either the inventor or legal representative cannot be reached after a diligent effort was made, or has refused to execute the oath or declaration under § 1.63 when presented with a copy of the application papers, with proof of the pertinent facts; and

(4) For a party to whom the nonsigning inventor is under an obligation to assign the invention, or has sufficient proprietary interest in the matter acting under paragraph (a) of this section, a showing, including proof of pertinent facts, either that:

(i) The nonsigning inventor is under an obligation to assign the invention to the party; or

(ii) The party has sufficient proprietary interest in the matter to execute the oath or declaration pursuant to § 1.63 on behalf of the nonsigning inventor and that such action is necessary to preserve the rights of the parties.

(d) If an inventor refuses to execute the oath or declaration under § 1.63, and is under an obligation to assign the invention, or cannot be found or reached after diligent effort, the applicant may provide a substitute statement in lieu of executing an oath or declaration under § 1.63. A substitute statement under this subsection shall:

(1) identify the inventor with respect to whom the statement applies, including the last known address thereof;

(2) state that

(i) the inventor refuses to execute the oath or declaration and the inventor is under an obligation to assign the invention; or

(ii) the inventor cannot be found or reached after diligent effort;

(3) be signed by a person professing knowledge of the facts, and

(i) be sworn; or

(ii) contain an acknowledgment that any willful false statement made in such statement is punishable under Section 1001 of Title 18 by fine or imprisonment of not more than 5 years, or both.

(4) The substitute statement shall be examined to determine whether on its face it appears to satisfy subsections (1)-(3) and shall be placed in the application file, but in the absence of intervention by a third party or by the individual, shall not be examined for sufficiency of any proof of the pertinent facts. In the event of intervention, the Director may require additional information or proof of the pertinent facts.

(e) The Office will publish notice of the filing of the application in the Official Gazette, and may send notice of filing of the application to the nonsigning inventor at the address(es) provided in the petition or substitute statement under this section. The Office may dispense with this notice provision in a continuing application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

(f) A nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under § 1.63. The submission of an oath or declaration by a nonsigning inventor or legal representative after the grant of a petition under this section or after the filing of a substitute statement under this section will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

Rule 1.48.

Adopt proposed Rule 1.48.

Rule 1.53.

Adopt proposed Rule 1.53.

Rule 1.55.

Adopt proposed Rule 1.55.

Rule 1.63.

Proposed Rule 1.63 should not be adopted; however Rule 1.63 should read:

§ 1.63 Oath or declaration.

(a) An oath or declaration filed as part of a nonprovisional application must:

(1) Be executed (i.e., signed) in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;

(2) Identify the inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

(3) Identify the application to which it is directed;

(4) Include a statement that the person executing the oath or declaration believes the named inventor to be the original inventor or an original joint inventor of a claimed invention in the application for which the oath or declaration is being submitted; and

(5) State that the application was made or was authorized to be made by the inventor.

(b) The patent application must include, or be amended to include, an application data sheet in accordance with § 1.76, except in the case of a national stage of an international patent application.

(c) (1) An assignment may also include the oath or declaration required by this section if:

(i) The assignment contains the information and statements required under paragraphs (a) and (b) of this section; and

(ii) A copy of the assignment is filed in the application.

(2) Any reference to an oath or declaration under § 1.63 includes an assignment as provided for in this paragraph.

(d) (1) A newly executed inventor oath or declaration under § 1.63 is not required under § 1.51(b)(2) and § 1.53(f) or § 1.497(a) in an application that claims the benefit under 35 U.S.C. §§ 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed application, provided that:

(i) An executed oath or declaration in compliance with this section was filed in the earlier-filed application;

(ii) A copy of such oath or declaration, showing the signature or an indication thereon that it was executed, is submitted in the continuing application; and

(iii) Any new inventors named in the continuing application provide an executed oath or declaration in compliance with this section.

(2) If applicable, the copy of the executed oath or declaration submitted under this paragraph must be accompanied by a statement signed pursuant to § 1.33(b) requesting the deletion of the name or names of the person or persons who are not inventors in the continuing application.

(3) If the earlier-filed application has been accorded status via a petition under § 1.42 or § 1.47, the copy of the executed oath or declaration must be accompanied by a copy of the decision granting the petition in the earlier-filed application, unless all inventors or legal representatives subsequently joined in the earlier-filed application. If one or more nonsigning inventor(s) or legal representative(s) subsequently joined in the earlier-filed application, the copy of the executed oath or declaration must be accompanied by a copy of the executed oath or declaration filed by the inventor or legal representative to join in the application.

(e) An oath or declaration filed at any time pursuant to 35 U.S.C. § 115(h)(1) will be placed in the file record of the application or patent, but may not be reviewed by the Office. Any request for correction of the named inventorship must comply with § 1.48 in an application and § 1.324 in a patent.

Rule 1.64.

Proposed Rule 1.64 should not be adopted; however Rule 1.64 should read:

§ 1.64 Person making oath or declaration.

(a) Any oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by an actual inventor except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

(b) If the person making an oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.47, or 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased or legally incapacitated inventor, the oath or declaration shall also state that the person is a legal representative.

Rule 1.67.

Proposed Rule 1.67 should not be adopted; however Rule 1.67 should read:

§ 1.67 Noncompliant oath or declaration.

(a) Where an oath or declaration does not comply with a requirement of 35 U.S.C. § 115, or a requirement of § 1.63 or § 1.162, the Office may require, or the inventors and applicants may submit, an oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier-filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§ 1.42 or § 1.47) may be corrected with one or more oaths or declarations in compliance with 35 U.S.C. § 115 and § 1.63 or § 1.162 each signed by its respective inventor or applicant.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§ 1.42 or § 1.47) may be corrected with one or more oaths or declarations in compliance with 35 U.S.C. § 115 and § 1.63 or § 1.162 identifying the entire inventive entity but each signed only by the respective inventor or applicant to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(b) in an oath or declaration may be corrected with a supplemental application data sheet in accordance with § 1.76.

(b) No new matter may be introduced into a nonprovisional application after its filing date, even if an oath or declaration is filed to correct deficiencies or inaccuracies present in an ~~the~~ earlier-filed oath or declaration.

Rule 1.76.

Adopt proposed Rule 1.76, except for section (d) (i.e., delete proposed section (d)).

Rule 1.78.

Adopt proposed Rule 1.78.

Rule 1.497.

Proposed Rule 1.497 should not be adopted; however Rule 1.497 should read:

§ 1.497 Oath or declaration under 35 U.S.C. § 371(c)(4).

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. § 371 pursuant to § 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1, the applicant must file an oath or declaration in accordance with § 1.63.

(b) One or more oaths or declarations will be accepted as complying with 35 U.S.C. § 371(c)(4) and § 1.495(c) for purposes of entering the national stage under 35 U.S.C. § 371 if each:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the application to which it is directed;

(3) Identifies the inventor to which it pertains;

(4) States that the person executing the oath or declaration believes himself or herself to be an original inventor or an original joint inventor of a claimed invention in the application;

(5) States that the application was made or was authorized to be made by the inventor; and

(6) Where the oath or declaration is not made by the inventor, complies with the applicable requirements of §§ 1.42 and 1.47.

(c) If the oath or declaration meeting the requirements of § 1.497(b) does not also meet the requirements of § 1.63, an oath or declaration in compliance with § 1.63 or a supplemental application data sheet will be required in accordance with § 1.67.

Rule 3.31.

Proposed Rule 3.31 should not be adopted.

However, an acceptable alternative 3.31(h) if such a Rule is adopted could read:

In the case where an assignment cover sheet required by § 3.28 is included in a non-electronic application filing submission in which a single document in the submission is being relied upon both as an assignment to be recorded and as the required oath or declaration under § 1.63 of this chapter, then the assignment cover sheet must contain a conspicuous indication of an intent to utilize the single document for both purposes.

Rule 3.73.

Proposed Rule 3.73 should not be adopted; however Rule 3.73 should read:

§ 3.73 Establishing right of assignee to request or take action in a trademark or patent matter.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)

(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number). If the reel and frame number appears in an Abstract of Title, the Abstract of Title may be attached to the statement and the statement may refer to "the Abstract of Title attached hereto." If the reel and frame number appears in a Notice of Recordation, the Notice of Recordation may be attached to the statement and the statement may refer to "the Notice of Recordation attached hereto."

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee; or

(iii) Being signed by a patent practitioner of record pursuant to § 1.32 of this chapter.

(3) In any one application or proceeding, a subsequent statement must provide a complete chain of title. If the complete chain of title appears in an Abstract of Title, the Abstract of Title may be attached to the subsequent statement and the subsequent statement may refer to "the Abstract of Title attached hereto".

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission is by an assignee of less than the entire right, title, and interest (e.g., more than one assignee exists), the Office may refuse to accept the submission as an establishment of ownership unless:

(i) Each assignee establishes the extent (by percentage) of its ownership interest, so as to account for the entire right, title, and interest in the application or patent by all parties including inventors; or

(ii) Each assignee submits a statement identifying the parties including inventors who together own the entire right, title, and interest and stating that all the identified parties own the entire right, title, and interest.

(3) A statement under paragraph (b) of this section from a prior application for which benefit is claimed under 35 U.S.C. §§ 120, 121, or 365(c) in a continuing application may have effect in the continuing application if the inventorship of the continuing application is the same as the prior application or one or more inventors from the prior application have been deleted in the continuing application, and a copy of the statement under paragraph (b) of this section from the prior application is filed in the continuing application.

(4) Where two or more purported assignees file conflicting statements under paragraph (b) of this section, the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application.

Attachment III

AIPLA Recommendations Regarding Forms

Revisions will be needed for Office standard forms. The Office's standard Application Data Sheet (Form PTO/SB/14) lists the first inventor as "applicant 1", the second inventor as "applicant 2", and so on. This, however, is inconsistent with the AIA. Form PTO/SB/14 will need to be revised to be like the PCT Request Form. For example, for each inventor there will need to be a check box, normally left unchecked, stating "this inventor is also an applicant".

Form PTO/SB/01, the declaration for use if there is no ADS, will need to be eliminated, since there will always be an ADS.

Form PTO/SB/02, the continuation sheet for use with Form PTO/SB/01, will need to be eliminated, since it is used only with Form PTO/SB/01, which will be eliminated.

Form PTO/SB/02LR, the sheet listing legal representatives for use with Form PTO/SB/01, will need to be eliminated, since it is used only with Form PTO/SB/01, which will be eliminated.

Forms PTO/SB/02CN, PTO/SB/02DE, PTO/SB/02ES, PTO/SB/02FR, PTO/SB/02IT, PTO/SB/02JP, PTO/SB/02KR, PTO/SB/02NL, PTO/SB/02RU, and PTO/SB/02SE will each need to be replaced with a new form corresponding to the attached Proposed Declaration Form.

Form PTO/SB/01A, the declaration for use with an ADS, will need to be revised so that it no longer lists the inventors. Instead, Form PTO/SB/01A can be amended to match the attached proposed form. (The attached proposed form includes nothing more than what Congress specified in Section 4 of the AIA.)

Proposed Declaration Form

DECLARATION FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET

Title of Invention _____

This declaration is directed to:

- The attached application, or
- United States application or PCT international application number
_____ filed on _____ as
amended on _____ (if applicable).

The application was made or was authorized to be made by me.

I believe myself to be the original inventor or an original joint inventor of a claimed invention in the application.

I acknowledge that any willful false statement made in this Declaration is punishable under 18 U.S.C. § 1001, by fine or imprisonment of not more than five years, or both.

Signature

Printed name

Date