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Mail Stop Comments - Patents
Commissioner for Patents
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By Email

Attention: Hiram H. Bernstein

Re: Comments Regarding Proposed Changes to Implement the Inventor's
Oath or Declaration Provisions of the Leahy-Smith America Invents Act (AIA)

Dear Mr. Bernstein:

Set forth below are our comments regarding the proposed changes to the rules of practice relating to the inventor's oath or declaration to implement the oath or declaration provisions of the AIA.

Oloff & Berridge appreciates the USPTO's engagement of community input on these issues, and the opportunity to have its positions considered by the USPTO. Oloff & Berridge, PLC is a nationwide law firm specializing in intellectual property matters. Its patent practice serves corporations, universities, and individuals worldwide, and has filed and prosecuted thousands of matters before the United States Patent and Trademark Office (USPTO). Its practice before the USPTO provides a perspective and depth of experience necessary to provide the following comments regarding the proposed changes to the rules.

We fully support and applaud the USPTO's efforts to revise the rules in view of the AIA's changes to 35 U.S.C. §115 and §118, as such changes are necessary. However, with respect, the USPTO's proposed rulemaking does not appear to reflect the paradigm shift accomplished by the AIA. Both the rules and also the USPTO's commentary fail to reflect or implement the goals of Congress that are reflected in the AIA's changes to §115 and §118. Thus, for the reasons discussed below, substantial revisions of the rules are necessary to implement provisions of amended §115 and §118 and to bring the rules into statutory compliance.

For convenience, the below comments use the term "Declaration" to mean the inventor's oath or declaration, and use the term "obligated assignee" to mean a person to whom an inventor is obligated to assign an invention.

I. Amended §118 and §115, and Unamended §117

The AIA amends 35 U.S.C. §118 and §115 to read as follows (with emphasis added):

§ 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.

* * *

§ 115. Inventor's oath or declaration

(a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION.—An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

(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).

(d) SUBSTITUTE STATEMENT.—

(1) IN GENERAL.—In lieu of executing an oath or declaration under subsection (a), the applicant for patent may provide a substitute statement under the circumstances described in paragraph (2) and such additional circumstances that the Director may specify by regulation.

(2) PERMITTED CIRCUMSTANCES.—A substitute statement under paragraph (1) is permitted with respect to any individual who—

(A) is unable to file the oath or declaration under subsection (a) because the individual—

(i) is deceased;

(ii) is under legal incapacity; or

(iii) cannot be found or reached after diligent effort; or

(B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).

(3) CONTENTS.—A substitute statement under this subsection shall—

(A) identify the individual with respect to whom the statement applies;

(B) set forth the circumstances representing the permitted basis for the filing of the substitute statement in lieu of the oath or declaration under subsection (a); and

(C) contain any additional information, including any showing, required by the Director.

(e) MAKING REQUIRED STATEMENTS IN ASSIGNMENT OF RECORD.—An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statements separately.

(f) TIME FOR FILING.—A notice of allowance under section 151 may be provided to an applicant for patent only if the applicant for patent has filed each required oath or declaration under subsection (a) or has filed a substitute statement under subsection (d) or recorded an assignment meeting the requirements of subsection (e).

(g) EARLIER-FILED APPLICATION CONTAINING REQUIRED STATEMENTS OR SUBSTITUTE STATEMENT.—

(1) EXCEPTION.—The requirements under this section shall not apply to an individual with respect to an application for patent in which the individual is named as the inventor or a joint inventor and who claims the benefit under section 120, 121, or 365(c) of the filing of an earlier-filed application, if—

(A) an oath or declaration meeting the requirements of subsection (a) was executed by the individual and was filed in connection with the earlier-filed application;

(B) a substitute statement meeting the requirements of subsection (d) was filed in connection with the earlier filed application with respect to the individual; or

(C) an assignment meeting the requirements of subsection (e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application.

(2) COPIES OF OATHS, DECLARATIONS, STATEMENTS, OR ASSIGNMENTS.—Notwithstanding paragraph (1), the Director may require that a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application be included in the later-filed application.

(h) SUPPLEMENTAL AND CORRECTED STATEMENTS; FILING ADDITIONAL STATEMENTS.—

(1) IN GENERAL.—Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time. If a change is made in the naming of the inventor requiring the filing of 1 or more additional statements under this section, the Director shall establish regulations under which such additional statements may be filed.

(2) SUPPLEMENTAL STATEMENTS NOT REQUIRED.—If an individual has executed an oath or declaration meeting the requirements of subsection (a) or an assignment meeting the requirements of subsection (e) with respect to an application for patent, the Director may not thereafter require that individual to make any additional oath, declaration, or other statement equivalent to those required by this section in connection with the application for patent or any patent issuing thereon.

(3) SAVINGS CLAUSE.—A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under paragraph (1).

(i) ACKNOWLEDGMENT OF PENALTIES.—Any declaration or statement filed pursuant to this section shall 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.

35 U.S.C. §117, which was not amended by the AIA, reads:

§117. Death or incapacity of inventor

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

a. Objectives

It is evident that Congress intended to simplify the declaration process by streamlining the requirements for a declaration, and making it easier for patent owners (i.e., "applicants") to file applications. *See* Report on H.R. 1249, House Judiciary Committee (June 29, 2011), pp. 40-41. Because Congress recognizes that it has become increasingly common for patent applications to be assigned to corporate entities, such as the employer of the inventor, Congress intended to facilitate the process by which an assignee may file and prosecute patent applications, as well as to provide similar flexibility to an obligated assignee. *Id.*

In line with these objectives, the amendments to §118 and §115 make clear that the terms "applicant" and "inventor" are no longer interchangeable, because no longer is the inventor automatically the applicant. This distinction finally brings the U.S. in line with the use of these

terms in other patent offices around the world. Congress's intent in making this distinction is further emphasized by its inclusion in the AIA of a definition of the term "inventor" in §100. *See* Amended §100(f) (stating that "inventor" means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention).

While the USPTO recognizes some of the "simplification" objectives of amended §115 and §118 (*see* Fed. Reg. Vol. 77, No. 4, p. 996, "Rulemaking Considerations"), the proposed rules fail to (1) address or comply with various statutory requirements of amended §115 and §118, (2) address and maintain the distinction between "who may apply for a patent" (as governed by amended §118 and unamended §117) and "who may sign the inventor's declaration" (as governed by amended §115), and (3) achieve the simplification objectives of amended §118 and §115 intended by Congress.

b. Summary of Changes to §118

§118 governs the filing of an application by someone other than an inventor. Amended §118 clarifies and expands upon who may apply for a patent, i.e., who may be the "applicant." However, amended §118 does not change the requirements of §115, which requires that each inventor (not necessarily synonymous with each "applicant") executes a declaration.

In relevant part, amended §118 states that an assignee or an obligated assignee "may make an application for patent," without restriction. Amended §118 further states that a "person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as an agent for the inventor on proof of the pertinent facts and a showing." Thus, amended §118 unambiguously facilitates the process by which an assignee or an obligated assignee may file an application for a patent as an "applicant," while permitting others (having a sufficient proprietary interest in the matter) to apply for a patent only on behalf of and as an agent for the inventor with proof and a showing.

c. Summary of Changes to §115

The very title of amended §115 is "Inventor's oath or declaration," thus indicating that the declaration must be executed by the inventor.

Amended §115 changes the language required to be present in an inventor's declaration and no longer requires that a declaration signed by a particular inventor list all other inventors. Additionally, amended §115 permits an assignment document to include the required declaration statements in place of separately filing the statements in a declaration, and changes the requirements for filing a declaration when one or more inventor is unable or refuses to execute a declaration, by allowing an applicant (who is not necessarily the inventor) to file a "substitute statement" in lieu of the inventor's declaration.

Specifically, amended §115 identifies specific permitted circumstances for filing such a substitute statement in lieu of the inventor's declaration. *See* amended §115(d)(2)(A)-(B). A critical distinction incorporated in amended §115 is that an "inventor's declaration" and a "substitute statement" are different documents, with different requirements, thus making the provisions of each not interchangeable with the other.

II. General Summary of Issues in USPTO's Proposed Rulemaking

The proposed rules fail to address the critical distinction between "inventor" and "applicant" emphasized by amended §115 and §118, respectively. Instead, the proposed rules muddle provisions governing who may apply for a patent with provisions governing declaration requirements. For example, the proposed rules erroneously incorporate the provisions of amended §115(d) regarding permitted circumstances for filing a substitute statement as limitations on persons/entities, other than the inventor, that may apply for a patent, and under what limited circumstances. Moreover, the proposed rules fail to set out provisions for the filing of a "substitute statement" by an applicant when an inventor cannot or refuses to sign a declaration, instead suggesting that the "substitute statement" permitted under amended §115 is merely a declaration signed by a person other than the inventor.

In view of the above grave misconstruction of amended §115 and §118, incorporated into the proposed rules are provisions that permit, or in certain circumstances would require, individuals other than the inventor or joint inventor to execute an inventor's declaration. Therefore, the proposed rules, if enacted, would be in conflict with amended §115 and §118, making compliance with both the statutory requirements and the USPTO rules impossible. Thus, substantial revisions to the proposed rules are necessary. Otherwise, many patent applicants who comply with the USPTO rules will necessarily fail to meet the statutory requirements, with the result that their patents may be invalidated in court because they complied with the USPTO rules.

The proposed rules are additionally infiltrated with inconsistencies, inaccuracies, conflicting provisions, and provisions that increase the burden on applicants and/or inventors, thus ignoring Congress's intended objectives of flexibility and simplicity.

III. Discussion of Proposed Rules

For clarity, the proposed rules will be discussed in groupings by topic, specifically: (a) rules governing who may apply for a patent in view of amended §118; (b) rules governing the inventor's declaration in view of amended §115; (c) rules governing reissue declarations; (d) rules governing the prosecution of an application; and (e) rules governing the Application Data Sheet ("ADS").

a. Who May Apply for a Patent**i. Relevant Statutory Provisions**

As summarized above, amended §118 governs who, other than the inventor, may apply for a patent. Specifically, the first sentence of amended §118 states that an assignee or an obligated assignee may make an application for patent, without any restriction. This is in accordance with Congress's intent to facilitate the process by which an assignee or obligated assignee may file and prosecute patent applications.

Amended §118 uses different language regarding when a person other than the assignee or obligated assignee may make an application for patent. That is, the second sentence of amended §118 states that "[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."

Therefore, there is clearly an intended distinction between when the USPTO may require a showing for a person other than the inventor to apply for a patent, and when no showing is required. Pursuant to amended §118 and the underlying legislative intent, no showing is required for an assignee or obligated assignee to be the applicant.

Additionally, §117, which was not amended by the AIA, provides that "[l]egal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor." Importantly, both §117 and §118 concern the "applicant" for a patent, and have no bearing on the requirements for who must sign a declaration.

ii. Rules Affected

The following rules fall under the general heading of Who May Apply for a Patent:

- §1.41 (Applicant for patent)
- §1.42 (When the inventor is dead)
- §1.43 (When the inventor is insane or legally incapacitated)
- §1.44 (Joint inventors)
- §1.46 (Assigned invention and patents)
- §1.47 (Filing when an inventor refuses to assign or cannot be reached)
- §1.48 (Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116)

The current rules are based on the prior §118 and §115, based on the premise that the inventor is the applicant for a patent, unless the exceptions of rules 1.42, 1.43, 1.46, and 1.47 apply, in which case other permitted persons or entities could file an application for a patent, along with a petition and a necessary showing. As is evident from amended §118, substantial revisions of the rules are necessary to reflect the changes with respect to who (other than the inventor) may apply for a patent without restriction and who may apply for a patent in circumstances requiring a showing.

iii. Discussion of Proposed Rules

1. Rule 1.41

Rule 1.41 provides the definition of "applicant." From the outset, the USPTO's critical misinterpretation of amended §118 is exemplified by the statement that "changes to 35 U.S.C. 115 and 118 do not mean that a person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent in all circumstances." *See* Fed. Reg., Vol. 77 at p. 989, third column. This is contrary to amended §118, which explicitly permits an assignee or obligated assignee to be the applicant, without restriction.

a. Identification of the "Applicant"

Proposed rule 1.41 retains section (a), which states that the "inventor" is the "applicant." This section must be amended to list entities that may be applicants, or at least to state that an applicant may or may not be an inventor. *See* §117 and amended §118. While other persons (e.g., legal representatives, assignees, obligated assignees, persons who otherwise show sufficient proprietary interest in the matter) may also be the "applicant," rule 1.41 should be amended to state that, in all circumstances, the assignee or obligated assignee may be the applicant, as such persons/entities may be the applicant without restriction and without any showing under amended §118.

While the inventor(s) of an application is identified in an Application Data Sheet and one or more declaration (or by a "substitute statement" under amended §115), the USPTO should also provide a method for identifying the "applicant," whether it is the inventor, assignee, obligated assignee, or some other person or entity. As a suggestion, we recommend the USPTO consider requiring this information under a new section heading in the "Application Data Sheet," and amending rule 1.76 (discussed further below) accordingly.

Furthermore, while rules governing the "Inventor's Declaration" provide requirements for identifying the inventor(s), rule 1.41 should be amended to include provisions regarding the information required to identify the applicant. For example, an assignee of a trademark application must currently provide its name and place of incorporation or the like. If the applicant is a juristic entity, the USPTO should consider a similar requirement.

b. No Showing Required

Proposed rule 1.41(b) states that "[u]nless the contrary is indicated the word "applicant" when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§ 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor," respectively. As a preliminary matter, section (b) must also be amended to state that "applicant" refers not only to the inventor, but also any assignee or obligated assignee who is the applicant.

The USPTO explains that this provision is maintained because it reflects the circumstances set forth in amended §115(d)(2) where "an assignee or person to whom the inventor is under an obligation to assign, or a legal representative of the dead or legally incapacitated inventor, is the applicant." *See Fed. Reg.*, Vol. 77 at p. 983, third column. This reasoning again exemplifies the USPTO's critically flawed understanding of amended §115. Amended §115(d)(2) in no way limits or provides exceptions for when an assignee or obligated assignee may be the applicant for a patent. Instead, section (d)(2) provides for "permitted circumstances" for filing a substitute statement in lieu of a declaration. It has no bearing on who is the applicant.

Therefore, rule 1.41 should in no way limit the ability of an assignee or obligated assignee to make an application for patent to the specific circumstances enumerated in current rule 1.42 (inventor is deceased) and rule 1.47 (inventor refuses to sign declaration). Notably, neither of rules 1.42 or 1.47 concerns the filing of an application by an assignee.

c. Showing Required

Proposed rule 1.41 fails to address the provision of amended §118 that allows "a person who otherwise shows sufficient proprietary interest in the matter" to file an application for a 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 1.41 should be further amended to address the statutory requirements of amended §118 for such a person, namely: (1) the proof and pertinent facts required; and (2) the showing required that such action is appropriate to preserve the rights of the parties.

2. Rule 1.42

Rule 1.42 covers the situation where an inventor is deceased. Proposed rule 1.42 is amended to include the situation where an inventor is legally incapacitated, which is addressed by current rule 1.43. We applaud this change, which removes the unnecessary distinction between "death" and "legal incapacity," which is not present in §117 (stating that legal representatives of deceased inventors and of those under legal incapacity may make application for patent).

**a. Persons/Entities Other Than the Inventor
May Not Execute the Inventor's Declaration**

Proposed rule 1.42(a) states that, in the case of death or legal incapacity of the inventor, the "legal representative ... of the deceased or incapacitated inventor, the assignee, or a party to whom the inventor is under an obligation to assign the invention or party who otherwise shows sufficient proprietary interest in the matter may execute the oath or declaration under §1.63" (emphasis added). This is not permitted under amended §115, which requires that each inventor sign the inventor's declaration and, in the situations identified above, applicants may file a "substitute statement," in lieu of the inventor's declaration. Thus, proposed rule 1.42 is fundamentally flawed and in conflict with the statute, because it states that persons/entities other than the inventor may execute the inventor's declaration. The statement statutorily required in §115(b)(2) would necessarily have to be absent or false for anyone other than the inventor to sign the declaration.

**b. Substitute Statement Provision Applies to
Declaration Practice, Not to Defining "Applicant"**

The proposed rule is confusing because, as explained in the USPTO's commentary, the rule is intended to reflect the first two situations provided in amended §115(d). *See* Fed. Reg., Vol. 77 at p. 988, first column. In other words, proposed rule 1.42 is intended to address situations for making a substitute statement in lieu of an inventor's declaration. *Id.* Not only does the proposed rule fail to mention "substitute statement" (instead permitting persons other than the inventor to execute the declaration), but the referenced provisions of amended §115 concern situations when a substitute statement may be filed by an applicant in lieu of an inventor's declaration, rather than when legal representatives may be the applicant. §117 addresses when the legal representative may be the applicant. Thus, it is evident that the critical distinction between who may apply for a patent under amended §118 and who must sign the declaration (i.e., the "inventor or joint inventor") under amended §115 is again not addressed by the proposed rules.

In this regard, section (a) must be amended to reflect §117, rather than §115, which permits legal representatives of a deceased or incapacitated inventor to apply for a patent, rather than to sign the inventor's declaration. Specifically, the situation addressed by §117 concerns "who may be an applicant" in such a situation, and does not affect the requirement that inventors must sign the inventor's declaration or, in permitted circumstances, the applicant must sign a substitute statement.

c. Improper Section of Rules for Substitute Statement Requirements

The requirements for making a "substitute statement" in lieu of a declaration under circumstances of death or incapacity of the inventor should be added to rules 1.63 and 1.64, which currently only address the requirements of the declaration and who may sign the declaration, respectively. However, even if incorporated into rules, such as 1.63 and 1.64, the requirements for making a "substitute statement" in lieu of a declaration cannot be treated as requirements for making a declaration by someone other than the inventor.

d. No Showing Required for an Obligated Assignee

Proposed rule 1.42(b) states that an obligated assignee or a party who otherwise has sufficient proprietary interest in the matter taking action under this section must do so by way of a petition that is accompanied by a fee.

However, amended §118 places no restriction on when an obligated assignee may apply for a patent. Therefore, the USPTO is proposing to require what would necessarily always be a grantable petition and, thus, completely unauthorized by and in conflict with the statute. Similarly, no fee requirement or showing should be imposed. That is, amended §118 makes no distinction between "assignee" and "a person to whom the inventor is under an obligation to assign the invention." Such persons or entities may apply for a patent without restriction. Amended §118 only requires an additional showing if the person applying for a patent is a non-assignee who otherwise shows sufficient proprietary interest in the matter. Therefore, the proposed rule should be amended to remove the USPTO's improper restrictions on when an obligated assignee may apply for a patent. The rules should only require that such an applicant identify the fact of being an assignee or obligated assignee.

3. Rule 1.47

Rule 1.47 covers situations where an inventor refuses or cannot be reached or found after diligent effort to join in an application. From the outset, the USPTO explains that the amendments to rule 1.47 revise procedures for when an inventor refuses to sign an oath or declaration or cannot be reached to sign. *See Fed. Reg.*, Vol. 77 at p. 988, third column. However, current rule 1.47 concerns "who may apply for a patent" rather than who may sign an inventor's declaration, and must be amended to clarify this distinction.

a. Persons/Entities Other Than the Inventor May Not Execute the Inventor's Declaration

Like proposed rule 1.42, proposed rule 1.47 permits persons other than the inventor to sign the inventor's declaration. Specifically, the rule suggests that, if an inventor or a legal

representative of a deceased or incapacitated inventor refuses to execute the oath or declaration, or cannot be found after diligent effort, then the assignee, obligated assignee, or a party who otherwise shows sufficient proprietary interest may execute the declaration. This is not permitted by amended §115, and any such declaration would by definition fail to meet the express statutory requirement of amended §115(b)(2), or be false.

b. Remaining Inventors May Not Execute a Declaration on Behalf of Joint Inventor

Proposed rule 1.47(a) further states that if a joint inventor or legal representative refuses to execute the oath or declaration, or cannot be found or reached after diligent effort, the remaining inventor(s) may execute the oath or declaration on behalf of the nonsigning inventor. As discussed above, nobody but an inventor may execute the inventor's declaration under amended §115(b)(2).

Furthermore, amended §115 requires that "each individual who is the inventor or a joint inventor ... execute an oath or declaration" (emphasis added). Therefore, the proposition that the remaining inventors sign an inventor's declaration on behalf of the nonsigning inventor is fundamentally flawed, as such action is not permitted by amended §115. They may only sign a substitute statement, under listed circumstances, and even then only if they are "applicants."

c. Where a Joint Inventor Refuses to Apply for a Patent May Pose a Predicament for the Remaining Inventors in Satisfying the Declaration Requirements

Even though rule 1.47 is not the proper rule to present the requirements of a "substitute statement" as provided for in amended §115, the situation when an inventor refuses to join in an application (as opposed to "refuses to sign a declaration") should be addressed by rule 1.47. Moreover, the scenario where a joint inventor refuses to "join in" an application poses a predicament for satisfying the declaration requirements under amended §115, which must be addressed by the USPTO's rulemaking.

If a joint inventor refuses to join in an application for patent with the remaining inventors, such remaining inventors might be able to apply for a patent under amended §118 as a person "who otherwise shows sufficient proprietary interest in the matter," if they retain any proprietary interest. Alternatively, amended §116(b) also states that "[i]f a joint inventor refuses to join in the application for patent or cannot be reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor." Thus, the amended statutory provisions provide a method for the remaining inventors to apply for a patent (i.e., be "applicants") without the joint inventor who refuses or cannot be found after diligent effort.

However, amended §115 clearly states that "each individual who is the inventor ... shall execute an oath or declaration." Nowhere does amended §115 permit someone other than the inventor to execute that inventor's declaration. For situations where an inventor cannot or refuses to sign a declaration, amended §115(d) permits the applicant (the remaining inventors in this scenario) to make a substitute statement. Specifically, the situation when an inventor refuses to sign a declaration is one of the permitted circumstances under §115(d) for applicant to file a substitute statement in lieu of a declaration. However, the specific scenario where an inventor refuses to sign a declaration provided for in amended §115(d)(2) entails an additional requirement not present in the permitted circumstances listed under section (d)(1), i.e., inventor is deceased, legally incapacitated, cannot be found or reached after diligent effort. That is, a substitute statement is only permitted for an inventor who has refused to make the declaration and is under an obligation to assign the invention.

Thus, in the above scenario where the remaining inventors are the applicant for patent, it is unlikely that the refusing inventor would be obligated to assign the invention (in which case the obligated assignee would likely be the applicant). Thus, in the specific scenario presented above, it appears that the remaining inventors (who are applicants) would be in an impasse for satisfying the declaration requirements of amended §115. Specifically, it is unclear on what permitted circumstance of section (d)(2) of amended §115 the applicants would be able to rely in order to make a substitute statement in lieu of the refusing inventor's declaration. The USPTO must provide clarification on its statutory interpretation and address this scenario, and if necessary urge Congress to recognize and correct the situation.

d. No Showing Required for an Obligated Assignee

Proposed rule 1.47(c)(4) states that the USPTO will require a showing, including proof of pertinent facts, "[f]or a party to whom the nonsigning inventor is under an obligation to assign the invention, or has sufficient proprietary interest in the matter." Aside from the fact that even this provision erroneously refers to the situation with respect to the signing of a declaration, rather than applying for a patent, amended §118 does not permit a showing requirement for an assignee or obligated assignee to file an application for patent. Thus, no such showing or proof of facts should be required by the USPTO for an assignee or obligated assignee to file an application for a patent, in any circumstances. The rules should only require that such an applicant identify the fact of being an assignee or obligated assignee.

b. The Inventor's Declaration

i. Relevant Statutory Provisions

As summarized above, amended §115 provides the requirements for an inventor's declaration, as well as permitted circumstances for filing a "substitute statement" in lieu of an inventor's declaration. With respect to the content of an inventor's declaration, amended §115

provides fewer requirements (i.e., removes the minimum age, citizenship, listing of all inventors, etc.) in an attempt to make the declaration process simpler.

ii. **Rules Affected**

The following rules fall under the general heading of Oath or Declaration:

- §1.63 (Oath or declaration)
- §1.64 (Person making oath or declaration)
- §1.66 (Officers authorized to administer oaths)
- §1.67 (Supplemental oath or declaration)
- §1.68 (Declaration in lieu of oath)
- §1.69 (Foreign language oaths and declarations)

iii. **Discussion of Proposed Rules**

1. **Rule 1.63**

Rule 1.63 provides the requirements for a declaration, as well as subsequent or supplemental declarations. The USPTO states that the primary impact of the proposed rule is the "streamlining of the requirements for oaths and declarations." *See Fed. Reg.*, Vol. 77 at p. 996, third column. Thus, the USPTO appears to recognize the congressional intent of simplifying the declaration requirements. However, proposed rule 1.63 fails to incorporate certain provisions of amended §115, while incorporating others with unnecessarily complicated caveats and burdensome requirements. Furthermore, the rule is fundamentally flawed due to the underlying concept that an inventor's declaration may be made by someone other than the inventor, which is not permitted under amended §115. Once again the USPTO muddles the distinction between §118 (who may apply for a patent) and §115 (who may execute the inventor's declaration, as well as who may sign a substitute statement).

a. **Content Requirements of a Declaration**

i. **Listing of Inventors**

Amended §115 states that "each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration." There is no requirement in amended §115 that requires that a declaration include the names of all of the inventors. However, proposed rule 1.63(a)(2) suggests that a declaration must identify each inventor, rather than that each inventor must execute a declaration. The USPTO should revise this section to clarify the above distinction.

ii. Name of Inventor

In an uncomplicated fashion, amended §115 states that a declaration shall include "the name of the inventor" (emphasis added). On the other hand, proposed rule 1.63(a)(2), states that each inventor must be identified by "his or her full name without any abbreviation (except for a middle initial)" (emphasis added). Thus, the proposed rule places further restrictions on what would otherwise be an uncomplicated requirement.

The USPTO commentary suggests that the amendment to the rule is made to simplify the requirement for the inventor name to be his or her full name. However, if the intent is to simplify the requirement and allow an inventor to provide his or her full name, then why place the unnecessary restriction on initials? The suggested "simplification" appears to be an additional requirement that may, at times, prevent an inventor from providing his or her full name. For example, what if an inventor has more than "a" middle initial (e.g., two or three), or what about legal names that begin with an initial (e.g., J. Edgar Hoover, F. Scott Fitzgerald, J.R.R. Tolkien)?

iii. Residence

Pursuant to amended §115, proposed rule 1.63 removes the requirement for identifying the citizenship of the inventor. However, while removing this requirement, rule 1.63(b) requires the mailing address and the residence of an inventor. The "residence" requirement is not only unnecessary (providing no useful information to the USPTO), but it causes problems and confusion for inventors attempting to file a declaration, because it is still unclear what is intended by "residence" (i.e., city, state, province, prefecture, etc.).

Many inventors would also prefer to keep their "residence" address private, especially where the mailing address of the inventor is the place of employment, many times the address of the assignee and many times in a different city from that in which the inventor resides. Furthermore, privacy laws of some countries (e.g., the United Kingdom) prohibit entities from requiring public disclosure of such information. Thus, the rules require assignees in those countries to violate their domestic laws by requiring inventors to make residence information publicly available.

In view of the congressional intent to simplify and facilitate the filing of declarations by inventors, exemplified by no longer requiring even the citizenship of the inventors, the USPTO should not require the "residence" of an inventor in addition to the mailing address.

iv. Required Statements

The "required statements" that must be present in an inventor's declaration according to amended §115(b) are:

- (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.*

However, sections (a)(4)-(5) of proposed rule 1.63 state that the oath or declaration must:

- (4) Include a statement that the person executing the oath or declaration believes the named inventor or joint inventors to be the original inventor or original joint inventors of the claimed invention in the application for which the oath or declaration is being submitted;
- (5) State that the application was made or was authorized to be made by the inventor.

The proposed language is contrary to and impermissibly broadens the language required by amended §115, as it suggest that the person making the declaration may not be an inventor, and permits such an improper declarant to attest to his or her beliefs that the original inventor or joint inventors meet the required statements imposed by amended §115. Such attestations by a person other than the inventor are not permitted by amended §115, which requires that "each individual who is the inventor or joint inventor of a¹ claimed invention in an application for patent shall execute an oath or declaration," the declaration requiring the two statements cited above. *See* Amended §115(a).

Furthermore, the required statement under amended §115(b)(1) is: "the application was made or was authorized to be made by the affiant or declarant" (emphasis added), rather than "by the inventor," as stated in the proposed rule. Notably, if a person other than an inventor is executing the declaration, as suggested by the proposed rule, then the statutorily required statement cannot be true.

Consistent with the underlying premise that an inventor or joint inventor must execute the "Inventor's oath or declaration," the required statements to be included in a declaration under amended §115(b)(1) and (2) could not be made by someone other than the inventor. Proposed rule 1.63 appears to address this discrepancy in wording by impermissibly rephrasing the above statements, to allow a person to attest to his or her belief about the inventor satisfying the requirements. However, such wording change results in noncompliance with the statutory requirement that the declaration "shall contain" the listed statements.

¹ Amended §115 requires "a" not "the."

v. Recommendations

First and foremost, we recommend revising rule 1.63 to be titled "Inventor's oath or declaration" to reflect amended §115, and to distinguish the "declaration" requirements from who may apply for a patent, which should be addressed by rule 1.41. To comply with the statutory requirements of amended §115, we recommend amending relevant sections (a)(1)-(5) of rule 1.63 as follows:

(a) ...An oath or declaration under this section must:

(1) Be executed (*i.e.*, signed) in accordance with either §1.66 or §1.68 by each individual inventor or a joint inventor of a claimed invention in an application for patent;

(2) Identify the affiant or declarant by his or her name;

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

(4) Include a statement that the person executing the oath or declaration believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application;

(5) State that the application was made or was authorized to be made by the affiant or declarant.

b. "Substitute Statement" in Lieu of a Declaration

Amended §115 provides an exception to the requirement that each inventor execute an inventor's declaration meeting the requirements of §115(a) discussed above. Specifically, §115(d) provides for making a "substitute statement" in lieu of executing a declaration. The restrictions on such a substitute statement are that (1) it must be made by an "applicant," (2) it may only be made in "permitted circumstances" identified in (2)(A)-(B), and (3) it must include the basic information identified in (d)(3)(A)-(C).

i. The USPTO Must Incorporate the Substitute Statement Provisions Permitted by Amended §115(d) in Lieu of a Declaration

In its proposed rule making, the USPTO fails to address the "substitute statement" provisions of amended §115, or to provide any requirements or methodology for an applicant to file such a substitute statement, in lieu of a declaration by an inventor, in appropriate circumstances. The USPTO instead defines the "supplemental statement" as an inventor's declaration that is executed by someone other than the inventor and is accompanied by a petition. Specifically, the USPTO provides the following reasoning regarding proposed rule 1.42 (which allegedly provides for the ability of persons other than the inventor to execute a declaration under rule 1.63):

Accordingly, the Office is proposing amendments to §1.42 to provide for the ability of the assignee, a party to whom the inventor is under an obligation to assign the invention, or a party who otherwise shows sufficient proprietary interest to execute the oath or declaration under § 1.63 in the case of a deceased or legally incapacitated inventor, in addition to the legal representative of such an inventor. This oath or declaration, together with any necessary showing, constitutes the substitute statement provided for in 35 U.S.C. §115(d).

See Fed. Reg., Vol. 77 at p. 988, first column, second paragraph (emphasis added).

While the USPTO provides the above critically flawed reasoning in its commentary, proposed rule 1.63 fails to reference a "substitute statement" altogether, let alone the "permitted circumstances" for making a substitute statement, the content requirements of a substitute statement, or the showing required by the USPTO in a substitute statement. Thus, further provisions are necessary to incorporate the "substitute statement" provisions of amended §115 to allow applicants to meet the substitute statements requirements in lieu of the inventor's declaration in permitted circumstances under which execution of a declaration by an inventor would be impossible.

ii. Any "Substitute Statement" Requirements, When Incorporated, Should Not be Burdensome

As acknowledged by the USPTO, the primary impact of its proposed changes should be "streamlining of the requirements for oaths and declarations and the simplification of the filing of an application by the assignee." *See Fed. Reg.*, Vol. 77 at p. 997, third column. Accordingly, the "substitute statement" requirements that must be addressed by the USPTO and incorporated into the rules should closely track the statutory requirements of amended §115 and avoid adding unnecessary burdens on applicants.

Currently, in situations where, for example, an inventor cannot be found or reached after diligent effort, a statement of facts must be submitted that "fully describe the exact facts which are relied on to establish that a diligent effort was made." *See* MPEP §409.03(d). However, whether the facts relied on are "sufficient" is a determination made on a case-by-case basis by the USPTO. Far from "simple," the USPTO currently requires extensive documentary evidence to support such a statement of facts that includes, without exhaustion, copies of internet searches, mailing receipts, emails, telegrams, letters, and outlines of steps taken and efforts exhausted in attempting to locate the nonsigning inventor. The current requirements for when an inventor cannot or refuses to sign a declaration are far from simple, but pose a great burden and unnecessary costs on applicants.

The "substitute statement" is permitted for an applicant in lieu of an inventor's declaration to satisfy the requirements of amended §115(a). Because the substitute statement may be used in

"permitted circumstances" to satisfy the requirements of amended §115(a), it is evident that Congress similarly intended that making substitute statements should be simple, as opposed to the burdensome requirements currently imposed by the USPTO. The Congressional intent of "streamlining" the requirements for declarations or substitute statements would most certainly not be achieved if the USPTO's rulemaking retained the current proof required, by petition, to show that an inventor refuses to or cannot execute the inventor's declaration, as suggested by the USPTO's commentary. *See Fed. Reg., Vol. 77 at p. 989, first column.*

Especially where assignees or obligated assignees are applicants, such persons/entities should be permitted to file a substitute statement in the permitted circumstances listed in amended §115(d)(2) without additional unnecessary requirements, as Congress explicitly intended for such entities to be able to apply for a patent in all circumstances without restriction. In situations where such assignee or obligated assignee applicant is unable to obtain an inventor's declaration due to any of the permitted circumstances of amended §115(d)(2), the applicant should be able to file a substitute statement without being subjected to the extremely burdensome requirements currently imposed by the USPTO.

Thus, while amended §115(d)(3)(C) states that the substitute statement shall contain "any additional information, including any showing, required by the Director," requiring the same level of information and showing as currently required would be contrary to the simplification envisioned by Congress. The content requirements of a substitute statement are provided in amended §115(d)(3)(A)-(B), which require merely that the substitute statement "identify the individual with respect to whom the statement applies" and "set forth the circumstances representing the permitted basis for filing of the substitute statement in lieu of a declaration," respectively. These basic requirements provide a clear indication of the simplicity of information Congress envisioned to be contained in a substitute statement. Therefore, the USPTO is urged to eliminate the current burdensome requirements in setting forth any additional requirements, and ensure that such requirements simplify and reduce the burden on applicants.

c. Making Required Statements in an Assignment

Amended §115 states that an inventor who is under an obligation of assignment of the application may include the required statements of a declaration in an assignment, in lieu of filing such statements in a declaration separately. Congress's rationale for this provision is in line with the underlying objective to facilitate and streamline the process by which an assignee or obligated assignee may file an application for a patent. Specifically, if the assignment document includes the required declaration statements by an inventor, then an assignee or obligated assignee (who may be the applicant without restriction under amended §118) will not have to cause the inventor to execute a separate declaration.

i. Proposed System is Burdensome

Proposed rule 1.63(c) attempts to incorporate the assignment provision of amended §115, but does so in a way that only increases the burden on all parties (the assignee and the USPTO). Specifically, the USPTO explains that the proposed rule requires that the assignment be made of record by recording the assignment (according to current USPTO practice), in addition to requesting that a copy of the assignment be filed in the application for which it is being used as an oath or declaration.

Under current practice, when an assignment is submitted for recording, the assignment is separated from the paper application and forwarded to a different branch, thus not becoming part of the application file. Rather than changing this archaic system, the USPTO instead proposes adding another level of complexity. Specifically, the USPTO proposes requiring a check-box on the assignment cover sheet that, if checked, indicates to the USPTO the intended use of the assignment to also comply with the declaration requirements. If the box is checked, the USPTO would then scan the assignment into the Image File Wrapper for the application prior to forwarding the assignment to the Assignment Recordation Branch. If the box is not checked, the USPTO would merely forward the assignment to the Assignment Recordation Branch without scanning it into the Image File Wrapper.

It is evident that the proposed system is complicated and will likely lead to clerical mistakes by applicants and/or the USPTO in scanning, filing, uploading and/or forwarding the assignment to the Assignment Recordation Branch, thus increasing the burden on all parties involved.

ii. The USPTO Should Finally Update PAIR

The USPTO appears to recognize the burden that will result from its proposed system, due to the current procedures for handling assignment documents. In fact, the USPTO states that, while it has considered automatically scanning an assignment into the Image File Wrapper, it believes that "applicants should be provided with the option of submitting an assignment only for recordation purposes without such assignment becoming part of the Image File Wrapper." *See* Fed. Reg., Vol. 77 at p. 991, second column. However, there is absolutely no supporting basis or rationale for this statement. Furthermore, it is directly contradicted by the USPTO's ensuing statement that "[i]t is the intention of the Office to develop a system whereby one submission of an assignment can be electronically treated for the dual purpose." *Id.* It also highlights the fact that while recorded assignments are public records, they are very difficult to access through the Assignment Recordation Branch and could be made far more accessible to the public by scanning them into the Image File Wrapper.

Rather than imposing further complicated procedures, the USPTO should update its systems to provide more convenient access to assignments that are recorded in accordance with the statutory scheme of 35 U.S.C. §261. Recorded assignment documents are public records that

are accessible at substantial burden and cost only by physically traveling to the USPTO. Therefore, they should be made available on the USPTO website, just like any other documents that are scanned by the USPTO. They should be directly linked to the patent information in PAIR, similarly to trademark assignments being available along with trademark information in the USPTO's TESS and TARR systems, which directly link to assignment information and copies (if any).

Updating PAIR in this way would further avoid errors in printed patents by eliminating the redundant separate presentation of assignment information in assignment recordations and Issue Fee Transmittals. By correlating assignment information in the assignment recordation database with the printing process through PAIR, assignee information could and should be automatically printed on the patent and publication, if at all, based on the information already in the USPTO records about recorded assignments.

The USPTO even states that it intends to develop a system whereby one submission of an assignment can be electronically treated for the dual purpose. *See* Fed. Reg., Vol. 77 at p. 991, second column. We urge the USPTO not to hesitate any longer and to do so by the effective date of the proposed rules.

d. No New Declaration Required in Continuing Applications Where an Earlier-Filed Declaration Contains the Required Statements of Amended §115

Amended §115(g) provides that the declaration requirements of amended §115(a) do not apply to an individual with respect to an application for patent in which the individual is named as the inventor or a joint inventor and who claims the benefit under section 120, 121, or 365(c) of the filing of an earlier-filed application, if a declaration meeting the requirements of subsection (a) was executed by the inventor filed in connection with the earlier filed application, or if a substitute statement or assignment meeting the requirements of §115(d) or (e) was filed in the earlier-filed application.

i. Compliance With "This Section" Must be Clarified to Mean "This Section as Amended"

Proposed rule 1.63(d)(1)(i) provides that a newly executed oath or declaration in an application claiming priority under the above sections is not required in a later-filed application where the declaration in the earlier-filed application is compliant with §1.78, provided that "[a]n executed oath or declaration in compliance with this section was filed in the earlier-filed application." This provision does not address applications that bridge the effective date (September 16, 2012).

Specifically, what if the earlier-filed application contains a declaration "in compliance" with the then-current rule 1.63? The language employed in the proposed rule suggests that a copy of such a declaration could be submitted in the continuing application, without the need for a newly executed declaration. However, this is not permitted by amended §115.

Amended §115(g) states that a new declaration will not be required of an individual who is named as the inventor or a joint inventor and who claims the benefit under section 120, 121, or 365(c) of the filing of the earlier-filed application, if a declaration meeting the requirements of amended §115(a) was executed in the earlier-filed application. To satisfy the requirements of amended §115(a), the earlier-filed application must contain the "required statements" of amended §115(b).

Thus, the USPTO should further revise rule 1.63 to clarify that, in order for the exception of not requiring a newly executed declaration in a continuing application under amended §115(g) to apply, the declaration executed and filed in the earlier filed application must be in compliance with the requirements of rule 1.63 as amended to incorporate provisions of amended §115.

ii. Statutory Interpretation Required to Determine How a Declaration in an Earlier-Filed Application Satisfies the Requirements of Amended §115(g)

Amended §115(g) provides that a new declaration will not be required for an individual who is named as the inventor or a joint inventor and who claims the benefit under section 120, 121, or 365(c) of the filing of the earlier-filed application, if a declaration meeting the requirements of amended §115(a) was executed by the individual and was filed in connection with the earlier-filed application. To satisfy the requirements of amended §115(a), the earlier-filed application must contain the required statements of amended §115(b), which are:

- (a) "the application was made or was authorized to be made by the affiant or declarant;" and
- (b) "such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application."

Thus, and as further discussed below, Congress intended that, if an earlier-filed declaration was true as to the original application, was executed by the inventor, and was filed in the original application, and the continuing application claims benefit to the original application under section 120, 121, or 365(c), a copy of that declaration may be used in that continuing application without restrictions. This statutory scheme reflects the paradigm shift accomplished by the AIA and, specifically, is in line with the simplification objectives of Congress.

**1. The USPTO Narrowly
and Improperly Interprets the
Requirements of Amended §115(g)**

The USPTO explains that proposed rule 1.63 permits the use of copies of declarations from prior-filed applications in continuation-in-part (CIP) applications "where appropriate," in addition to the currently permitted continuation and divisional applications. *See* Fed. Reg., Vol. 77 at p. 991, third column. Thus, proposed rule 1.63 employs the term "continuing" to cover continuation, divisional, and CIP applications, and provides that new declarations will not have to be executed in such continuing applications with respect to any individual who executed a declaration meeting the requirements of "this section" (*see* discussion above regarding necessary clarification) in the earlier-filed application.

The USPTO explains that the revisions to rule 1.63 reflect the "breadth of the language utilized by [amended §115]." *Id.* However, while the USPTO states that its interpretation reflects the breadth of the language utilized in amended §115 above, the USPTO limits the use of copies of an earlier-filed declaration in continuing applications by incorporating additional requirements into the proposed rule.

Specifically, proposed rule 1.63(a)(4) and (a)(6) requires that the required statements of amended §115(b) must be applicable to the "application for which the oath or declaration is being submitted," which the USPTO interprets to include any continuing application for which a copy of the declaration is being submitted. Thus, under proposed rule 1.63, the exception of amended §115(g) will apply to continuing applications only if the statements made in the earlier-filed declaration also hold true for the continuing application for which a copy of the earlier-filed declaration is being submitted.

**a. Demonstrative Example
Employing the USPTO's
Narrow Statutory Interpretation**

In light of the above statutory provision, we demonstrate the ambiguity resulting from the USPTO's erroneous interpretation of amended §115(g) by applying the USPTO's interpretation to the foreseeable scenario below.

Take, for example, the following scenario:

- An original application discloses inventions A and B, and claims only invention A.
- A continuing (CIP) application with the same inventor(s) claiming §120 benefit of the original application discloses inventions A, B, and C, and claims either: (1) invention B, or (2) invention C.

b. The USPTO's Proposed Interpretation is Ambiguous

As we understand the USPTO's comments, in the above identified example, a copy of the declaration from the original application (i.e., the "earlier-filed declaration") could be filed in the CIP application only if, by the continuing application filing date² the following statements would also hold true with respect to the CIP application:

- (a) the inventor has made or authorized the filing of the CIP application (even though that was not true when the inventor signed the earlier-filed declaration);
- (b) the inventor believes himself to be the original inventor of (1) invention B, or (2) invention C (even though the earlier-filed declaration did not refer to invention B or invention C, as inventions B and C were not "claimed," and invention C may not even have been made when the inventor signed the earlier-filed declaration); and
- (c) the inventor has reviewed and understands the content of the CIP application³ (even though it did not exist at the time that he signed the earlier-filed declaration).

For reasons discussed below, the USPTO's suggested limitations on when a copy of an earlier-filed declaration may be used in a continuing application are ambiguous and improper in view of the statutory requirements of amended §115(g).

Under the USPTO's proposed interpretation of amended §115(g), the USPTO has not commented regarding who must make the above factual determination regarding the suggested limitations/statements (a)-(c), which would not have been made in the earlier-filed declaration that was signed and filed in the original application. In addition, the USPTO has not commented regarding who, if anyone, would have to make a statement that the statements (a)-(c) above are true (a statement that clearly was not made by the inventor in the earlier-filed declaration).

A more coherent interpretation, using the USPTO's interpretation that the declaration must apply to the continuing application, would be that a copy of the original declaration could only be used for continuing applications (continuation, divisional, or CIP) in which the invention disclosed and claimed in the continuing application was also disclosed and claimed in the original application.

² The comments are not clear on whether the "time of filing" applies to the continuation application filing date or to the date of filing the copy of the declaration, which could be later.

³ This required statement is not mandated by the statute, and seems inappropriate as to a CIP application using a copy of the declaration from the parent application.

Thus, returning to the example above, for an original application disclosing inventions A and B, and claiming only invention A, a copy of the earlier-filed declaration could not be used in a CIP application claiming invention B or invention C. However, if the original application claimed both inventions A and B, but the claims to B were canceled, then the earlier-filed declaration could be filed in the CIP application with claims to invention B, but still not with claims to invention C, as invention C was not disclosed and claimed in the original application.

This interpretation, however, seems to conflict with the AIA's goal of simplification. For example, currently, a copy of a declaration can be used in a continuing application disclosing and claiming invention B based on an original application that disclosed inventions A and B, but only claimed invention A. Thus, by this interpretation, the requirements have become more, rather than less, demanding and inconvenient.

**c. Whether or Not
Revised as Above, the
USPTO's Interpretation
is Contrary to Amended §115(g)**

Whether or not the USPTO's proposed interpretation is clarified to be more coherent, as suggested directly above, the general interpretation limiting the use of copies of earlier-filed declarations in continuing applications is contrary to the clear statutory language of §115(g)(1)(A)⁴, which states (with emphasis added):

The requirements under this section shall not apply to an individual with respect to an application for patent in which the individual is named as the inventor or a joint inventor and who claims the benefit under section 120, 121, or 365(c) of the filing of an earlier-filed application if ... an oath or declaration meeting the requirements of subsection (a) was executed by the individual and was filed in connection with the earlier-filed application.

In other words, amended §115(g) requires that the declaration was true as to the original application and was executed and filed in it, and the continuing application claims benefit to the original application under section 120, 121, or 365(c). Thus, if the inventor is willing to claim benefit (and thus limit his patent term based on the filing date) of a prior application, and the inventor properly executed a declaration in the prior application, a copy of that declaration may be used in the continuing application regardless of any overlap among the inventions disclosed and claimed in the two applications.

⁴ The same applies to situations where a substitute statement meeting the requirements of amended §115(d) or an assignment meeting the requirements of amended §115(e) was filed in the original application. *See* amended §115(g)(1)(B)-(C).

While this may seem extreme and unusual under pre-AIA paradigms, it clearly meets goals of the AIA to simplify and streamline the requirements for declarations. If the USPTO thinks that such a statutory scheme is not appropriate, it should urge Congress to change it, rather than ignoring the clear statutory language of amended §115.

iii. Exception Also Applies if Earlier-Filed Application Contained a Substitute Statement or an Assignment Under Amended §115(d) or (e)

With respect to the exception of not requiring new declarations in "continuing" applications, proposed rule 1.63 only addresses the exception provided in §115(g)(1)(a), where an oath or declaration meeting the requirements of amended §115(a) was executed in the application to which benefit is claimed. The proposed rule fails to address the exceptions provided for in §115(g)(1)(b) and (c), which state that no new declaration need be filed where a substitute statement (under §115(d)) or an assignment (under §115(e)) meeting the statutory requirements was filed in the application to which benefit is claimed.

Provisions addressing these exceptions should be added, to ensure that no new declaration will be required of an individual who satisfied the requirements of amended §115 through a substitute statement or an assignment in the earlier-filed application.

iv. Clarification Regarding Reference to Declaration Includes an Assignment

The USPTO states that rule 1.63(c)(2) is proposed to provide that any reference to an oath or declaration pursuant to §1.63 would include the assignment as provided for in §1.63. *See* Fed. Reg., at p. 991, second column, last paragraph. This statement should be corrected for grammatical clarity, as it is unclear how a reference would include an assignment.

2. Rule 1.64

Rule 1.64 concerns the persons executing the declaration. As is clear from amended §115, only an inventor or joint inventor may execute the inventor's declaration.

a. "Actual" Inventors

Section (a) of rule 1.64 not amended and states that the declaration "must be made by all of the actual inventors, except as provided for in §§ 1.42, 1.43, 1.47, or 1.67." The section should be revised to employ the statutory language of amended §115, i.e., "each individual who is the inventor or a joint inventor of a claimed invention."

**b. Person Who is Not the Inventor
May Not Execute the Inventor's Declaration**

As previously discussed, amended §115 unmistakably requires that the declaration be executed by an inventor or a joint inventor. However, rule 1.64(b) states that "[i]f the person making the oath or declaration or any supplemental oath or declaration is not the inventor, the declaration shall state" This statement is contrary to amended §115, which does not provide for any situation in which a person that is not the inventor would be making the declaration or a substitute declaration. Amended §115 provides for "substitute statements" in lieu of a declaration if an inventor cannot or refuses to sign a declaration.

Thus, section (a) should be amended to remove reference to rules 1.42, 1.43, and 1.47, which are directed to persons who may apply for patent (i.e., who may be the "applicant"), rather than persons who may sign a declaration.

**c. Provisions Regarding Persons Executing
Substitute Statement or Assignment are Required**

Rule 1.64 should be amended to address the provisions of amended §115(d) and (e). Specifically, section (d) permits an applicant to file a "substitute statement" in lieu of the inventor's declaration in appropriate circumstances. The permitted circumstances reflect the situations addressed by rules 1.42, 1.43, and 1.47. Therefore, the reference to sections 1.42, 1.43, and 1.47 in section (a), which is not amended in the proposed rule, should instead be moved into a provision that addresses such situations as permitted circumstances for an applicant to file a substitute statement.

d. Residence

In addition to suggesting that persons other than the inventor may sign the declaration, rule 1.64 also requires that such persons provide their mailing address and residence. Assuming that the rule is revised to correct the critical error of permitting non-inventors to sign an inventor's declaration, the "residence" requirement should also be removed. For the reasons discussed above with respect to proposed rule 1.63, the "residence" provides no useful information to the USPTO, and only causes problems and confusion for inventors attempting to file a declaration.

3. Rule 1.67

Rule 1.67 addresses situations where the declaration is deemed noncompliant. In accordance with the simplification objectives of Congress, amended §115(h)(2) states that "[i]f an individual has executed an oath or declaration meeting the requirements of subsection (a) or an assignment meeting the requirements of subsection (e) with respect to an application for

patent, the Director may not thereafter require that individual to make any additional oath, declaration, or other statement equivalent to those required by this section."

Proposed rule 1.67 states that deficiencies or inaccuracies relating to fewer than all of the inventors or applicants may be corrected with an oath or declaration identifying the entire inventive entity, but signed only the inventor to whom the error relates.

By referencing inaccuracies relating to the "applicants," it appears that this rule is, like the others, infiltrated with the USPTO's critical misconception that a declaration may be made by someone other than the inventor. It is unclear how a deficiency or inaccuracy relating to fewer than all of the applicants could be cured by an inventor's declaration.

Furthermore, amended §115 nowhere requires that a declaration list the entire inventive entity. Instead, §115 states that each inventor shall execute a declaration attesting to that inventor's inventorship. This requirement is therefore improper.

c. Reissue Oaths and Declarations

i. Rules Affected

The following rules fall under the general heading of Reissues:

- §1.171 (Application for reissue)
- §1.172 (Applicants, assignees)
- §1.173 (Reissue specification, drawings, and amendments)
- §1.175 (Reissue oath or declaration)
- §1.176 (Examination of reissue)
- §1.177 (Issuance of multiple reissue patents)
- §1.178 (Original patent; continuing duty of applicant)

ii. Discussion of Proposed Rules

1. Rule 1.172

Rule 1.172 currently states that a reissue declaration must be made by the inventor or inventors except as provided for in rules 1.42, 1.43, and 1.47, and must be accompanied by the written consent of all assignees. The exceptions of rules 1.42, 1.43, and 1.47 are discussed above, and should now be applied as permitted circumstances for filing a substitute statement, rather than when someone other than the inventor may sign the inventor's declaration.

a. Title

Proposed rule 1.172 amends the title to delete the duplicative reference to assignee, recognizing that assignees may be an applicant for patent. However, the title should be amended to include reference to "inventor" because the term inventor is no longer synonymous with "applicant."

b. Improper References to Who May Sign Declaration

Proposed rule 1.172 distinguishes between who may sign the reissue oath or declaration for a non-broadening reissue (*see* (b)(1)(i)-(iii)) versus a broadening reissue (*see* (b)(2)(i)-(ii)). Specifically, the USPTO proposes that, in the case of broadening reissue filed on or after September 16, 2012, an assignee of the entire interest could sign the reissue declaration if the application for the original patent was filed by the assignee of the entire interest. In this regard, the USPTO further states "i.e., the oath or declaration was execute by the assignee under §1.42 or §1.47." *See* Fed. Reg., Vol. 77 at p. 994, first column. Throughout the commentary, the USPTO refers to the assignee of the entire interest that was the applicant in the issued patent as necessarily being the entity that executed the declaration in the prior patent.

As previously discussed, an assignee may not sign the inventor's declaration. An assignee may, however, provide a "substitute statement." Thus, the rule should be amended to clarify that the assignee must have been the "applicant," without the requirement that the assignee also executed the declaration, in the original patent.

2. Rule 1.175

Rule 1.175 concerns reissue declarations. The proposed changes incorporate requirements that the reasons or errors relied upon as basis for reissue be present in the reissue declaration, as well as to distinguish who can sign the reissue oath or declaration based on whether a claim is broadened in any respect. *See* Fed. Reg., Vol. 77 at p. 994, first column.

a. Reissue Declaration Must Comply With Rule 1.63

Proposed rule 1.175(a) states that "in addition to complying with the requirements of §1.63, [the reissue declaration] must also specifically identify at least one error." The requirements of rule 1.63 are discussed above. In view of amended §115 (which governs the provisions of rule 1.63), rule 1.175 cannot permit the signing of a declaration by an assignee, or any other entity that is not the inventor.

Due to the USPTO's critical error in, for example, distinguishing between "inventor's declaration" and "substitute statement" in rule 1.63, similarly erroneous provisions are incorporated into proposed rule 1.175. Furthermore, rule 1.175 repeatedly requires that the

assignee of the entire interest have executed the declaration in the issued patent. While the assignee may have been the "applicant" in a prior application under amended §118, the assignee cannot have executed the declaration (on or after the effective date). Thus, substantial revisions of rule 1.175 are necessary to address the issues discussed above with respect to rule 1.63.

b. Identification of Error in Declaration

Proposed rule 1.175 is amended to require that the reissue oath or declaration identify an error that is being relied upon or corrected. It is unclear why the USPTO proposes requiring identification of at least one error being relied upon as the basis for reissue to be present in the declaration. It appears that the purpose would be better served, as well as much less burdensome, if such an error could be identified by the attorney of record.

c. Identification of a Broadened Claim

Proposed rule 1.175(b) requires identification of a broadened claim and is further amended to clarify that a claim broadened in any respect must be treated and identified as a broadened claim. However, the legal conclusion that a claim is broadened may not be apparent to the applicant, or even believed to be true by the applicant in many cases, and is not a fact to which an applicant is qualified to attest.⁵

The USPTO must recognize that the law is replete with cases in which the very issue in dispute was whether a claim was broadened or not. Examiners, applicants, and even judges on the same bench often disagree on whether claim broadening exists. For example, a panel of the Federal Circuit has held that the cancellation of a claim may constitute broadening of another claim, and that claim scope may be narrowed even though claims are not amended. *See, e.g., Marine Polymer Techs. Inc. v. HemCon Inc.*, 659 F.3d 1084 (Fed. Cir. 2011). Thus, the requirements for identifying whether a claim is broadened should be eliminated, particularly as a requirement of an inventor's declaration, as it is a legal determination to be made by the Examiner, rather than by an applicant who may be unable to determine such a complex legal issue.

d. Prosecution of Application

i. Current Rules

The current rules are based on the premise that the inventor is the applicant for a patent, under previous §118 and §115. Specifically, under the current rules, a power of attorney is given

⁵ Claim construction is a matter of law, not fact. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

by a principal to a patent practitioner, the "principal" meaning either an applicant for patent or an assignee.

ii. Discussion of Proposed Rule

1. Rule 1.33

Proposed rule 1.33 includes a new provision (f) that states that "an assignee may only conduct prosecution of an application in accordance with §1.31 and §3.71." Rule 1.31 states that an applicant may file and prosecute his or her own case, or may give a power of attorney to a practitioner. Under amended §118, the assignee may easily apply for a patent and thus be the "applicant." However, the reference to §3.71 appears unnecessary. Specifically, under amended §118, assignees are able to be the applicant for a patent, without restriction. Thus, no restrictions should be placed on assignees with respect to the prosecution of an application other than that corporate entities act through a registered practitioner.

e. Application Data Sheet

i. Relevant Statutory Provisions

Amended §120 states, *inter alia*:

An application for patent for an invention disclosed ... in an application previously filed in the United States, or as provided by section 363 ... shall have the same effect, as to such invention, as though filed on the date of the prior application, if ... it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director.

Additionally, according to amended §111, the required components of an "application for patent," as provided in §111, are still only (1) a specification, (2) drawings (if any), and (3) a declaration.

ii. Rules Affected

Rule 1.76 concerns the Application Data Sheet, and rule 1.78 concerns requirements for claiming benefit of an earlier filing date. Thus, the rules are related because the USPTO is proposing to require that any claim for foreign priority be provided in the Application Data Sheet. However, for reasons discussed below, rule 10.23 must also be considered, as compliance with the USPTO's proposals would likely result in violations of that rule.

iii. Discussion of Proposed Rule**1. Rule 1.76**

Proposed rule 1.76 requires that a claim for priority be included in an Application Data Sheet. The proposed rule further clarifies that, after an application has been filed, a "supplemental" application data sheet, rather than an application data sheet, will be required. However, the USPTO's rationale for the clarification is troubling, as the USPTO repeatedly states that "the application data sheet becomes or is considered part of the application as filed. *See* Fed. Reg., Vol. 77 at p. 993, first column.

In making the above statements, the USPTO further states that such an application data sheet that becomes part of the application must thus not be signed by the applicant. *Id.* Instead, the USPTO states that the Application Data Sheet or Supplemental Data Sheet must be signed in accordance with §1.33(b) (which allows a registered patent practitioner of record to sign certain documents or amendments). *Id.*

a. Considering the Application Data Sheet to be Part of the Application Would Inevitably Result in a Practitioner Engaging in "Misconduct"

Proposed rule 1.63(a)(6) requires that "the person making the oath or declaration has reviewed and understands the contents of the application." Per §120, the contents of an application include the specification, drawings, and the declaration being signed. Notably, the Application Data Sheet is not "part" of the application.

Rule 10.23 which governs practitioner misconduct, states that conduct which constitutes a violation includes "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." *See* rule 10.23(c)(11).

The Application Data Sheet is generally not reviewed by an inventor executing the declaration. The USPTO appears to be aware of this fact, as it even states that the Application Data Sheet "must not" be signed by an inventor. *See* Fed. Reg., Vol. 77 at p. 993, first column. However, it is confusing why, if the USPTO is now erroneously considering the Application Data Sheet as part of the application, it goes on to repeatedly state that the inventor "therefore" must not sign it.

Furthermore, if the Application Data Sheet is being improperly considered "part" of the application, the filing of the Application Data Sheet by a practitioner after execution of the inventor's declaration would appear to qualify as "misconduct" under rule 10.23. Thus, the

USPTO must revise its statements, as the Application Data Sheet is not and should not be considered part of the application.

b. Amended §120 Still Requires Claim for Benefit in the Application

Even though the USPTO may request that any benefit and/or foreign priority claim be presented in the Application Data Sheet for an application claiming such priority, the USPTO ignores the statutory requirement of amended §120, which still requires claims for §120 benefit to be made in the application. Specifically, amended §120 requires that "[a]n application ... contains or is amended to contain [the benefit claim]."

Proposed rule 1.76(d) states that an amendment to the specification with respect to a priority claim will not govern over a foreign priority claim or benefit claim in the application data sheet. However, per §120, the application (i.e., the specification, drawings, or declaration) must contain or be amended to contain any §120 benefit claim.

Therefore, while the USPTO is desirous of receiving all priority claims in Application Data Sheets or Supplemental Application Data Sheets, it must still recognize that such information is statutorily required to be present in the application. If any inconsistencies arise between information in an Application Data Sheet and the specification with respect to priority claims, the USPTO should ensure that the application includes the correct priority claim information. To do so, the USPTO should construe an identification of §120 benefit information in an Application Data Sheet as an instruction to amend the application to include that information if it is not already present, or to replace such information in the specification if it is inconsistent.

c. Application Data Sheet Should Identify the "Applicant"

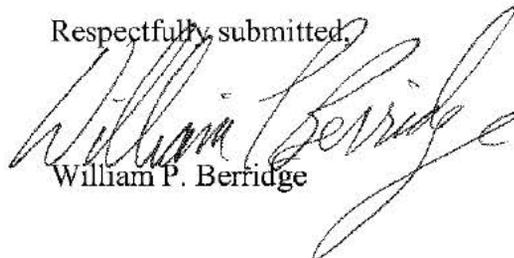
As discussed above under IV(a)(iii)(1)(a), we recommend that the USPTO consider including a new section heading in the Application Data Sheet as a method for identifying the "applicant."

Proposed rule 1.76(a) maintains previous section (b), which lists necessary bibliographic data to be present in an Application Data Sheet, including "applicant information." However, this heading is based on rule 1.41(a), which retains the incorrect notion that the "inventor" is still always the "applicant." Under amended §118, the applicant may and often will be the assignee or obligated assignee. Additionally, a person who otherwise shows sufficient proprietary interest in the matter may also be the applicant under amended §118.

The USPTO's failure to amend the rules to provide provisions allowing for a simple identification of the "applicant," as distinguished from the "inventor," is repeatedly emphasized in the commentary above. While revisions to the proposed rules are necessary to address the general distinction between "inventor" and "applicant" made by the AIA, a simple method of identifying the "applicant" is also necessary. Because the USPTO requires all bibliographic data, as well as inventor and foreign priority information, in an Application Data Sheet, we believe this would be the appropriate form in which to also require the "applicant" information, without posing any additional burden on applicants or the USPTO.

We further stress the importance of the USPTO providing a simple and efficient methodology for identifying the "applicant" in view of the "substitute statement" provision of amended §115(d). Because a substitute statement is permitted for an "applicant" in lieu of a declaration in permitted circumstances listed in amended §115(d)(2), it would further streamline and simplify the process for filing such a substitute statement if the "applicant" status of an entity making the substitute statement was established from the start and, thus, immediately evident.

Respectfully submitted,



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