Implementing Inventor's Oath or Declaration
Provisions of the America Invents Act

IP Law Bulletin
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On August 14, 2012, the U.S. Patent and Trademark Office (USPTO) published its final rules for implementing the Inventor’s Oath or Declaration provisions of the America Invents Act (AIA). The final rules take effect on September 16, 2012, with respect to any application filed on or after this date, regardless of any claim for priority. The final rules provide a great deal of detailed explanation and include the new text of the relevant C.F.R. sections, but below is a brief summary of significant changes implemented by the final rules.

Filing by Another: Section 4 of the AIA amends 35 U.S.C. § 118 to allow an assignee (or an entity holding an obligation of an assignment) to file a patent application. The final rules implement this provision by providing that an assignee, party holding an obligation of an assignment, or a party that otherwise shows sufficient proprietary interest in the application can file and prosecute an application as the applicant. Accordingly, the Application Data Sheet (ADS) is being updated to include a section for the applicant. The USPTO notes that it will continue to reference patents by inventor names rather than applicant names, and it requires that the assignee record documentary evidence of ownership by the date the issue fee is paid (in the case of parties “otherwise showing sufficient proprietary interest in an application,” a petition and showing will have to be submitted and granted before the party can be deemed the applicant). In addition, organizations acting as applicants will be required to appoint a registered practitioner and update the USPTO of any change in the real party in interest before payment of the issue fee.

New Oath/Declaration: The requirements for the content of an oath/declaration under 35 U.S.C. § 115 are being streamlined, with a great deal of information being transferred to the Application Data Sheet (ADS). An oath or declaration must be filed by each inventor in an application and must contain two statements: (1) that the application was made by or authorized to be made by the declarant, and (2) that the declarant believes him- or herself to be the original inventor(s) of the claimed invention. In addition, the declarant must acknowledge the penalties for making false statements. Declarants no longer need to state that they have reviewed and understand the application and are aware of their duty of disclosure, but the rules still require that these conditions be met in order for an oath/ declaration to be executed. In addition, an oath/declaration need not include the names and addresses of each inventor if an ADS is submitted including this information (i.e., the oath/declaration need only include the name of the executing inventor). Substitute statements are available if an inventor cannot execute an oath/declaration due to reasons such as death, legal incapacity, inability to find the inventor, or refusal of the inventor to sign if under an obligation to do so.

Submitting an Oath/Declaration: Several changes are being implemented to streamline the process of submitting an oath/declaration during prosecution. For example, the required statements discussed above can be included in an assignment, thereby combining the two documents into one. Applicants using a combined assignment/declaration must include an assignment cover sheet under 37 C.F.R. § 3.31 that includes a conspicuous statement of their
intention to use a combined document. Furthermore, applicants can wait to submit an oath/declaration until allowable subject matter is found, provided that an ADS was submitted prior to examination listing all inventors and their residence information. In such a case, the USPTO will issue a Notice of Allowability (as opposed to a Notice of Allowance) and provide a non-extendable 3 month period to supply inventor oaths/declarations. The USPTO warns, however, that this practice may have implications for Patent Term Adjustment for applicants entering the US through a PCT application under 35 U.S.C. § 371. This is because § 371 requires an executed oath to fulfill the requirements of a national stage application, and PTA does not begin accruing until after the requirements of § 371 are satisfied. In a third streamlining change, continuing applications need not comply with the oath/declaration requirements if an earlier-filed application contains all of the required papers. The final rules clarify, however, that copies of these earlier-filed documents should be filed in the continuing application. In addition, continuing applications based on applications filed before the effective date of these rules may still have to file new oaths/declarations to ensure compliance with the new rules.

Reissues: Several changes have been made to implement the amendments to 35 U.S.C. § 251 regarding reissue applications. In particular, the requirement that inventors declare that all errors were made without deceptive intent has been removed. Also eliminated is the requirement for a supplemental oath. If a reissue application seeks to broaden a claim, the reissue oath/declaration must identify the claim being broadened. Finally, the rules allow an assignee to sign the reissue oath/declaration, even if the reissue application is broadening.

Correcting Inventorship: In line with the increased importance of ADS’s discussed above, the procedures for correcting inventorship have been streamlined and rely primarily on the ADS. For non-provisional applications, correcting inventorship requires submitting an ADS, the fee from 37 C.F.R. § 1.17(i), and an oath/declaration from any new inventors. For provisional applications, a request to correct inventorship and the fee from 37 C.F.R. § 1.17 (q) is all that is required. To correct names and the listed order of inventors in an application, all that is required is a new ADS and the fee from § 1.17(i).

For more information on the new rules related to the Inventor’s Oath or Declaration, please see the final rules published in the Federal Register, as well as the new forms.

This advisory was prepared by Nutter’s Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.

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