

NPRM

Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act

Michele A. Cimbala

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

March 6, 2012

1493416.1

Ds
Data Security

SKGF.COM

Bt
Biotechnology

S
Software

C
Chemistry

Changes to the Inventor's Oath/Declaration



982

Federal Register / Vol. 77, No. 4 / Friday, January 6, 2012 / Proposed Rules

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Parts 1 and 3

[Docket No. PTO-P-2011-0074]

RIN 0651-AC68

Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office) proposes changes to the existing rules of practice to implement the inventor's oath or declaration provisions of the Leahy-

document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT:

application must execute declaration in connection with application.

35 U.S.C. 115(b) provides that an inventor's oath or declaration under 35 U.S.C. 115(b) must contain statements that the application was made or to be made by the affiant and the individual believing himself to be the original inventor or joint inventor in the application. No longer a requirement in the inventor must state citizenship and that the believes himself or herself "first" inventor of the invention (process, machine, manufacture, or composition of matter) patented.

35 U.S.C. 115(c) provides that the Director may specify a

Effective Date

**AIA Section 4:
September 16, 2012**

**12 months after the Date of
Enactment**

NPRM Comments Due: March 6, 2012

Miscellaneous: Mail Stop for PTE's

37 C.F.R. §1.1(e) Patent term extension.

Changed/updated the mail stop

From: Mail Stop Patent Ext

To: Mail Stop Hatch-Waxman PTE

PTO comment: When appropriate, the communication should also be marked to the attention of a particular individual, such as where a decision has been rendered.

Rem: The initial PTE request must be filed in paper.

In comment section PTO says that in general, even EFS-web filings should include the appropriate mail stop.

Miscellaneous: Credit card payments in patent cases

NPRM 37 C.F.R. §1.4(e)

Correspondence requiring a person's signature and relating to

“payment by credit card in patent cases . . . ”

must be submitted with:

an original handwritten signature

personally signed in permanent dark ink or its equivalent by that person.

*The comment states that the rule is being amended to “require” that payment by credit card in patent cases **MAY ONLY** be submitted with an original handwritten signature.*

No more EFS-web credit card payments for prosecution fees??

What about patent assignment recordation fees?

Maintenance fees?

Changes to Representation and Correspondence Rules

37 CFR §1.31 Representation

Current

An applicant for patent may file and prosecute his or her own case, or he or she may give a power of attorney to be represented by one or more patent practitioners or joint inventors.

Juristic entity = corporation or other non-human entity created by law and given certain legal rights.

NPRM

(a)

An applicant for patent may file and prosecute his or her own case, or he or she may give a power of attorney to be represented by one or more patent practitioners or joint inventors,

except that a juristic entity must be represented by a patent practitioner. Prosecution by a juristic entity is governed by §3.71(a), and the taking of action by any assignee is governed by §3.73.

37 CFR §1.31 Representation

Current

The United States Patent and Trademark Office cannot aid in the selection of a patent practitioner.

NPRM

(b)

The United States Patent and Trademark Office cannot aid in the selection of a patent practitioner.

37 CFR §1.32 Power of Attorney

New 1.32(d) allows use of a previously filed POA in a CIP

Q: what about POAs from provisional appln's?

Q: what about POAs from assignees?

Current 1.63(d)(4) would be deleted – it had required ID'ing any change in POA if a Con or Div was filed

NPRM – new section

(d) A power of attorney 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 if a copy of the power of attorney from the prior application is filed in the continuing application.

37 CFR §1.32 Power of Attorney

PTO comments:

- 1. The new rule requires actually filing a copy of the POA because currently applicants “identify” a change in power of attorney in a con or div in different ways – causing confusion.**
- 2. USPTO recommends against using the combined declaration and POA.**
- 3. If an assignee exists, then the POA should be from the assignee, thus avoiding the question as to who is the client – the inventor who gave the POA or the assignee who is paying the bills.**
- 4. If POA is from inventor instead of assignee, the inventor can revoke POA and attempt to control prosecution.**

37 CFR §1.32 Power of Attorney

A POA from inventors must be from all inventors – so addition of a new inventor revokes the POA (doesn't apply if POA is from assignee of entire interest)

Practice tip: send POA from new inventor along with the petition to change inventorship.

If attorney can't get POA from new inventor then must petition - MPEP 402.10.

NPRM – new section

(e) If a power of attorney has been granted by all of the inventors and not an assignee,

the addition of an inventor pursuant to §1.48 results in the loss of that power of attorney upon grant of the §1.48 request,

unless the added inventor provides a power of attorney consistent with the power of attorney provided by the other inventors.

This provision does not preclude a practitioner from acting pursuant to §1.34, if applicable.

37 CFR §1.33 Correspondence Address

Current 1.33(a)

...

If more than one correspondence address is specified in a single

document,

the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address.

...

NPRM 1.33(a)

...

If more than one correspondence address is specified in a single

paper or in multiple papers submitted on one day,

the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the address associated with a Customer Number over a typed correspondence address.

...

37 CFR §1.33 Correspondence Address

Current 1.33(b)(3)

Amendments . . . must be signed
by

. . .

(3) An assignee as provided for
under §3.71 of this chapter;
or

*PTO comments: “Thus, all papers
submitted on behalf of a juristic
entity must be signed by a patent
practitioner. (page 987, column 1)*

NPRM

*(would delete 1.33(b)(3) in favor of
new 1.33(f))*

**(f) An assignee may only conduct
prosecution of an application in
accordance with §§1.31 and 3.71 of
this chapter. Unless otherwise
specified, all papers submitted on
behalf of a juristic entity must be
signed by a patent practitioner.**

37 CFR §1.33 Correspondence Address

PTO comments: “Thus, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner. (page 987, column 1, second full paragraph; emphasis added)

This is more restrictive than the proposed rule.

Question: Does the PTO intend to include terminal disclaimers and Rule 3.73(b) Certifications – which are also papers submitted on behalf of a juristic entity?

37 CFR §1.33 Correspondence Address

***This replaces
Rule 63(d)(4)***

*Note the use of
the word “must.”*

***Practice tip:
docket this with
all transfer-in
cases***

NPRM – new 1.33(g)

(g) Where application papers from a prior application are used in a continuing application

and the correspondence address was changed during the prosecution of the prior application,

an application data sheet or separate paper identifying the updated correspondence address to be used for the continuing application must be submitted.

Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

37 CFR §1.33 Correspondence Address

i.e., no POA on file

*Cannot use this rule to change
correspondence address while
application is pending*

*Previously the practitioner
acting in a representative
capacity had no way to change
correspondence address or to
withdraw since he/she wasn't
of record.*

NPRM – new 1.33(h)

**(h) A patent practitioner acting in a
representative capacity**

**whose correspondence address is the
correspondence address of record in an
application**

**may change the correspondence address
after the patent has issued,**

**provided that the change of correspondence
address is accompanied by a statement that
notice has been given to the patentee or
owner.**

37 CFR §1.41 Applicant for Patent

Current 1.41(c)

Any person authorized by the applicant may physically or electronically deliver an application for patent

to the Office on behalf of the inventor or inventors

but an oath or declaration (§1.63) can only be made in accordance with §1.64

This rule is intended to distinguish between “delivery” of documents and “signing” of correspondence.

NPRM 1.41(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 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).

Correcting Inventorship in PCT and Domestic Applications

37 CFR §1.41 Applicant for Patent

Current 1.41(a)(4)

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in

the international application, which includes any change effected under PCT rule 92bis. . . .

(1.63(d) = copies of decs in continuing applications)

NPRM 1.41(a)(4)

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in

the 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). . . .

37 CFR §1.41 Applicant for Patent

Example:

National stage is entered but the application is abandoned in favor of a continuing application prior to filing the inventors' declaration.

NPRM 1.41(a)(4)

. . . If 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 92bis.

37 CFR 1.48 Correction of Inventorship

**Current
(none)**

Paragraph (a) is used to change inventorship in nonprov after decl is filed.

Q: Do they mean paragraph (f)(1)?

(f)(1) = nonprov with no dec; filing dec corrects inventorship

NPRM

(k) National stage application under 35 U.S.C. 371.

The procedure set forth in paragraph (a) of this section for correcting an error in inventorship is also applicable to international applications entering the national stage under 35 U.S.C. 371 prior to becoming nonprovisional applications (§1.9(a)(3)), and to correct an error in the inventive entity set forth in an executed declaration submitted under PCT Rule 4.17(iv).

37 CFR 1.48 Correction of Inventorship

**Current
(none)**

**(a) . . . and such error arose
without any deceptive
intention . . .**

**(a)(3) an oath or declaration . .
. as permitted by . . . 1.43**

NPRM comments

(page 989 last column, first full paragraph)

Section 1.48 is also proposed to be amended to eliminate the “without deceptive intention” requirement (as this requirement has been eliminated from 35 U.S.C. 116), and delete the reference to §1.43 (as §1.42 is proposed to be amended to include the subject matter of 1.43).

[The rules section is missing these amendments to the rule.]

Is this missing? Error in the NPRM?

Changes to the Manner of Making Claims for Foreign Priority and Domestic Benefit

37 CFR §1.55: Foreign Priority Claims

Important Change to Current Practice:

All claims to foreign priority would have to be made on an Application Data Sheet (or supplemental ADS).

- NOT on declaration
 - NOT in the application
 - NOT anywhere else in the filing

37 CFR §1.78: Domestic Benefit Claims

Important Change to Current Practice:

All claims for benefit of an earlier domestic filing date would have to be made on an Application Data Sheet (or supplemental ADS).

- NOT in the first sentence following the title of the application in the specification
- NOT anywhere else in the filing

Changes to Application Data Sheets

37 CFR §1.76: Application Data Sheets

- All foreign priority claims, and all domestic benefit claims, must be made in an ADS or supplemental ADS
- All ADS' filed after the filing date would be called "Supplemental ADS" even if no ADS has previously been filed in the application
 - *(Note: An ADS filed with national stage entry is not a "supplemental ADS" even though it is filed after the 'legal' filing date of the application, i.e., after the PCT filing date.)*
- All supplemental ADS' MUST be signed

Applicants and Changes to Declaration Practice

STATUTE

35 USC §115 Inventor's Oath or Declaration

§115(a)

Except as otherwise provided. . .

each individual who is the inventor or a joint inventor

. . .

shall execute an oath or declaration in connection
with the application.

STATUTE **35 USC §115 Inventor's Oath or Declaration**

Current §115

such individual believes himself

to be the original *[[and first]]* inventor

**of the process, machine,
manufacture, or composition of
matter, or improvement thereof for
which he solicits a patent;**

***[[and shall state of what country he is
a citizen]].***

New §115(b)(2)

**such individual believes himself or
herself**

**to be the original inventor or an
original joint inventor**

**of a claimed invention in the
application.**

**(c) any additional information required
by the USPTO**

37 CFR §1.41 Applicant for Patent

Current 1.41(a)(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, residence, and citizenship

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.

NPRM 1.41(a)(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.

STATUTE: 35 USC §115(b)

Declaration: Required Statements

2 required statements for the Oath or Declaration:

(b)(1) the application was made or was authorized to be made by the . . . declarant;

(b)(2) such individual believes himself or herself to be original inventor or an original joint inventor of a claimed invention. . .

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63 - organization

Current

**(a) signed/name inventor/
citizenship/assert inventorship**

**(b) ID application/reviewed and
understood contents/duty of
disclosure**

NPRM

**(a) signed/name
inventor/IDapplication/assert
inventorship**

***appln made or authorized to be
made by inventors***

**reviewed and understood
contents/duty of disclosure**

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63 - organization

Current

**(c) Mailing address/foreign
priority claim**

**(d) Reuse oath/declaration in
continuation/divisional**

NPRM

(b) Mailing address

**(c) Assignment contains
oath/declaration**

**(d) Reuse oath/declaration in
continuation/divisional or CIP**

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(a) preamble

Current

An oath or declaration filed under §1.51(b)(2)

as a part of a nonprovisional application

must:

NPRM

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

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(a)(1)

Current *[the oath must]*

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;

NPRM *[the oath must]*

Be executed, i.e., signed, in accordance with either §1.66 or §1.68;

[2nd sentence deleted as being unnecessary in view of Rule 63(a)(6) requirement that person signing states he/she has reviewed and understands the contents of the application.]

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(a)(2)

Current ***[the oath must]***

**Identify each inventor by full name,
including the family name,
and at least one given name**

**without abbreviation together with
any other given name or initial;**

NPRM ***[the oath must]***

**Identify each inventor by his or her
full name**

**without any abbreviation (except
for a middle initial);**

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(a)(3)

Current
[the oath must]

**Identify the country of citizenship
of each inventor;**

NPRM
[the oath must]

**Identify the application to which it
is directed;**

[Current: 1.63(b)(1)]
***[rem: Identification of citizenship
is no longer required.]***

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(a)(4)

Current
[the oath must]

State that

the person making the oath or declaration believes the named inventor or inventors to be

the original and first inventor or inventors

of the subject matter which is claimed and for which a patent is sought.

NPRM
[the oath must]

Include a statement that

the person executing the oath or declaration believes the named inventor or joint inventors to be

the original inventor or original joint inventors

of the claimed invention in the application for which the oath or declaration is being submitted;

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(a)(5) – new subsection

Current

(none)

NPRM

[the oath must]

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

[This statement is required under 35 U.S.C. §115(b)(1).]

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(a)(6) – new subsection

Current

[37 C.F.R. §1.63(b)(2)]

Amended *[the oath must]*

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;

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(a)(7) – new subsection

Current

[37 C.F.R. §1.63(b)(3)]

NPRM

[the oath must]

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.

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(b)

Current

In addition, . . . the oath or declaration must . . .

- (1) Identify the application
- (2) State the person making the oath has reviewed and understands . . .
- (3) State the person making the oath acknowledges the duty to disclose information . . .

NPRM

[now 37 CFR §1.63(a)(3)]

[now 37 CFR §1.63(a)(6)]

[now 37 CFR §1.63(a)(7)]

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(b)

Current

[currently 37 CFR §1.63(c)(1)]

NPRM

Unless such information is supplied on an ADS in accordance with §1.76, 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, . . .

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(c)(2)

Current
[the oath must identify]

Any foreign application for patent . . . for which a claim for priority is made pursuant to §1.55,

and any foreign applications having a filing date before that of the application on which priority is claimed,

by specifying the application number, country, day, month, and year of its filing.

NPRM

[The requirement to identify the foreign priority in the oath/declaration would be deleted in favor of a requirement that it be identified only in an application data sheet (ADS) – per revised 37 C.F.R. §1.55]

35 USC §115(e) Inventor's Declaration §115(b)+(c) Statements Can be Made in Assignments

In some instances, an assignment of record might replace the inventor's declaration:

35 U.S.C. §115(e): An individual who is under an obligation of assignment of an application may include the required statements under subsection (b) and (c) in the inventor's assignment, in lieu of filing such statements separately.

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(c)(1)

Amended

An assignment may also include the oath or declaration . . . 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.**

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §3.31

Amended

Would require that an assignment submitted for a dual purpose (i.e., assignment of rights and also as the inventor's declaration) be clearly identified as such,

Example: use of a check-box on the assignment cover sheet, to alert the Office

[The assignment may be sent for recording at the same time it is being submitted in the application, provided applicant makes a statement to that effect.]

Inventors' Declaration Made in Assignment

Possible complication:

Some assignment forms may not list the names of all the other inventors in the body of the form.

Assignment must be sure to list ALL inventors within the body of the assignment document part that is intended to be the declaration section.

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(d)(1)

Current

A newly executed oath or declaration is not required . . .

in a continuation or divisional application,

provided that:

NPRM

A newly executed inventor oath or declaration . . . Is not required . . .

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:

*[practice note: CIP *may* not need a new declaration.]*

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(d)(1)

Current

provided that:

- **Copy was filed in earlier appln**
- **Con/div has same or fewer inventors**
- **Con/div has no new matter**
- **Copy is submitted in the con/div**

NPRM

provided that:

- **Copy was filed in earlier appln**
- ***n/a***
- ***n/a***
- **Copy is submitted in the con/div**
- **Any new inventors also provide an oath/declaration**

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(d)(1)

Caution regarding using prior declaration in a continuation-in-part (CIP) application:

To reuse the prior oath/declaration it must still be true that:

- (a) The person making the oath/declaration has reviewed and understands the contents of the CIP application; and***
- (b) The person executing the oath/declaration believes the named inventor(s) to be the original inventor/joint inventors; and***
- (c) The person making the oath/declaration acknowledges the duty to disclose all information known to the person to be material to patentability as defined in §1.56.***

37 CFR §1.63 Inventor's Oath or Declaration

Grandfathering Question: Are oaths or declarations filed for continuing applications filed on/after September 16, 2012 grandfathered under the old declaration rules?

That is, may applicants continue to use an oath/declaration for continuation and divisional applications? Can a declaration first filed prior to September 16, 2012, be filed for a CIP application filed on/after September 16, 2012?

Question: If an application is filed prior to September 16, 2012, but the oath/declaration is filed on/after September 16, 2012, should the oath/declaration be prepared under the new rules or the old rules?

35 USC §115(h) Inventor's Declaration Supplemental and Corrected Statements

- Any person making a statement required under 35 U.S.C. §115 may withdraw, replace, or otherwise correct it at any time.
- USPTO cannot require a supplemental declaration or statement once one has been made.
- A patent shall not be invalid or unenforceable based upon failure to comply with one of these requirements if the failure is remedied as provided by the USPTO.

37 CFR §1.63 Inventor's Oath or Declaration

37 CFR §1.63(e)

Current

A newly executed oath or declaration must be filed in any continuation-in-part application,

. . . .

NPRM

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.

37 CFR §1.64: Person Making the Oath or Declaration

- Requirement to state citizenship is removed
- 1.64(b) is amended to refer to both “deceased inventor” and “legally incapacitated inventor”
- Requires a legal representative of both a deceased inventor and of a legally incapacitated inventor to state that person is a legal representative.
- Requires residence and mailing address of the legal representative here or in ADS

37 CFR §1.67: Noncompliant Oath or Declaration

- Replace “supplemental declaration” with “declaration in compliance”

Filing by Other than the Inventor

STATUTE: 35 USC §118

Filing by Other than Inventor

The following may make an application for patent:

- (1) Assignee; or
- (2) Person to whom inventor is under obligation to assign; or
- (3) Person with “sufficient proprietary interest” (but only on behalf or and as agent for the inventor)

The patent grants to the real party in interest.

NPRM

37 CFR §1.42 (deceased/legally incapacitated)

37 CFR §1.47 (refuses to sign or can't be reached)

35 USC §115(d)(1) and (2)

Inventor's Declaration – Substitute Statements

“Applicants for patent” can file a “Substitute Statement” if an inventor:

- is deceased
- under legal incapacity
- cannot be found or reached after diligent effort

or

- is under an obligation to assign the invention but has refused to make the required declaration

Statutory Requirements for the Contents of a Substitute Statement

- (A) Identify the individual to whom the statement applies
- (B) Set out the circumstances that form the permitted basis for the statement
- (C) Other information as may be required by USPTO

37 CFR 1.42 Deceased/Legally Incapacitated Inventor Substitute Statement Contents

Additional PTO Requirements

Petition with showing:

1. proof of obligation to assign; or
2. proof (similar to the current practice) of sufficient proprietary interest to execute the oath and that such action is necessary to preserve the rights of the parties.

(“or to prevent irreparable damage” was removed)

Important

1. Legal representatives do not need a petition.
2. Assignees do not need a petition.

37 CFR 1.47 Inventor Refuses to Sign or Can't be Found - Substitute Statement Contents

Current

**(1) assignee, or
(2) a party to whom the inventor
has agreed in writing to assign, or
(3) a party who otherwise shows
sufficient proprietary interest**

**can only sign for a nonsigning
inventor:**

**when there are no inventors
available to sign the
oath/declaration**

NPRM

**Any of (1), (2) or (3) may execute
the oath/declaration on behalf of
the nonsigning inventor**

**Or on behalf of a legal
representative of a deceased or
incapacitated joint inventor who
refuses to execute the
oath/declaration or who can't be
found**

**- even if other inventors are
signing**

37 CFR 1.47 Inventor Refuses to Sign or Can't Be Found - Substitute Statement Contents

(C) Other information required by the PTO

Petition with showing:

1. proof of obligation to assign; or
2. proof (similar to the current practice) of sufficient proprietary interest to execute the oath and that such action is necessary to preserve the rights of the parties.

 (“or to prevent irreparable damage” was removed)

35 USC §115(i) Acknowledgment of Penalties (and 37 C.F.R. § 1.68)

A declaration or substitute statement must contain an acknowledgment that:

“any willful false statement made in such declaration or statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.”

Practice tip: Be sure to add this language to assignments to rely on an assignment of record for the “required statements”

35 USC §115(f) Timing: Inventor's Declaration - Substitute Statement, or Recorded Assignment

Prior to mailing of the notice of allowance

The applicant for patent must:

Submit the declaration; or

Submit the substitute statement; or

Record assignment with the required statements.

Statute allows for late submission but PTO policy will be to require names of inventors before prosecution because this may affect the art rejections.

Reissue applications

37 CFR §1.172 Reissue applicants

Current

§1.172 Applicants, ~~assignees~~

- (a) A reissue applicant must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided see §§1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, . . .**

NPRM

§1.172 Applicants

- (a) A reissue applicant must submit an oath or declaration accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent.**

37 CFR §1.172 Reissue applicants

Current

NPRM

(b) Oath or declaration:

(1) Nonbroadening reissues:

If the application does not seek to enlarge the scope of the claims of the original patent, the oath or declaration must be signed by:

(i) The inventor or inventors, including the legal representatives of deceased or legally incapacitated inventors or a §1.47 applicant for a nonsigning inventor; . . .

37 CFR §1.172 Reissue applicants

Current (a) Cont

. . . but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent . . .

NPRM

(b) Oath or declaration:

(non broadening cont)

. . .

(ii) An assignee of the entire interest; or

(iii) All partial assignees together with all inventors who have not assigned their rights, including the legal representatives of deceased or legally incapacitated inventors or a §1.47 applicant for a nonsigning inventor.

37 CFR §1.172 Reissue applicants

Current

NPRM

(b) Oath or declaration:

(2) Broadening reissues: If the applicant seeks to enlarge the scope of the claims of the original patent, the oath or declaration must be signed by:

- (i) The inventor or inventors, including the legal representatives of deceased or legally incapacitated inventors or a §1.47 applicant for a nonsigning inventor; or**
- (ii) For a reissue application filed on or after September 16, 2012, the assignee of the entire interest where the application for the original patent was filed by the assignee of the entire interest (i.e., the oath or declaration was executed by the assignee under §1.42 or §1.47).**

37 CFR §1.172 Reissue applicants

Current (a) Cont

...

All assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of §3.73(b) of this chapter.

NPRM

(c) Assignee ownership:

All assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of §3.73(b).

37 CFR §1.172 Reissue applicants

Current

(b)

A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

NPRM

(d)

A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

37 CFR §1.175 Reissue oath or declaration

Current

(a) The reissue oath or declaration, in addition to complying with the requirements of §1.63, must also state that:

NPRM

(a) The reissue oath or declaration, in addition to complying with the requirements of §1.63, must also

specifically identify at least one error pursuant to 35 U.S.C. 251 being relied upon as the basis for reissue

37 CFR §1.175 Reissue oath or declaration

Current

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of

NPRM

(a)

. . . and state that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of

each one of the following reasons that are applicable:

37 CFR §1.175 Reissue oath or declaration

Current

(1)

... a defective specification or drawing,

or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

NPRM

(a) . . .

(1) A defective specification or drawing;

(2) The patentee claiming more than the patentee had the right to claim in the patent; or

(3) The patentee claiming less than the patentee had the right to claim in the patent and identify a broadened claim and a broadened portion of the specification if a change thereto is the basis for the claim broadening;

37 CFR §1.175 Reissue oath or declaration

Current

[(b)supplemental oaths - deleted]

NPRM

(b) A claim broadened in any respect must be treated and identified as a broadened claim pursuant to paragraph (a)(3) of this section.

37 CFR §1.175 Reissue oath or declaration

Current

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

NPRM

(c) Where all errors previously identified in the reissue oath or declaration pursuant to paragraph (a) of this section are no longer being relied upon as the basis for reissue, a new error currently being relied upon as the basis for reissue must be identified in a reissue oath or declaration under this section, which statement need only address the new error.

37 CFR §1.175 Reissue oath or declaration

Current

(e) The filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration

which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. . . .

NPRM

(e) Continuing reissue applications:

(1) Where a continuing reissue application replaces a prior reissue application, the requirement for a reissue oath or declaration pursuant to §1.172 may be satisfied by a copy of the reissue oath or declaration from the prior reissue application it replaces.

37 CFR §1.175 Reissue oath or declaration

NPRM

(2) Where a continuing reissue application does not replace a prior reissue application, the requirement for a reissue oath or declaration pursuant to §1.172 may be satisfied by:

- (i) A newly executed reissue oath or declaration that identifies at least one error in the original patent which has not been corrected by a prior reissue application; or**
- (ii) A copy of the reissue oath or declaration from a prior reissue application within the chain of the benefit claim, accompanied by a statement that explains either that an identified error was not corrected in a prior reissue application, or how an identified error is currently being corrected in a manner different than in a prior reissue application.**

37 CFR §1.175 Reissue oath or declaration

NPRM Comments:

Example 1

Reissue oath lists more than one error.

The declaration can be used to file a continuing reissue application even if the applicant is no longer attempting to correct some of the originally listed errors, provided that at least one of the originally filed errors remains.

A copy of the reissue oath may be used.

(See NPRM comments for an additional more complicated example.)

37 CFR §1.175 Reissue oath or declaration

NPRM

(f) A reissue 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 reissue application, but may not be reviewed by the Office.

37 CFR §1.311 Notice of Allowance

NPRM (new)

(c) Where an assignee, person to whom the inventor is under an obligation to assign the invention,

or person who otherwise shows sufficient proprietary interest in the matter

has filed an application under §§1.42, or 1.47, the applicant must notify the Office of any change in ownership of the application no later than payment of the issue fee.

The Office will treat the absence of such a notice as an indication that there has been no change in ownership of the application.

Changes to Part 3: Assignment, Recording, and Rights of Assignee

37 CFR §3.31 Assignment Cover Sheet

NPRM (new paragraph)

(h) 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.

37 CFR §3.71 Prosecution by Assignee

Current

(a) Patents--conducting of prosecution.

One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application . . .

NPRM

(a) Patents--conducting of prosecution on behalf of assignee.

Subject to the requirements of §§1.31 and 1.33(f),

one or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application . . .

37 CFR §3.71 Prosecution by Assignee

Current 3.71(a) cont

. . . or a reexamination proceeding to the exclusion of either the inventive entity or the assignee(s) previously entitled to conduct prosecution.

NPRM 3.71(a) cont

. . . or a reexamination proceeding to the exclusion of either the inventive entity or the assignee(s) previously entitled to conduct prosecution.

Conflicts between purported assignees are handled in accordance with §3.73(c)(4).

37 CFR §3.73 Establishing right of assignee to take action

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

Current

(b) * * * (2) * * *

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee; or

NPRM

(b) * * * (2) * * *

(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.

37 CFR §3.73 Establishing right of assignee to take action

NPRM comments:

Currently, having a POA does not make the practitioner an “official” of the assignee or empower the practitioner to sign the submission on behalf of the assignee. MPEP §324

Patent practitioners who sign §3.73(b) statements merely on the basis of having been appointed in a POA have done so improperly.

The proposed rule would permit a practitioner who has a POA to sign §3.73(b) statements.

37 CFR §3.73 Establishing right of assignee to take action

NPRM 3.73(b)(3) - new

(3) In any one application or proceeding, a subsequent statement must provide a complete chain of title.

37 CFR §3.73 Establishing right of assignee to take action

Current 3.73(c)(2)

If the submission under this section is by an assignee of less than the entire right, title, and interest,

such assignee must indicate the extent (by percentage) of its ownership interest,

or the Office may refuse to accept the submission as an establishment of ownership.

NPRM 3.73(c)(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; . . .

37 CFR §3.73 Establishing right of assignee to take action

NPRM 3.73(c)(2)

. . . 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.

37 CFR §3.73 Establishing right of assignee to take action

NPRM Comments:

Distinguish between:

100 % ownership of the right, title, and interest in the invention from a single inventor; and

100 % ownership of the entire right, title, and interest in the invention from all the inventors.

37 CFR §3.73 Establishing right of assignee to take action

NPRM Comments:

Example 1:

Assignee A owns 100% interest from inventor X.

Assignee B owns 100% interest from inventor Y.

To comply with a requirement to identify the “entire right, title and interest”:

BOTH assignees need to set forth their ownership interest by percentage (i.e., 100% of the entire right, title, and interest)

3.73(c)(2)(i)

Or both assignees need to provide a statement that all parties owning an interest (without identification of percentage) have been identified) 3.73(c)(2)(ii)

37 CFR §3.73 Establishing right of assignee to take action

NPRM Comments:

Example 2:

Sole Inventor A assigns to company A and B but the assignment does not identify the percentages of ownership.

The 3.73(b) statement needs to identify that companies A and B together own 100 percent of the entire right, title, and interest without specific individual percentages for company A and company B.

37 CFR §3.73 Establishing right of assignee to take action

NPRM (new 3.73(c)(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.

37 CFR §3.73 Establishing right of assignee to take action

NPRM (new 3.73(c)(4))

(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.



Thank you!

Michele A. Cimbala, Esq.
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue
Washington, DC 20005

phone (202) 371-2600
fax (202) 371-2540

mcimbala@SKGF.com