

REVIEW OF “Changes To Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act” 77 FR 48776 (8/14/2012)

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SUMMARY

➤ BACKGROUND

➤ SCOPE OF RULES CHANGES

➤ REVIEW OF MOST RELEVANT
STATUTORY AND REGULATORY
CHANGES

BACKGROUND

- THE LEAHY-SMITH AMERICA INVENTS ACT (“AIA”) ENACTED 9/16/2011
- AIA AUTHORIZES AN ASSIGNEE TO BE AN APPLICANT AND CHANGES INVENTOR OATH AND DECLARATION REQUIREMENTS
- USPTO AMENDED AIA RELATED RULES OF PRACTICE TO EFFECT AIA CHANGES.
- USPTO ALSO AMENDED RULES OF PRACTICE TO EFFECT ADDITIONAL USPTO GOALS

SCOPE OF “Changes To Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act,” 77 FR 48776 (8/14/2012)

EFFECTIVE DATE: 9/16/2012

Applicability Date: *“The changes to ... [certain rules], apply only to patent applications **filed under** 35 U.S.C. 111(a) or 363 on or after September 16, 2012.”*

APPLICABILITY DATE IS CONDITIONAL

APPLICABILITY DATE: “*The changes to ... [certain rules], apply only to patent applications **filed under** 35 U.S.C. 111(a) or 363 on or after September 16, 2012.*”

CONDITION IS THAT THE CHANGES TO THE CERTAIN RULES APPLY: “*only to patent applications **filed under** 35 U.S.C. 111(a) or 363*”

RULES SPECIFIED IN THE APPLICABILITY DATE PROVISION

“37 CFR 1.9, 1.12, 1.14, 1.17(g), 1.27, 1.32, 1.33, 1.36, 1.41, 1.42, 1.43, 1.45, 1.46, 1.53(f) and (h), 1.55, 1.56, 1.63, 1.64, 1.66, 1.67, 1.76, 1.78, 1.81, 1.105, 1.131, 1.153, 1.162, 1.172, 1.175, 1.211, 1.215, 1.321, 1.421, 1.422, 1.424, 1.431, 1.491, 1.495(a), (c), and (h), 1.497, 3.31, 3.71, 3.73, and 41.9, and the removal of 37 CFR 1.47 and 1.432”

CONDITIONS UNDER WHICH CHANGES TO THESE RULES APPLY ARE UNCLEAR. USPTO SHOULD CLARIFY.

DEROGATE INVENTORSHIP RELATIVE TO IP OWNER

RULES PACKAGE STATES:

“Section 4 of the AIA amends the patent laws to change the practice regarding the inventor’s oath or declaration and filing of an application by a person other than the inventor. *** The Office is revising the rules of practice to permit a person to whom the inventor has assigned or is under an obligation to assign an invention to file and prosecute an application for patent as the applicant, and to permit a person who otherwise shows sufficient proprietary interest in the matter to file and prosecute an application for patent as the applicant on behalf of the inventor.”

SECTION 4 OF THE AIA INCLUDES AMENDED 35 USC 118

35 USC 118 AND NON INVENTOR APPLICANT

AIA AMENDS 35 USC 118 TO READ:

“118. Filing by other than inventor

“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. If the Director grants a patent on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient.

RULE 1.46(a) AND NON INVENTOR APPLICANT

NEW RULE 1.46(a):

“§ 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.”

“(a) 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.”**

RULE 1.46(a) AND CONSEQUENCES FOR IP OWNER

NEW RULE 1.46(a) AND 35 USC 118
ENABLE THE IP OWNER TO BE THE
APPLICANT.

THE APPLICANT CAN PROSECUTE AND
GRANT POWERS OF ATTORNEY.

NEW RULE 1.46(b) AND NON INVENTOR APPLICANT

NEW RULE 1.46(b):

“(b) If an application under 35 U.S.C. 111 is made by a person other than the inventor under paragraph (a) of this section, the application ***must contain an application data sheet under § 1.76 specifying in the applicant information section (§ 1.76(b)(7)) the 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. If the application is the national stage of an international application, the person who is identified in the international stage as an applicant for the United States is the person specified as the original applicant for the national stage.***”

RULE 1.46(b) AND CONSEQUENCES FOR IP OWNER

1.46(b) REQUIRES AN APPLICANT TO FILE AN ADS IN ORDER TO APPLY FOR A PATENT IN THE NAME OF THE OWNER INSTEAD OF THE INVENTOR.

1.46(b) REQUIRES A PCT APPLICANT TO NAME THE OWNER IN THE PCT REQUEST IN ORDER TO HAVE THE OWNER BE THE APPLICANT IN THE US NATIONAL STAGE OF THE PCT APPLICATION.

RULE 1.46(b) AND CONSEQUENCES FOR IP OWNER

PCT APPLICATIONS FILED ON AND AFTER 9/16/2012
HAVE THE OPTION OF NAMING THE IP OWNER AS
THE ONLY APPLICANT.

BENEFIT – SIMPLER US NATIONAL STAGE
PROSECUTION

DRAWBACKS – PCT RESIDENCE AND NATIONALITY
DETERMINE COMPETENT RO. LIMITING APPLICANT
TO IP OWNER MAY LIMIT CHOICE OF RO. PCT RULE
19.

RO SELECTION DETERMINES WHICH OFFICES CAN
BE THE ISA.

RULE 1.46(b) AND CONSEQUENCES FOR IP OWNER

PTO ADVICE:

“While identifying the party making the application for patent (the applicant) in an application data sheet is not a filing date requirement, a delay in naming the applicant under § 1.46 in an application data sheet may cause it to appear that the applicant is the inventor and thus requiring the party to proceed under §§ 3.71 and 3.73 to become the applicant.” AND “An unsigned application data sheet will be treated only as a transmittal letter.”

CONSEQUENCE: FILING AN APPLICATION NAMING INVENTORS WITHOUT A PROPER ADS MAY RESULT IN THE PTO RECOGNIZING THE INVENTOR TO BE THE APPLICANT.

NEW RULE 1.46(c) AND NON INVENTOR APPLICANT

NEW RULE 1.46(c):

“(c) Any request to correct or update the name of the applicant after an applicant has been specified under paragraph (b) of this section must include an application data sheet under § 1.76 specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)). Any request to change the applicant after an original applicant has been specified under paragraph (b) of this section must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) and comply with §§ 3.71 and 3.73 of this title.”

RULE 1.46(c) AND CONSEQUENCES FOR IP OWNER

NEW RULE 1.46(c) REFERS TO RULES 3.71 AND 3.73:

3.71 AUTHORIZES THE RULE 1.46 ASSIGNEE (IP OWNER)
APPLICANT TO PROSECUTE.

3.73 REQUIRES AN ASSIGNEE (IP OWNER) THAT IS NOT THE
APPLICANT TO “establish its ownership of the patent property ... to
the satisfaction of the Director” BEFORE THE PTO WILL RECOGNIZE
THE ASSIGNEE’S RIGHT TO PROSECUTE

PTO COMMENTS “Thus, if there is a change of applicant under §
1.46(b) (either from the inventor to the assignee, or from one assignee
to another assignee), the new applicant must establish its ownership of
the application under §§ 3.71(b) and 3.73.”

NEW RULE 1.46(d) AND NON INVENTOR APPLICANT

NEW RULE 1.46(d):

“(d) Even if the whole or a part interest in the invention or in the patent to be issued is assigned or obligated to be assigned, an oath or declaration must be executed by the actual inventor or each actual joint inventor, except as provided for in § 1.64. *See § 1.64 concerning the execution of a substitute statement by an assignee, person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter.*”

RULE 1.46(c) AND CONSEQUENCES FOR IP OWNER

NEW RULE 1.46(d) REFERS TO RULE 1.64 **“Substitute statement in lieu of an oath or declaration”**.

RULE 1.64(a) ALLOWS AN APPLICANT TO “execute a substitute statement in lieu of an oath or declaration ... if the inventor is deceased, is under a legal incapacity, has refused to execute the oath or declaration ... or cannot be found or reached after diligent effort.”

NOTE: PTO STILL REQUIRES EITHER INVENTOR OATH OR DECLARATION OR A SUBSTITUTE STATEMENT, FOR OR ON BEHALF OF EACH INVENTOR.

REMOVAL OF LACK OF DECEPTIVE INTENT

AIA REMOVAL OF “WITHOUT ANY DECEPTIVE INTENT” FROM 35 USC 116 AND 35 USC 251 INVENTOR DECLARATIONS

AS AMENDED, 35 USC 116, LAST PARAGRAPH READS:

“(c) CORRECTION OF ERRORS IN APPLICATION.— Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, ~~and such error arose without any deceptive intention on his part,~~ the Director may permit the application to be amended accordingly, under such terms as he prescribes.

REMOVAL OF LACK OF DECEPTIVE INTENT

PTO COMMENTS:

“Section 20 of the AIA amends 35 U.S.C. 116, 184, 251, and 256 to eliminate “without any deceptive intention” clauses from each portion of the statute. 125 Stat. at 333–34. Section 20 of the AIA provides that its amendments shall take effect on, and shall apply to proceedings commenced on or after September 16, 2012. 125 Stat. at 335. ***This change should not be taken as an endorsement for applicants and inventors to act with “deceptive intention” in proceedings before the Office.*** As discussed previously, 35 U.S.C. 115(i) requires that any declaration or statement filed pursuant to 35 U.S.C. 115 must contain an acknowledgement that any willful false statement made in the declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.”

35 USC 115(a)-(d) AND INVENTOR DECLARATION

35 USC 115(a) REQUIRES AN APPLICATION TO NAME THE INVENTORS

35 USC 115(b) REQUIRES THE DECLARATION TO CONTAIN CERTAIN STATEMENTS AND 35 USC 115(c) AUTHORIZES THE DIRECTOR TO IMPOSE ADDITIONAL OATH OR DECLARATOIN INFORMATION REQUIREMENTS

35 USC 115(d) AUTHORIZES A SUBSTITUTE STATEMENT IN LIEU OF OATH OR DECLARATION WHEN THE INVENTOR IS DECEASED, INCAPABLE, OR UNAVAILABLE, OR OBLIGATED TO ASSIGN, BUT REFUSES TO EXECUTE THE OATH OR DECLARATION.

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35 USC 115(b)-(c) AND INVENTOR DECLARATION

35 USC 115(b) AND (c) READ:

“(b) REQUIRED STATEMENTS.—An oath or declaration under subsection (a) shall contain statements that—

(1) the application was made or was authorized to be made by the affiant or declarant; and

(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) ADDITIONAL REQUIREMENTS.—The Director may specify additional information relating to the inventor and the invention that is required to be included in an oath or declaration under subsection (a).”

RULE 1.63 REQUIREMENTS FOR INVENTOR DECLARATION

“§ 1.63 Inventor’s oath or declaration.

(a) The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration directed to the application, except as provided for in § 1.64.”

RULE 1.63(a) REQUIRES INVENTOR OATH OR DECLARATION.

RULE 1.63 REQUIREMENTS FOR INVENTOR DECLARATION

RULE 1.63(a)(1)-(4) UNCONDITIONAL REQUIREMENTS

“(1) Identify the inventor or joint inventor executing the oath or declaration by his or her legal name;

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

(3) Include a statement that the person executing the oath or declaration believes the named inventor or joint 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

(4) State that the application was made or was authorized to be made by the person executing the oath or declaration.”

RULE 1.63 REQUIREMENTS FOR INVENTOR DECLARATION

RULE 1.63(b) CONDITIONAL REQUIREMENTS

“(b) Unless the following information is supplied in an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

- (1) Each inventor by his or her legal name; and
- (2) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.”

1.63(b) REQUIREMENTS DEPEND UPON WHETHER AN
ADS IS FILED.

COMMENTS ON RULE 1.63 REQUIREMENTS

NOTE: PRE-EXISTING INVENTOR DECLARATIONS DO NOT “(4) State that the application was made or was authorized to be made by the person executing the oath or declaration.”

PRE-EXISTING DECLARATIONS DO NOT MEET THE NEW RULE 1.63 REQUIREMENTS AS TO STATEMENTS.

CONTINUING APPLICATIONS WILL REQUIRE NEWLY SIGNED INVENTOR DECLARATIONS.

COMMENTS ON RULE 1.63 REQUIREMENTS

THE PCT REQUEST FORM INCLUDES A US INVENTOR DECLARATION FORM.

THE US INVENTOR DECLARATION IN THE PCT REQUEST FORM AS JUST REVISED INCLUDES FIELDS FOR THE RULE 1.63(a) AND (b) REQUIREMENTS.

CLAIMING FOREIGN PRIORITY REQUIRES FILING AN ADS

RULE 1.55 (a)(1)(i) AS AMENDED READS IN RELEVANT PART:

“In an original application filed under 35 U.S.C. 111(a), the claim for foreign priority **must be presented in an application data sheet (§ 1.76(b)(6))** during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing.”

CLAIMING DOMESTIC PRIORITY REQUIRES FILING AN ADS

EXISTING RULE 1.78(a)(2) AND (a)(5) SPECIFY THAT ANY “nonprovisional application or international application ... claiming the benefit of” any prior-filed copending nonprovisional applications, international application, or provisional application, “must contain or be amended to contain a reference to each such prior-filed application”.

CLAIMING DOMESTIC PRIORITY REQUIRES FILING AN ADS

RULE 1.78 IS AMENDED TO INCLUDE
NEW 1.78(a)(2)(III) AND 1.78(a)(5)(III)
BOTH OF WHICH READ:

“If the later filed application is a
nonprovisional application, the reference
required by this paragraph must be included
in an application data sheet (§ 1.76(b)(5)).”

INCOMPETENDPRIORITYCLAIMS

DOMESTICE AND FOREIGN BENEFIT CLAIMS IN THE SPECIFICATION, DECLARATION, OR ANY OTHER MODE, EXCEPT FOR AN ADS, FOR 111(A) AND 363 APPLICATIONS FILED ON AND AFTER 9/16/2012, **WILL NOT BE RECOGNIZED BY THE PTO.**

NOTE: 371 FILINGS FOR PCT APPLICATIONS FILED PRIOR TO 9/16/2012, FALL UNDER OLD RULES

ADS CONCLUSIONS

UNDER NEW RULES, APPLICATIONS THAT DO NOT REQUIRE AN ADS, WILL BE AN EXCEPTION.

AN ADS SHOULD BE FILED IN ALL APPLICATIONS FOR UNIFORMITY OF PROCEDURE.

ADDITIONAL 35 USC 115 PROVISIONS

35 USC 115(e) AUTHORIZES THE 115(b) REQUIRED STATEMENTS TO BE MADE IN AN ASSIGNMENT THAT IS RECORDED IN LIEU OF BEING FILED IN THE APPLICATION.

35 USC 115(f) REQUIRES ALL OATH, DECLARATIONS, AND SUBSTITUTE STATEMENTS BE FILED OR RECORDED BEFORE A NOTICE OF ALLOWANCE CAN BE ISSUED.

35 USC 115 AND INVENTOR DECLARATION

35 USC 115(e) AUTHORIZES THE 115(b) REQUIRED STATEMENTS TO BE MADE IN AN ASSIGNMENT THAT IS RECORDED IN LIEU OF BEING FILED IN THE APPLICATION.

35 USC 115(f) REQUIRES ALL OATH, DECLARATIONS, AND SUBSTITUTE STATEMENTS BE FILED OR RECORDED BEFORE A NOTICE OF ALLOWANCE CAN BE ISSUED.

35 USC 115 AND INVENTOR DECLARATION

35 USC 115(g)(1) REMOVES THE REQUIREMENTS FOR FILING OATH, DECLARATION, OR SUBSITUTE STATEMENT, IN APPLICATIONS CLAIMING PRIORITY TO AN APPLICATION IN WHICH STATEMENTS COMPLYING WITH 35 USC 115(a)-(d) WERE FILED.

35 USC 115(g)(2) AUTHORIZES THE DIRECTOR TO REQUIRE FILING OF COPIES OF 35 USC 115(a)-(d) PAPERS FILED IN THE PARENT APPLICATION.

THE DIRECTOR HAS REQUIRED A COPY OF THE PRIOR FILED PAPERS. SEE RULE 1.63(d)(1).)

35 USC 115 AND INVENTOR DECLARATION

35 USC 115(h) AUTHORIZES A PERSON TO “withdraw, replace, or otherwise correct” ANY PRIOR FILED 35 USC 115 STATEMENT.

35 USC 115(i) REQUIRES ANY DECLARATION OR STATEMENT TO 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.”.

MISCELLANEOUS CHANGES TO 10.23(c)(11) AND 1.52(c)

THE PTO STATES THAT “*Section 10.23: Section 10.23(c)(11) is removed and reserved. Section 1.52(c) no longer prohibits changes to the application papers after execution of the inventor’s oath or declaration. Thus, § 10.23 is amended to eliminate the clause concerning knowingly filing or causing to be filed an application containing any material alteration made in the application papers after the signing of the accompanying oath or declaration without identifying the alteration at the time of filing the application papers (except as permitted by § 1.52(c)) as conduct which constitutes a violation of § 10.23.*”

MISCELLANEOUS CHANGES TO 10.23(c)(11) AND 1.52(c)

THE PTO STATES THAT “Section 1.52(c) is amended to provide that interlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor’s oath or declaration referring to those application papers, provided that the statements in the inventor’s oath or declaration remain applicable to those application papers. Thus, § 1.52(c) no longer prohibits changes after execution of the inventor’s oath or declaration. Section 1.52(c) also provides that a substitute specification (§ 1.125) may be required if the application papers do not comply with paragraphs (a) and (b) of this section.”

MISCELLANEOUS CHANGES TO 10.23(c)(11) AND 1.52(c)

AMENDED 1.52(c) READS:

“(c) Interlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor’s oath or declaration referring to those application papers, provided that the statements in the inventor’s oath or declaration pursuant to § 1.63 remain applicable to those application papers. A substitute specification (§ 1.125) may be required if the application papers do not comply with paragraphs (a) and (b) of this section.”

NOTE: SCOPE OF “OTHER ALTERATION” LIMITED ONLY BY
“statements in the inventor’s oath or declaration ... remain applicable”

THE END THANK YOU!

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