

America Invents Act Implementation of Rules Relating to the Inventor Oath or Declaration for Patent Applications

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As part of the implementation of provisions of the **America Invents Act of 2011**, the U.S. Patent Office has enacted a new set of rules effective as of September 16, 2012. These new rules impact the format and procedures relating to many of the documents that are filed with a patent application, including the application data sheet, the inventor oath or declaration (the Declaration), and the power of attorney. The most significant change is that the assignee of an invention may now be designated as the patent applicant, in contrast to previous U.S. practice in which only the inventors could be applicants. Other rule changes permit the filing of a Declaration to be deferred until patent claims are allowed and make it easier to file a substitute statement when an inventor is unavailable or unwilling to sign the Declaration.

Below is a summary of the changes to the forms and procedures relating to the Assignee as Patent Applicant, the Application Data Sheet, and the Declaration which took effect on September 16, 2012.

Assignee as Patent Applicant

For an entity to be an Assignee-Applicant, the entity must be an actual assignee (i.e. assignments have been executed by the inventors), the inventors must be under an obligation to assign to the entity (e.g. via an employment agreement), or the entity must show a sufficient proprietary interest in the invention. As is the case with an ordinary Assignee, an Assignee-Applicant has authority to perform the various tasks involved in managing a patent application or can appoint a legal representative to perform these tasks. However, an advantage of filing as an Assignee-Applicant is that the procedures are more streamlined.

Note, however, that filing as an Assignee-Applicant in a **Patent Cooperation Treaty (PCT)** application can restrict the choice of receiving office. For example if the entity is a foreign corporation with U.S. based inventors, the entity will not be able to use the U.S. as the receiving office if the application is filed with the entity as the Assignee-Applicant. On the other hand, if the application is filed listing the U.S. based inventors as the applicants, the U.S. receiving office can be used. Since either procedure can be used, an applicant can determine which filing status to use depending on the circumstances.

Application Data Sheet

The **Application Data Sheet (ADS)** is now considered to be the primary source for all information regarding a patent application. Priority claims must now be made on the ADS and it is no longer necessary to put priority claims in the specification and priority claims will no longer be listed on the Declaration. The address for an inventor in the ADS, can be a post office box, a work address, or another address where mail is received by the inventor, and there is no longer a requirement to provide the inventors' citizenship information on the ADS or any other document

filed with a patent application. Finally, the new rules provide simplified procedures for making changes to the ADS after filing which involve providing a marked-up word processor document showing the changes relative to the previous version of the ADS.

Inventor Oath or Declaration (the Declaration)

The U.S. Patent Office has issued a new Declaration form which includes several changes relative to previous Declaration forms, including the addition of new language and the removal of other language. Among other changes, the new Declaration form does not include language granting power of attorney and thus a separate Power of Attorney form will be used.

The new Declaration form includes required language not found in the old Declaration and thus new forms will need to be used in most cases for new filings. Applications for which a new Declaration form is required include new filings made on or after September 16, 2012, as well as any continuation or divisional filings made on or after September 16, 2012, provided that these applications claim priority to an application filed before September 16, 2012, and the Declaration from the prior filing did not include the newly-required language. On the other hand, a PCT National Stage filing in the U.S. under Section 371 will use the old Declaration form if the international filing date is prior to September 16, 2012. For applications that were filed prior to September 16, 2012, in which a Declaration has not yet been submitted, the old Declaration form should be used.

The new Declaration form no longer requires language stating that the inventor "has reviewed and understands the contents of the application" or "is aware of the duty to disclose to the office all information known to the person to be material to patentability as defined in 37 CFR 1.56." Nonetheless, applicants are still required to be aware of these requirements and so it is advisable to add language to this effect to the new U.S. Patent Office Declaration form. However, if a U.S. Patent Office form is modified, official markings should be removed from the form to make clear that the form is no longer in the official U.S. Patent Office format.

Under the new rules the filing of a Declaration can be postponed until a Notice of Allowability is received. Applicants should be aware, however, that such late filing of the Declaration will incur an additional fee and can lead to a loss of Patent Term Adjustment. Further, any delay in obtaining the inventors' signatures runs the risk that the inventors may later be unavailable and thus require the additional time and expense of filing a Substitute Statement in place of the Declaration.

An advantage of the new rules is that in cases where an inventor's signature cannot be obtained (e.g. where the inventor is deceased, unavailable, or unwilling to sign), the newer procedures for filing a Substitute Statement are less onerous than previous procedures under Rule 47.

Copies of the new forms are available from the US Patent Office [here](#).

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