

THOUGHT LEADERSHIP

LEGAL UPDATES

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Services

Intellectual Property
Patent Preparation &
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Check Your Forms — America Invents Act Regulations Took Effect

September 16

On August 14, the U.S. Patent and Trade Office (USPTO) released the final rules for oath or declaration practice that took effect on September 16, 2012, and has also provided new forms. In parallel, the World Intellectual Property Organization (WIPO) has released new forms and instructions as well.

The America Invents Act changed the statutory requirements for the content of the oath or declaration. *Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 Fed. Reg. 48776-48826 (Aug. 14, 2012) (final rule).

<http://www.gpo.gov/fdsys/pkg/FR-2012-08-14/pdf/2012-17907.pdf>

Inventors Need Not be Applicants Anymore

The old statute and rules required the applicant to execute the oath or declaration, which made the inventor the applicant. This is no longer true. The inventor and the applicant can be different now so an assignee, obligated assignee or other person with sufficient pecuniary interest can be the applicant. As a reminder, employers should have taken the appropriate predicate steps in advance to assure smooth processing at the time of a patent application.

In a related change, juristic entities (corporations, limited partnerships, etc.) must be represented by a patent practitioner in all filings.

The USPTO encourages assignee filing because the USPTO has had to waste resources to deal with disgruntled applicant-inventors approaching them directly.

Oath or Declaration Need Not be Filed Until Application Is Allowable

The USPTO is permitting applicants to wait until the application is substantively allowable before filing an oath or declaration for a \$130 fee. If the inventors on the oath or declaration change from those on the application data sheet during prosecution, there may be larger fees depending on the final determination of fee sizes.

Practitioners should be aware that application data sheets that declare inventorship at the time of filing under Rule 76 must be signed under Rule 76(e) if the oath or declaration requirement is not substantively met at filing.

One risk is that patent term extension may be adversely affected by the post-allowance processing. Patent Cooperation Treaty (PCT) applicants have a special hazard under this rule because one kind of patent term adjustment accumulates when the first office action occurs 14 months after the last of the 35 United States Code (USC) 371 requirements is fulfilled, one of which is the filing of oath or declaration. Delay in filing the oath or declaration could cost the PCT applicant patent term adjustment it would otherwise be entitled to.

USPTO Definition of “Oath or Declaration” Covers Three Types of Documents

Owing to the broader set of applicants, the America Invents Act is more complicated than prior practice. The term “oath or declaration” now encompasses an oath or declaration under 35 USC § 115(a), a substitute statement under 35 USC § 115(d), and an assignment statement under 35 USC § 115(e). The term “oath or declaration” in the USPTO rules encompasses all of these unless otherwise noted in the rule. The substitute statement is made if the inventor is unavailable or uncooperative, and putting the oath in the assignment means that only one document is signed.

New Requirements Render Inoperative Old Oath or Declaration Forms

The new oath or declaration rules require parts not in the old forms. Using old forms may result in additional fees to advance the application to allowance.

1. The oath or declaration must state that the application was made or was authorized to be made by the person executing the oath or declaration.
2. Oaths or declarations require different wording regarding the representations being made under penalty of perjury.
3. Oaths or declarations are not effective avenues to make priority claims foreign or domestic. These must be included in the application data sheet. The office will no longer look at oaths or declarations or specifications to identify priority claims of any type.

New Options Available Under New Rules

By their nature, the following optional items must be applied to specific factual situations by a patent attorney fluent with the new rules and their implications. We strongly advise clients or foreign attorneys to work with their attorneys at Husch Blackwell to use them in appropriate ways.

1. Oath or declaration forms will no longer need to name all the inventors if the information data sheet (ADS) filed with the application reflects the inventorship of the application and there are oaths or declarations for each inventor.
2. Until now, oath or declaration forms needed to expressly state that the person executing the oath or declaration has reviewed and understood the contents of the application and acknowledged the duty to disclose to the USPTO all information known by the person to be material to patentability as defined in Rule 56. Instead, Rule 63 requires that the person know of those issues but that they do not have to be expressly recited in the oath.
3. Also, Rule 63 requires inventors to disclose only their residence, not citizenship.

Locations for Forms

The America Invents Act (AIA) forms for new applications can be found at:

http://www.uspto.gov/forms/aia_forms.jsp

Translated AIA forms for declarations or substitute statements can be found at:

http://www.uspto.gov/forms/translated_forms.jsp

Forms for applications filed under the old regulations can be found at:

<http://www.uspto.gov/forms/forms.html>

The PCT forms are available in PDF format in English and French (currently on the right hand side of the page) at:

<http://www.wipo.int/pct/en/forms/index.html>

What This Means to You

In both the USPTO and WIPO, inventors and applicants should experience changes as the America Invents Act is implemented. In particular, assignee filing, delayed filing of oaths or declarations, and changed wording in oaths or declarations will change the documents submitted by practitioners for signature and the internal processes that will be necessary to get those documents signed.

Representatives of foreign companies that seek U.S. patents now will need to use new PCT and USPTO forms for filings and should contact U.S. counsel versed in the particulars of the America Invents Act to obtain new forms for filings to be done via the Paris Convention.

Contact Info

For additional information about these or any other intellectual property issues, please contact your Husch Blackwell attorney.

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