

Articles

August 15, 2012

USPTO Issues Final Rules: Inventor's Oath or Declaration

AUTHORS

Michael A. Sartori, Ph.D.

RELATED PRACTICES

Patent Prosecution and
Counseling

Patent Litigation

AIA *Inter Partes* Litigation

ARCHIVES

2012 2008 2004

2011 2007 2003

2010 2006 2002

2009 2005

The U.S. Patent and Trademark Office (USPTO) issued final rules, effective September 16, 2012, that implement provisions of the Leahy-Smith America Invents Act related to an inventor's oath or declaration. See 77 Fed. Reg. 48776 (2012). The rules streamline the statements required in an inventor's oath or declaration and permit these statements to be included in an assignment. In lieu of an inventor's oath or declaration, a substitute statement can be filed in certain circumstances. Further, the filing of the inventor's oath or declaration can now be delayed until an application is in condition for allowance. The rules also modify existing practice by relaxing the requirement that only inventors may be an applicant for a patent application and now permitting an assignee to be an applicant for a patent application.

Under Rule 1.63, the inventor's oath or declaration must: (1) identify the inventor, using the inventor's legal name; (2) identify the application; (3) include a statement that the inventor believes to be the original or joint inventor of a claimed invention in the application; and (4) state that the application was made or authorized to be made by the inventor. The inventor may not execute the oath unless the person has reviewed and understands the contents of the application and is aware of the duty of disclosure under Rule 1.56. For an inventor declaration, the declaration needs to additionally indicate that the inventor acknowledges that any willful false statements made in the declaration is punishable by fine or imprisonment of not more than five years.

Compared to previous practice, the inventor's citizenship is no longer required in the inventor's oath or declaration. Further, the inventor's oath or declaration no longer needs to list all of the joint inventors or include the claim for foreign priority, as long as this information is submitted with a signed application data sheet. Additionally, if the signed application data sheet (1) identifies each inventor, using each inventor's legal name, (2) provides a mailing address for each inventor, and (3) provides a residence for each inventor, this information does not need to be included in the inventor's oath or declaration.

Per Rule 1.63(e), the statements required in an inventor's oath or declaration may now be combined with an assignment. If so, the assignment must be recorded with the USPTO. Under Rule 1.64, in lieu of an oath or declaration, a substitute statement may be executed by the assignee (as the applicant) if the inventor is deceased, is under a legal incapacity, has refused to execute an oath or declaration, or cannot be located after diligent effort. The substitute statement needs to comply with the requirements of Rule 1.63.

Under Rules 1.53 and 1.495, the inventor's oath or declaration does not need to be filed until the application is in condition for allowance. For example, if the application is filed with the applicable fees (e.g., filing fee, examination fee, search fee, any excess claim fee, and any application size fee) and the surcharge fee, but is not filed with an inventor's oath or declaration, the USPTO will no longer issue a Notice to File Missing Parts. Instead, once the application is in condition for allowance and if an inventor's oath or declaration has not been filed, the USPTO will mail a Notice of Allowability (but not a Notice of Allowance and Issue Fee(s) Due). The Notice of Allowability will set a non-extendable time period of three months to submit the missing inventor's oath or declaration. Once the missing inventor's oath or declaration is filed, the USPTO will then mail a Notice of Allowance and Issue Fee(s) Due.

Finally, an assignee can be the "applicant" of a patent application. The USPTO no longer limits the applicant of a patent application to be one or more inventors. To do so, under Rule 1.76, the application data sheet now includes a section entitled "applicant," in which the assignee can be named as the applicant. If the inventor (and not the assignee) is the applicant, this section may be left blank.

To assist applicants, the USPTO is providing some patent forms that implement these new rules. See http://www.uspto.gov/forms/aia_forms_preview.jsp.