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Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act; Final Rule

**DEPARTMENT OF COMMERCE****Patent and Trademark Office****37 CFR Parts 1, 3, 5, 10, and 41**

[Docket No.: PTO-P-2011-0074]

RIN 0651-AC68

**Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

**SUMMARY:** The United States Patent and Trademark Office (Office) is revising the rules of practice to implement the inventor's oath or declaration provisions of the Leahy-Smith America Invents Act (AIA). The AIA permits a person to whom the inventor has assigned, or is under an obligation to assign, the invention, or who otherwise shows sufficient proprietary interest in the matter, to make the application for patent. The AIA also streamlines the requirements for the inventor's oath or declaration, and permits a substitute statement in lieu of an oath or declaration in certain circumstances. The Office is revising the rules of practice relating to the inventor's oath or declaration, including reissue oaths or declarations, and substitute statements signed by a person other than an inventor, and to provide for assignments containing oath or declaration statements. Additionally, the Office is revising the rules of practice relating to the inventor's oath or declaration to allow applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance. Finally, to better facilitate processing of patent applications, the Office is revising and clarifying the rules of practice for power of attorney and prosecution of an application by an assignee.

**DATES: Effective Date:** The changes in this final rule take effect on September 16, 2012.

**Applicability Date:** The changes to 37 CFR 1.9, 1.12, 1.14, 1.17(g), 1.27, 1.32, 1.33, 1.36, 1.41, 1.42, 1.43, 1.45, 1.46, 1.53(f) and (h), 1.55, 1.56, 1.63, 1.64, 1.66, 1.67, 1.76, 1.78, 1.81, 1.105, 1.131, 1.153, 1.162, 1.172, 1.175, 1.211, 1.215, 1.321, 1.421, 1.422, 1.424, 1.431, 1.491, 1.495(a), (c), and (h), 1.497, 3.31, 3.71, 3.73, and 41.9, and the removal of 37 CFR 1.47 and 1.432, apply only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012.

**FOR FURTHER INFORMATION CONTACT:**

Hiram H. Bernstein ((571) 272-7707), Senior Legal Advisor; or Eugenia Jones ((571) 272-7727), Senior Legal Advisor; or Terry J. Maciejewski ((571) 272-7730), Technical Writer-Editor, Office of Patent Legal Administration, directly by telephone, or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of the Hiram H. Bernstein.

**SUPPLEMENTARY INFORMATION:**

*Executive Summary: Purpose:* Section 4 of the AIA amends the patent laws to change the practice regarding the inventor's oath or declaration and filing of an application by a person other than the inventor. Section 20 of the AIA amends the patent laws to remove the "without any deceptive intention" provisions. This final rule revises the rules of practice to implement these provisions of sections 4 and 20 of the AIA. The changes in sections 4 and 20 of the AIA take effect on September 16, 2012, and apply to patent applications filed, or proceedings commenced, on or after September 16, 2012.

*Summary of Major Provisions:* The Office is revising the rules of practice to permit a person to whom the inventor has assigned or is under an obligation to assign an invention to file and prosecute an application for patent as the applicant, and to permit a person who otherwise shows sufficient proprietary interest in the matter to file and prosecute an application for patent as the applicant on behalf of the inventor. Formerly, a person to whom the inventor had assigned an invention could file and prosecute an application for patent, but the inventor was considered the applicant. The Office is also revising the rules of practice to require that juristic entities take action in a patent application via a registered practitioner.

The Office is revising the rules of practice to eliminate a number of former requirements pertaining to the inventor's oath or declaration and correction of inventorship. The Office is revising the rules of practice to permit applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance. The Office is revising the rules of practice to provide for the filing of a substitute statement in lieu of an oath or declaration by an inventor if the inventor is deceased, under legal incapacity, or cannot be found or reached after diligent effort, or is under an obligation to assign the invention but has refused to execute an oath or declaration.

The Office is also revising the rules of practice to remove the provisions which set forth "without any deceptive intention" requirements. The Office is further revising the rules pertaining to reissue practice to eliminate the requirement for a supplemental reissue oath or declaration, and to require that the inventor's oath or declaration identify a claim that the application seeks to broaden if the reissue application seeks to enlarge the scope of the claims of the patent.

The Office is also revising the rules of practice to harmonize the practice regarding foreign priority claims with the practice regarding domestic benefit claims by requiring that both foreign priority claims and domestic benefit claims be set forth in an application data sheet.

*Costs and Benefits:* This rulemaking is not economically significant as that term is defined in Executive Order 12866 (Sept. 30, 1993).

*Background:* The AIA was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 284 (2011). Section 4 of the AIA amends 35 U.S.C. 115 and 118 to change the practice regarding the inventor's oath or declaration and filing of an application by a person other than the inventor. See 125 Stat. at 293-94. Section 20 of the AIA amends 35 U.S.C. 116, 184, 251, and 256 (and other sections) to remove the provisions which set forth a "without any deceptive intention" requirement. See 125 Stat. at 333-34. This final rule revises the rules of practice to implement the provisions of section 4 of the AIA and to remove the "without any deceptive intention" language due to the changes to 35 U.S.C. 116, 184, 251, and 256 in section 20 of the AIA.

Section 4(a) of the AIA amends 35 U.S.C. 115 to change the requirements for the inventor's oath or declaration as follows.

Amended 35 U.S.C. 115(a) provides that an application filed under 35 U.S.C. 111(a) or that commences the national stage under 35 U.S.C. 371 must include, or be amended to include, the name of the inventor for any invention claimed in the application. 125 Stat. at 293. 35 U.S.C. 115(a) also provides that, except as otherwise provided in 35 U.S.C. 115, each individual who is the inventor or a joint inventor of a claimed invention in an application must execute an oath or declaration in connection with the application. 125 Stat. at 293-94.

Amended 35 U.S.C. 115(b) provides that an oath or declaration under 35 U.S.C. 115(a) must contain statements that the application was made or was authorized to be made by the affiant or

declarant, and the individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application. 125 Stat. at 294. There is no longer a requirement in the statute that the inventor must state his country of citizenship or that the inventor believes himself or herself to be the “first” inventor of the subject matter (process, machine, manufacture, or composition of matter) sought to be patented.

Amended 35 U.S.C. 115(c) provides that the Director may specify additional information relating to the inventor and to the invention that is required to be included in an oath or declaration under 35 U.S.C. 115(a). *Id.*

Amended 35 U.S.C. 115(d)(1) provides that, in lieu of execution of an oath or declaration by an inventor under 35 U.S.C. 115(a), the applicant for patent may provide a substitute statement under the circumstances described in 35 U.S.C. 115(d)(2), and such additional circumstances as the Director specifies by regulation. *Id.* 35 U.S.C. 115(d)(2) provides that an applicant may provide a substitute statement where an inventor is unable to file the oath or declaration under 35 U.S.C. 115(a) because the individual is deceased, under legal incapacity, or cannot be found or reached after diligent effort, or an individual is under an obligation to assign the invention but has refused to make the oath or declaration required under 35 U.S.C. 115(a). *Id.* Therefore, while an assignee, a person under an obligation to assign the invention (an “obligated assignee”), or a person who otherwise shows sufficient proprietary interest in the matter may make an application for patent as provided for in 35 U.S.C. 118, an oath or declaration (or an assignment containing the required statements) by each inventor is still required, except in the circumstances set forth in 35 U.S.C. 115(d)(2) and in any additional circumstances specified by the Director in the regulations. The contents of a substitute statement are set forth in 35 U.S.C. 115(d)(3). Specifically, 35 U.S.C. 115(d)(3) provides that the substitute statement must identify the individual with respect to whom the statement applies, set forth the circumstances for the permitted basis for filing the substitute statement in lieu of the oath or declaration under 35 U.S.C. 115(a), and contain any additional information, including any showing, required by the Director. *Id.*

Amended 35 U.S.C. 115(e) provides for making the statements required under 35 U.S.C. 115(b) and (c) in an assignment of record and specifically permits an individual who is under an

obligation of assignment of an application to include the required statements in the assignment executed by the individual, in lieu of filing the statements separately. *Id.*

Amended 35 U.S.C. 115(f) provides that a notice of allowance under 35 U.S.C. 151 may be provided to an applicant only if the applicant has filed each required oath or declaration under 35 U.S.C. 115(a), substitute statement under 35 U.S.C. 115(d), or recorded assignment meeting the requirements of 35 U.S.C. 115(e). *Id.*

The changes to 35 U.S.C. 115 in the AIA do not affect 35 U.S.C. 111(a)(2), which continues to require that an application filed under 35 U.S.C. 111(a) include an oath or declaration as prescribed by 35 U.S.C. 115, and 35 U.S.C. 111(a)(3), which continues to permit the oath or declaration to be submitted after the filing date of the application, but within such period and under the conditions prescribed by the Director, including payment of the currently charged surcharge. *See* 35 U.S.C. 111(a)(2)(C) and (a)(3), and 37 CFR 1.16(f). Likewise, 35 U.S.C. 371(c) continues to require an oath or declaration complying with the requirements of 35 U.S.C. 115 for an international application to enter the national stage, and 35 U.S.C. 371(d) continues to require the oath or declaration to be submitted within the period prescribed by the Director, and with the payment of any surcharge required by the Director, if not submitted by the date of the commencement of the national stage. *See* 35 U.S.C. 371(c)(4) and (d).

Amended 35 U.S.C. 115(g)(1) provides that the requirements under 35 U.S.C. 115 shall not apply to an individual named as the inventor or a joint inventor in an application that claims benefit under 35 U.S.C. 120, 121, or 365(c) of an earlier-filed application, if: (1) An oath or declaration meeting the requirements of 35 U.S.C. 115(a) was executed by the individual and was filed in connection with the earlier-filed application; (2) a substitute statement meeting the requirements of 35 U.S.C. 115(d) was filed in connection with the earlier-filed application with respect to the individual; or (3) an assignment meeting the requirements of 35 U.S.C. 115(e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application. 125 Stat. at 294–95. 35 U.S.C. 115(g)(2) provides that the Director may still require a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed

application to be filed in the later-filed application. *Id.*

Amended 35 U.S.C. 115(h)(1) provides that any person making a statement under 35 U.S.C. 115 may withdraw, replace, or otherwise correct the statement at any time. 35 U.S.C. 115(h)(1) also provides that the Director shall establish regulations under which additional statements may be filed when a change is made in the naming of the inventor requiring the filing of one or more additional statements under 35 U.S.C. 115. *Id.* 35 U.S.C. 115(h)(2) provides that if an individual has executed an oath or declaration meeting the requirements of 35 U.S.C. 115(a) or an assignment meeting the requirements of 35 U.S.C. 115(e), then the Director may not require that individual to subsequently make any additional oath, declaration, or other equivalent statement in connection with the application or any patent issuing thereon. *Id.* 35 U.S.C. 115(h)(3) provides that 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 35 U.S.C. 115(h)(1). *Id.*

Amended 35 U.S.C. 115(i) provides that any declaration or statement filed pursuant to 35 U.S.C. 115 must contain an acknowledgement that any willful false statement made in the declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than 5 years, or both. *Id.* This is similar to the requirements in pre-existing 35 U.S.C. 25 for the use of a declaration in lieu of an oath in an Office proceeding. *See* 35 U.S.C. 25(b) (“Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001).”).

Section 4(a)(2) of the AIA amends 35 U.S.C. 121 to eliminate the sentence that provided for the Director to dispense with signing and execution by the inventor in a divisional application when the divisional application is directed solely to subject matter described and claimed in the original application as filed. *Id.* This amendment to 35 U.S.C. 121 is consistent with 35 U.S.C. 115(g)(1) because the inventor named in a divisional application would not need to execute an oath or declaration or equivalent statement for the divisional application regardless of whether the divisional application is directed solely to subject matter described and claimed in the original application.

Section 4(a)(3) of the AIA amends 35 U.S.C. 111(a) to insert “or declaration” after “oath.” *Id.*

Section 4(b)(1) of the AIA amends 35 U.S.C. 118 to change the practice regarding the filing of an application by a person other than the inventor. First, 35 U.S.C. 118 is amended to provide that a person to whom the inventor has assigned, or is under an obligation to assign, the invention may make an application for patent. 125 Stat. at 296. Second, 35 U.S.C. 118 is amended to provide 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. *Id.* Under amended 35 U.S.C. 118, the Director may continue to provide whatever notice to the inventor that the Director considers to be sufficient. *Id.* 35 U.S.C. 118 is also amended to provide that if a patent is granted on an application filed under 35 U.S.C. 118, the patent shall be granted to the real party in interest. *Id.* Amended 35 U.S.C. 116 (35 U.S.C. 116(b)) continues to provide that if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. *See* 35 U.S.C. 116(b). Likewise, 35 U.S.C. 117 continues to provide that 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. *See* 35 U.S.C. 117.

Section 4(b)(2) of the AIA amends 35 U.S.C. 251 to provide for the filing of a reissue application by an assignee of the entire interest if the application for the original patent was filed by the assignee of the entire interest. *Id.*

Section 4(c) of the AIA amends 35 U.S.C. 112 to change, *inter alia*, the undesignated paragraphs to subsections. *Id.* Section 4(d) makes conforming amendments to 35 U.S.C. 111(b) to make reference to the subsections of 35 U.S.C. 112. 125 Stat. at 296–97.

Section 4(e) of the AIA provides that the amendments made by Section 4 shall take effect on, and shall apply to any patent application filed on or after, September 16, 2012. 125 Stat. at 297.

Section 20 of the AIA amends 35 U.S.C. 116, 184, 251, and 256 to eliminate “without any deceptive intention” clauses from each portion of the statute. 125 Stat. at 333–34. Section

20 of the AIA provides that its amendments shall take effect on, and shall apply to proceedings commenced on or after September 16, 2012. 125 Stat. at 335. This change should not be taken as an endorsement for applicants and inventors to act with “deceptive intention” in proceedings before the Office. As discussed previously, 35 U.S.C. 115(i) requires that any declaration or statement filed pursuant to 35 U.S.C. 115 must contain an acknowledgement that any willful false statement made in the declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

*General Discussion Regarding Implementation:* The Office proposed changes and requested comments on the changes to the rules of practice to implement section 4 of the AIA in a notice of proposed rulemaking published in January 2012. *See Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR 982–1003 (Jan. 6, 2012) (notice of proposed rulemaking). The public submitted a number of comments suggesting that the Office take a more robust approach to implementing the changes in section 4 of the AIA, rather than shoehorn those provisions into existing Office practices. In this final rule, the Office is making a number of changes to the implementation of section 4 of the AIA in view of the input from the public.

*Changes Concerning Who May Apply for a Patent (the Applicant):* The Office took the position in the notice of proposed rulemaking that the change to 35 U.S.C. 118 did not permit the assignee to be the applicant except in the situations enumerated in 35 U.S.C. 115(d)(2). *See Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR at 983. The public submitted a number of comments suggesting that the changes to 35 U.S.C. 118 permit an assignee or an obligated assignee to be the applicant even in situations other than those enumerated in 35 U.S.C. 115(d)(2). The Office has revised the position taken in the notice of proposed rulemaking based on the public comments, and is now taking the position that the changes to 35 U.S.C. 115 and 118 permit an assignee to file an application for patent as the applicant.

35 U.S.C. 118, as amended by the AIA, permits (but does not require) a person to whom the inventor has assigned (assignee) or is under an obligation to assign (obligated assignee) the invention to make the application for patent. That section also permits a

person who otherwise shows sufficient proprietary interest in the matter to make an application for patent on behalf of, and as agent for, the inventor. The legislative history of the AIA makes clear that the change to 35 U.S.C. 118 is designed to: (1) Make it easier for an assignee to file a patent application; (2) allow obligated assignees (entities to which the inventor is obligated to assign the application) to file applications; and (3) allow a person who has a sufficient proprietary interest in the invention to file an application to preserve that person’s rights and those of the inventor. *See* H.R. Rep. 112–98, at 44 (2011). 35 U.S.C. 115, as amended by the AIA, still requires each inventor to execute an oath or declaration, except in the limited circumstances specified in 35 U.S.C. 115(d), even if the application has been filed by the assignee or an obligated assignee.

Traditionally, being the applicant (or the person who may “make the application”) under 35 U.S.C. chapter 11 has been synonymous with being the person who must execute the oath or declaration under 35 U.S.C. 115. However, 35 U.S.C. 115, as amended by the AIA, separates the applicant from the person who must execute the oath or declaration under 35 U.S.C. 115. Therefore, the Office now reads 35 U.S.C. 116, 117, and 118 in view of the public comment to specify the circumstances under which a person other than the inventor may be the applicant, but 35 U.S.C. 115 defines who must execute the oath or declaration that is required by 35 U.S.C. 115.

As the AIA distinguishes between the “applicant” and the person who must execute the oath or declaration under 35 U.S.C. 115, the Office is separating the regulations pertaining to being the applicant from the regulations pertaining to execution of the inventor’s oath or declaration. Specifically, the regulations pertaining to being the applicant are as follows: (1) 37 CFR 1.41 pertains to inventorship; (2) 37 CFR 1.42 pertains to the applicant for patent (which may be the inventor or may be the assignee); (3) 37 CFR 1.43 pertains to applications by the legal representative of a deceased or legally incapacitated inventor; (4) 37 CFR 1.45 pertains to joint inventors and applications by remaining joint inventors; and (5) 37 CFR 1.46 pertains to applications by the assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in the matter, or to applications in which the assignee has taken over prosecution to the exclusion of the inventor. The regulations pertaining to

the inventor's oath or declaration are as follows: (1) 37 CFR 1.63 pertains to an inventor's oath or declaration under 35 U.S.C. 115(a) or an assignment under 35 U.S.C. 115(e) that contains the statements required in an inventor's oath or declaration by the inventor or a joint inventor; and (2) 37 CFR 1.64 pertains to a substitute statement under 35 U.S.C. 115(d) if the inventor is deceased, is legally incapacitated, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration.

To further clarify the rules, and because of the statutory change from an inventor-applicant system to an assignee-applicant system, the Office explains the terms "applicant" and "assignee" as now used in the rules of practice. The term "applicant" means the inventor (all joint inventors collectively) if there is no assignee, or if the assignee has opted not to file (make) the application for patent and not to take over prosecution to the exclusion of the inventor. The term "applicant" means the assignee (or obligated assignee or person who otherwise shows sufficient proprietary interest in the matter) if the assignee (or obligated assignee or person who otherwise shows sufficient proprietary interest in the matter) has filed the application for patent, or if the assignee has taken over prosecution of the application to the exclusion of the inventor. The term "assignee" means the assignee of the entire right, title and interest in the application regardless of whether the assignee filed the application for patent or has taken over prosecution of the application to the exclusion of the inventor.

Under 35 U.S.C. 118, as amended, provides that where the Director grants a patent on an application filed under 35 U.S.C. 118 by a person other than the inventor, the Office must grant the patent to the real party in interest. Therefore, the Office is requiring applicants other than the inventor to notify the Office of any change in the real party in interest in a reply to a notice of allowance. Absent any such notification, the Office will presume no change has occurred and will grant the patent to the real party in interest of record.

The Office plans to continue to use the inventor's name for application and patent identification purposes as inventor names tend to provide a more distinct identification than assignee names.

*Changes to Oath or Declaration Practice:* The Office proposed in the notice of proposed rulemaking to require that an oath or declaration

include the names of all inventors, as well as the "reviewed and understands" and "duty to disclose" clauses formerly required by 37 CFR 1.63(b)(2) and (b)(3). *See Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR at 1000. The public submitted a number of comments suggesting that the Office should not require that an oath or declaration name all of the inventors or require any statements other than those required by 35 U.S.C. 115(b).

The Office is, in this final rule, streamlining a number of oath or declaration requirements (vis-a-vis both the proposed and former requirements) based upon the public comments. First, the Office is revising 37 CFR 1.63 to state that an inventor's oath or declaration need not indicate the name of each inventor if the applicant provides an application data sheet indicating the legal name, residence, and mailing address of each inventor. Second, the Office is revising 37 CFR 1.63 to eliminate the requirement that an inventor's oath or declaration state that the person executing the oath or declaration has reviewed and understands the contents of the application, and acknowledges 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. 37 CFR 1.63 will simply state that a person may not execute an oath or declaration for an application unless that person has reviewed and understands the contents of the application, and 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. Third, the Office is revising 37 CFR 1.63 to eliminate the requirements that any declaration under 35 U.S.C. 115 contain an acknowledgement that willful false statements may jeopardize the validity of the application or any patent issuing thereon, and that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true. Finally, since 35 U.S.C. 115 no longer contains a requirement that the inventor identify his country of citizenship, the Office will no longer require this information in the oath or declaration.

As revised by the AIA, 35 U.S.C. 115 (entitled "Inventor's oath or declaration") provides for an oath or declaration (35 U.S.C. 115(a)), substitute statement (35 U.S.C. 115(d)), and an assignment-statement (35 U.S.C. 115(e)), and any substitute statement or assignment-statement must contain a

willful false statements clause pursuant to 35 U.S.C. 115(i). The requirement for the willful false statements clause has the effect of making a substitute statement under 35 U.S.C. 115(d) or an assignment-statement under 35 U.S.C. 115(e) properly denominated as a "declaration." *See* previous discussion of 35 U.S.C. 115(i). Consistent with these statutory provisions, and the provisions of 35 U.S.C. 111(a) and 371(c) which require that an application contain an "oath or declaration" as prescribed by 35 U.S.C. 115 (*see* 35 U.S.C. 111(a)(2)(C) and 371(c)(4)), the Office is employing the phrase "inventor's oath or declaration" in the rules of practice to mean an oath or declaration as provided for in 35 U.S.C. 115(a), a substitute statement as provided for in 35 U.S.C. 115(d), or an assignment-statement as provided for in 35 U.S.C. 115(e).

Specifically, when the rules reference "an inventor's oath or declaration," it means an oath or declaration under 35 U.S.C. 115(a), substitute statement under 35 U.S.C. 115(d), or assignment-statement under 35 U.S.C. 115(e) executed by or with respect to an individual (whether the inventor or a joint inventor) for an application. The phrase "the inventor's oath or declaration" means the oaths or declarations under 35 U.S.C. 115(a), substitute statements under 35 U.S.C. 115(d), or assignment-statements under 35 U.S.C. 115(e) executed by the inventive entity. With respect to an application naming more than one inventor, any reference to "the inventor's oath or declaration" means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors, unless otherwise clear from the context.

The Office proposed in the notice of proposed rulemaking to continue the practice of requiring the inventor's oath or declaration before examination. *See Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR at 984-85. The public submitted a number of comments suggesting that the Office should not require the inventor's oath or declaration before an application is in condition for allowance. Based upon the public comments, the Office is providing in this final rule that applicants may postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance if the applicant provides an application data sheet before examination indicating the name, residence, and mailing address of each inventor. The Office will continue the

practice permitted by 35 U.S.C. 111(a)(3) of requiring a surcharge (currently \$130) to recover the cost of the special processing and additional notices for original (non-reissue) applications that are not complete on filing. If the applicant, however, provides a signed application data sheet providing the name, residence, and mailing address of each inventor, the Office will not require an additional fee beyond the surcharge simply to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

The Office indicated in the notice of proposed rulemaking that the Office needs to know who the inventors are prior to examination and that postponing the requirement for the inventor's oath or declaration until allowance would add to overall patent pendency. *See Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR at 984. The Office is proposing in a separate rulemaking an additional fee of \$1,000 (\$500 for a small entity, and \$250 for a micro entity) for a request to correct inventorship in an application after the first Office action on the merits to encourage reasonable diligence and a bona fide effort in ascertaining the actual inventorship and providing that information to the Office prior to examination. The Office is also considering proposing (in a separate rulemaking) changes to the patent term adjustments provisions of 37 CFR 1.704 (defining the circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application, and which result in a reduction of patent term adjustment) to ensure that applicants who delay the issuance of a notice of allowance under 35 U.S.C. 151 do not gain patent term adjustment as a consequence of their delay.

Applicants entering the national stage under 35 U.S.C. 371 from an international application under the Patent Cooperation Treaty (PCT) must be mindful of the patent term adjustment consequences of this course of action. The Office is changing its rules to provide that a PCT international application enters the national stage when the applicant files the fee required by 35 U.S.C. 371(c)(1) (the national fee provided in 35 U.S.C. 41(a)), and the documents required by 35 U.S.C. 371(c)(2) (a copy of the international application (unless not required under 35 U.S.C. 371(a) or already communicated by the International Bureau), and a translation into the

English language of the international application, if it was filed in another language)) within the period set in 37 CFR 1.495. The fourteen-month time frame in 35 U.S.C. 154(b)(1)(A)(i)(II) for issuing an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 is measured from "the date on which an international application fulfilled the requirements of section 371," which includes the filing of the inventor's oath or declaration. *See* 35 U.S.C. 371(c)(4). This process is discussed in detail in the Manual of Patent Examining Procedure (MPEP). *See* MPEP § 1893.03(b) (8th ed. 2001) (Rev. 8, July 2010).

*Changes Pertaining to Substitute Statements:* In the notice of proposed rulemaking, the Office proposed to require a petition with showings and a fee for applicants executing a substitute statement in lieu of an oath or declaration as required by former 37 CFR 1.47. *See Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR at 988–89, and 999. The public submitted a number of comments suggesting that the Office should not require proof or showings from applicants executing a substitute statement in lieu of an oath or declaration. The Office is in this final rule streamlining a number of proposed substitute statement requirements (vis-a-vis both the proposed and former requirements of 37 CFR 1.47) based upon the public comments. For an assignee or obligated assignee filing the application as the applicant, the final rule provides that the documentary evidence of ownership (e.g., assignment for an assignee, employment agreement for an obligated assignee) should be recorded as provided for in 37 CFR part 3 no later than the date the issue fee is paid in the application. For a person who otherwise shows sufficient proprietary interest in the matter to file the application as the applicant, the final rule provides that the showing of proprietary interest must be filed in the application, the fee set forth in 37 CFR 1.17(g) paid, and a petition granted before the person who has shown sufficient proprietary interest in the matter will be considered the applicant. The fee for persons who otherwise show sufficient proprietary interest in the matter is to recover the cost of the special processing and *Official Gazette* notice required for applications that are filed and prosecuted on behalf of the nonsigning inventor by a person who is not the assignee or obligated assignee.

The Office will also provide that an assignee, an obligated assignee, or a person who otherwise shows sufficient

proprietary interest in the matter who is the applicant may execute a substitute statement in lieu of an oath or declaration if the applicant identifies: (1) The circumstances permitting the person to execute the substitute statement in lieu of an oath or declaration (e.g., whether the nonsigning inventor cannot be reached after a diligent effort was made, or has refused to execute the oath or declaration); (2) the person executing the substitute statement with respect to the nonsigning inventor and the relationship of such person to the nonsigning inventor; and (3) the last known address of the nonsigning inventor.

*Changes Pertaining to Reissue Practice:* Consistent with the amendments made to 35 U.S.C. 115 and 251, the Office is revising reissue practice (vis-a-vis the former requirements) to: (1) Delete the requirement for a reissue inventor's oath or declaration to include a statement that all errors arose without any deceptive intent on the part of the applicant; (2) eliminate the requirement for a supplemental inventor's oath or declaration; (3) require the inventor's oath or declaration for a reissue application to identify a claim that the application seeks to broaden if the reissue application seeks to enlarge the scope of the claims of the patent (a basis for the reissue is the patentee claiming less than the patentee had the right to claim in the patent); and (4) clarify that a single claim containing both a broadening and a narrowing of the claimed invention is to be treated as a broadening. These changes will provide for more efficient processing of reissue applications and improve the quality of patents, in accordance with the intent of the AIA. In order to implement the conforming amendment made to 35 U.S.C. 251 in section 4(b)(2) of the AIA, the Office is also revising the rules to permit an assignee of the entire interest who filed an application under 35 U.S.C. 118 that was patented to sign the inventor's oath or declaration in a reissue application of such patent (even if the reissue application is a broadening reissue).

*Miscellaneous Changes:* The Office, under the authority provided by 35 U.S.C. 2(b)(2), is also revising the rules of practice for power of attorney, prosecution of an application by an assignee, and foreign priority and domestic benefit claims to facilitate prosecution of applications and improve the quality of patents. Juristic entities (organizations) who seek to prosecute an application, including taking over prosecution of an application, will need

to do so via a registered practitioner. The Office's experience is that the vast majority of juristic entities act via a registered practitioner, but a small number attempt to prosecute applications "pro se."

Other changes (vis-a-vis the former regulations) include: (1) Streamlining correction of inventorship, correction of an inventor's name, and changes in the order of the names of joint inventors; (2) providing for the carryover of a power of attorney in continuing applications, where no inventors are being added in the continuing application; (3) permitting practitioners who have acted only in a representative capacity in an application to change the correspondence address after a patent has issued; (4) accepting the signature of a practitioner of record on a statement under 37 CFR 3.73(c) on behalf of an assignee without requiring further evidence of the practitioner's authority to act on behalf of the assignee; (5) providing a procedure for handling conflicts between different purported assignees attempting to control prosecution; and (6) harmonizing the practice regarding foreign priority claims with the practice regarding domestic benefit claims by requiring both types of claims to be set forth in an application data sheet.

Changes for consistency with section 4(c) of the AIA (amending 35 U.S.C. 112 to change, *inter alia*, the undesignated paragraphs to subsections) will be made in a separate rulemaking that implements miscellaneous post patent provisions of the AIA.

### Discussion of Specific Rules

The following is a discussion of the amendments to Title 37 of the Code of Federal Regulations, parts 1, 3, 5, 10, and 41 that are implemented in this final rule:

#### 37 CFR Part 1

**Section 1.1:** Section 1.1(e) is amended to update the mail stop designation for communications relating to patent term extensions under 35 U.S.C. 156 to make it consistent with the Office's list of mail stops. Mail stops assist the Office in routing correspondence to the office or area assigned with treating it. Use of mail stops is not required but is strongly recommended, even where the documents are submitted via the Office's electronic filing system-Web (EFS-Web). A mail stop designation can help the Office more quickly identify the type of document if the applicant did not select the correct document code when uploading a document through EFS-Web. For this reason, use of mail stops is encouraged.

Applicants are reminded that initial requests for patent term extension may not be submitted via EFS-Web and must be filed in paper. These initial requests are handled differently by Office personnel than other types of official patent correspondence. Therefore, the use of a mail stop will help ensure that initial requests are properly recognized and processed in a timely manner.

**Section 1.4:** Section 1.4(e)(2) provides that a payment by credit card that is not being made via the Office's electronic filing systems (e.g., EFS-Web, the Electronic Patent Assignment System (EPAS), or the Finance On-line Shopping Web page for patent maintenance fees), may only be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent by that person. This change will avoid possible controversies regarding use of an S-signature (§ 1.4(d)(2)) instead of a handwritten signature (§ 1.4(d)(1)) for credit card payments, e.g., a request for refund where there is a change of purpose by the applicant and the request is based on use of an S-signature rather than a handwritten signature. An S-signature includes any signature made by electrical or mechanical means, and any other mode of making or applying a signature not covered by a handwritten signature. See § 1.4(d)(2). Section 1.4(e)(1) contains the language of former § 1.4(e).

An original handwritten signature is required only when the credit card payment is being made in paper and thus the Office's Card Payment Form, PTO-2038, or an equivalent, is being used. A submission via the Central Facsimile Number is considered a paper submission and requires an original handwritten signature. Applicants are reminded that neither Form PTO-2038 nor an equivalent should be filed via EFS-Web.

**Section 1.5:** Section 1.5(a) is amended to indicate that letters directed to the Office concerning applications for patent should state the name of the first listed inventor, rather than the name of the applicant. As discussed previously, the Office plans to continue to use the inventor's name for application and patent identification purposes as inventor names tend to provide a more distinct identification than assignee name.

**Section 1.9:** Section 1.9(a) is amended to indicate that the terms "national application" and "nonprovisional application" as used in 37 CFR chapter I with respect to international applications filed under the PCT refer to an international application filed under the PCT in which the basic national fee

under 35 U.S.C. 41(a)(1)(F) has been paid. Section 1.9(b) is amended to indicate that the term "international application" as used in 37 CFR chapter I refers to an international application for patent filed under the PCT prior to entering national processing at the Designated Office stage. This change is being made to avoid the situation in which a PCT "international application" that is pending as to the U.S. is neither an international application (because national processing at the Designated Office stage has begun) nor a nonprovisional application (because the application has not yet entered the national stage under § 1.491). The use of the terms "national application" and "nonprovisional application" for such applications will identify the stage at which the application currently resides.

**Section 1.12:** Sections 1.12(b) and (c) are amended to indicate that a request for access to assignment records of an application maintained in confidence under 35 U.S.C. 122(a) must include written authority of an inventor, the applicant, the assignee or an assignee of an undivided part interest, or a patent practitioner of record, unless by petition having the requisite showing. This change is for consistency with the change in practice concerning who is the applicant for patent in § 1.42.

**Section 1.14:** Section 1.14(c) is amended to indicate that a request to access an application maintained in confidence under 35 U.S.C. 122(a) must be signed by: (1) The applicant; (2) a patent practitioner of record; (3) the assignee or an assignee of an undivided part interest; (4) the inventor or a joint inventor; or (5) a registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.495, if a power of attorney has not been appointed under § 1.32. This change is for consistency with the change in practice concerning who is the applicant for patent in § 1.42.

Section 1.14(f) is amended to limit publication of notice in the *Official Gazette* of an application filed by someone other than the inventor to the filing of an application on behalf of an inventor by a person who otherwise shows sufficient propriety interest in the matter.

**Section 1.16:** Section 1.16(f) is amended to refer to "the inventor's oath or declaration" rather than "oath or declaration." This change to § 1.16(f), as well as the use of "the inventor's oath or declaration" in other rules, e.g., §§ 1.17(i), 1.51(b)(2), 1.52(b) and (c), 1.53, 1.77(a)(6), 1.136(c)(1), 1.153(b),

1.154(a)(6), 1.162, and 1.163(b)(6), 1.175, 1.492(h), and 1.495(c)(1)(ii), is for consistency with the use of the phrase “the inventor’s oath or declaration” to denote: (1) the oath or declaration under 35 U.S.C. 115(a), substitute statement under 35 U.S.C. 115(d), or assignment-statement under 35 U.S.C. 115(e) executed by or with respect to the inventor for an application naming only one inventor; and (2) the oaths or declarations under 35 U.S.C. 115(a), substitute statements under 35 U.S.C. 115(d), or assignment-statements under 35 U.S.C. 115(e) that collectively have been executed by or with respect to all of the joint inventors for an application naming joint inventors.

**Section 1.17:** Section 1.17(g) is amended to refer to the filing of an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter under § 1.46, rather than the filing of an application by other than all the inventors or by a person not the inventor under former § 1.47. This change is for consistency with the changes to applicant practice in §§ 1.42, 1.43, 1.45, and 1.46. Thus, an assignee or obligated assignee will no longer be required to file a petition and fee to be considered the applicant or to execute a substitute statement (in lieu of an oath or declaration) with respect to a nonsigning inventor.

Section 1.17(i) is amended to refer to supplying the name or names of the inventor or inventors in an application without either an application data sheet or an inventor’s oath or declaration (rather than just without an oath or declaration as prescribed by § 1.63). This change is for consistency with the changes to practice for naming the inventors in § 1.41.

**Section 1.27:** Section 1.27(c)(2) is amended to indicate that a written assertion of small entity status can be signed by: (1) The applicant (§ 1.42 or § 1.421); (2) a patent practitioner of record or a practitioner acting in a representative capacity under § 1.34; (3) the inventor or a joint inventor, if the inventor is the applicant; or (4) the assignee. This change is for consistency with the change in practice concerning who is the applicant for patent in § 1.42. This change also results in any written assertion being signed by or on behalf of the real party in interest, rather than by a party who no longer has a financial interest in the application.

**Section 1.31:** Section 1.31 is amended to provide that an applicant for patent may file and prosecute the applicant’s own case, or the applicant may give power of attorney so as to be represented by one or more patent

practitioners or joint inventors, except that a juristic entity (e.g., organizational assignee) must be represented by a patent practitioner even if the juristic entity is the applicant. This change is for consistency with the change in practice concerning who is the applicant for patent in § 1.42. Thus, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner unless otherwise specified, § 1.33(b)(3). Juristic entities include corporations (MPEP § 409.03(b)) or other non-human entities created by law and given certain legal rights. This change is because juristic entities have been attempting to prosecute patent applications before the Office *pro se* and requesting additional assistance from examiners. Juristic entities attempting to prosecute patent applications before the Office *pro se* also make more procedural errors that result in delays in prosecution. Accordingly, this change will facilitate a reduction in the Office’s backlog and pendency by reducing prosecution delays caused by procedural errors.

Section 1.31 also provides that the Office cannot aid in the selection of a patent practitioner.

**Section 1.32:** Section 1.32(a)(2) is amended to provide that the term “power of attorney” means a written document by which a principal authorizes one or more patent practitioners or joint inventors to act on the principal’s behalf. Section 1.32(a)(3) is amended to provide that the term “principal” means the applicant (§ 1.42) for an application for patent and the patent owner for a patent, including a patent in a supplemental examination or reexamination proceeding, and that the principal executes a power of attorney designating one or more patent practitioners or joint inventors to act on the principal’s behalf. Section 1.32(a)(4) is amended to provide that the term “revocation” means the cancellation by the principal of the authority previously given to a patent practitioner or joint inventor to act on the principal’s behalf. Section 1.32(a)(6) is added to provide that the term “patent practitioner of record” means a patent practitioner who has been granted a power of attorney in an application, patent, or other proceeding in compliance with § 1.32(b), and that the terms “practitioner of record” and “attorney or agent of record” also mean a patent practitioner who has been granted a power of attorney in an application, patent, or other proceeding in compliance with § 1.32(b). These changes are for consistency with the change in practice concerning the applicant for patent in § 1.42.

Section 1.32(b) is amended to provide that a power of attorney must: (1) Be in writing; (2) name one or more representatives in compliance with § 1.32(c); (3) give the representative power to act on behalf of the principal; and (4) be signed by the applicant for patent (§ 1.42) or the patent owner. This provision also applies in reissue applications, supplemental examination proceedings, and reexamination proceedings. These changes are for consistency with the change in practice concerning who is the applicant for patent in § 1.42.

Section 1.32(b)(4) provides that a patent owner who was not the applicant under § 1.46 must appoint any power of attorney in compliance with §§ 3.71 and 3.73. This covers a patent owner in a reissue application who was not the applicant under § 1.46 in the application for the original patent, as well as a patent owner in a supplemental examination or reexamination proceeding who was not the applicant under § 1.46.

Section 1.32(d) is added to provide that a power of attorney from a prior national application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application unless: (1) The power of attorney was granted by the inventor; and (2) the continuing application names an inventor who was not named as an inventor in the prior application. Former § 1.63(d)(4) provided that, when filing continuation and divisional applications and including a copy of a declaration from the parent application, applicants should “identify” in the continuation or divisional any change in power of attorney that occurred after the filing of the parent application. The requirement in former § 1.63(d)(4) to “identify” the change in power of attorney has been interpreted differently by applicants, with varying success of the Office recognizing the change in power of attorney. Attempts to comply have included: filing a copy of the power of attorney from the parent, filing a copy of only the notice of acceptance of power of attorney, and making a statement about the power of attorney in a transmittal letter that accompanied the continuation or divisional application. Sometimes applicants did not accurately identify the change in power of attorney (e.g., the power of attorney document in the parent application appointed specific practitioners by name and registration number, but the papers filed in the continuation or



divisional application directed the Office to recognize the practitioners associated with a customer number as having power of attorney). Specifically requiring a copy of the power of attorney in the continuing application in all situations (even where a change in power did not occur in the prior application) will make the record clear with respect to who has power of attorney.

The Office does not recommend that practitioners use a combined declaration and power of attorney document, and no longer provides a combined declaration and power of attorney form on its Internet Web site. The power of attorney should be from the assignee where one exists. Otherwise, the assignee may be paying the bill, while the inventor is providing the power of attorney, thereby possibly raising an issue as to who is the practitioner's client. Additionally, relationships between an assignee and the inventors may deteriorate. It is not uncommon in these situations for inventors to stop cooperating and in some cases file powers of attorney in an attempt to control prosecution of the application.

Section 1.32(e) is added to provide that if the power of attorney was granted by the originally named inventive entity and an added inventor pursuant to § 1.48 does not provide a power of attorney consistent with the power of attorney granted by the originally named inventive entity, the addition of the inventor results in the loss of that power of attorney upon grant of the § 1.48 request. This provision does not preclude a practitioner from acting pursuant to § 1.34, if applicable.

*Section 1.33:* Section 1.33(a) is amended to specify that if an applicant provides more than one correspondence address (in a single paper or in different papers), the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the correspondence address associated with a Customer Number over a typed correspondence address. This change pertains to the problem that arises when applicants provide multiple correspondence addresses in a single paper (e.g., providing both a typed correspondence address and a Customer Number in a single paper) or multiple papers (e.g., an oath or declaration, a transmittal letter, and a preliminary amendment that each includes a different correspondence address), and the Office inadvertently does not select the correspondence address actually desired by applicant. The Office may then need to re-mail papers to the desired address. This change does not

affect the hierarchy provided in § 1.76(d) for inconsistencies between an application data sheet and other documents. This change is designed to encourage applicants to review their submissions carefully to ensure that the Office receives clear instructions regarding the correspondence address.

Section 1.33(a) also provides that the correspondence address may be changed by the parties set forth in § 1.33(b)(1) (a patent practitioner of record) or § 1.33(b)(3) (the applicant under § 1.42)). Section 1.33(a) also provides that prior to the appointment of any power of attorney under § 1.32(b), the correspondence address may also be changed by any patent practitioner named in the application transmittal papers who acts in a representative capacity under the provisions of § 1.34. Section 1.33(a) no longer discusses the filing of an oath or declaration under § 1.63 as the Office is revising the rules to allow applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

Sections 1.33(b)(1) and (2) are amended to provide that amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(iii) or (c)(2)(iv), filed in the application must be signed by: (1) A patent practitioner of record; (2) a patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34; or (3) the applicant (§ 1.42). Section 1.33(b)(3) also provides that unless otherwise specified (e.g., terminal disclaimers and § 3.73(c) statements), all papers submitted on behalf of a juristic entity must be signed by a patent practitioner, as § 1.31 provides that a juristic entity may prosecute a patent application only through a patent practitioner.

Section 1.33(f) is added to replace former § 1.63(d)(4) with respect to the correspondence address. Where application papers (e.g., the inventor's oath or declaration) from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application. Historically, some applicants would file continuing applications with copies of papers from the prior application that include correspondence addresses to former law firms or correspondence addresses that

are no longer current. This change will facilitate the processing of patent applications by the Office by making it easier to determine the correct correspondence address and reduce the number of instances where the Office mails correspondence to an incorrect address.

Section 1.33(g) is added to provide that a practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in an application may change the correspondence address after the patent has issued, provided that the change of correspondence address is accompanied by a statement that notice has been given to the patentee or owner. Section 1.33(g) provides a means for practitioners acting in a representative capacity in an application to effect a change in correspondence address after the patent has granted but would not provide authority to a practitioner acting under § 1.34 to change the correspondence address in an application. *See* § 1.33(a).

Practitioners that file and prosecute an application in a representative capacity, pursuant to § 1.34, usually provide their business address as the correspondence address of record. Once the patent issues, practitioners have attempted to withdraw as attorney or agent by filing a petition, and also attempt to change the correspondence address to direct correspondence to the patentee's or owner's address. Such attempts have not been successful as the rules did not permit the correspondence address to be changed by a practitioner acting in a representative capacity, nor would the Office grant withdrawal where a practitioner is not of record. *See Change in Procedure for Requests to Withdraw from Representation In a Patent Application*, 1329 *Off. Gaz. Pat. Office* 99 (Apr. 8, 2008). There have been instances where practitioners acting in a representative capacity have indicated that they have repeatedly requested that the client change the correspondence address, but the client has refused to submit the change of correspondence address to the Office. Section 1.33(g) will permit practitioners to change the correspondence address after a patent has issued where practitioners have provided notice to the patentees or owners.

*Section 1.36:* Section 1.36(a) is amended to change "by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant, or the owner of the entire interest of a patent" to "by the applicant or patent owner." An assignee conducting prosecution of a national patent application does so as

the applicant (note that all papers submitted on behalf of a juristic entity must be signed by a patent practitioner). Thus, there is no need to refer separately to the applicant and an assignee of the entire interest of the applicant. This change is for consistency with the change in practice concerning the applicant for patent in § 1.42. In addition, the patent owner is the owner of the entire interest of a patent. Section 1.36(a) is also amended to change the parenthetical “or fewer than all of the assignees of the entire interest of the applicant or, in a reexamination proceeding, fewer than all the owners of the entire interest of a patent” in the third sentence to “or fewer than all patent owners in a supplemental examination or reexamination proceeding.” Section 1.36(a) is also amended to change the phrase “but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee’s own selection as provided in § 1.32(b)” in the ultimate sentence to “but the assignee may become the applicant under § 1.46(c) and revoke any previous power of attorney and grant a power of attorney as provided in § 1.32(b).”

*Section 1.41:* Section 1.41(a) provides that an application must include, or be amended to include, the name of the inventor for any invention claimed in the application (the inventorship). See 35 U.S.C. 115(a). As discussed previously, the “applicant” is provided for in § 1.42.

Section 1.41(b) provides that the applicant may name the inventorship of a nonprovisional application under 35 U.S.C. 111(a) in the application data sheet in accordance with § 1.76 or the inventor’s oath or declaration. Section 1.41(b) specifically provides that the inventorship of a nonprovisional application under 35 U.S.C. 111(a) is the inventor or joint inventors set forth in the application data sheet in accordance with § 1.76 filed before or concurrently with the inventor’s oath or declaration. An application data sheet must be signed (§ 1.76(e)) to comply with § 1.76. An unsigned application data sheet is treated as only an application transmittal letter. See § 1.76(e). Section 1.41(b) also provides that if an application data sheet is not filed before or concurrently with the inventor’s oath or declaration, the inventorship is the inventor or joint inventors set forth in the inventor’s oath or declaration, except as provided for in §§ 1.53(d)(4) (continued prosecution applications) and 1.63(d) (continuing applications). Section 1.41(b) also provides that once

an application data sheet or the inventor’s oath or declaration is filed in a nonprovisional application, any correction of inventorship must be pursuant to § 1.48. Section 1.41(b) finally provides that if neither an application data sheet nor the inventor’s oath or declaration is filed during the pendency of a nonprovisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to § 1.53(b), unless the applicant files a paper, including the processing fee set forth in § 1.17(i), supplying the name or names of the inventor or joint inventors.

Applicants who wish to take advantage of the ability to name the inventors in an application data sheet rather than the inventor’s oath or declaration should take care to ensure that an application data sheet under § 1.76 that is signed in compliance with § 1.33(b) is present on filing, or at least is filed prior to the filing of any inventor’s oath or declaration in the application. If an inventor’s oath or declaration is filed in the application prior to the filing of an application data sheet under § 1.76 that is signed in compliance with § 1.33(b), the inventorship named in the inventor’s oath or declaration controls. For example, if an inventor’s oath or declaration naming only inventor “A” is present on filing without an accompanying application data sheet, and a signed application data sheet naming inventors “A” and “B” is subsequently filed in the application, the application will be treated as naming only inventor “A” (the inventor provided in the inventor’s oath or declaration) until the inventorship is corrected under § 1.48(a).

Section 1.41(c) provides that the inventorship of a provisional application is the inventor or joint inventors set forth in the cover sheet as prescribed by § 1.51(c)(1). Section 1.41(c) also provides that once a cover sheet as prescribed by § 1.51(c)(1) is filed in a provisional application, any correction of inventorship must be pursuant to § 1.48. Section 1.41(c) finally provides that if a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to § 1.53(c), unless the applicant files a paper including the processing fee set forth in § 1.17(q), supplying the name or names of the inventor or joint inventors.

Section 1.41(d) provides that in either a nonprovisional application under 35 U.S.C. 111(a) filed without an application data sheet or the inventor’s

oath or declaration, or in a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name and residence of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or § 1.53(c) are filed.

Section 1.41(e) provides that the inventorship of an international application entering the national stage under 35 U.S.C. 371 is the inventor or joint inventors set forth in the application data sheet in accordance with § 1.76 filed with the initial submission under 35 U.S.C. 371. Thus, the applicant in an international application may change inventorship as to the U.S. at the time of national stage entry by simply filing an application data sheet in accordance with § 1.76 with the initial submission under 35 U.S.C. 371 naming the inventor or joint inventors. Section 1.41(e) also provides that unless the initial submission under 35 U.S.C. 371 is accompanied by an application data sheet in accordance with § 1.76 setting forth the inventor or joint inventors, the inventorship is the inventor or joint inventors set forth in the international application, which includes any change effected under PCT Rule 92*bis*. Section 1.41(e) does not provide the ability to name the inventors or joint inventors via the inventor’s oath or declaration even when an application data sheet in accordance with § 1.76 is not provided.

*Section 1.42:* Section 1.42 defines who is the applicant for a patent.

Section 1.42(a) provides that the word “applicant” when used in this title refers to the inventor or all joint inventors, or to the person applying for a patent as provided in §§ 1.43, 1.45, or 1.46.

Section 1.42(b) provides that if a person is applying for a patent as provided in § 1.46, the word “applicant” refers to the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for a patent under § 1.46 and not the inventor. Section 1.46 (discussed subsequently) implements 35 U.S.C. 118 and provides that a person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent, and 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.

Section 1.42(c) provides that if fewer than all joint inventors are applying for a patent as provided in § 1.45, the phrase “the applicant” means the joint inventors who are applying for the patent without the omitted inventor(s).

Section 1.42(d) provides that any person having authority may deliver an application and fees to the Office on behalf of the applicant. However, an oath or declaration, or substitute statement in lieu of an oath or declaration, may be executed only in accordance with § 1.63 or 1.64, a correspondence address may be provided only in accordance with § 1.33(a), and amendments and other papers must be signed in accordance with § 1.33(b).

Section 1.42(e) provides that the Office may require additional information where there is a question concerning ownership or interest in an application, and a showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

*Section 1.43:* Section 1.43 provides that if an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor; and that if an inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention. *See* 35 U.S.C. 117 (“[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”). Section 1.43 refers to § 1.64 concerning the execution of a substitute statement by a legal representative in lieu of an oath or declaration.

*Section 1.45:* Section 1.45 pertains to an application for patent by joint inventors. Section 1.45(a) provides that joint inventors must apply for a patent jointly, and that each joint inventor must make the inventor’s oath or declaration required by § 1.63, except as provided for in § 1.64. *See* 35 U.S.C. 116(a) (“[w]hen an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title.”). Section 1.45(a) also provides that if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other joint inventor or inventors may make the application for patent on behalf of themselves and the omitted inventor.

*See* 35 U.S.C. 116(b) (“[i]f a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor.”). Section 1.45(a) also cross-references § 1.64 concerning the execution of a substitute statement by the other joint inventor or inventors in lieu of an oath or declaration.

Sections 1.45(b) and (c) contain the provisions of pre-existing §§ 1.45(b) and (c).

*Section 1.46:* Section 1.46 is amended to provide for the filing of an application for patent by an assignee, a person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter under 35 U.S.C. 118. Section 1.46(a) provides that a person to whom the inventor has assigned or is under an obligation to assign an invention may make an application for patent. Section 1.46(a) also provides 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. The ability for a person who otherwise shows sufficient proprietary interest in the matter was previously set forth in former § 1.47(b), which restricted such ability to situations in which all of the inventors refused to execute the application, or could not be found or reached after diligent effort.

Section 1.46(b) provides that if an application under 35 U.S.C. 111 is made by a person other than the inventor under § 1.46(a), the application must contain an application data sheet under § 1.76 specifying in the applicant information section (§ 1.76(b)(7)) the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter. Section 1.46(b) further provides that if the application is the national stage of an international application, the person who is identified in the international stage as an applicant for the United States is the person specified as the original applicant for the national stage. While identifying the party making the application for patent (the applicant) in an application data sheet is not a filing date requirement, a delay in naming the applicant under § 1.46 in an application data sheet may cause it to appear that the applicant is the inventor and thus requiring the party to proceed under

§§ 3.71 and 3.73 to become the applicant.

Section 1.46(b)(1) provides that if the applicant is the assignee or person to whom the inventor is under an obligation to assign an invention, the documentary evidence of ownership (e.g., assignment for an assignee, employment agreement for an obligated assignee) should be recorded as provided for in 37 CFR part 3 no later than the date the issue fee is paid in the application. Section 1.46(b)(2) provides that if the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including: (1) The fee set forth in § 1.17(g); (2) a showing that such person has sufficient proprietary interest in the matter; and (3) a statement that making the application for patent by a person who otherwise shows sufficient proprietary interest on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties. A discussion of the evidence necessary for a showing that a person has sufficient proprietary interest in the matter is set forth in MPEP § 409.03(f).

Section 1.46(c) provides that any request to correct or update the name of the applicant after an applicant has been specified under § 1.46(b) must include an application data sheet under § 1.76 specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)). Thus, if there is no change in the applicant itself but just the applicant’s name (due to a correction or name change), the applicant need only submit an application data sheet specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)). Section 1.46(c) also provides that any request to change the applicant after an original applicant has been specified under § 1.46(b) must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) and must comply with §§ 3.71 and 3.73. Thus, if there is a change of applicant under § 1.46(b) (either from the inventor to the assignee, or from one assignee to another assignee), the new applicant must establish its ownership of the application under §§ 3.71(b) and 3.73.

Section 1.46(d) provides that even if the whole or a part interest in the invention or in the patent to be issued is assigned or obligated to be assigned, an oath or declaration must be executed by the actual inventor or each actual joint inventor, except as provided for in § 1.64. This provision is similar to the provisions of former § 1.46. Section 1.46

also refers to § 1.64 concerning the execution of a substitute statement by an assignee, person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter.

Section 1.46(e) provides that if a patent is granted on an application filed under § 1.46 by a person other than the inventor, the patent shall be granted to the real party in interest (*e.g.*, the current assignee for an application that has been assigned). Otherwise, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81.

Section 1.46(e) also provides that where a real party in interest has filed an application under § 1.46, the applicant shall notify the Office of any change in the real party in interest no later than payment of the issue fee, and that the Office will treat the absence of such a notice as an indication that there has been no change in the real party in interest. This provision implements the requirement of 35 U.S.C. 118 that: “[i]f 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.” Section 3.81 provides that an “application may issue in the name of the assignee \* \* \* where a request for such issuance is submitted with payment of the issue fee.” This is accomplished by providing the assignee information in box 3 of the Part B—Fee(s) Transmittal form, PTOL–85B. The use of box 3 will be required where the real party in interest has changed from filing of the application and the application was filed pursuant to § 1.46.

Section 1.46(f) provides that the Office may publish notice of the filing of the application by a person who otherwise shows sufficient proprietary interest in the *Official Gazette*.

*Section 1.47:* Section 1.47 is removed and reserved. As discussed previously, execution of a substitute statement in lieu of an oath or declaration is now provided for in § 1.64.

*Section 1.48:* Section 1.48 is amended to no longer include a “without deceptive intention” requirement as this requirement has been eliminated from 35 U.S.C. 116 in section 20 of the AIA. Section 1.48 is also amended to no longer require the written consent of any assignee as the Office does not require express written consent by an assignee to other amendments to an application.

Section 1.48(a) provides for correction of inventorship in a nonprovisional

application filed either under 35 U.S.C. 111(a) or resulting from an international application in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid. Section 1.48(a) provides that any request to correct or change the inventorship once the inventorship has been established under § 1.41 must include: (1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name; and (2) the processing fee set forth in § 1.17(i). Due to the streamlining of the requirements for correction of inventorship, it is no longer necessary to have separate provisions based upon whether the correction is necessitated by the original inventorship being in error or by an amendment to the claims.

Section 1.48(b) also provides that an oath or declaration as required by § 1.63, or a substitute statement in compliance with § 1.64, will be required for any actual inventor who has not yet executed such an oath or declaration.

Section 1.48(c) is currently reserved.

Section 1.48(d) provides for correction of inventorship in a provisional application filed under 35 U.S.C. 111(b). Section 1.48(d) provides that once a cover sheet as prescribed by § 1.51(c)(1) is filed in a provisional application, any request to correct or change the inventorship must include: (1) a request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies each inventor by his or her legal name; and (2) the processing fee set forth in § 1.17(q).

Section 1.48(e) provides that the Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

Section 1.48(f) provides for corrections to the name of the inventor or a joint inventor, or the order of the names of joint inventors. Due to the streamlining of the requirements for correction of inventorship, it is no longer necessary to have distinct procedures for correction of inventorship and for correction to the name of an inventor or to the order of the names of the inventors. Corrections to the name of an inventor or to the order of the names of the inventors were formerly provided for as exception processes, such as under § 1.182. *See* MPEP §§ 605.04(b), (c), and (f). Section 1.48(f) specifically provides that any request to correct or update the name of the inventor or a joint inventor, or the order of the names of joint inventors, in a nonprovisional application must include: (1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name

in the desired order; and (2) the processing fee set forth in § 1.17(i).

Section 1.48(g) provides that the provisions of § 1.48 do not apply to reissue applications. Section 1.48(g) also refers to §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

Section 1.48(h) provides a cross reference to § 1.324 for correction of inventorship in a patent.

Section 1.48(i) provides for correction of inventorship in an interference or contested case before the Patent Trial and Appeal Board. Section 1.48(i) provides that in an interference under part 41, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 41.121(a)(2) of this title. Section 1.48(i) also provides that in a contested case under part 42, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 42.22 of this title. Section 1.48(i) finally provides that the motion under §§ 41.121(a)(2) or 42.22 of this title must comply with the requirements of § 1.48(a).

*Section 1.51:* Section 1.51(b)(2) is amended to refer to “the inventor’s oath or declaration” and to cross-reference §§ 1.63 and 1.64. *See* previous discussion of § 1.16(f).

*Section 1.52:* Section 1.52(b) and (c) are amended to refer to “the inventor’s oath or declaration.” *See* previous discussion of § 1.16(f).

Section 1.52(b) is amended to also refer to supplemental examination proceedings.

Section 1.52(c) is amended to provide that interlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor’s oath or declaration referring to those application papers, provided that the statements in the inventor’s oath or declaration remain applicable to those application papers. Thus, § 1.52(c) no longer prohibits changes after execution of the inventor’s oath or declaration. Section 1.52(c) also provides that a substitute specification (§ 1.125) may be required if the application papers do not comply with paragraphs (a) and (b) of this section.

Section 1.52(d) is amended to be limited to nonprovisional or provisional applications filed under 35 U.S.C. 111(a) and (b), respectively.

*Section 1.53:* Section 1.53 is amended to change the phrase “oath or declaration” to the phrase “the inventor’s oath or declaration” throughout. *See* previous discussion of § 1.16(f).

Section 1.53(c) is also amended to replace “the first paragraph of 35 U.S.C. 112” with “35 U.S.C. 112(a)” for consistency with the change to 35 U.S.C. 112 in the AIA.

Section 1.53(c)(3) is also amended to replace “the second paragraph of 35 U.S.C. 112” with “35 U.S.C. 112(b)” for consistency with the change to 35 U.S.C. 112 in the AIA.

Section 1.53(f) is amended to revise the missing parts practice to allow applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

Section 1.53(f)(1) provides for a notice (if the applicant has provided a correspondence address) if the application does not contain the basic filing fee, the search fee, or the examination fee, or if the application under § 1.53(b) does not contain the inventor's oath or declaration. Section 1.53(f)(1) provides that applicant must pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by § 1.16(f) within the time period set in the notice to avoid abandonment. Section 1.53(f)(3) (discussed subsequently) sets forth the time period for filing the inventor's oath or declaration in an application under § 1.53(b) (an application under § 1.53(d) uses the inventor's oath or declaration from the prior application) and provides the conditions under which an applicant may postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

Section 1.53(f)(2) provides for the situation where applicant has not provided a correspondence address in an application under § 1.53(b), and the application does not contain the basic filing fee, the search fee, or the examination fee, or does not contain the inventor's oath or declaration. Section 1.53(f)(2) provides that if the applicant has not provided a correspondence address, the applicant must pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by § 1.16(f), within two months from the filing date of the application to avoid abandonment. As discussed previously, § 1.53(f)(3) (discussed subsequently) sets forth the time period for filing the inventor's oath or declaration in an application under § 1.53(b) and provides the conditions under which an applicant may postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

Section 1.53(f)(3) sets forth the time period for filing the inventor's oath or declaration in an application under

§ 1.53(b) and provides the conditions under which an applicant may postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance. Section 1.53(f)(3) specifically provides that the inventor's oath or declaration in an application under § 1.53(b) must also be filed within the period specified in § 1.53(f)(1) or (f)(2), except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in § 1.53(f)(3)(i) through (f)(3)(ii). Section 1.53(f)(3)(i) provides that the application must be an original (non-reissue) application that contains an application data sheet in accordance with § 1.76 identifying: (1) each inventor by his or her legal name; and (2) a mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor. Section 1.53(f)(3)(ii) provides that the applicant must file an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor no later than the expiration of the time period set in the “Notice of Allowability” to avoid abandonment, when the applicant is notified in a “Notice of Allowability” that an application is otherwise in condition for allowance. The time period set in a “Notice of Allowability” is not extendable. *See* § 1.136(c). The Office may dispense with the notice provided for in § 1.53(f)(1) if an oath or declaration under § 1.63, or substitute statement under § 1.64, executed by or with respect to each actual inventor has been filed before the application is in condition for allowance.

Under former practice, the Office issued a Notice to File Missing Parts if an application under § 1.53(b) did not contain the basic filing fee, the search fee, or the examination fee, or the inventor's oath or declaration. If the Office issued a Notice to File Missing Parts, the applicant was given a time period (usually two months) within which to file the missing basic filing fee, the search fee, the examination fee, or the inventor's oath or declaration and pay the surcharge required by § 1.16(f) to avoid abandonment. *See* MPEP § 601.01(a). The Office is modifying this process such that if an application under § 1.53(b) contains the applicable filing fees (basic filing fee, search fee, the examination fee, any applicable excess claims fee, and any applicable

application size fee), the surcharge required by § 1.16(f), and a signed application data sheet providing the information required by § 1.53(f)(3)(i), but does not include the inventor's oath or declaration, the Office will not issue a Notice to File Missing Parts requiring the applicant to file the inventor's oath or declaration. If an application under § 1.53(b) that does not contain the inventor's oath or declaration also does not contain the applicable filing fees, or the surcharge required by § 1.16(f), or a signed application data sheet providing the information required by § 1.53(f)(3)(i), the Office will issue a Notice to File Missing Parts giving the applicant a time period (usually two months) within which to file the missing filing fees, the surcharge required by § 1.16(f), or signed application data sheet providing the information required by § 1.53(f)(3)(i) (or the inventor's oath or declaration) to avoid abandonment. In either situation, the inventor's oath or declaration will not be required within the period for reply to the Notice to File Missing Parts if the applicant provides a signed application data sheet providing the information required by § 1.53(f)(3)(i) within the period for reply to the Notice to File Missing Parts. The filing fees and surcharge required by § 1.16(f), however, must be filed within the period for reply to the Notice to File Missing Parts to avoid abandonment.

If an application is in condition for allowance and includes an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, the Office will issue a “Notice of Allowability” (PTOL-37) and a “Notice of Allowance and Fee(s) Due” (PTOL-85). If an application is in condition for allowance but does not include an oath or declaration in compliance with § 1.63, or a substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, the Office will issue a “Notice of Allowability” (PTOL-37) (but not a “Notice of Allowance and Fee(s) Due” (PTOL-85)) giving the applicant three months to file an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, to avoid abandonment. This three-month time period is not extendable under § 1.136(a). The “Notice of Allowance and Fee(s) Due” (PTOL-85) will not be issued until the application includes an oath or declaration in compliance with § 1.63, or substitute statement in compliance

with § 1.64, executed by or with respect to each actual inventor.

Section 1.53(f)(4) contains the provisions of former § 1.53(f)(3).

Section 1.53(f)(5) contains the provisions of former § 1.53(f)(4).

Section 1.53(f)(6) contains the provisions of former § 1.53(f)(5).

Section 1.53(h) is amended to provide an exception for the situation in which the inventor's oath or declaration is not filed until the application is otherwise in condition for allowance under § 1.53(f)(3).

*Section 1.55:* Sections 1.55(a)(1)(i), (c), and (d)(1)(ii) are amended to require a foreign priority claim be identified in an application data sheet (§ 1.76). 35 U.S.C. 119(b) does not specify the particular location in the application for setting forth a claim to the benefit of a prior foreign application. Additionally, § 1.55 formerly did not specify where in the application a foreign priority claim must be, but former § 1.63(c) required that the foreign priority claim be in an application data sheet or identified in the oath or declaration. The change to § 1.55 in this final rule establishes a single location for the foreign priority claim in the application data sheet, which would facilitate application processing by providing practitioners with a clear location for the foreign priority claim, and the Office with one location to locate the foreign priority claim quickly. Formerly, the Office had to look at the specification, amendments to the specification, the oath or declaration, the application data sheet (if provided), and elsewhere to determine the priority claim. In addition, when applicants provided inconsistent information relating to the claim for foreign priority, the Office had to then determine which priority claim governed.

Additionally, providing this information in a single location will facilitate review of patents and patent application publications, because applications frequently set forth a benefit and/or foreign priority claim in the first sentence(s) of the specification, which is superseded by an application data sheet that includes a different benefit or foreign priority claim, and thus the benefit claim and/or foreign priority information contained on the front page of the patent or patent application publication is different from the benefit claim and/or foreign priority claim included in the first sentence(s) of the specification. While the benefit and/or foreign priority claim on the front page of the patent or patent application publication is usually correct, anyone (including an examiner, a practitioner or the public) reviewing the patent or

patent application publication must review the file history of the application to be certain of its correctness. Since most applications are filed with an application data sheet, requiring the benefit and/or foreign priority claims to be included in the application data sheet will not require most practitioners to change their practice.

35 U.S.C. 119(b) provides that the foreign application is identified by specifying the application number, country or intellectual property authority, and filing date of each foreign application for which priority is claimed. Section 1.55(a)(1) and (c) thus provide that the foreign priority claim must identify the foreign application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In addition, § 1.55(a)(1)(i) requires identification of any foreign application having a filing date before that of the application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. Providing this information in the application data sheet constitutes the claim for foreign priority as required by 35 U.S.C. 119(b) and § 1.55(a).

*Section 1.56:* Section 1.56(c)(3) is amended to indicate that its provisions also apply to every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application. This change is for consistency with the change in practice concerning who is the applicant for patent in § 1.42.

*Section 1.59:* Section 1.59(a)(2) is amended to refer to any preliminary amendment present on the filing date of the application in the parenthetical for consistency with § 1.115(a)(1).

*Section 1.63:* Section 1.63(a) provides that the inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration directed to the application, except as provided for in § 1.64. *See* 35 U.S.C. 115(a). Section 1.63(a) further provides that an oath or declaration must: (1) Identify the inventor or joint inventor executing the oath or declaration by his or her legal name; (2) identify the application to which it is directed; (3) include a statement that the person executing the oath or declaration believes the named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed

invention in the application for which the oath or declaration is being submitted; and (4) state that the application was made or was authorized to be made by the person executing the oath or declaration. The requirements that an oath or declaration include a statement that the person executing the oath or declaration believes the named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application for which the oath or declaration is being submitted, and state that the application was made or was authorized to be made by the person executing the oath or declaration are requirements of 35 U.S.C. 115(a) and (b). The requirements that an oath or declaration must identify the inventor or joint inventor executing the oath or declaration by his or her legal name and identify the application to which it is directed are necessary for the Office to ensure that there is compliance with the requirement of 35 U.S.C. 115(a) that each individual who is the inventor or a joint inventor of a claimed invention in an application for patent has executed an oath or declaration in connection with the application (except as provided in 35 U.S.C. 115).

Section 1.63(a)(1) simplifies the requirement for the inventor's name to be his or her legal name without reference to a family or given name. The requirement for the inventor's legal name is sufficient, given that individuals do not always have both a family name and a given name, or have varying understandings of what a "given" name requires.

Section 1.63(a)(2) contains the language of former § 1.63(b)(1) (requiring identification of the application to which the oath or declaration is directed).

Section 1.63(a)(3) no longer includes a requirement for identifying the country of citizenship for each inventor, as this information is no longer required by 35 U.S.C. 115.

Section 1.63(a)(4) no longer includes the requirement that the person executing the oath or declaration state that he or she is believed to be the "first" inventor, as this statement is no longer provided for by 35 U.S.C. 115(b)(2) and would not be consistent with a first inventor to file system. Section 1.63(a)(4) does include a requirement from 35 U.S.C. 115(b)(1), not present in former 35 U.S.C. 115 or § 1.63, that the oath or declaration state that the application was made or was authorized to be made by the person executing the oath or declaration.

Section 1.63(b) provides that unless such information is supplied in an

application data sheet in accordance with § 1.76, the oath or declaration must also identify: (1) each inventor by his or her legal name; and (2) a mailing address where the inventor customarily receives mail, and (3) residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor. Therefore, the applicant is not required to name each inventor in a single oath or declaration as long as the inventorship is provided in an application data sheet in accordance with § 1.76. This will permit each joint inventor to execute an oath or declaration stating only that the joint inventor executing the oath or declaration is an original joint inventor of the claimed invention in the application for which the oath or declaration is being submitted. The phrase “application data sheet in accordance with § 1.76” requires that the application data sheet be signed in compliance with § 1.33(b). An unsigned application data sheet will be treated only as a transmittal letter.

The requirement for identification of a mailing address is clarified by noting that it is the address where the inventor “customarily receives mail,” which may encompass an address where the inventor works, a post office box, or other address where mail is received even if it is not the main mailing address of the inventor. The mailing address is for the benefit of the inventor in the event that the Office would need to contact the inventor directly.

Section 1.63 is also amended to eliminate the requirement for identifying the claim for foreign priority under § 1.55 in the oath or declaration. This change reflects the Office’s desire to have claims for foreign priority under § 1.55 and claims for domestic benefit under § 1.78 be presented in an application data sheet (§ 1.76). The former requirement that the domestic claim for benefit be placed in the first sentence(s) of the specification or an application data sheet (§ 1.76), while requiring that a foreign priority claim be identified in an oath or declaration or application data sheet, has led to confusion by applicants as to the proper placement of these priority or benefit claims and to Office processing issues of such claims. As section 3 of the AIA placed foreign priority claims on equal footing with domestic benefit claims in regard to what may be relied upon as a prior art date, it is important that there be one unified place that the Office and the public rely upon in determining these claims. Accordingly, §§ 1.55 and 1.78 are amended to provide a unified way (the application data sheet) to

present the claims that will lead to a more reliable placement of the claims in a printed patent or a patent application publication.

Section 1.63(c) provides that a person may not execute an oath or declaration for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56. Thus, an oath or declaration under § 1.63 is no longer required to contain the “reviewed and understands” clause and “duty to disclose” clause of former § 1.63(b)(2) and (b)(3). However, § 1.63 still requires that a person executing an oath or declaration for an application review and understand the contents of the application, and be aware of the duty of disclosure under § 1.56. Section 1.63(c) also provides that there is no minimum age for a person to be qualified to execute an oath or declaration, but the person must be competent to execute, *i.e.*, understand, the document that the person is executing. This provision contains the language of former § 1.63(a)(1).

Section 1.63(d) implements the provisions of 35 U.S.C. 115(g). Section 1.63(d)(1) provides that a newly executed oath or declaration under § 1.63, or substitute statement under § 1.64, is not required under § 1.51(b)(2) and § 1.53(f) or § 1.497 for an inventor in a continuing application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed application, provided that an oath or declaration in compliance with § 1.63, or substitute statement under § 1.64, was executed by or with respect to such inventor and was filed in the earlier-filed application, and a copy of such oath, declaration, or substitute statement showing the signature or an indication thereon that it was executed, is submitted in the continuing application. Section 1.63(d)(2) provides that the inventorship of a continuing application filed under 35 U.S.C. 111(a) is the inventor or joint inventors specified in the application data sheet filed before or concurrently with the copy of the inventor’s oath or declaration from the earlier-filed application. If an application data sheet is not filed before or concurrently with the copy of the inventor’s oath or declaration from the earlier-filed application, the inventorship is the inventorship set forth in the copy of the inventor’s oath or declaration from the earlier-filed application, unless the copy of the inventor’s oath or declaration is accompanied by a statement signed

pursuant to § 1.33(b) stating the name of each inventor in the continuing application. Section 1.63(d)(3) provides that any new joint inventor named in the continuing application must provide an oath or declaration in compliance with § 1.63, except as provided for in § 1.64.

Section 1.63(e) implements the provisions of 35 U.S.C. 115(e). Section 1.63(e)(1) provides that an assignment may also serve as an oath or declaration required by § 1.63 if the assignment: (1) includes the information and statements required under § 1.63(a) and (b); and (2) a copy of the assignment is recorded as provided for in 37 CFR part 3. The assignment, including the information and statements required under § 1.63(a) and (b), must be executed by the individual who is under the obligation of assignment. Section 1.63(e)(2) provides that any reference to an oath or declaration under § 1.63 includes an assignment as provided for in § 1.63(e).

Applicants should be mindful of the change to § 3.31 requiring a conspicuous indication, such as by use of a check-box on the assignment cover sheet, to alert the Office that an assignment submitted with an application is submitted for a dual purpose: recording in the assignment database, such as to support a power of attorney, and for use in the application as the oath or declaration. Assignments cannot be recorded unless an application number is provided against which the assignment is to be recorded. When an assignment is submitted for recording along with a paper application, the assignment is separated from the paper application and forwarded to the Assignment Recordation Branch for recording in its database at the time where the application is assigned an application number. The assignment does not become part of the application file. If the applicant indicates that an assignment-statement is also an oath or declaration, the Office will scan the assignment into the Image File Wrapper (IFW) file for the application before forwarding it to the Assignment Recordation Branch. Failure to utilize the check-box will result in a Notice to File Missing Parts of Nonprovisional Application requiring an inventor’s oath or declaration as the assignment will not be made part of the application file nor will the Office recognize that the § 1.63 oath or declaration requirement has been satisfied. A copy of the assignment would need to be submitted in reply to the Notice along with the surcharge for the late submission of the inventor’s oath or declaration.

For EFS–Web filing of application papers, EFS–Web does not accept

assignments for recording purposes when filing an application. *See Legal Framework for Electronic Filing System—Web (EFS—Web)*, 74 FR 55200, 55202 (Oct. 27, 2009). Recording of assignments may only be done electronically in EPAS (Electronic Patent Assignment System), notwithstanding the existence of a link from EFS—Web to EPAS that can be utilized to file an assignment after the application is filed. Accordingly, for EFS—Web submissions, all assignments submitted on filing of the application or later submitted will be made of record in the application (entered into the Image File Wrapper (IFW)), and will not be forwarded to the Assignment Recordation Branch for recordation by the Office. Thus, an assignment must be submitted to the Assignment Recordation Branch in order to comply with § 1.63(e)(1)(ii). If an applicant files the assignment-statement for recording via EPAS and utilizes the check-box, the Office will place a copy of the assignment-statement in the related application file.

Section 1.63(f) provides that with respect to an application naming only one inventor, any reference to the inventor's oath or declaration in 37 CFR chapter I also includes a substitute statement executed under § 1.64. Thus, any requirement in 37 CFR chapter I for the inventor's oath or declaration with respect to an application naming only one inventor is met if an oath or declaration under § 1.63, an assignment-statement under § 1.63(e), or a substitute statement under § 1.64 executed by or with respect to the inventor is filed.

Section 1.63(f) also provides that with respect to an application naming more than one inventor, any reference to the inventor's oath or declaration in 37 CFR chapter I means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors, unless otherwise clear from the context. Thus, any requirement in 37 CFR chapter I for the inventor's oath or declaration with respect to an application naming more than one inventor is met if an oath or declaration under § 1.63, an assignment-statement under § 1.63(e), or a substitute statement under § 1.64 executed by or with respect to each joint inventor is filed.

Section 1.63(g) provides that an oath or declaration under § 1.63, including the statement provided for in § 1.63(e), must be executed (*i.e.*, signed) in accordance either with § 1.66, or with an acknowledgment that any willful false statement made in such declaration or statement is punishable under 18 U.S.C. 1001 by fine or

imprisonment of not more than five (5) years, or both. *See* 35 U.S.C. 115(i). The inventor's oath or declaration must be executed (*i.e.*, signed) by the inventor or the joint inventors, unless the oath or declaration is a substitute statement under § 1.64, which must be signed by the party or parties making the statement, or an assignment under § 1.63(e), which must be signed by the individual who is under the obligation of assignment of the patent application.

35 U.S.C. 115(h)(1) provides that any person making a statement under this section may at any time "withdraw, replace, or otherwise correct the statement at any time." Section 1.63(h) provides that an oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1) will be placed in the file record of the application or patent, but may not necessarily be reviewed by the Office. Oaths or declarations submitted pursuant to 35 U.S.C. 115(h)(1) that are filed prior to the mailing of a notice of allowance in an application would continue to be reviewed by the Office for compliance with 35 U.S.C. 115 and the applicable regulations. Oaths or declarations submitted pursuant to 35 U.S.C. 115(h)(1) that are filed after the mailing of a notice of allowance in an application or patent would generally not be reviewed by the Office. Section 1.63(h) further provides that any request for correction of the named inventorship must comply with § 1.48 in an application and § 1.324 in a patent. This is a reminder that the mere submission of an oath or declaration pursuant to 35 U.S.C. 115(h)(1) will not operate to correct inventorship in compliance with § 1.48 in an application and § 1.324 in a patent.

The provisions in former § 1.63 concerning the power of attorney in a continuing application are now contained in § 1.32 and the correspondence address in a continuing application are now contained in § 1.33(f).

*Section 1.64:* Section 1.64 implements the substitute statement provisions of 35 U.S.C. 115(d). The provisions of former § 1.64 concerning who must execute an oath or declaration are now contained in § 1.63 with respect to an oath, declaration, or assignment-statement under § 1.63 and are now contained within § 1.64 with respect to who may execute a substitute statement.

Section 1.64(a) provides that an applicant under § 1.43, 1.45 or 1.46 may execute a substitute statement in lieu of an oath or declaration under § 1.63 if the inventor is deceased, is under a legal incapacity, has refused to execute the oath or declaration under § 1.63, or cannot be found or reached after

diligent effort. 35 U.S.C. 115(d) provides that, in lieu of execution of an oath or declaration by an inventor, the applicant for patent may provide a substitute statement under the circumstances described in 35 U.S.C. 115(d)(2) and such additional circumstances as the Director specifies by regulation. *See* 35 U.S.C. 115(d)(1). The circumstances set forth in 35 U.S.C. 115(d)(2) in which the applicant may provide a substitute statement are the situations where the inventor is deceased, under legal incapacity, or cannot be found or reached after diligent effort, or is under an obligation to assign the invention but has refused to execute the oath or declaration. *See* 35 U.S.C. 115(d)(2).

As discussed previously, 35 U.S.C. 115(d)(1) provides that the applicant for patent may provide a substitute statement in lieu of execution of an oath or declaration by an inventor under 35 U.S.C. 115(a) under such additional circumstances as the Director specifies by regulation. The Office is permitting the applicant to provide a substitute statement in lieu of an oath or declaration whenever the inventor has refused to execute the oath or declaration, even if the inventor is not under an obligation to assign the invention. 35 U.S.C. 118 and § 1.46, as adopted in this final rule, provide 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. Thus, § 1.64, as adopted in this final rule, permits a person who otherwise shows sufficient proprietary interest in the matter to execute a substitute statement in lieu of execution of an oath or declaration by the inventor or a joint inventor if the inventor or a joint refuses to join in an application for patent regardless of whether there is an obligation to assign. 35 U.S.C. 116(b) and § 1.45, as adopted in this final rule, provide that if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. *See* 35 U.S.C. 116(b). Thus, § 1.64, as adopted in this final rule, permits another joint inventor to execute a substitute statement in lieu of execution of an oath or declaration by the omitted inventor if a joint inventor refuses to join in an application for patent regardless of whether there is an obligation to assign the invention. If the



Office does not permit the applicant to also provide a substitute statement in lieu of an oath or declaration whenever the inventor or a joint inventor has refused to execute the oath or declaration (even if the inventor or joint inventor is not under an obligation to assign the invention), a person who otherwise shows sufficient proprietary interest in the matter who provides a showing that such action is appropriate to preserve the rights of the parties, or the remaining inventor or inventors, may be the applicant under either 35 U.S.C. 118 or 116(b), respectively, but may be precluded from providing a substitute statement in lieu of an oath or declaration. This is consistent with existing Office practice under which a person who otherwise shows sufficient proprietary interest in the matter or the remaining inventor or inventors may execute the oath or declaration as the applicant if all of the inventors have refused to execute the oath or declaration.

Section 1.64(b) provides that a substitute statement under § 1.64 must: (1) comply with the requirements of § 1.63(a), identifying the inventor or joint inventor with respect to whom a substitute statement in lieu of an oath or declaration is executed, and stating upon information and belief the facts which such inventor is required to state; (2) identify the person executing the substitute statement and the relationship of such person to the inventor or joint inventor with respect to whom the substitute statement is executed, and unless such information is supplied in an application data sheet in accordance with § 1.76, the residence and mailing address of the person signing the substitute statement; and (3) identify the circumstances permitting the person to execute the substitute statement in lieu of an oath or declaration under § 1.63, namely whether the inventor is deceased, is under a legal incapacity, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration under § 1.63. Section 1.64(b) also provides that, unless such information is supplied in an application data sheet in accordance with § 1.76, the substitute statement must also identify: (1) each inventor by his or her legal name; and (2) the last known mailing address where the inventor customarily receives mail, and last known residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor who is not deceased or under a legal incapacity.

Section 1.64(c) provides that a person may not execute a substitute statement under § 1.64 for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Section 1.64(d) provides that any reference to an inventor's oath or declaration also includes a substitute statement provided for in § 1.64.

Section 1.64(e) provides that a substitute statement under § 1.64 must contain an acknowledgment that any willful false statement made in such statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

Section 1.64(f) provides that a nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under § 1.63. Section 1.64(f) also provides that the submission of an oath or declaration by a nonsigning inventor or legal representative in an application filed under § 1.43, 1.45 or 1.46 will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

*Section 1.66:* Section 1.66 is amended to eliminate the special provisions for oaths taken before an officer in a country other than the United States.

*Section 1.67:* Section 1.67 provides for a supplemental inventor's oath or declaration (which includes oaths, declarations, assignment-statements under § 1.63(e), and substitute statements under § 1.64) under 35 U.S.C. 115(h).

Section 1.67(a) provides that the applicant may submit an inventor's oath or declaration meeting the requirements of § 1.63, § 1.64, or § 1.162 to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. *See* 35 U.S.C. 115(h)(1). Section 1.67(a) also provides that deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(b) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76, except that any correction of inventorship must be pursuant to § 1.48.

Section 1.67(b) provides that a supplemental inventor's oath or declaration under § 1.67 must be executed by the person whose inventor's oath or declaration is being withdrawn, replaced, or otherwise corrected.

Section 1.67(c) provides that the Office will not require a person who has executed an oath or declaration in

compliance with 35 U.S.C. 115 and § 1.63 or § 1.162 for an application to provide an additional inventor's oath or declaration for the application. *See* 35 U.S.C. 115(h)(2).

Section 1.67(d) contains the provision of former § 1.67(b) that no new matter may be introduced into a nonprovisional application after its filing date even if an inventor's oath or declaration is filed to correct deficiencies or inaccuracies present in the earlier-filed oath or declaration.

*Section 1.76:* Section 1.76(a) is amended to clarify that an application data sheet may be submitted in a provisional application under 35 U.S.C. 111(b), a nonprovisional application under 35 U.S.C. 111(a), or a national stage application under 35 U.S.C. 371. Section 1.76(a) is also amended to require that an application data sheet must be submitted to claim priority to or the benefit of a prior-filed application under 35 U.S.C. 119, 120, 121, or 365 for consistency with the changes to §§ 1.55 and 1.78. Including foreign priority and domestic benefit claims in the Office's Application Data Sheet form (PTO/SB/14) can benefit applicants as the data can be loaded directly into the Office's electronic systems; thus ensuring the data is accurately captured. The data will only load directly into the Office's electronic systems when the PTO/SB/14 is submitted as an EFS-Web Fillable Form, rather than a scanned portable document format (PDF) image submitted electronically via EFS-Web. Section 1.76(a) is also amended to provide that the provisions of § 1.76(c)(2) (discussed subsequently) are an exception to the requirement that an application data sheet must contain all of the section headings listed in § 1.76(b), with any appropriate data for each section heading.

Section 1.76(b)(1) is amended to pertain to inventor information, rather than applicant information. As discussed previously, the Office plans to continue to use the inventor's name for application and patent identification purposes as inventor names tend to provide a more distinct identification than assignee name. Section 1.76(b)(1) indicates that inventor information includes the legal name, residence, and mailing address of the inventor or each joint inventor.

Section 1.76(b)(3) is amended to eliminate a suggested classification, by class and subclass, and the Technology Center, from the application information portion of the application data sheet. This information is no longer utilized by the Office in view of internal changes relating to how applications are classified.

Section 1.76(b)(5) is amended to provide that domestic benefit information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Section 1.76(b)(5) further provides that providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(5).

Section 1.76(b)(7) is amended to pertain to “applicant” rather than “assignee” information. Section 1.76(b)(7) provides that applicant information includes the name (either natural person or juristic entity) and address of the legal representative, assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under § 1.43 or 1.46. Thus, § 1.76(b)(7) provides for the situation in which the applicant is a person other than the inventor under § 1.43 (legal representative) or § 1.46 (assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter). This section may be left blank if the applicant is the inventor or is the remaining joint inventor or inventors (§ 1.45).

As discussed previously, § 1.46(b) provides that if an application is filed by the assignee, a person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter, the application must contain an application data sheet under § 1.76 specifying the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter in the applicant information section. As also discussed previously, § 1.46(c) provides that any request to correct or update the name of the applicant, or change the applicant, must include an application data sheet under § 1.76 specifying the applicant in the applicant information section. Section 1.76(b)(7) continues to provide that providing assignment information in the application data sheet does not substitute for compliance with any requirement of 37 CFR part 3 to have an assignment recorded by the Office.

Section 1.76(c) is amended to eliminate the distinction between an application data sheet and a

supplemental application data sheet. An application data sheet provided on filing and an application data sheet submitted after the filing date of the application are both considered an application data sheet.

Section 1.76(c)(1) provides that information in a previously submitted application data sheet, the inventor’s oath or declaration under § 1.63, § 1.64, or § 1.67, or otherwise of record, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, except that inventorship changes must comply with the requirements of § 1.48, foreign priority and domestic benefit information changes must comply with §§ 1.55 and 1.78, and correspondence address changes must comply with § 1.33(a).

Section 1.76(c)(2) provides that an application data sheet providing corrected or updated information may include all of the sections listed in § 1.76(b) or only those sections containing changed or updated information. Section 1.76(c)(2) further provides that the application data sheet must include the section headings listed in § 1.76(b) for each section included in the application data sheet, and must identify the information that is being changed, with underlining for insertions, and strike-through or brackets for text removed, except that identification of information being changed is not required for an application data sheet included with an initial submission under 35 U.S.C. 371.

Section 1.76(d) governs the situation in which there are inconsistencies between the application data sheet and other documents.

Section 1.76(d)(1) provides that the most recent submission will govern (control) with respect to inconsistencies as between the information provided in an application data sheet, a designation of a correspondence address, or by the inventor’s oath or declaration, except that: (1) the most recent application data sheet will govern with respect to foreign priority (§ 1.55) or domestic benefit (§ 1.78) claims; and (2) the naming of the inventorship is governed by § 1.41 and changes to inventorship or the names of the inventors is governed by § 1.48. Section 1.76(d)(1) no longer references “an amendment to the specification” as governing with respect to inconsistencies in view of the changes to § 1.78.

Section 1.76(d)(2) provides that the information in the application data sheet will govern when the inconsistent information is supplied at the same time by a designation of correspondence

address or the inventor’s oath or declaration.

Section 1.76(d)(3) provides that the Office will capture bibliographic information from the application data sheet. Section 1.76(d)(3) further provides that the Office will generally not review the inventor’s oath or declaration to determine if the bibliographic information contained therein is consistent with the bibliographic information provided in an application data sheet. Section 1.76(d)(3) further provides that incorrect bibliographic information contained in an application data sheet may be corrected as provided in § 1.76(c)(1).

Section 1.76(e) provides that an application data sheet must be signed in compliance with § 1.33(b). Section 1.76(e) further provides that an unsigned application data sheet will be treated only as a transmittal letter. Thus, an unsigned application data sheet will not be effective to provide the name of the inventor for any invention claimed in the application (§ 1.41(b)), to make a claim to priority of a foreign application (§§ 1.55(a)(1)(i), (c) and (d)(1)(ii)), or make a claim to the benefit of a prior-filed domestic application (§§ 1.78(a)(2)(iii) and (a)(5)(iii)).

The Office published a notice in March of 2008 indicating that the requirement under § 1.14(h)(2) that the written authority must be submitted on a separate document is waived in the event the applicant files a properly executed oath or declaration (e.g., the modified Form PTO/SB/01) with the Authorization to Permit Access to Application by Participating Offices. *See Enhancement of Priority Document Exchange Program and USPTO Declaration Form*, 1328 *Off. Gaz. Pat. Office* 90, 91 (Mar. 11, 2008). In view of the changes to §§ 1.63 and 1.76 in this final rule, the Office is now providing that the requirement under § 1.14(h)(2) that the written authority must be submitted on a separate document is not applicable if the applicant files a properly executed application data sheet (e.g., the modified Form PTO/SB/14) with the Authorization to Permit Access to Application by Participating Offices.

*Section 1.77:* Section 1.77(a)(6) is amended to refer to “the inventor’s oath or declaration.” *See* previous discussion of § 1.16(f).

*Section 1.78:* Section 1.78(a)(2)(iii) is amended to provide that the reference to the prior-filed application that is required for benefit claim to a prior-filed nonprovisional application or international application designating the U.S. by a nonprovisional application must be in the application data sheet.

Sections 1.78(a)(5)(iii) is amended to provide that the reference requirement for a benefit claim to a prior-filed provisional application by a nonprovisional application must be in the application data sheet.

Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120. The patent statute requires that a claim to the benefit of (specific reference to) a provisional application (35 U.S.C. 119(e)(1)) or nonprovisional application (35 U.S.C. 120) be in the application. Since the application data sheet (if provided) is considered part of the application, the specific reference to an earlier filed provisional or nonprovisional application in the application data sheet meets the "specific reference" requirement of 35 U.S.C. 119(e)(1) or 120.

Providing this information in a single location will also facilitate more efficient processing of applications, as the Office will only have to look at one location for the benefit claim and the most recent application data sheet will govern. Formerly, the Office had to look at the specification, amendments to the specification and the application data sheet if provided to determine the benefit claim. When applicants provided inconsistent information among the three sources, the Office had to then determine which benefit claim governs in accordance with the rule.

Providing this information in a single location will facilitate review of patents and patent application publications, because applications frequently provide a benefit and/or foreign priority claim in the first sentence(s) of the specification, which is amended by an application data sheet that includes a different benefit or foreign priority claim, and thus the benefit claim and/or foreign priority information contained on the front page of the patent or patent application publication is different from the benefit claim and/or foreign priority claim included in the first sentence(s) of the specification. While the benefit and/or foreign priority claim on the front page of the patent or patent application publication is usually correct, anyone (including an examiner, a practitioner or the public) reviewing the patent or patent application publication must review the file history of the application. Since most applications are filed with an application data sheet, requiring benefit and/or foreign priority claims be included in the application data sheet will not require most practitioners to change their practice.

Section 1.78(a)(5)(iv) is amended to delete the reference to "an amendment"

and to delete the word "Supplemental." Section 1.78(a)(5)(iv) is also amended to change three phrase "withdrawing the benefit claim" to "eliminating the reference under this paragraph to the prior-filed provisional application."

Section 1.78(c) is amended to change "assignee" to "applicant." This change is for consistency with the change in practice concerning who is the applicant for patent in § 1.42.

*Section 1.81:* Section 1.81(a) is amended to change "his or her invention" to "the invention." This change is for consistency with the change in practice concerning who is the applicant for patent in § 1.42.

*Section 1.105:* Section § 1.105 is amended to remove § 1.105(a)(2) (and redesignate §§ 1.105(a)(3) and (a)(4) as §§ 1.105(a)(2) and (a)(3), respectively) as an assignee that has asserted its right to prosecute the application is the applicant. *See* § 1.46.

*Section 1.131:* Section 1.131(a) is amended to change "the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47" to "the applicant or patent owner." This change is for consistency with the change in practice concerning who is the applicant for patent in § 1.42.

*Section 1.136:* Section 1.136(c)(1) is amended to refer to "the inventor's oath or declaration." *See* previous discussion of § 1.16(f).

*Section 1.153:* Section 1.153(b) is amended to refer to "the inventor's oath or declaration." *See* previous discussion of § 1.16(f).

*Section 1.154:* Section 1.154(a)(6) is amended to refer to "the inventor's oath or declaration." *See* previous discussion of § 1.16(f).

*Section 1.162:* Section 1.162 is amended to state that the inventor named for a plant patent application must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought. This change from "applicant" to "inventor" is for consistency with the change in practice concerning who is the applicant for patent in § 1.42. Section 1.162 is also amended to refer to "the inventor's oath or declaration." *See* previous discussion of § 1.16(f).

*Section 1.163:* Section 1.163(b)(6) is amended to refer to "the inventor's oath or declaration." *See* previous discussion of § 1.16(f).

*Section 1.172:* Section 1.172(a) is revised to state that the reissue applicant is the original patentee, or the current patent owner if there has been an assignment. Section 1.172(a) requires

that a reissue application be accompanied by the written consent of all assignees, if any, currently owning an undivided interest in the patent, and that all assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(c). Section 1.172(b) provides that a reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

*Section 1.175:* Section 1.175(a) provides that the inventor's oath or declaration for a reissue application, in addition to complying with the requirements of § 1.63, § 1.64, or § 1.67, must also specifically identify at least one error pursuant to 35 U.S.C. 251 being relied upon as the basis for reissue and state that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent. Examples of proper error statements are discussed in MPEP § 1414, II. The reissue oath or declaration may identify more than one specific error that forms the basis of the reissue, but at least one error must be identified.

Section 1.175(b) provides that if the reissue application seeks to enlarge the scope of the claims of the patent (a basis for the reissue is the patentee claiming less than the patentee had the right to claim in the patent), the inventor's oath or declaration for a reissue application must identify a claim that the application seeks to broaden.

Section 1.175(b) indicates that a claim is a broadened claim if the claim is broadened in any respect for purposes of 35 U.S.C. 251. *See Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2 (Fed. Cir. 1987), *In re Ruth*, 278 F.2d 729, 730 (CCPA 1960), and *In re Rogoff*, 261 F.2d 601, 603 (CCPA 1958). The requirement that a claim broadened in any respect be treated as a broadened claim is important to determine who can sign the reissue oath or declaration. It also is important because a reissue application that broadens the scope of the original patent may only be filed within two years from the grant of the original patent. *See* 35 U.S.C. 251(d).

Section 1.175(c) provides that the inventor, or each individual who is a joint inventor of a claimed invention, in a reissue application must execute an oath or declaration for the reissue application, except as provided for in § 1.64, and except that the inventor's oath or declaration for a reissue application may be signed by the

assignee of the entire interest if: (1) The application does not seek to enlarge the scope of the claims of the original patent; or (2) the application for the original patent was filed under § 1.46 by the assignee of the entire interest. See 35 U.S.C. 251(c).

*Section 1.175(d)* provides that where all errors previously identified in the inventor's oath or declaration for a reissue application pursuant to § 1.175(a) are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue. Thus, a supplemental reissue oath or declaration is no longer required where all errors previously identified in the inventor's oath or declaration for a reissue application pursuant to § 1.175(a) are no longer being relied upon as the basis for reissue. However, the applicant must still identify an error being relied upon as the basis for reissue (e.g., in the remarks of an amendment). A new reissue oath or declaration would be still required if the reissue oath or declaration pursuant to § 1.175(a) fails to identify any error or fails to identify at least one error of the type that would support a reissue. See MPEP § 1402.

Section 1.175 does not contain a requirement for supplemental reissue oaths or declarations in view of the change to 35 U.S.C. 251 in section 20 of the AIA (i.e., removal of the "without any deceptive intention" provision in section 20 of the AIA).

Section 1.175(e) provides that the inventor's oath or declaration for a reissue application required by § 1.175(a) may be submitted under the provisions of § 1.53(f), except that the provisions of § 1.53(f)(3) do not apply to a reissue application. Thus, the inventor's oath or declaration for a reissue application must be present before a reissue application will be examined.

Section 1.175(f) provides that the requirement for the inventor's oath or declaration for a continuing reissue application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed reissue application may be satisfied by a copy of the inventor's oath or declaration from the earlier-filed reissue application, provided that: (1) The inventor, or each individual who is a joint inventor of a claimed invention, in the reissue application executed an inventor's oath or declaration for the earlier-filed reissue application, except as provided for in § 1.64; (2) the continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or (3) the application for the original patent was

filed under § 1.46 by the assignee of the entire interest. Thus, the requirement for the inventor's oath or declaration for a continuing reissue application may be satisfied by a copy of the inventor's oath or declaration from the earlier-filed reissue application except when all of the following conditions exist: (1) The inventor's oath or declaration for the earlier-filed reissue application was executed by the patent owner and not by or with respect to the inventor, (2) the continuing reissue application seeks to enlarge the scope of the claims of the original patent; and (3) the application for the original patent was not filed under § 1.46 by the assignee of the entire interest. Section 1.175(f) further provides that if all errors identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

Section 1.175(g) provides that an oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1), will be placed in the file record of the reissue application, but may not necessarily be reviewed by the Office.

*Section 1.211:* Section 1.211(c) is amended to no longer require "an executed oath or declaration" for publication of the application. Section 1.211(c) is also amended to state that the Office may delay publishing any application until it includes "the inventor's oath or declaration or application data sheet containing the information specified in § 1.63(b)" and to no longer reference a petition under § 1.47. These changes are due to the change to §§ 1.53 and 1.495 to allow applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

*Section 1.215:* Section 1.215(a) is amended to replace "executed oath or declaration" with "application data sheet and/or the inventor's oath or declaration." This change is due to the change to §§ 1.53 and 1.495 to allow applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

Section 1.215(b) is amended to state that the patent application publication will include the name of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter if that information is provided in the application data sheet in an application filed under § 1.46.

Section 1.215(c) is amended to replace "oath or declaration" with "application data sheet and/or the inventor's oath or declaration." This change is due to the change to §§ 1.53 and 1.495 to allow applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

*Section 1.321:* Section 1.321(b) is amended to provide that a terminal disclaimer must be signed by the applicant or an attorney or agent of record and state the present extent of applicant's ownership interest in the patent to be granted.

*Section 1.324:* Section 1.324 is amended to no longer include a "without deceptive intention" requirement (as this requirement has been eliminated from 35 U.S.C. 256 in section 20 of the AIA). Section 1.324(a) provides that whenever through error a person is named in an issued patent as the inventor, or an inventor is not named in an issued patent, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. See 35 U.S.C. 256.

Section 1.324(b) provides that any request to correct inventorship of a patent pursuant to 1.324(a) must be accompanied by: (1) A statement from each person who is being added as an inventor and each person who is currently named as an inventor either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change; (2) a statement from all assignees of the parties submitting a statement under 1.324(b)(1) agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(c); and (3) the fee set forth in § 1.20(b).

Section 1.324(c) provides a cross reference to § 1.48 for correction of inventorship in an application.

Section 1.324(d) provides that in an interference under part 41, subpart D, of this title, a request for correction of inventorship in a patent must be in the form of a motion under § 41.121(a)(2) of this title, and that in a contested case under part 42, subpart D, of this title, a request for correction of inventorship in a patent must be in the form of a motion under § 42.22 of this title. Section 1.324(d) further provides that the motion under § 41.121(a)(2) or 42.22 of this title must comply with the requirements of § 1.324.

*Section 1.414:* Section 1.414(c)(2) is amended to replace "[a]ccepting for

national stage examination international applications which satisfy the requirements of 35 U.S.C. 371” with “[n]ational stage processing for international applications entering the national stage under 35 U.S.C. 371.” As discussed previously, an international application does not satisfy the requirements of 35 U.S.C. 371 until the inventor’s oath or declaration has been filed. Thus, under the changes to inventor’s oath or declaration practice in this final rule, the Office must process and conduct national examination of international applications before they satisfy the requirements of 35 U.S.C. 371.

*Section 1.421:* Section 1.421(b) is amended to provide that “[a]lthough the United States Receiving Office will accept international applications filed by any applicant who is a resident or national of the U.S. for international processing, for the purposes of the designation of the U.S., an international application will be accepted by the Patent and Trademark Office for the national stage only if the applicant is the inventor or other person as provided in § 1.422 or § 1.424.” Section 1.421(b) continues to provide that joint inventors must jointly apply for an international application.

Section 1.421 is amended to delete the provision of former § 1.421(c) that for purposes of designations other than the U.S., international applications may be filed by the assignee or owner. This provision is deleted in view of the changes to 35 U.S.C. 118 under the AIA.

Sections 1.421(c), (d), and (e) contain the provisions of former §§ 1.421(d), (e), and (f), respectively.

Section 1.421(f) contains the provisions of former § 1.421(g), except for the provision that the submission of a separate power of attorney may be excused upon the request of another applicant where one or more inventors cannot be found or reached after diligent effort, and that such a request must be accompanied by a statement explaining to the satisfaction of the Director the lack of the signature concerned.

*Section 1.422:* Section 1.422 is amended to provide that if an inventor is deceased or under legal incapacity, the legal representative of the inventor may be an applicant in an international application which designates the United States.

*Section 1.423:* Section 1.423 is removed and reserved as its provisions are now in § 1.422.

*Section 1.424:* Section 1.424 is added to provide for an assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in

the matter as the applicant under 35 U.S.C. 118 in an international application.

Section 1.424(a) provides that a person to whom the inventor has assigned or is under an obligation to assign the invention may be an applicant in an international application which designates the U.S. Section 1.424(a) also provides that a person who otherwise shows sufficient proprietary interest in the matter may be an applicant in an international application which designates the U.S. on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

Section 1.424(b) provides that neither any showing required under § 1.424(a) nor documentary evidence of ownership or proprietary interest will be required or considered by the Office in the international stage, but such showings will be required in the national stage in accordance with the conditions and requirements of § 1.46.

*Section 1.431:* Section 1.431(b)(3)(iii) is amended to reference §§ 1.421, 1.422 and 1.424 for consistency with the removal of § 1.423 and the addition of § 1.424.

*Section 1.491:* Section 1.491(b) is amended by stating that an international application enters the national stage when the applicant has filed “the documents and fees required by 35 U.S.C. 371(c)(1) and (c)(2) within the period set in § 1.495” rather than “the documents and fees required by 35 U.S.C. 371(c) within the period set in § 1.495.” 35 U.S.C. 371 provides that “[a]fter an international application has entered the national stage, no patent may be granted or refused thereon before the expiration of the applicable time limit under [PCT Article 28 or 41], except with the express consent of the applicant.” See 35 U.S.C. 371(e). 35 U.S.C. 371, however, does not define when an international application enters the national stage. The Office formerly defined when an international application enters the national stage as when the applicant files the documents and fees required by 35 U.S.C. 371(c) within the period set in § 1.495, which means that an international application would not enter the national stage until the applicant files the inventor’s oath or declaration. See 35 U.S.C. 371(c)(4). As the Office is changing inventor’s oath or declaration practice to allow applicants to postpone filing the inventor’s oath or declaration until the application is otherwise in condition for allowance, the Office would be examining international applications prior to national stage entry under the definition

of national stage entry provided in former § 1.491(b).

Section 1.491(c) is added to state that an international application fulfills the requirements of 35 U.S.C. 371 when all applicable requirements of 35 U.S.C. 371, including commencement under 35 U.S.C. 371(b) or (f), have been satisfied. As discussed previously, the fourteen-month time frame in 35 U.S.C. 154(b)(1)(A)(i)(II) for issuing an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 is measured from “the date on which an international application fulfilled the requirements of section 371 of this title” (not the date of commencement of national stage processing or entry into the national stage). An international application does not fulfill the requirements of 35 U.S.C. 371 until the applicant files the inventor’s oath or declaration. See 35 U.S.C. 371(c)(4) and MPEP § 1893.03(b). Thus, § 1.491(c) is added as a reminder to PCT applicants that an international application fulfills the requirements of 35 U.S.C. 371 only when all applicable requirements of 35 U.S.C. 371 have been satisfied.

*Section 1.492:* Section 1.492(h) is amended to refer to “the inventor’s oath or declaration.” See previous discussion of § 1.16(f).

*Section 1.495:* Section 1.495(a) is amended to remove the sentence that stated “international applications for which the requirements of § 1.495 are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America” as the sentence was confusing.

Section 1.495(c)(1)(ii) is amended to refer to “the inventor’s oath or declaration.” See previous discussion of § 1.16(f).

Section 1.495(c)(2) provides that a notice under § 1.495(c)(1) will set a time period within which applicant must provide any omitted translation, search fee set forth in § 1.492(b), examination fee set forth in § 1.492(c), and any application size fee required by § 1.492(j) in order to avoid abandonment of the application. Section 1.495(c)(3) (discussed subsequently) sets forth the time period for filing the inventor’s oath or declaration and provides the conditions under which an applicant may postpone filing the inventor’s oath or declaration until the application is otherwise in condition for allowance.

Section 1.495(c)(3) sets forth the time period for filing the inventor’s oath or declaration and provides the conditions under which an applicant may postpone filing the inventor’s oath or declaration until the application is otherwise in condition for allowance. Section

1.495(c)(3) specifically provides that the inventor's oath or declaration must also be filed within the period specified in § 1.495(c)(2), except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in §§ 1.495(c)(3)(i) through (c)(3)(iii). Section 1.495(c)(3)(i) provides that the application must contain an application data sheet in accordance with § 1.76 filed prior to the expiration of the time period set in any notice under § 1.495(c)(1) identifying: (1) Each inventor by his or her legal name; and (2) a mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor. Section 1.495(c)(3)(ii) provides that the applicant must file an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor no later than the expiration of the time period set in the "Notice of Allowability" to avoid abandonment, when the applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance. The time period set in a "Notice of Allowability" is not extendable. *See* § 1.136(c). The Office may dispense with the notice provided for in § 1.495(c)(1) if an oath or declaration under § 1.63, or substitute statement under § 1.64, executed by or with respect to each actual inventor has been filed before the application is in condition for allowance.

Under former practice, the Office issued a Notification of Missing Requirements if the basic national fee and copy of the international application (if required under § 1.495(b)(1)) have been received by the expiration of thirty months from the priority date, but the inventor's oath or declaration has not been filed. If the Office issued a Notification of Missing Requirements, the applicant was given a time period (the later of two months from the date of the notice or thirty-two months from the priority date) within which to file the inventor's oath or declaration and pay the surcharge required by § 1.492(h) to avoid abandonment. *See* MPEP § 1893.01(e). The Office is modifying this practice such that if a signed application data sheet providing the information required by § 1.495(c)(3)(i) has been received, but not the inventor's oath or declaration, the Office will not issue a Notification of Missing Requirements

requiring the applicant to file the inventor's oath or declaration. This change will not affect the practice of issuing a Notification of Missing Requirements if another requirement is missing (e.g., an English translation of the international application required under § 1.495(c) or the surcharge required by § 1.492(h) for filing the inventor's oath or declaration after the date of commencement). If the basic national fee and required copy of the international application have been received by the expiration of thirty months from the priority date, but neither the inventor's oath or declaration as required under § 1.497 nor a signed application data sheet providing the information required by § 1.495(c)(3)(i) have been received, the Office will issue a Notification of Missing Requirements giving the applicant a time period (at least two months) within which to file the inventor's oath or declaration (or signed application data sheet providing the information required by § 1.495(c)(3)(i) and surcharge required by § 1.492(h) (unless previously paid) to avoid abandonment. In this situation, the inventor's oath or declaration will not be required within the period for reply to the Notification of Missing Requirements if the applicant provides a signed application data sheet providing the information required by § 1.495(c)(3)(i) within the period for reply to the Notification of Missing Requirements. The surcharge required by § 1.492(h), and any other item required by the Notification, however, must be filed within the period for reply to the Notification of Missing Requirements to avoid abandonment.

If an application is in condition for allowance and includes an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, the Office will issue a "Notice of Allowability" (PTOL-37) and a "Notice of Allowance and Fee(s) Due" (PTOL-85). If an application is in condition for allowance but does not include an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, the Office will issue a "Notice of Allowability" (PTOL-37) (but not a "Notice of Allowance and Fee(s) Due" (PTOL-85)) giving the applicant three months to file an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, to avoid abandonment.

This three-month time period is not extendable under § 1.136(a). The "Notice of Allowance" (PTOL-85) will not be issued until the application includes an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor.

Section 1.495(c)(3)(iii) provides that an international application in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid and for which an application data sheet in accordance with § 1.76 has been filed may be treated as complying with 35 U.S.C. 371 for purposes of eighteen-month publication under 35 U.S.C. 122(b) and § 1.211 *et seq.* Section 4508 of the American Inventors Protection Act of 1999 provides that its eighteen-month publication provisions apply to applications (other than for a design patent) filed under 35 U.S.C. 111(a) on or after November 29, 2000, and to applications in compliance with 35 U.S.C. 371 that resulted from international applications filed under 35 U.S.C. 363 on or after November 29, 2000. *See* Pub. L. 106-113, 113 Stat. 1501, 1501A-566 through 1501A-567 (1999). As discussed previously, an international application is not in compliance with 35 U.S.C. 371 until the applicant files the inventor's oath or declaration. *See* 35 U.S.C. 371(c)(4). Thus, this provision permits the Office to treat an international application in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid and for which an application data sheet in accordance with § 1.76 has been filed as complying with 35 U.S.C. 371 for purposes of eighteen-month publication.

There is a distinction between treating an international application without the inventor's oath or declaration as complying with 35 U.S.C. 371 for purposes of eighteen-month publication and treating an international application without the inventor's oath or declaration as fulfilling the requirements of 35 U.S.C. 371 for patent term adjustment purposes. The PCT provides for eighteen-month publication (PCT Article 21) and thus the publication by the Office of an international application that is in compliance with 35 U.S.C. 371 is a republication of the application. *See Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR 57021, 57045 (Sept. 20, 2000) (comment 47 and response). Patent term adjustment, however, has an impact on the rights of third parties to the application process (the public). *See* 35 U.S.C. 282(c) (provides a defense based

upon invalidity of an extension under 35 U.S.C. 154(b)).

Sections 1.495(c)(4) and (c)(5) contain the provisions of former § 1.495(c)(3) and (c)(4).

Section 1.495(g) provides that if the documents and fees contain conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371, the documents and fees will be treated as a submission to enter the national stage under 35 U.S.C. 371. It is Office experience that, in most cases, documents and fees that contain such conflicting indications were intended as submissions under 35 U.S.C. 371.

Section 1.495(h) is amended to delete the provision that if the requirements of § 1.495(b) are complied with within thirty months from the priority date, but either any required translation of the international application or the oath or declaration are not timely filed, an international application will become abandoned as to the U.S. upon expiration of the time period set pursuant to § 1.495(c).

*Section 1.496:* Section 1.496 is amended to provide that national stage applications having paid therein the search fee as set forth in § 1.492(b)(1) and examination fee as set forth in § 1.492(c)(1) may be amended subsequent to the date of commencement of national stage processing only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Section 1.496 also provides that such national stage applications will be advanced out of turn for examination. Section 1.496 is also amended to eliminate the language concerning when international applications are otherwise taken up for examination as relating to an unnecessary internal Office instruction.

*Section 1.497:* Section 1.497(a) provides that when an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with § 1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1, the applicant must file the inventor's oath or declaration. Section 1.497(a) further provides that the inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration in accordance with the conditions and requirements of § 1.63, except as provided for in § 1.64.

Section 1.497(b) provides that an oath or declaration under § 1.63 will be accepted as complying with 35 U.S.C.

371(c)(4) if it complies with the requirements of §§ 1.63(a), (c) and (g). Section 1.497(b) provides that a substitute statement under § 1.64 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§ 1.64(b)(1), (c) and (e) and identifies the person executing the substitute statement. Section 1.497(b) further provides that if a newly executed inventor's oath or declaration under § 1.63 or substitute statement under § 1.64 is not required pursuant to § 1.63(d), submission of the copy of the previously executed oath, declaration, or substitute statement under § 1.63(d)(1) is required to comply with 35 U.S.C. 371(c)(4).

Section 1.497(c) provides that if an oath or declaration under § 1.63, or substitute statement under § 1.64, meeting the requirements of § 1.497(b) does not also meet the requirements of § 1.63 or 1.64, an oath, declaration, substitute statement, or application data sheet in accordance with § 1.76 to comply with § 1.63 or § 1.64 will be required.

*Section 1.530:* Section 1.530(l)(1) is amended to eliminate the "without deceptive intention" requirement (as this requirement has been eliminated from 35 U.S.C. 256 in section 20 of the AIA).

*Section 1.730:* Section 1.730(b)(1) is amended to change the reference to "3.73(b)" to "3.73(c)" for consistency with the change to § 3.73.

### 37 CFR Part 3

*Section 3.31:* Section 3.31(h) is amended to provide that the assignment cover sheet required by § 3.28 must contain a conspicuous indication of an intent to utilize the assignment as the required oath or declaration under § 1.63. This implements the provision of 35 U.S.C. 115(e) which allows use of an assignment in lieu of an oath or declaration to meet the oath or declaration requirements of § 1.63. See previous discussion of § 1.63(e).

*Section 3.71:* Section 3.71(a) is amended to provide that one or more assignees as defined in § 3.71(b) may conduct prosecution of a national patent application as the applicant under § 1.46 of this title, or conduct prosecution of a supplemental examination or reexamination proceeding, to the exclusion of the inventor or previous applicant or patent owner. Section 3.71(a) formerly provided that an assignee may take over prosecution of a national patent application to the exclusion of the inventor or previous assignee. As discussed previously, in view of the changes to § 1.46 to implement the

provisions of 35 U.S.C. 118, an assignee who files the application or takes over prosecution of a national patent application does so as the applicant under § 1.46. Section 3.71(a) also includes a reference to the supplemental examination proceedings that have been added by section 12 of the AIA. Section 3.71(a) also provides that conflicts between purported assignees are handled in accordance with § 3.73(c)(3).

Section 3.71(b) provides that the assignee(s) who may conduct either the prosecution of a national application for patent as the applicant under § 1.46 of this title or a supplemental examination or reexamination proceeding are: (1) a single assignee who is the assignee of the entire right, title and interest in the application or patent, or (2) all partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent, who together own the entire right, title and interest in the application or patent. Section 3.71(b) provides that a partial assignee is any assignee having less than the entire right, title and interest in the application or patent. Section 3.71(b) further provides that the word "assignee" as used in this chapter means with respect to patent matters the single assignee of the entire right, title and interest in the application or patent if there is such a single assignee, or all of the partial assignees, or all of the partial assignees and inventors who have not assigned their interest in the application or patent, who together own the entire right, title and interest in the application or patent.

Section 3.71(c) provides that an assignee becomes of record as the applicant in a national patent application under § 1.46 of this title, and in a supplemental examination or reexamination proceeding, by filing a statement in compliance with § 3.73(c) that is signed by a party who is authorized to act on behalf of the assignee.

*Section 3.73:* Section 3.73(a) provides with respect to patents that the original applicant is presumed to be the owner of an application for an original patent, and any patent that may issue therefrom, unless there is an assignment. Thus, in view of the changes to § 1.46 to implement the provisions of 35 U.S.C. 118, the presumption is now that the original applicant (and not the inventor(s)) is the owner of an application for an original patent. Section 3.73(a) continues to provide with respect to trademarks that the original applicant is presumed to be the owner of a trademark application or

registration, unless there is an assignment.

Section 3.73(b) is amended to provide only for trademark matters (patent matters are provided for in § 3.73(c)). Section 3.73(b) provides that in order to request or take action in a trademark matter, the assignee must establish its ownership of the trademark property of § 3.73(a) to the satisfaction of the Director, and that the establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Section 3.73(b) further provides that ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either: (1) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment), which documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or (2) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

Section 3.73(c) provides that in order to request or take action in a patent matter, an assignee who is not the original applicant must establish its ownership of the patent property of § 3.73(a) to the satisfaction of the Director, and that the establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Section 3.73(c) further provides that ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either: (1) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment), and that the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (2) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

Section 3.73(c)(2) provides that if the submission is by an assignee of less than the entire right, title and interest (e.g., more than one assignee exists), the Office may refuse to accept the submission as an establishment of

ownership unless: (1) Each assignee establishes the extent (by percentage) of its ownership interest, so as to account for the entire right, title and interest in the application or patent by all parties including inventors; or (2) each assignee submits a statement identifying the parties including inventors who together own the entire right, title and interest and stating that all the identified parties own the entire right, title and interest.

Section 3.73(c)(3) provides that if two or more purported assignees file conflicting statements under § 3.73(c)(1), the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application. This provision sets out the Office's practice for treating two or more conflicting statements under § 3.73(c), currently discussed in MPEP § 324, IX.

Section 3.73(d) provides that the submission establishing ownership under § 3.73(b) (for trademark matters) or § 3.73(c) (for patent matters) must show that the person signing the submission is a person authorized to act on behalf of the assignee by: (1) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; (2) being signed by a person having apparent authority to sign on behalf of the assignee; or (3) for patent matters only, being signed by a practitioner of record.

#### 37 CFR Part 5

*Section 5.25:* Sections 5.25(a)(3)(iii) and 5.25(b) are amended to delete the "without deceptive intention" clauses for consistency with the change to 35 U.S.C. 184 in section 20 of the AIA.

#### 37 CFR Part 10

*Section 10.23:* Section 10.23(c)(11) is removed and reserved. Section 1.52(c) no longer prohibits changes to the application papers after execution of the inventor's oath or declaration. Thus, § 10.23 is amended to eliminate the clause concerning knowingly 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 (except as permitted by § 1.52(c)) as conduct which constitutes a violation of § 10.23.

#### 37 CFR Part 41

*Section 41.9:* Section 41.9(a) is amended to change the reference to "3.73(b)" to "§§ 3.71 and 3.73."

*Comments and Responses to Comments:* As discussed previously, the

Office published a notice on January 6, 2012, proposing to change the rules of practice to implement the inventor's oath or declaration provisions of section 4 of the AIA. *See Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR at 982–1003. The Office received thirty-one written comments from intellectual property organizations, academia, industry, law firms, individual patent practitioners, and the general public in response to this notice. The comments and the Office's responses to the comments follow:

- A. Assignee Filing.
- B. Oath/Declaration.
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#### A. Assignee Filing

*Comment 1:* A number of comments questioned the Office permitting assignee filing only under the narrow exceptions of death, incapacity, absence or refusal. A number of comments suggested that the rules be revised to recognize that "applicant" and "inventor" are no longer interchangeable because assignees, parties to whom an inventor is obligated to assign, and parties with a sufficient proprietary interest in the matter, can also be applicants. One comment stated that by replacing the language in 35 U.S.C. 118 (which formerly permitted filing by other than the inventor only in the situations where the inventor was unwilling or unavailable to execute the oath or declaration) with broader language, Congress has in 35 U.S.C. 118 authorized an assignee to file an application for a patent as the applicant. A number of comments requested that the rules be revised for submission of



the inventor statements in applications filed by assignees and obligated assignees to simplify the submission of the inventor statements, facilitate the process by which an assignee or obligated assignee may file and prosecute applications, and accomplish greater international harmonization. One comment suggested that, in the interest of procedural harmonization with the patent laws of other countries, the Office should dispense with the oath or declaration entirely. One comment, however, expressed agreement with most of the changes in the notice of proposed rulemaking, and agreement with the requirement that inventors must execute oaths or declarations.

*Response:* The Office agrees that the AIA changes 35 U.S.C. 118 to permit an assignee, an obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter to make an application as the "applicant." Accordingly, this final rule revises the rules of practice to provide that assignees, obligated assignees (parties to whom an inventor is obligated to assign) and parties who otherwise show sufficient proprietary interest in the matter may file an application for patent as the applicant. Historically, being the applicant was synonymous with being the one to execute the oath or declaration under 35 U.S.C. 115. However, the AIA amends 35 U.S.C. 115 to separate being the applicant from being the one who must execute the oath or declaration under 35 U.S.C. 115 (normally the inventor). Thus, 35 U.S.C. 115 and 118, as amended by the AIA, provide that an application may be filed by a person other than the inventor as the applicant, but 35 U.S.C. 115 still also requires an oath or declaration from the inventor (except in certain situations). The situations in which the applicant for patent may submit a substitute statement in lieu of an oath or declaration with respect to an inventor are set forth in 35 U.S.C. 115(d)(2).

*Comment 2:* A number of comments requested that the Office recognize the ability of assignees, obligated assignees, and persons who otherwise show sufficient proprietary interest in the matter to file an application and have requested that the requirements be simplified. A few comments suggested that in the case of an assignment or obligation to assign, no documents should be required to perfect the right to file the application. The comments stated that an application filed by the assignee or an obligated assignee plus an oath or declaration by the inventors would be sufficient. One comment suggested that the Office should require no more than a copy of the assignment

to perfect the right to execute an oath or declaration, as the inventor no longer has a property interest and thus the assignee should be able to make the application without additional requirements. One comment suggested that the Office permit assignees to make certifications regarding ownership in the application data sheet.

Some comments recognized that the Office would likely want documents containing "proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties" where an application is filed by a party with sufficient proprietary interest. However, two comments stated that there is no need for the Office to review these documents to determine sufficiency, but rather the Office should only review them to determine whether they appear to satisfy the requirements for submission, with one comment stating that any challenge to a filing should be made in court. One comment requested that the Office not include any confidential documents used as "proof" in the public image file wrapper. The comment suggested that the Office could state in the file wrapper that certain agreements were reviewed by the Office and found to fulfill the criteria.

*Response:* Section 1.46 as adopted in this final rule permits the filing of applications by assignees, obligated assignees, and persons who otherwise show sufficient proprietary interest in the matter with an application data sheet identifying the party filing the application (the applicant). For assignees and obligated assignees, documentary evidence of an ownership interest should be recorded no later than the date the issue fee is paid. See § 1.46(b)(1).

Section 1.46 provides that parties who otherwise show sufficient proprietary interest in the matter must also submit a petition with documentary evidence of the sufficient proprietary interest. 35 U.S.C. 118 provides that a party with sufficient proprietary interest may file an application, but the filing is done on behalf of and as agent for the inventors on proof of the pertinent facts. The Office believes that the petition is necessary in these situations to determine whether an appropriate party is filing the application, which requires some additional review as to the assertion of sufficient proprietary interest. It is not the intent of the Office to make a definitive factual determination of the showing of sufficiency of the proprietary interest, but the showing will be reviewed to ensure that the party has a valid basis for being treated as the applicant for

patent on behalf of and as agent for the inventors.

The documentary evidence submitted to establish proof of sufficient proprietary interest is not always as clear-cut as an assignment or a document showing an obligation to assign. Thus, it is appropriate that the documentary evidence be visible in the file record when the application becomes available to the public.

*Comment 3:* A number of comments suggested that all that should be required on filing is a two-part statement affirming: (1) that the applicant is either the inventor, or is authorized by the inventor to file the application, and (2) that the applicant has filed with the application or will file an inventor statement under 35 U.S.C. 115 before receiving a notice of allowance. In addition to the two-part statement, one comment suggested that every application as filed could be required to contain identifying information essential to the orderly processing of the application, such as the name of the inventor, the name of the applicant (if different from the inventor), residence, and correspondence address. A number of comments suggested that, other than the two-part statement and identifying information, no more than the minimum averments mandated by 35 U.S.C. 115(b) should be required in an inventor statement.

*Response:* In response to the comments, this final rule revises § 1.63 to require only the statements that are required by 35 U.S.C. 115(b), provided that an application data sheet is submitted to provide inventor and other application information.

*Comment 4:* A number of comments suggested that the application data sheet should be used to provide inventor information instead of an oath or declaration. The comments suggested that the vast majority of applications do not have inventorship or assignment issues and the process of dealing with the formalities should be deferred until an indication of allowable subject matter. Another comment stated that the assignee-applicant is in the best position to decide who is to be named as an inventor, based on a legal analysis of what it takes to be an inventor, and the Office on its own should not raise inventorship issues, as such issues are best handled through a derivation action or a court action. One comment noted that early submission of the declaration can be difficult for foreign applicants and entities whose inventors are no longer available.

*Response:* The Office needs the correct identification of the inventive

entity prior to examination of the application to determine whether an exception under 35 U.S.C. 102(b), as amended in the AIA, is applicable and to conduct a double patenting analysis. Accordingly, an applicant may file the application and identify the inventive entity in either an application data sheet under § 1.76 or in the inventor's oath or declaration. If an application data sheet is submitted with the application or within the period provided in §§ 1.53(f)(1) or (f)(2), an applicant may postpone submission of the inventor's oath or declaration until the application is in condition for allowance. The Office does not generally question whether the identified inventive entity is the inventor except in interference and contested cases.

*Comment 5:* One comment suggested that the proposed rules not include a requirement for notification of a change in ownership no later than payment of the issue fee.

*Response:* 35 U.S.C. 118 requires the Office to grant the patent to the real party in interest where the application was filed under 35 U.S.C. 118 by a person other than the inventor. In order for the Office to carry out this statutory mandate, the Office must be notified of any change in the real party in interest no later than payment of the issue fee. Therefore, § 1.46, as adopted in this final rule, requires applicants to notify the Office of any change in the real party in interest no later than payment of the issue fee in the situation where a real party in interest has filed the application under § 1.46.

## B. Oath/Declaration

### 1. Time of Submission

*Comment 6:* A number of comments suggested that, in view of 35 U.S.C. 115(f), the Office should not require applicants to file the inventor's oath or declaration until the application is in condition for allowance. One comment supported early submission of the oath or declaration as better for the examination process and patent pendency.

*Response:* In response to the comments, this final rule permits delaying submission of the inventor's oath or declaration until the application is otherwise in condition for allowance. The inventor's oath or declaration will not be required within the period specified in §§ 1.53(f)(1) or (f)(2) but may be filed when the application is otherwise in condition for allowance if the application is an original (non-reissue) application that contains an application data sheet in accordance with § 1.76 identifying: (1) Each

inventor by his or her legal name; and (2) a mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

It should be noted that 35 U.S.C. 115(f) does not provide that an applicant is entitled as a matter of right to postpone submission of the inventor's oath or declaration until an application is in condition for allowance. The Office's authority to set the period (and conditions) under which the inventor's oath or declaration may be submitted after the filing date of an application is set forth in 35 U.S.C. 111(a)(3) ("The application must be accompanied by the fee required by law. The fee and oath or declaration may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.") and (a)(4) ("Upon failure to submit the fee and oath or declaration within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath or declaration was unavoidable or unintentional."). See 35 U.S.C. 111(a)(3) and (a)(4) (AIA changes emphasized). Some previous legislative proposals (e.g., S. 515 and H.R. 1260 in the 111th Congress) would have changed this provision to delete any reference to an oath (or declaration) such that the Office could not set the period (and conditions) under which the inventor's oath or declaration could be submitted after the filing date of an application. However, the AIA maintains the existing provisions of 35 U.S.C. 111(a)(3) and (a)(4), adding only "or declaration" after every instance. Thus, the Office retains the authority to set the period (and conditions) under which the inventor's oath or declaration must be submitted.

It should also be noted that 35 U.S.C. 115(f) does not require the Office to permit applicants to postpone submission of the inventor's oath or declaration until allowance. The Office previously proposed under existing 35 U.S.C. 111 and 115 to permit applicants to delay submission of an oath or declaration until the expiration of a time period set in the "Notice of Allowability." See *Changes to Implement the Patent Business Goals*, 63 FR 53497, 53503–06 (Oct. 5, 1998). The Office, however, did not proceed with that proposal. See *Changes to Implement the Patent Business Goals*, 64 FR 53771, 53773–74 (Oct. 4, 1999).

Thus, the only effect of 35 U.S.C. 115(f) is to preclude the Office from issuing a notice of allowance until each required inventor's oath or declaration has been filed.

*Comment 7:* Two comments expressed concern about the fees to be charged for the late submission of an oath or declaration. One comment stated that 35 U.S.C. 111(a) and 371 do not require a surcharge for submitting the oath or declaration after the filing date. One comment stated that the preliminary proposed patent fee schedule published February 7, 2012, indicated that the \$130 surcharge would be increased to \$140 and that no actual unit cost was associated with this fee because there was no specific activity supporting it other than collecting and depositing the fee. The comment stated that this contradicts the Office's statement in the notice of proposed rulemaking that applications filed without an oath or declaration require special processing. The comment also questioned the proposed fee of \$3,000 for filing the oath or declaration up to the notice of allowance on the same basis that there is no specific activity supporting the fee other than collecting and depositing the fee.

*Response:* The notice of proposed rulemaking did not propose, and this final rule does not adopt, any change to the late filing surcharge under § 1.16(f). As discussed previously, 35 U.S.C. 111(a)(3) provides that: "The fee and oath or declaration may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director." While the Office is not "required" to charge this surcharge, the Office is permitted to require it. The surcharge is due to the additional processing costs incurred when the inventor's oath or declaration is submitted after filing of the application and the initial processing of the application. The fact that the cost of the additional processing of the later-submitted oath or declaration is not tracked separately from other pre-examination costs does not negate the existence of this cost. In addition, under the changes in this final rule the Office will incur additional costs due to the need to track submission of the inventor's oath or declaration up to allowability of the application.

The Office published materials on its Internet Web site in February 2012, associated with a rulemaking to set and adjust patent fees using the authority provided in section 10 of the AIA, which proposed a \$3,000 fee to

postpone submission of the inventor's oath or declaration until the application is in condition for allowance. The final rule to set and adjust patent fees under section 10 of the AIA will not include this proposal.

*Comment 8:* One comment suggested that examiners should be properly compensated for any additional work required by delays in establishing the proper inventorship.

*Response:* The Office will require that the inventorship be named in an application data sheet (or the inventor's oath or declaration) prior to examination. Thus, the inventorship will be established before an application is examined and examiners should not experience any delays with respect to the establishment of the proper inventorship. Additionally, compensation of examiners is not a subject of this rulemaking.

## 2. Averments

*Comment 9:* A number of comments suggested that the Office should not require the inventor's oath or declaration to contain any statements other than the statements required by 35 U.S.C. 115(b).

*Response:* 35 U.S.C. 115(c) provides that the Office may specify additional information relating to the inventor and to the invention that is required to be included in an oath or declaration under 35 U.S.C. 115(a). In response to comments, however, the Office is requiring that an oath or declaration contain only the averments required by 35 U.S.C. 115(b), if the inventor information is provided in an application data sheet. The Office has not retained regulatory averments to be made in the inventor's oath or declaration, such as acknowledgement of the duty of disclosure under § 1.56. However, a person may not execute an oath or declaration unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information that is material to patentability. See § 1.63(c).

*Comment 10:* One comment stated that the averment in proposed § 1.63(a)(5) that the application "was made or authorized to be made by the inventor" should not be required in an oath or declaration that is signed by the assignee.

*Response:* 35 U.S.C. 115(b)(1) requires that an oath or declaration contain a statement that the application was made or was authorized to be made by the affiant or declarant irrespective of whether the application was filed by the assignee. Therefore, § 1.63(a)(4) requires

the oath or declaration to state that the application was made or was authorized to be made by the person executing the oath or declaration.

## 3. Inventors Named

*Comment 11:* A number of comments suggested that the Office should not require the inventor's oath or declaration to provide the names of all of the inventors, which could be provided together in another document (such as an application data sheet).

*Response:* An inventor executing an oath or declaration need only identify himself or herself as an inventor, provided an application data sheet is submitted to identify the complete inventive entity.

*Comment 12:* One comment stated that proposed § 1.63(d)(2) should be deleted since the naming of the inventive entity should be established by filing an application data sheet in a continuing application and thus there would be no need to request removal of inventors.

*Response:* A request to remove one or more inventors is retained for those situations where an application data sheet is not supplied concurrently with or before submission of the inventor's oath or declaration.

## 4. Copies in Continuing Applications

*Comment 13:* One comment suggested that the Office scan the inventor statement or assignment into the Office's image file wrapper (IFW) system so that a copy of any previously filed statement would not be required in a later-filed application claiming benefit.

*Response:* Consistent with pre-existing practice and the notice of proposed rulemaking, the Office is requiring a copy of the oath or declaration or an assignment serving as the oath or declaration in continuing applications so that the Office can determine whether an oath or declaration has been executed by or with respect to each inventor in a continuing application.

*Comment 14:* One comment questioned whether a combination assignment and oath or declaration in a parent application would need to be recorded against a continuation or a divisional application when also used in the continuation or divisional application. The comment also questioned whether the assignee listed on such an assignment would still need to be the owner when submitting the oath or declaration in the continuation or divisional application.

*Response:* Section 1.63(d)(1) provides that a newly executed oath or

declaration under § 1.63 is not required for a continuing application where a copy of the oath or declaration from the earlier-filed application is provided. Where the oath or declaration is set forth in an assignment document that was recorded against the parent application, there is no requirement that the copy be again recorded against the continuing application. 35 U.S.C. 115(g)(1) provides that the requirement under 35 U.S.C. 115 for an oath or declaration shall not apply to an individual named as the inventor or a joint inventor in an application that claims benefit under 35 U.S.C. 120, 121, or 365(c) of an earlier-filed application, if: (1) An oath or declaration meeting the requirements of 35 U.S.C. 115(a) was executed by the individual and was filed in connection with the earlier-filed application; (2) a substitute statement meeting the requirements of 35 U.S.C. 115(d) was filed in connection with the earlier-filed application with respect to the individual; or (3) an assignment meeting the requirements of 35 U.S.C. 115(e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application.

*Comment 15:* One comment asserted an inconsistency between proposed § 1.63(d)(1)(iii) which requires a new oath or declaration from those inventors being added and § 1.63(d)(2), which permits deletion by a separate paper without a new oath or declaration. The comment indicated that it is not clear how the statements in the oath or declaration filed in the parent application can remain true where a copy of the declaration from the parent is filed along with declarations executed by only the newly added inventors. Other comments noted that proposed §§ 1.63(a)(4) and (a)(6) would prevent the use of a copy of an oath or declaration in continuation-in-part applications and possibly continuation and divisional applications.

*Response:* Section 1.63(d), as adopted in this final rule, provides for use of a copy of the inventor's oath or declaration from a prior-filed application in a continuing application, including a continuation-in-part application. 35 U.S.C. 115(g) does not require a new inventor's oath or declaration if: (1) An oath or declaration meeting the requirements of 35 U.S.C. 115(a) was executed by the individual and was filed in connection with the earlier-filed application; (2) a substitute statement meeting the requirements of 35 U.S.C. 115(d) was filed in connection with the earlier-filed application with respect to the individual; or (3) an

assignment meeting the requirements of 35 U.S.C. 115(e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application. Thus, an additional inventor's oath or declaration would be necessary in a continuing application only for an inventor for whom an oath or declaration was not submitted in the prior-filed application. Section 1.63(d), as adopted in this final rule, does not include the proposed requirement that the statements in the copy of the inventor's oath or declaration from a prior-filed application also be applicable to the continuing application.

#### 5. Supplemental Oath or Declaration

*Comment 16:* One comment asserted that once a one-time statement from an inventor has been made in satisfaction of 35 U.S.C. 115, 35 U.S.C. 115(h)(2) precludes the Office from requiring any supplemental oath or declaration. Several comments objected to proposed § 1.67 and asserted that the Office was proposing to merely retain requirements for supplemental oaths, notwithstanding the statutory prohibition against them.

*Response:* Section 1.67(c) provides that the Office will not require a person who has executed an oath or declaration in compliance with 35 U.S.C. 115 and § 1.63 or § 1.162 to provide an additional oath or declaration. 35 U.S.C. 115(h)(2) precludes the Office from requiring a supplemental oath or declaration only if the initial oath or declaration complied with 35 U.S.C. 115 and § 1.63 or § 1.162.

*Comment 17:* One comment expressed concern about the elimination of supplemental oaths (proposed § 1.67(b)), as they give the inventor the opportunity to object to the assignee's interpretation of the invention which may be broader than the inventor's understanding of the description. The comment noted the existing requirement that reissue oaths or declarations be signed by the inventors when one or more claims are being broadened, and suggested that inventors be permitted to request "post grant review" to clarify new matter issues that may arise from differences in interpretation.

*Response:* 35 U.S.C. 115(h)(1) and § 1.67 provide that an applicant may submit an inventor's oath or declaration to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. 35 U.S.C. 115(h)(2) provides that supplemental statements are not required where the oath or declaration meets 35 U.S.C. 115(a) or the assignment meets the requirements of 35 U.S.C. 115(e).

Inventors still must execute an oath or declaration except under the permitted circumstances. Thus, inventors would still have an opportunity to review the application in connection with the execution of the oath or declaration and raise any concerns regarding breadth of the claimed invention with the assignee. Moreover, an inventor may have access to the application file and can follow the prosecution. 35 U.S.C. 321(a) provides that a person who is not the owner may request post grant review of a patent.

#### 6. Effective Date

*Comment 18:* One comment questioned whether the Office would accept oaths or declarations (1) In an application filed prior to September 16, 2012, in which the oath or declaration is filed on or after September 16, 2012; and (2) in an application filed on or after September 16, 2012, where the oath or declaration was executed prior to September 16, 2012. One comment suggested that the Office clarify § 1.63 to address applications that bridge the effective date of the rule to make clear that a new declaration will not be required in a continuing application where the prior declaration was compliant with the new required statutory statements. A few comments recommended that oaths or declarations filed before September 16, 2012, be grandfathered in and accepted in continuing applications filed on or after September 16, 2012, even though the oaths or declarations contain the language in former 35 U.S.C. 115 and not the language in new 35 U.S.C. 115(b).

*Response:* The changes to 35 U.S.C. 115 in the AIA apply to any application filed on or after September 16, 2012. Accordingly, the date of execution of the oath or declaration is not relevant, particularly as the Office does not check such dates of execution. MPEP § 602.05. For applications filed prior to September 16, 2012, any oath or declaration filed before, on, or after September 16, 2012, must comply with the oath and declaration rules in effect prior to September 16, 2012. Any oath or declaration submitted in an application filed on or after September 16, 2012, (regardless of the date of execution of the oath or declaration) must meet the requirements of 35 U.S.C. 115 as amended by the AIA.

With respect to continuing applications, 35 U.S.C. 115(g)(1)(A) provides an exception to a newly executed oath or declaration only where the oath or declaration in the earlier-filed application meets the requirements of amended 35 U.S.C. 115(a) which

must include the required statements in 35 U.S.C. 115(b). Accordingly, a copy of an oath or declaration from a prior application filed before September 16, 2012, must meet the requirements of 35 U.S.C. 115 as amended by the AIA.

Nevertheless, in view of the changes to permit applicants to postpone the submission of the inventor's oath or declaration until the application is otherwise in condition for allowance, the Office will no longer review an oath or declaration in an application under 35 U.S.C. 111(a) for compliance with § 1.63 (or a substitute statement for compliance with § 1.64) during the examination process. The Office will review applications to determine whether the application includes an oath or declaration executed by or with respect to each inventor when the application is in condition for allowance.

#### 7. Miscellaneous

*Comment 19:* One comment noted that 35 U.S.C. 115 requires "the name of the inventor," whereas proposed § 1.63(a)(2) requires identification by "his or her full name without any abbreviation (except for a middle initial)" and thus places further restrictions on what would otherwise be an uncomplicated requirement. Another comment stated that the rules should permit an inventor to abbreviate his or her first name if he or she is known by his or her middle name.

*Response:* The Office agrees that the phrase "his or her full name without any abbreviation (except for a middle initial)" is more complicated than necessary. The requirement for identification of the name of the inventor in the rules of practice (e.g., § 1.63(a)(1)) will be for the legal name of the inventor.

*Comment 20:* One comment suggested eliminating the requirement for the residence in that: (1) It is still unclear what is intended by residence (e.g., city, state, province, prefecture, etc.); (2) many inventors would prefer to keep their residence private, especially where the mailing address is the place of employment; and (3) it requires assignees to violate their domestic privacy laws in some countries (e.g., United Kingdom) by requiring inventors to make residence information publicly available.

*Response:* The comment appears to confuse the separate requirements for residence and mailing address. The residence, as noted in MPEP § 605.02, is a city and either a state or foreign country, while a mailing address, as noted in MPEP § 605.03, is where one customarily receives mail, such as one's

home or business address. Additionally, a post office box may be used as the mailing address. The Office reviews residence information to ensure that a residence is provided, but the Office does not review the manner in which the residence is stated. Thus, applicants should not have concerns about distinctions between province and prefecture.

*Comment 21:* One comment requested revising the title to be “Inventor’s oath or declaration” to distinguish the declaration requirements in § 1.63 from who may apply for a patent, which should be addressed by § 1.41.

*Response:* The Office agrees that the title of § 1.63 should read “Inventor’s oath or declaration.” The title has been revised as suggested.

*Comment 22:* One comment stated that proposed § 1.63(c)(2) needs to be corrected for grammatical clarity since it is unclear how a reference itself would constitute an assignment.

*Response:* Section 1.63(e)(2) contains the language of proposed § 1.63(c)(2). The provision merely explains that the phrase “oath or declaration” under § 1.63 as referred to in the rules covers a combination assignment and oath or declaration document.

*Comment 23:* One comment suggested that since a “wet” signature is required for a declaration, the practitioner should be allowed to obtain a “wet” signature for the practitioner’s file and then submit an S-signature by the practitioner with a notice to the Office that a “wet” signature is on file with this practitioner and will be supplied to the Office if requested.

*Response:* An oath or declaration may be signed either with a wet (handwritten, per § 1.4(d)(1)) signature or an S-signature (e.g., a printed name inserted between forward slashes, per § 1.4(d)(2)), regardless of whether the oath or declaration is filed with the Office in paper, facsimile transmitted, or filed via the Office’s Electronic Filing System (EFS-Web). An S-signature is any signature not covered by § 1.4(d)(1), and an S-signature must be personally inserted by the signer per § 1.4(d)(2)(i). The practice suggested in the comment would not have the signer personally insert the S-signature. Thus, it would not be a proper signature by the inventor.

*Comment 24:* One comment suggested retaining in § 1.63 the statement that no minimum age is required to sign an oath or declaration.

*Response:* Section 1.63(c) continues to recite that there is no minimum age for a person to be qualified to execute an oath or declaration.

*Comment 25:* One comment requested information as to whether the Office will have updated forms to reflect the proposed rule changes at the same time the rules take effect.

*Response:* The Office will have revised forms available prior to the effective date of this final rule.

#### C. Substitute Statements

*Comment 26:* Several comments questioned the need for proof of facts regarding the inventor who is not executing the inventor’s oath or declaration when filing a substitute statement where an assignee, party to whom an inventor is under an obligation to assign or a party who otherwise shows sufficient proprietary interest in the matter files the application.

*Response:* In response to the comments, the Office is discontinuing the practice of routinely requiring proof of facts when an oath or declaration is not executed by each inventor. Section 1.64 provides that an applicant under §§ 1.43, 1.45 or 1.46 may execute a substitute statement with identifying information regarding (1) the inventor and the person executing the statement, and (2) the particular permitted circumstances involved, e.g., the inventor cannot be reached or has refused to execute the oath or declaration. Furthermore, a person may not execute a substitute statement unless that person has reviewed and understands the contents of the application and is aware of the duty to disclose to the Office all information that is material to patentability. Proof of the circumstances (e.g., attempts to contact the inventor) is no longer required.

*Comment 27:* One comment expressed concern about the effect of 35 U.S.C. 115(d)(2)(B). The comment identified the situation where one joint inventor refuses to execute the oath or declaration and since none of the inventors are under an obligation to assign, the other executing inventors may not be able to provide a substitute statement on behalf of the nonsigning inventor.

*Response:* 35 U.S.C. 116(b) provides that if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. Section 1.45, as amended in this final rule, permits the other joint inventor or inventors to make the application for patent as the applicant on behalf of themselves and the omitted inventor if a joint inventor refuses to join in an application for

patent or cannot be found or reached after diligent effort. 35 U.S.C. 115(d)(1) provides that the applicant for patent may provide a substitute statement in lieu of execution of an oath or declaration by an inventor under 35 U.S.C. 115(a) under such additional circumstances as the Director specifies by regulation. Thus, § 1.64 as adopted in this final rule permits another joint inventor to execute a substitute statement in lieu of execution of an oath or declaration by the omitted inventor if a joint inventor refuses to join in an application for patent (regardless of whether there is an obligation to assign) or cannot be found or reached after diligent effort.

*Comment 28:* One comment noted proposed § 1.47 and requested that the assignee be allowed to execute the oath or declaration on behalf of the assigning inventor in general, and not only in circumstances where the inventor has refused or cannot be found or reached to execute the oath or declaration.

*Response:* 35 U.S.C. 115(a) explicitly requires execution of an inventor’s oath or declaration by each inventor except as otherwise provided in 35 U.S.C. 115. The situations in which the applicant for patent may submit a substitute statement in lieu of an oath or declaration with respect to an inventor are set forth in 35 U.S.C. 115(d)(2).

#### D. Combined Declaration and Assignment

##### 1. Generally

*Comment 29:* One comment recognized that the AIA provision for dual-purpose documents (assignment and oath or declaration) is already possible and asserted that the AIA prohibits the Office from making rules that impede the use of dual-purpose documents, such as requiring the recordation of the document before submission in the application as required by proposed § 1.63(c)(1)(ii). The comment asserted that the recordation requirement is neither beneficial to the public nor beneficial to assignees. The comment noted that some assignees may save up and then record multiple assignments at once to save on recording fees. In the absence of an explanation as to why flexibility is to be taken away, the comment suggested that the proposed requirement for recordation should not be adopted and the assignment should be made of record in the application file.

A few comments, however, opposed submitting a copy of an assignment containing the statements required of an oath or declaration in the application file and noted that Congress did not

require an assignment with such oath or declaration statements to be included in the application file and did not envision that the statement would be “examined” by a patent examiner. These comments stated that 35 U.S.C. 115(e) permits the assignment to simply be recorded in the assignment records without submitting a copy in the application file.

*Response:* 35 U.S.C. 115(e) provides for making the statements required under 35 U.S.C. 115(b) and (c) in an “assignment of record,” and 35 U.S.C. 115(f) provides that a notice of allowance under 35 U.S.C. 151 may be provided to an applicant only if the applicant has filed each required oath or declaration under 35 U.S.C. 115(a), or has filed a substitute statement under 35 U.S.C. 115(d), or *recorded* an assignment meeting the requirements of 35 U.S.C. 115(e), 35 U.S.C. 115(e) and (f) (emphasis added). Thus, the recording requirement of § 1.63(e)(1)(ii) is required by 35 U.S.C. 115, which envisions that the assignment containing the statements required of an oath or declaration be “recorded.” 35 U.S.C. 111(a)(2)(C) also requires that an application contain an oath or declaration. If an applicant files in paper an assignment-statement for recordation together with a patent application, the Office will scan a copy of the assignment into the Office IFW of the application and forward the submission to Assignment Recordation Branch provided that there is a conspicuous indication of an intent to utilize the assignment as the required oath or declaration under § 1.63.

*Comment 30:* One comment stated that proposed § 1.63(a) should be amended to clarify that an assignment that includes the statements required by 35 U.S.C. 115(b) and (c) may be filed “in lieu of filing such statements separately” pursuant to 35 U.S.C. 115(e).

*Response:* Section 1.63(e)(1) implements that portion of 35 U.S.C. 115(e) relating to the “in lieu of” language by its recitation that an assignment may also serve as the oath or declaration.

*Comment 31:* With respect to the combined assignment and oath or declaration document, one comment questioned the result if one portion is determined to be void or voidable. The comment specifically questioned whether the declaration portion would be void or invalid where the assignment portion is found to be void or invalid. The comment stated that the Office should clearly indicate that the legality (or invalidity) of one part will not impact the other part.

*Response:* Where there is an error in the oath or declaration portion, such as in bibliographic information, the rest of the oath or declaration is still effective and only that error need be corrected. *See* § 1.67(a). In other instances, such as a failure to provide a statutorily required averment, the oath or declaration must be resubmitted. Where the assignment portion of a combined assignment and oath or declaration document is found to be invalid, the combined assignment and oath or declaration document would remain effective for the declaration portion provided that the assignment contains the statements required of an oath or declaration.

## 2. Recordation of Assignments

*Comment 32:* One comment opposed the proposed addition to a recordation cover sheet of a check-box indicating that the assignment is to be used in an application to comply with § 1.63. The comment asserted that the person filing the assignment is likely not a registered practitioner and should not have the burden of arriving at a legal conclusion as to whether the document is to serve as a declaration. The comment further asserted that the application and assignment are frequently separately filed electronically by different individuals, and requested that the rule should be tailored for non-electronic filing of the assignment containing the inventor statement. Another comment suggested that the Office should update the Office’s Patent Application Information Retrieval (PAIR) system to directly link recorded assignments to the application as recorded assignments are now accessible only by physically traveling to the Office, at substantial burden and cost on the requester.

*Response:* Section 3.31 requires that where an applicant has included the statements required by 35 U.S.C. 115(b) and (c) in an assignment, the applicant indicate as much to the Office via a check-box on the assignment recordation cover sheet. Thus, the Office will know both to record the assignment in the assignment database and to place a copy of the assignment in its related application file, so that applicants will not be required to submit an oath or declaration in the application.

There are three ways to submit an assignment-statement document: (1) In paper (including facsimile transmission); (2) through the Electronic Patent Assignment System (EPAS); and (3) via EFS-Web. For paper submissions, the Office frequently receives in the same envelope a patent application, an assignment to be recorded in connection with that application, the Assignment

Recordation Cover Sheet (PTO–1595) and the recordation fee. In such circumstances, the Office would simply forward the assignment document and PTO–1595 to the Assignment Recordation Branch for recording. As discussed previously, if an applicant indicates that an assignment submitted for recording also contains statements required of an oath or declaration, the Office will scan a copy of the assignment into the Office IFW of the application and forward the submission to Assignment Recordation Branch.

The Office notes the concern with the ability of a person submitting the assignment-statement document for recordation being able to make a legal conclusion as to the ability of an assignment to serve as a combination assignment and oath or declaration document and so indicate on the recordation cover sheet. The failure to check the box to identify the submission as a combination assignment and oath or declaration document, however, would not prevent the applicant from submitting a copy of the assignment-statement in the application to serve as the oath or declaration. More importantly, it is not necessary for a person to make a legal conclusion as to the ability of an assignment to serve as a combination assignment and oath or declaration document and so indicate on the recordation cover sheet. The person would only need to know the purpose for submission of the assignment.

## E. Power of Attorney

*Comment 33:* One comment suggested that in regard to an application filed by an assignee-applicant, the Office should permit only a power of attorney from the assignee-applicant and not from the inventors. One comment suggested that the reference in § 1.33(f) to § 3.71 (as well as § 1.31) is unnecessary in that an assignee may easily apply for a patent and thus be the applicant referred to in § 1.31.

*Response:* Section 1.33(b)(3) provides that a power of attorney can be signed by the applicant. Section 1.42(b) provides that if a person is applying for a patent as provided in § 1.46, the person applying for a patent under § 1.46 (and not the inventor) is the applicant. Accordingly, an assignee or obligated assignee who has filed an application may supply an effective power of attorney without the need to establish the right to take action under § 3.71. For example, an assignee who files an application can appoint a power of attorney, provided that the party granting the power is the same party who filed the application. Persons who

otherwise show sufficient proprietary interest in the matter may supply a power of attorney along with a petition under § 1.46(b)(2), which power would be effective once the petition is granted. If an assignee, obligated assignee, or person who otherwise show sufficient proprietary interest in the matter is applying for a patent as provided in § 1.46, the inventor is not the applicant and the Office would not accept a power of attorney from the inventor.

*Comment 34:* One comment suggested that where the original declaration provides a power of attorney by the inventors, the power of attorney should automatically “transfer” as being a power of attorney by the assignee where the inventors have or are obligated to assign their portion to the assignee. The comment also stated that the power of attorney should continue in an application when ownership is transferred. Where a “new” assignee/applicant does not wish the original attorney to have power of attorney, the “new” assignee/applicant should then prepare and file the appropriate revocation and new power of attorney and correspondence forms.

*Response:* Under this final rule, an assignee may file an application on its own behalf as the applicant and should provide the initial power of attorney. The transfer of ownership of an application is external to the Office and would not affect any existing power of attorney in the application file. See § 1.36(a). It is the Office’s experience that where ownership of an application is changed, the new assignee takes over the prosecution and provides a new power of attorney.

*Comment 35:* Two comments stated that, with respect to proposed § 1.32(d), if the power of attorney in the earlier application is from an assignee and a continuing application is filed that adds new inventors, a new power of attorney should not be required where the newly added inventors have also assigned, or are under an obligation to assign, to the same assignee and the assignment is recorded at the Office.

*Response:* Section 1.32(d) provides that a power of attorney will have effect in a continuing application if a copy of the power is supplied in the continuing application, unless the power of attorney was granted by the inventors and the continuing application names an inventor who was not named in the prior application. Therefore, if the power of attorney in the earlier application is from the assignee (as discussed in the comment), a new power of attorney is not required.

*Comment 36:* One comment stated that proposed § 1.32(d) should be

broadened to include powers of attorney filed in provisional applications so that a power of attorney filed in a provisional application would have effect in a nonprovisional application that claims the benefit of the provisional application under 35 U.S.C. 119(e) if submitted in the nonprovisional application.

*Response:* It is the Office’s experience that powers of attorney are not usually supplied in provisional applications, particularly as there is no prosecution and they become abandoned after a year as a matter of law. Accordingly, there is little need to provide for the carryover of powers of attorney from a provisional application to a nonprovisional application.

*Comment 37:* One comment asserted that the power of attorney rules are “form over substance” and should be relaxed. The Office should leave it to the attorneys and law firms to obtain the requisite paperwork granting them power of attorney, which is to be retained in the attorney’s/law firm’s record and if an issue arises that raises the question of whether or not the attorney acted appropriately, the Office should request a copy of the requisite power of attorney form and act accordingly.

*Response:* Filing of a power of attorney in an application file is not mandatory in that an attorney can act in a representative capacity pursuant to § 1.34, although there are some limitations, such as signing a terminal disclaimer, change of correspondence address, or an express abandonment without filing a continuation, MPEP § 402. Given the significant consequences to such actions, the Office believes that such actions should only be undertaken pursuant to a power of attorney that is of record in the application file.

*Comment 38:* One comment suggested that the Office should take the position that when an applicant-assignee executes a power of attorney, the attorney of record automatically has the right to act on behalf of the applicant-assignee, including executing a statement under § 3.73(b). A contrary comment stated that proposed § 3.73(b)(2)(iii) should not be implemented since it gives significantly more authority to patent practitioners than an assignee may otherwise explicitly authorize. The comment stated that only individuals who are authorized to act on behalf of the assignee should be able to sign a statement under § 3.73(b).

*Response:* The Office disagrees with the position that the Office should not treat a patent practitioner of record as

being authorized to act on behalf of the assignee. Section 3.73(d), as adopted in this final rule, permits a patent practitioner of record to sign a statement under § 3.73(c) in patent matters. A party to a proceeding before the Office is generally bound by the actions (or omissions) of his or her representative. See *Huston v. Ladner*, 973 F.2d 1564 (Fed. Cir. 1992). There does not appear to be any reason to make an exception to this general rule for statements under § 3.73(c). If a particular assignee has appointed a practitioner via a power of attorney document but does not want the practitioner to be able to sign a § 3.73(c) statement, then such assignee can inform the practitioner of such a limit on his or her authority. That, however, is a matter between the assignee and its chosen representative, and the Office is not the forum for resolving disputes between an applicant and his or her representative. See *Ray v. Lehman*, 55 F.3d 606 (Fed. Cir. 1995).

*Comment 39:* One comment suggested that powers of attorney and statements under § 3.73(b) filed before September 16, 2012 in patent applications, including provisional applications, should be grandfathered in and permitted to be filed in pending and continuing applications.

*Response:* The applicability date section of the final rule identifies which rules apply only to patent applications filed on or after September 16, 2012. Section 3.73 applies only to patent applications filed on or after September 16, 2012, but it applies to any patent application filed on or after September 16, 2012, even of that application claims the benefit of a provisional or nonprovisional application filed prior to September 16, 2012.

#### F. PCT

*Comment 40:* One comment stated that the PCT rules should no longer require a statement that the inventor is the applicant for the U.S. only. A different carve out in PCT for U.S. law should be used for what remains unique to U.S. law, such as where the inventor is under a continuous duty to disclose known material information.

*Response:* The rules governing applicants for international applications (§§ 1.421, 1.422, and 1.424) have been amended consistent with the AIA to no longer require that an inventor be an applicant in the United States.

*Comment 41:* One comment stated that it is unclear whether proposed § 1.48(k) only applies if an executed declaration submitted under PCT Rule 4.17(iv) has been filed. The comment suggested adding a second sentence to reference § 1.41(a)(4) for correction of

inventorship of an international application entering the national stage under 35 U.S.C. 371 in which no oath or declaration has been filed.

*Response:* In response to the comments, the Office has revised § 1.48 in this final rule. Section 1.48(a) applies to nonprovisional applications, including U.S. national stage applications in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid. Under § 1.48(a), the requirements for correcting inventorship have been eased, requiring only an application data sheet setting forth the inventive entity, a processing fee, and an oath or declaration as required by § 1.63 (or substitute statement in compliance with § 1.64) for any actual inventor who has not executed such an oath or declaration. Furthermore, recognizing that inventorship sometimes changes in a national stage application from that originally indicated in the international phase, § 1.41(e) allows applicants to set inventorship in a U.S. national stage application without having to request correction under § 1.48(a) by simply including with the initial submission under 35 U.S.C. 371 an application data sheet in accordance with § 1.76 setting forth the correct inventive entity.

*Comment 42:* One comment questioned whether an application data sheet filed with a national stage entry, after the PCT filing date, is considered a supplemental application data sheet, or whether it was intended that the document be called an application data sheet, in which case § 1.76(a) should be amended to recite “or after payment of the basic national fee for a national stage entry under 35 U.S.C. 371.”

*Response:* The distinction between “application data sheet” and “supplemental application data sheet” has been a source of confusion for applicants. Accordingly, the Office revised § 1.76 to eliminate “supplemental application data sheet” and simply refer to “application data sheet.” In this regard, § 1.76(c) in this final rule, now indicates that information in a previously submitted application data sheet, or the inventor’s oath or declaration under § 1.63, § 1.64, or § 1.67, or otherwise of record, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, except that inventorship changes must comply with the requirements of § 1.48, foreign priority and domestic benefit information changes must comply with §§ 1.55 and 1.78, and correspondence address changes are governed by § 1.33(a).

### G. Reissue Applications

*Comment 43:* One comment suggested amending the title of § 1.172 (“Applicants”) to include a reference to “inventor” because the term “inventor” is no longer synonymous with “applicant.” One comment suggested revising the parenthetical in § 1.172(b)(2)(ii) by replacing the concept of the assignee executing the oath or declaration with the assignee providing a substitute statement as the applicant in the patent being reissued. One comment suggested that §§ 1.172 and 1.175 be revised to provide for filing a substitute statement, rather than an oath or declaration, in the permitted circumstances.

*Response:* The use of “applicant” in the title of § 1.172 is a generic term that will cover assignees and inventors when either are the applicant. In this final rule, § 1.172 has been revised to no longer address execution of the oath or declaration. Section 1.175(c) provides for filing a substitute statement in reissue applications by its reference to § 1.64.

*Comment 44:* One comment suggested eliminating the requirement for identifying whether a claim is broadened under § 1.175(b). The comment asserted that the requirement is a complex legal issue in that cancellation of one claim may constitute broadening of another claim, and claim scope may be narrowed even though claims are not amended, and such legal determination should be left to the examiner and not to applicant as part of an inventor’s declaration.

*Response:* 35 U.S.C. 251(d) places a time limit on the filing of a broadening reissue application. Accordingly, applicants must make a determination as to whether a reissue application is being filed with a broadened claim. Applicants, in filing a reissue application, already have a good indication as to whether the error that renders the patent wholly or partly inoperative or invalid is one that is driven by a need to broaden or narrow the claims. Thus, focusing applicants’ attention on whether a claim is being broadened should not be burdensome on applicants, and is beneficial to examination of the reissue application.

*Comment 45:* One comment stated that it is unclear why at least one error being relied upon as the basis for reissue must be identified in the declaration, and suggested that such an error could be identified by the attorney of record. Two comments questioned the requirement for a supplemental oath or declaration in a reissue application where all errors previously identified

are no longer relied upon, particularly in view of the elimination of the “without deceptive intent” language from 35 U.S.C. 251.

*Response:* The requirement to initially identify the error being corrected in the oath or declaration has been retained as the Office believes that the error being used to support jurisdiction for a reissue should be acknowledged by the inventor. In view of 35 U.S.C. 115(h)(2), the Office will permit the practitioner to identify a replacement error where the first error is no longer being corrected. The retention of a requirement, albeit by practitioner statement rather than by supplemental oath or declaration, to identify an error being corrected (where the initially identified error being corrected is no longer being corrected) is deemed necessary so that the file record clearly establishes jurisdiction for the reissue. It should be noted, however, that where the original oath or declaration does not comply with § 1.175, the Office will require a compliant oath or declaration, and a practitioner statement will not be sufficient.

### H. Application Data Sheet (§ 1.76)

#### 1. Domestic Benefit and Foreign Priority Claims

*Comment 46:* One comment suggested that the Office construe an identification of 35 U.S.C. 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.

*Response:* An application data sheet is part of the application. See § 1.76(a).

*Comment 47:* One comment questioned whether applications filed before September 16, 2012, would be grandfathered in with regard to how a claim for foreign priority or domestic benefit must be made. The comment requested clarification as to whether the requirement that all priority and benefit claims be in an application data sheet or supplemental application data sheet depends on the filing date of the application or on the date of filing of the foreign priority or domestic benefit claim.

*Response:* Applications filed on or after September 16, 2012, must comply with §§ 1.55 or 1.78 as amended by this final rule. Applications filed before September 16, 2012, need not comply with §§ 1.55 or 1.78 as amended by this final rule (but would need to comply with §§ 1.55 or 1.78 as previously in effect).



*Comment 48:* One comment questioned what information the Office would enter into the application file record if, on the same day (e.g., application filing date), a priority claim is made both in the application data sheet and the first paragraph of the specification, but the information between the two varies, e.g., one has a typographical error in the priority date or priority document number.

*Response:* For applications filed on or after September 16, 2012, a foreign priority claim under § 1.55 or domestic benefit claim under § 1.78 made in the first paragraph of a specification would not be an effective priority or benefit claim and the Office would process the priority claim based on the information in the application data sheet.

## 2. Form Requirements

*Comment 49:* One comment suggested that the application data sheet be treated as authoritative in all cases, even where there are inconsistencies between the application data sheet and the oath or declaration, and § 1.76(d) deleted so that the most recent application data sheet would always control.

*Response:* Section 1.76(d)(1)(ii) provides that the most recent submission of an application data sheet will govern in most instances, except that the naming of the inventorship is governed by § 1.41 and changes to inventorship or the names of the inventors is governed by § 1.48. Section 1.76(d)(2) provides that the application data sheet will govern when the inconsistent information is supplied at the same time by a designation of correspondence address or the inventor's oath or declaration.

*Comment 50:* One comment believed that consideration of the application data sheet as part of the application causes a practitioner to engage in misconduct under § 10.23. The comment asserted that the Office stated that the application data sheet must not be signed by an inventor and that the application data sheet is generally not reviewed by an inventor executing the declaration. Thus, a practitioner submitting an application data sheet with an application, with an already executed declaration, would have altered the application in violation of § 10.23(c)(11), which 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."

*Response:* In response to the comment, § 1.52(c) now provides that an alteration of the application papers may be made after the signing of the inventor's oath or declaration provided the statements made in the oath or declaration remain applicable. Thus, an application data sheet signed after the execution of the oath or declaration would be a permitted alteration where any change brought about by the application data sheet does not alter the applicability of the statements in the oath or declaration. Additionally, there is no prohibition on the inventive entity signing an application data sheet, but the inventive entity would not need to sign an application data sheet if the document is signed by a practitioner. Section 10.23(c)(11) has been removed and reserved in view of the change to § 1.52(c).

*Comment 51:* One comment suggested that a new section be included in the application data sheet as a method of identifying the "applicant," which may be the assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest. One comment suggested that a method be provided for identifying the applicant (inventor, assignee, obligated assignee, or some other person or entity) in the application data sheet with provisions regarding the information required to identify the applicant.

*Response:* Section 1.76(b)(7) has been retitled "Applicant Information" and is identified as including assignees, persons to whom the inventor is under an obligation to assign, or persons who otherwise show sufficient proprietary interest in the matter. No further information in the "Applicant Information" section, other than the identification of the applicant (i.e., name and address), is needed.

*Comment 52:* One comment supported the proposed change to § 1.76 in amended form. The comment asserted that the requirement that a supplemental application data sheet contain all the section headings and all the appropriate data for each section heading is burdensome on applicants and on the Office. The comment noted that often a supplemental application data sheet changes a single word or single number or single line of text in one field of the seven section headings. Reproduction by applicant and scouring of text by the Office would be limited if only the change were provided. Since supplemental application data sheets are hand-keyed rather than scanned and converted into text by optical character recognition, Office personnel must wade through large amounts of unchanged information to try to catch one or two

changed items. One comment stated that when submitting a supplemental application data sheet to correct information in the file, the applicant should be able to file the application data sheet form (PTO/SB/14) and show only those changes being requested without strike-through and underlining.

*Response:* Where information in an application data sheet is changed with submission of a later-submitted application data sheet, only the appropriate data for each section heading to be changed need be filled in identifying the change in information with appropriate markings. Some information, such as benefit or priority claims, can be extensive in nature and would be burdensome for the Office to identify the specific change without a mark-up. Furthermore, some benefit claims contain a chain of applications and the entire chain needs to be provided to ensure that the information is accurate.

*Comment 53:* One comment questioned whether a supplemental application data sheet that is the first filed application data sheet must be underlined in its entirety or whether only the information that is different from the information that the Office currently has in its records must be underlined. One comment recommended that § 1.76 be simplified as it is extensive and burdensome. The comment stated that it is not easy to prepare a supplemental application data sheet since the Office does not provide a supplemental application data sheet form.

*Response:* In response to the comments, the Office is discarding the notion of the "supplemental" application data sheet. The first filed application data sheet would not need to contain any markings unless information is being updated or corrected. Additionally, an application data sheet included with an initial submission under 35 U.S.C. 371 would not need to contain any markings. An application data sheet that is updating or correcting information must identify the information that is being changed with underlining for insertions, and strike-through or brackets for text removed.

## I. Miscellaneous Rules

### 1. Mail Stop (§ 1.1(e))

*Comment 54:* One comment suggested that the Office not go forward with the proposed change of a mail stop from "Mail Stop Patent Ext." to "Mail Stop Hatch-Waxman PTE." The comment stated that the change incurs training costs on both the Office and applicants

with no apparent benefit to either applicants or the Office, particularly as the Office does not provide the actual underlying reason for the proposed change.

*Response:* Section 1.1(e) is being revised to reflect the current mail stop for applications under 35 U.S.C. 156 for patent term extension and additional correspondence regarding applications for patent term extension under 35 U.S.C. 156. The current mail stop for such applications and correspondence is "Mail Stop Hatch-Waxman PTE." The Office published a notice including this new mail stop on November 21, 2006. See *Mailing and Hand Carry Addresses for the United States Patent and Trademark Office*, 1312 *Off. Gaz. Pat. Office* 107 (Nov. 21, 2006). The mail stop designated as "Mail Stop Patent Ext." is for applications for patent term extension or adjustment under 35 U.S.C. 154 and any communication relating thereto (except when being mailed together with the issue fee). The two different mail stops lead to more efficient processing of the different types of applications and correspondence for patent term extension and adjustment since different areas of the Office process the different correspondence. Thus, § 1.1(e) has been revised to reflect the correct mail stop.

## 2. Signatures (§ 1.4)

*Comment 55:* Several comments questioned whether proposed § 1.4(e) would prevent the use of credit card payments with electronic submissions, such as EFS-Web, EPAS, the Office's Revenue Accounting and Management (RAM) system, the Office's Order Entry Management System (OEMS), and the Central Fax Number. Another comment questioned whether the proposed change means that patentees will not be able to pay maintenance fees online with a credit card.

*Response:* Section 1.4(e) does not prevent the use of credit card payments with electronic submissions via the Office's electronic filing systems such as EFS-Web. Section 1.4(e) has been revised to require an original handwritten signature personally signed in permanent dark ink or its equivalent for payments by credit cards where the payment is not being made via the Office's various electronic filing systems. An original handwritten signature is only required when the credit card payment is being made in paper, and thus the Office's Credit Card Payment Form, PTO-2038, or an equivalent, is being used. The credit card payment form is not required (and should not be used) when making a

credit card payment via EFS-Web or other electronic filing systems. A submission via the Central Facsimile Number is not considered an electronic submission and thus credit card payments being made by facsimile submission to the Central Facsimile Number require an original handwritten signature.

*Comment 56:* One comment stated that there are various rules which seem to require an original signature and requested that the Office clarify that such "original signatures" include "e-signatures."

*Response:* The term "original" is used in connection with handwritten signatures in § 1.4(d)(1) and does not include S-signatures. Section 1.4(e) specifies when an original handwritten signature is required. A handwritten signature can be an original or a copy thereof, except when an original handwritten signature is required, as set forth in § 1.4(e). See MPEP § 502.02. Unless § 1.4(e) is applicable, an S-signature, as provided for in § 1.4(d)(2), may be used.

## 3. Juristic Entity (§ 1.31)

*Comment 57:* One comment stated that proposed § 1.33(f) seems to allow a juristic entity to sign documents such as terminal disclaimers and statements under § 3.73(b) because of the language "unless otherwise specified," which is contrary to the preamble discussion which stated that all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

*Response:* Section 1.33(b)(3) contains the language of proposed § 1.33(f). Section 3.73(c) now contains the provisions for establishing ownership in a patent matter including the required statement. Section 1.321 provides for a terminal disclaimer to be signed by the applicant or an attorney or agent of record. Thus, an assignee who is the applicant may sign a terminal disclaimer. Section 3.73(d) provides for a statement under § 3.73(c) to be signed by a person authorized to act on behalf of the assignee.

## 4. Correspondence Address (§ 1.33)

*Comment 58:* One comment suggested that § 1.33(a) be amended to state that the correspondence address must be provided in an application data sheet since the Office's application data sheet form (PTO/SB/14) already has a field for correspondence address.

*Response:* The Office encourages applicants to provide an application data sheet containing a correspondence address, but applicants may also provide a correspondence address in another paper (e.g., a transmittal letter)

accompanying the application, particularly where an application data sheet is not being filed with the application. The Office needs to be able to communicate with applicants even when an application data sheet is not submitted.

*Comment 59:* One comment suggested maintaining the language of current § 1.33(a) to state that where more than one correspondence address is specified in a single paper or multiple papers submitted on one day, the Office will use a Customer Number for the correspondence address over a typed correspondence address. The comment indicated that the Office has used a different correspondence where a Customer Number "has been properly presented in the filings associated with an application."

*Response:* The Office will generally select the address associated with a Customer Number over a typed correspondence address when more than one correspondence address is specified in a paper or papers submitted on the same day. The Office, however, prefers not to be required by rule to select the Customer Number since there may be situations where it is clear that the Customer Number given is not the intended or current correspondence address. Thus, the Office requires some flexibility in this regard.

*Comment 60:* One comment suggested that to ensure prompt processing of correspondence addresses, a practitioner using private PAIR should have the ability to input a new/correct correspondence address which becomes effective immediately upon submission.

*Response:* The Office is currently considering changes to the PAIR system that may include the ability of a patent practitioner of record to change the correspondence address in an application. The Office would notify the public of any changes to the PAIR system via a notice on the Office's Internet web site.

## 5. Person Making Declaration (§ 1.64)

*Comment 61:* One comment suggested that: (1) § 1.64(a) which 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," be revised to employ the statutory language of 35 U.S.C. 115, that "each individual who is the inventor or a joint inventor of a claimed invention;" (2) the portion of § 1.64(b) that states "[i]f the person making the oath or declaration is not the inventor, the declaration shall state \* \* \*" should be removed as only an inventor or joint inventor may execute an oath or declaration; and (3) the requirement for the residence of non-

inventors who sign should be removed. Another comment suggested that § 1.64 be amended to reflect that a single oath or declaration document is not required and to eliminate the requirement for the residence and mailing address of the legal representative.

*Response:* In response to the comments, the provisions of former § 1.64 have been eliminated. Section 1.64 now provides for a substitute statement in lieu of an oath or declaration and requires the residence and mailing of address of the person signing the substitute statement. The Office needs this information for identification purposes and to be able to communicate with the person executing the substitute statement in the event that this becomes necessary.

#### 6. Noncompliant Declarations (§ 1.67)

*Comment 62:* One comment stated that proposed § 1.67 included a critical misconception that a declaration may be made by someone other than the inventor. Additionally, the comment stated that it is unclear how a deficiency or inaccuracy relating to fewer than all the applicants could be cured by an inventor's declaration. Another comment stated that § 1.67 should be amended to reflect that a single oath or declaration document is not required.

*Response:* Initially, it should be noted that § 1.67 is directed to supplemental oaths or declarations and provides a mechanism for applicants to correct deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. Section 1.67, in this final rule, prohibits the Office from requiring a person who has executed an oath or declaration that is in compliance with 35 U.S.C. 115 and § 1.63 or § 1.162 to provide an additional inventor's oath or declaration for the application.

However, the Office is not prohibited from requiring a new oath or declaration in compliance with 35 U.S.C. 115 and § 1.63 where the oath or declaration that was submitted does not comply with 35 U.S.C. 115 and § 1.63. The Office notes that former § 1.47(b) permitted an assignee to sign the oath or declaration for the nonsigning inventor where no inventors were available. The assignee would simply make the statements in the oath or declaration on information and belief. *See* former § 1.64(b). Section 1.63(f), in this final rule, provides that any reference to the inventor's oath or declaration in this chapter means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors. Accordingly, a single oath or declaration document is not required under § 1.63 or § 1.67. Since

§ 1.63 is amended to only require that the oath or declaration identify the inventor or joint inventor executing the oath or declaration rather than identifying the entire inventive entity, § 1.67 no longer refers to a deficiency or inaccuracy relating to fewer than all of the inventors or applicants.

#### 7. Statement Under § 3.73

*Comment 63:* One comment supported the proposed change to § 3.73, but suggested a modification of § 3.73(b). The comment noted the difficulties practitioners face in attempting to reproduce reel and frame numbers, including time, effort and the potential for typographical errors from the hand-keying required when form PTO/SB/96 is completed, and the need for Office personnel to check the information character by character. The comment suggested that these efforts can be limited by permitting attachment of a copy of the Abstract of Title or Notice of Recordation where they contain the reel and frame numbers.

*Response:* Section 3.73(c)(1)(i) requires documentary evidence of a chain of title from the original owner to the assignee. A copy of an executed assignment is only one example of the type of documentary evidence that may be submitted. Other types of documentary evidence may be submitted. An Abstract of Title or Notice of Recordation would be insufficient documentary evidence since any person can submit documents for recordation to Assignment Recordation Branch, therefore an Abstract of Title may list extraneous or erroneous documents unrelated to the chain of title.

*Comment 64:* One comment stated that, with respect to proposed § 3.73(c)(3), the applicants should be allowed to also file a copy of a statement under § 3.73(b) that was originally filed in a provisional application in a nonprovisional application that claims benefit of the provisional application.

*Response:* Section 3.73 does not provide for the filing of a copy of a statement under § 3.73(c) in a nonprovisional application that was originally filed in a prior application, such as a provisional application whose benefit is being claimed in the nonprovisional application. Generally, there is no need to file a § 3.73(c) statement in a provisional application and such statements are not usually filed in provisional applications as such applications are not examined and do not undergo prosecution. Furthermore, where an assignee has filed such a statement in the provisional application, the assignee would presumably be the

applicant filing the nonprovisional application. An assignee who is the applicant who filed the application need not to file a § 3.73(c) statement.

*Comment 65:* One comment stated that, with respect to proposed § 3.73(c)(3), if a statement under § 3.73(b) in the earlier application is from an assignee, it should not be required that the inventorship of the continuing application be the same as or less than that of the earlier application, if the newly added inventors have also assigned, or are under an obligation to assign, to the same assignee and the assignment is recorded at the Office.

*Response:* Section 3.73 does not provide for the filing of a copy of a statement under § 3.73(c) in a continuing application that was originally filed in the prior application. Where an assignee has filed a statement under § 3.73(c) in a prior application, the assignee may file the continuing application as the applicant and would not need to file a § 3.73(c) statement.

*Comment 66:* One comment suggested that the Office simplify the process relating to the power of attorney from an assignee such that the power of attorney document(s) may be filed concurrently with the filing of patent application documents. The comment noted that the Office's form (PTO/SB/96) requires entry of specific application data which are only available after filing of the patent application.

*Response:* An assignee who is the applicant will not need to comply with the procedure in §§ 3.71 and 3.73, including filing a § 3.73(c) statement (*e.g.*, Form PTO/SB/96). The assignee will only need to identify him or herself as the applicant and submit a power of attorney. Thus, the assignee will be able to file the power of attorney document(s) concurrently with the patent application documents even though he or she does not have an application number for the application. An assignee who did not file the application and thus is not the original applicant would need to file a § 3.73(c) statement to become the applicant and take over prosecution of the application. *See* §§ 1.46(c), 3.71, and 3.73.

#### 8. Lack of Deceptive Intent

*Comment 67:* One comment expressed concern about the deletion of the "lack of deceptive intent" clause. One comment suggested that notwithstanding the acknowledgement that willful false statements are punishable by fine or imprisonment, keeping the "without deceptive intention" in the statute may be a good idea. The comment noted that there may be semantic differences between "false

statement” and “deceptive intention” that retaining the language may help clarify.

*Response:* Section 20 of the AIA amended 35 U.S.C. 116, 184, 251, and 256 (as well as other statutes that do not require corresponding rule changes) to eliminate the “without any deceptive intention” clauses. The changes to the rules at issue simply implement the changes to 35 U.S.C. 116, 184, 251, and 256 in section 20 of the AIA. As discussed previously, this should not be taken as an endorsement for applicants and inventors to act with “deceptive intention” in proceedings before the Office, as 35 U.S.C. 115(i) requires that any declaration or statement filed pursuant to 35 U.S.C. 115 contain an acknowledgement that any willful false statement made in the declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

## Rulemaking Considerations

### A. Administrative Procedure Act

The primary changes in this final rule implement the inventor’s oath or declaration provisions of the AIA. This final rule changes the rules of practice that concern the procedure for applying for a patent, namely, how an application is to identify the applicant for patent, the statements required in the inventor’s oath or declaration required by 35 U.S.C. 115 for a patent application (including the oath or declaration for a reissue application), the manner of presenting claims for priority to or the benefit of prior-filed applications under 35 U.S.C. 119, 120, 121, or 365, and the procedures for prosecution of an application by an assignee. The changes in this final rule do not alter the substantive criteria of patentability. Therefore, the changes in this final rule involve rules of agency practice and procedure, and/or interpretive rules. *See Bachow Commc’ns., Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims); *Nat’l Org. of Veterans’ Advocates v. Sec’y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive). Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). *See Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336–37 (Fed. Cir. 2008)

(stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.”) (quoting 5 U.S.C. 553(b)(A)). The Office, however, published proposed changes and a Regulatory Flexibility Act certification for comment as it sought the benefit of the public’s views on the Office’s proposed implementation of this provision of the AIA.

### B. Regulatory Flexibility Act

As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is required. *See* 5 U.S.C. 603.

In addition, for the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes in this final rule will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b).

This final rule changes the rules of practice to implement sections 4 and 20 of the AIA, which provide changes to the inventor’s oath or declaration and the filing of an application by the assignee as the applicant. The primary impact of the changes in this final rule is the streamlining of the requirements for oaths and declarations and the simplification of the filing of an application by the assignee as the applicant. The burden to all entities, including small entities, imposed by the changes in this final rule is significantly less than the burden imposed by the former regulations in most situations, and is no more than a minor addition to that of the former regulations in any situation. The change to the manner of presenting claims for priority to or the benefit of prior-filed applications under 35 U.S.C. 119, 120, 121, or 365 will not have a significant economic impact on a substantial number of small entities as an application data sheet is easy to prepare and use, and the majority of patent applicants already submit an application data sheet with the patent application. The change to reissue oaths or declarations will not have a significant economic impact on a substantial number of small entities as reissue is sought by the patentee for fewer than 1,200 of the 1.2 million patents in force each year, and a reissue applicant already needs to know whether claims are being broadened to

comply with the requirements of 35 U.S.C. 251. The change to the procedures for prosecution of an application by an assignee will not have a significant economic impact on a substantial number of small entities as it is rare for a juristic entity to attempt to prosecute a patent application *pro se*. Therefore, the changes in this final rule will not have a significant economic impact on a substantial number of small entities.

### C. Executive Order 12866 (Regulatory Planning and Review)

This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

### D. Executive Order 13563 (Improving Regulation and Regulatory Review)

The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

### E. Executive Order 13132 (Federalism)

This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

### F. Executive Order 13175 (Tribal Consultation)

This rulemaking will not: (1) Have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

*G. Executive Order 13211 (Energy Effects)*

This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

*H. Executive Order 12988 (Civil Justice Reform)*

This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

*I. Executive Order 13045 (Protection of Children)*

This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

*J. Executive Order 12630 (Taking of Private Property)*

This rulemaking will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

*K. Congressional Review Act*

Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), the United States Patent and Trademark Office will submit a report containing this final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this final rule are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this final rule is not a "major rule" as defined in 5 U.S.C. 804(2).

*L. Unfunded Mandates Reform Act of 1995*

The changes in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the

expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 *et seq.*

*M. National Environmental Policy Act*

This rulemaking will not have any effect on the quality of environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 *et seq.*

*N. National Technology Transfer and Advancement Act*

The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

*O. Paperwork Reduction Act*

This rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collection of information involved in this rulemaking has been reviewed and previously approved by OMB under OMB Control Numbers 0651-0032 and 0651-0035. The primary impact of the changes in this notice is the streamlining of the requirements for oaths and declarations and the simplification of the filing of an application by the assignee when an inventor cannot or will not execute an oath or declaration. The Office is not resubmitting an information collection package to OMB for its review and approval because the changes in this rulemaking do not change patent fees or change the information collection requirements (the estimated number of respondents, time per response, total annual respondent burden hours, or total annual respondent cost burden) associated with the information collections approved under OMB Control Numbers 0651-0032 and 0651-0035.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act, unless that collection of information displays a currently valid OMB control number.

**List of Subjects**

*37 CFR Part 1*

Administrative practice and procedure, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

*37 CFR Part 3*

Administrative practice and procedure, Patents, Trademarks

*37 CFR Part 5*

Classified information, Foreign relations, Inventions and patents.

*37 CFR Part 10*

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

*37 CFR Part 41*

Administrative practice and procedure, Inventions and patents, Lawyers.

For the reasons set forth in the preamble, 37 CFR parts 1, 3, 5, 10 and 41 are amended as follows:

**PART 1—RULES OF PRACTICE IN PATENT CASES**

- 1. The authority citation for 37 CFR Part 1 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2).

- 2. Section 1.1 is amended by revising paragraph (e) to read as follows:

**§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.**

\* \* \* \* \*

(e) *Patent term extension.* All applications for extension of patent term under 35 U.S.C. 156 and any communications relating thereto intended for the United States Patent and Trademark Office should be additionally marked "Mail Stop Hatch-Waxman PTE." When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

\* \* \* \* \*

- 3. Section 1.4 is amended by revising paragraph (e) to read as follows:

**§ 1.4 Nature of correspondence and signature requirements.**

\* \* \* \* \*

(e) The following correspondence must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent:

- (1) Correspondence requiring a person's signature and relating to registration to practice before the Patent

and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings; and

(2) Payments by credit cards where the payment is not being made via the Office's electronic filing systems.

\* \* \* \* \*

■ 4. Section 1.5 is amended by revising paragraph (a) to read as follows:

**§ 1.5 Identification of patent, patent application, or patent-related proceeding.**

(a) No correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all letters directed to the Patent and Trademark Office concerning applications for patent should also state the name of the first listed inventor, the title of the invention, the date of filing the same, and, if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the letter and the name of

the examiner or other person to which it has been assigned.

\* \* \* \* \*

■ 5. Section 1.9 is amended by revising paragraphs (a) and (b) to read as follows:

**§ 1.9 Definitions.**

(a)(1) A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

\* \* \* \* \*

■ 6. Section 1.12 is amended by revising paragraphs (b) and (c)(2) to read as follows:

**§ 1.12 Assignment records open to public inspection.**

\* \* \* \* \*

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application, which is open to the public pursuant to § 1.11 or for which copies or access may be supplied pursuant to § 1.14, are available to the public. Copies of any assignment records, digests, and indexes that are not available to the public shall be obtainable only upon written authority of an inventor, the applicant, the assignee or an assignee of an undivided part interest, or a patent practitioner of record, or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in this part.

(c) \* \* \*

(2) Include written authority granting access to the member of the public to the particular assignment records from an inventor, the applicant, the assignee or an assignee of an undivided part

interest, or a patent practitioner of record.

\* \* \* \* \*

■ 7. Section 1.14 is amended by revising paragraphs (c) and (f) to read as follows:

**§ 1.14 Patent applications preserved in confidence.**

\* \* \* \* \*

(c) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (e.g., a power to inspect) granting access to such person. The written authority must be signed by:

- (1) The applicant;
- (2) A patent practitioner of record;
- (3) The assignee or an assignee of an undivided part interest;
- (4) The inventor or a joint inventor; or
- (5) A registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.495, if a power of attorney has not been appointed under § 1.32.

\* \* \* \* \*

(f) *Notice to inventor of the filing of an application.* The Office may publish notice in the *Official Gazette* as to the filing of an application on behalf of an inventor by a person who otherwise shows sufficient propriety interest in the matter.

\* \* \* \* \*

■ 8. Section 1.16 is amended by revising paragraph (f) to read as follows:

**§ 1.16 National application filing, search, and examination fees.**

\* \* \* \* \*

(f) Surcharge for filing any of the basic filing fee, the search fee, the examination fee, or the inventor's oath or declaration on a date later than the filing date of the application, except provisional applications:

By a small entity (§ 1.27(a))	\$65.00
By other than a small entity	\$130.00

\* \* \* \* \*

■ 9. Section 1.17 is amended by revising paragraphs (g) and (i) to read as follows:

**§ 1.17 Patent application and reexamination processing fees.**

\* \* \* \* \*

(g) For filing a petition under one of the following sections which refers to this paragraph: \$200.00.

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.46—for filing an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.

§ 1.59—for expungement of information.

§ 1.103(a)—to suspend action in an application.

§ 1.136(b)—for review of a request for extension for extension of time when the provisions of § 1.136(a) are not available.

§ 1.295—for review of refusal to publish a statutory invention registration.

§ 1.296—to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.550(c)—for patent owner requests for extension of time in *ex parte* reexamination proceedings.

§ 1.956—for patent owner requests for extension of time in *inter partes* reexamination proceedings.

§ 5.12—for expedited handling of a foreign filing license.

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.

\* \* \* \* \*

(i) Processing fee for taking action under one of the following sections which refers to this paragraph: \$130.00.

§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.

§ 1.41(b)—for supplying the name or names of the inventor or joint inventors in an application without either an application data sheet or the inventor's oath or declaration, except in provisional applications.

§ 1.48—for correcting inventorship, except in provisional applications.

§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.

§ 1.53(c)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§ 1.55—for entry of late priority papers.

§ 1.71(g)(2)—for processing a belated amendment under § 1.71(g).

§ 1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§ 1.53(d)).

§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d)—for requesting deferred examination of an application.

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221—for requesting voluntary publication or republication of an application.

§ 1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.

§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

\* \* \* \* \*

■ 10. Section 1.27 is amended by revising paragraph (c)(2) to read as follows:

**§ 1.27 Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.**

\* \* \* \* \*

(c) \* \* \*

(2) *Parties who can sign the written assertion.* The written assertion can be signed by:

- (i) The applicant (§ 1.42 or § 1.421);
- (ii) A patent practitioner of record or a practitioner acting in a representative capacity under § 1.34;

- (iii) The inventor or a joint inventor, if the inventor is the applicant; or
- (iv) The assignee.

\* \* \* \* \*

■ 11. Section 1.31 is revised to read as follows:

**§ 1.31 Applicant may be represented by one or more patent practitioners or joint inventors.**

An applicant for patent may file and prosecute the applicant's own case, or the applicant may give power of attorney so as to be represented by one or more patent practitioners or joint inventors, except that a juristic entity (e.g., organizational assignee) must be represented by a patent practitioner even if the juristic entity is the applicant. The Office cannot aid in the selection of a patent practitioner.

■ 12. Section 1.32 is amended by revising paragraphs (a)(2), (a)(3), (a)(4) and (b) and adding paragraphs (a)(6), (d) and (e) to read as follows:

**§ 1.32 Power of attorney.**

(a) \* \* \*

(2) *Power of attorney* means a written document by which a principal authorizes one or more patent practitioners or joint inventors to act on the principal's behalf.

(3) *Principal* means the applicant (§ 1.42) for an application for patent and the patent owner for a patent, including a patent in a supplemental examination or reexamination proceeding. The principal executes a power of attorney designating one or more patent practitioners or joint inventors to act on the principal's behalf.

(4) *Revocation* means the cancellation by the principal of the authority previously given to a patent practitioner or joint inventor to act on the principal's behalf.

\* \* \* \* \*

(6) *Patent practitioner of record* means a patent practitioner who has been granted a power of attorney in an application, patent, or other proceeding in compliance with paragraph (b) of this section. The phrases practitioner of record and attorney or agent of record also mean a patent practitioner who has been granted a power of attorney in an application, patent, or other proceeding in compliance with paragraph (b) of this section.

(b) A power of attorney must:

- (1) Be in writing;
- (2) Name one or more representatives in compliance with paragraph (c) of this section;
- (3) Give the representative power to act on behalf of the principal; and
- (4) Be signed by the applicant for patent (§ 1.42) or the patent owner. A

patent owner who was not the applicant under § 1.46 must appoint any power of attorney in compliance with §§ 3.71 and 3.73 of this chapter.

\* \* \* \* \*

(d) A power of attorney from a prior national application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application unless:

(1) The power of attorney was granted by the inventor; and

(2) The continuing application names an inventor who was not named as an inventor in the prior application.

(e) If the power of attorney was granted by the originally named inventive entity, and an added inventor pursuant to § 1.48 does not provide a power of attorney consistent with the power of attorney granted by the originally named inventive entity, the addition of the inventor results in the loss of that power of attorney upon grant of the § 1.48 request. This provision does not preclude a practitioner from acting pursuant to § 1.34, if applicable.

■ 13. Section 1.33 is amended by revising paragraphs (a) and (b) and adding paragraphs (f) and (g) to read as follows:

**§ 1.33 Correspondence respecting patent applications, patent reexamination proceedings, and other proceedings.**

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, *see* §§ 1.76(b)(1) and 1.63(b)(2)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified, the Office will select one of the specified addresses for use as the correspondence

address and, if given, may select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed by the parties set forth in paragraph (b)(1) or (b)(3) of this section. Prior to the appointment of any power of attorney under § 1.32(b), the correspondence address may also be changed by any patent practitioner named in the application transmittal papers who acts in a representative capacity under the provisions of § 1.34.

**(b) Amendments and other papers.**

Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(iii) or (c)(2)(iv), filed in the application must be signed by:

- (1) A patent practitioner of record;
- (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34; or
- (3) The applicant (§ 1.42). Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

\* \* \* \* \*

(f) Where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

(g) A patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in an application may change the correspondence address after the patent has issued, provided that the change of correspondence address is accompanied by a statement that notice has been given to the patentee or owner.

■ 14. Section 1.36 is amended by revising paragraph (a) to read as follows:

**§ 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.**

(a) A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceedings of a case by the applicant or patent owner. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any

powers of attorney previously given. Fewer than all of the applicants (or fewer than all patent owners in a supplemental examination or reexamination proceeding) may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(f). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee may become the applicant under § 1.46(c) and revoke any previous power of attorney and grant a power of attorney as provided in § 1.32(b).

\* \* \* \* \*

■ 15. Section 1.41 is revised to read as follows:

**§ 1.41 Inventorship.**

(a) An application must include, or be amended to include, the name of the inventor for any invention claimed in the application.

(b) The inventorship of a nonprovisional application under 35 U.S.C. 111(a) is the inventor or joint inventors set forth in the application data sheet in accordance with § 1.76 filed before or concurrently with the inventor's oath or declaration. If an application data sheet is not filed before or concurrently with the inventor's oath or declaration, the inventorship is the inventor or joint inventors set forth in the inventor's oath or declaration, except as provided for in §§ 1.53(d)(4) and 1.63(d). Once an application data sheet or the inventor's oath or declaration is filed in a nonprovisional application, any correction of inventorship must be pursuant to § 1.48. If neither an application data sheet nor the inventor's oath or declaration is filed during the pendency of a nonprovisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to § 1.53(b), unless the applicant files a paper, including the processing fee set forth in § 1.17(i), supplying the name or names of the inventor or joint inventors.



(c) The inventorship of a provisional application is the inventor or joint inventors set forth in the cover sheet as prescribed by § 1.51(c)(1). Once a cover sheet as prescribed by § 1.51(c)(1) is filed in a provisional application, any correction of inventorship must be pursuant to § 1.48. If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to § 1.53(c), unless applicant files a paper including the processing fee set forth in § 1.17(q), supplying the name or names of the inventor or joint inventors.

(d) In a nonprovisional application under 35 U.S.C. 111(a) filed without an application data sheet or the inventor's oath or declaration, or in a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name and residence of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or § 1.53(c) are filed.

(e) The inventorship of an international application entering the national stage under 35 U.S.C. 371 is the inventor or joint inventors set forth in the application data sheet in accordance with § 1.76 filed with the initial submission under 35 U.S.C. 371. Unless the initial submission under 35 U.S.C. 371 is accompanied by an application data sheet in accordance with § 1.76 setting forth the inventor or joint inventors, the inventorship is the inventor or joint inventors set forth in the international application, which includes any change effected under PCT Rule 92 *bis*.

■ 16. Section 1.42 is revised to read as follows:

**§ 1.42 Applicant for patent.**

(a) The word "applicant" when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in §§ 1.43, 1.45, or 1.46.

(b) If a person is applying for a patent as provided in § 1.46, the word "applicant" refers to the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for a patent under § 1.46 and not the inventor.

(c) If fewer than all joint inventors are applying for a patent as provided in § 1.45, the phrase "the applicant" means the joint inventors who are applying for the patent without the omitted inventor(s).

(d) Any person having authority may deliver an application and fees to the Office on behalf of the applicant. However, an oath or declaration, or substitute statement in lieu of an oath or declaration, may be executed only in accordance with § 1.63 or 1.64, a correspondence address may be provided only in accordance with § 1.33(a), and amendments and other papers must be signed in accordance with § 1.33(b).

(e) The Office may require additional information where there is a question concerning ownership or interest in an application, and a showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

■ 17. Section 1.43 is revised to read as follows:

**§ 1.43 Application for patent by a legal representative of a deceased or legally incapacitated inventor.**

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor. If an inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention. See § 1.64 concerning the execution of a substitute statement by a legal representative in lieu of an oath or declaration.

■ 18. Section 1.45 is revised to read as follows:

**§ 1.45 Application for patent by joint inventors.**

(a) Joint inventors must apply for a patent jointly, and each must make an inventor's oath or declaration as required by § 1.63, except as provided for in § 1.64. If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other joint inventor or inventors may make the application for patent on behalf of themselves and the omitted inventor. See § 1.64 concerning the execution of a substitute statement by the other joint inventor or inventors in lieu of an oath or declaration.

(b) Inventors may apply for a patent jointly even though:

(1) They did not physically work together or at the same time;

(2) Each inventor did not make the same type or amount of contribution; or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

■ 19. Section 1.46 is revised to read as follows:

**§ 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.**

(a) 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.

(b) If an application under 35 U.S.C. 111 is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under § 1.76 specifying in the applicant information section (§ 1.76(b)(7)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If the application is the national stage of an international application, the person who is identified in the international stage as an applicant for the United States is the person specified as the original applicant for the national stage.

(1) If the applicant is the assignee or a person to whom the inventor is under an obligation to assign the invention, documentary evidence of ownership (*e.g.*, assignment for an assignee, employment agreement for a person to whom the inventor is under an obligation to assign the invention) should be recorded as provided for in part 3 of this chapter no later than the date the issue fee is paid in the application.

(2) If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including:

(i) The fee set forth in § 1.17(g);

(ii) A showing that such person has sufficient proprietary interest in the matter; and

(iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

(c) Any request to correct or update the name of the applicant after an applicant has been specified under paragraph (b) of this section must include an application data sheet under § 1.76 specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)). Any request to change the applicant after an original applicant has been specified under paragraph (b) of this section must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) and comply with §§ 3.71 and 3.73 of this title.

(d) Even if the whole or a part interest in the invention or in the patent to be issued is assigned or obligated to be assigned, an oath or declaration must be executed by the actual inventor or each actual joint inventor, except as provided for in § 1.64. See § 1.64 concerning the execution of a substitute statement by an assignee, person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter.

(e) If a patent is granted 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. Otherwise, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81. Where a real party in interest has filed an application under § 1.46, the applicant shall notify the Office of any change in the real party in interest no later than payment of the issue fee. The Office will treat the absence of such a notice as an indication that there has been no change in the real party in interest.

(f) The Office may publish notice of the filing of the application by a person who otherwise shows sufficient proprietary interest in the *Official Gazette*.

**§ 1.47 [Removed and Reserved]**

■ 20. Section 1.47 is removed and reserved.

■ 21. Section 1.48 is revised to read as follows:

**§ 1.48 Correction of inventorship pursuant to 35 U.S.C. 116 or correction of the name or order of names in a patent application, other than a reissue application.**

(a) *Nonprovisional application:* Any request to correct or change the inventorship once the inventorship has been established under § 1.41 must include:

(1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name; and

(2) The processing fee set forth in § 1.17(i).

(b) *Inventor's oath or declaration for added inventor:* An oath or declaration as required by § 1.63, or a substitute statement in compliance with § 1.64, will be required for any actual inventor who has not yet executed such an oath or declaration.

(c) [Reserved]

(d) *Provisional application.* Once a cover sheet as prescribed by § 1.51(c)(1) is filed in a provisional application, any request to correct or change the inventorship must include:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies each inventor by his or her legal name; and

(2) The processing fee set forth in § 1.17(q).

(e) *Additional information may be required.* The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(f) *Correcting or updating the name of an inventor:* Any request to correct or update the name of the inventor or a joint inventor, or the order of the names of joint inventors, in a nonprovisional application must include:

(1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name in the desired order; and

(2) The processing fee set forth in § 1.17(i).

(g) *Reissue applications not covered.* The provisions of this section do not apply to reissue applications. See §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

(h) *Correction of inventorship in patent.* See § 1.324 for correction of inventorship in a patent.

(i) *Correction of inventorship in an interference or contested case before the Patent Trial and Appeal Board.* In an interference under part 41, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 41.121(a)(2) of this title. In a contested

case under part 42, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 42.22 of this title. The motion under § 41.121(a)(2) or 42.22 of this title must comply with the requirements of paragraph (a) of this section.

■ 22. Section 1.51 is amended by revising paragraph (b)(2) to read as follows

**§ 1.51 General requisites of an application.**

\* \* \* \* \*

(b) \* \* \*

(2) The inventor's oath or declaration, see §§ 1.63 and 1.64;

\* \* \* \* \*

■ 23. Section 1.52 is amended by revising the heading of paragraph (b) and paragraphs (c) and (d) to read as follows:

**§ 1.52 Language, paper, writing, margins, compact disc specifications.**

\* \* \* \* \*

(b) *The application (specification, including the claims, drawings, and the inventor's oath or declaration) or supplemental examination or reexamination proceeding and any amendments or corrections to the application or reexamination proceeding.*

\* \* \* \* \*

(c) Interlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor's oath or declaration referring to those application papers, provided that the statements in the inventor's oath or declaration pursuant to § 1.63 remain applicable to those application papers. A substitute specification (§ 1.125) may be required if the application papers do not comply with paragraphs (a) and (b) of this section.

(d) A nonprovisional or provisional application under 35 U.S.C. 111 may be in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application under 35 U.S.C. 111(a) is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in § 1.17(i) are required. If these items are not filed with the application, the applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application under 35 U.S.C. 111(b) is filed in a language other than English, an English language translation

of the non-English language provisional application will not be required in the provisional application. See § 1.78(a) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

\* \* \* \* \*

■ 24. Section 1.53 is amended by revising the introductory text of paragraphs (c) and (c)(3), and paragraphs (d)(2)(iv), (f), and (h) to read as follows:

**§ 1.53 Application number, filing date, and completion of application.**

\* \* \* \* \*

(c) *Application filing requirements—Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by 35 U.S.C. 112(a), and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

\* \* \* \* \*

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by 35 U.S.C. 112(b), unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed

by 35 U.S.C. 112(b). The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, the inventor's oath or declaration, and the surcharge required by § 1.16(f) if either the basic filing fee for a nonprovisional application or the inventor's oath or declaration was not present on the filing date accorded the resulting nonprovisional application (i.e., the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

\* \* \* \* \*

(d) \* \* \*

(2) \* \* \*

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and the inventor's oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and

\* \* \* \* \*

(f) *Completion of application subsequent to filing—Nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, the search fee, or the examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the inventor's oath or declaration (§ 1.63, § 1.64, § 1.162 or § 1.175), and the applicant has provided a correspondence address (§ 1.33(a)), the applicant will be notified and given a period of time within which to pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by § 1.16(f) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, the search fee, the examination fee, or the inventor's oath or declaration, and the applicant has not provided a correspondence address (§ 1.33(a)), the applicant has two months from the filing date of the application within which to pay the basic filing fee, search fee, and examination fee, and pay the surcharge required by § 1.16(f) to avoid abandonment.

(3) The inventor's oath or declaration in an application under § 1.53(b) must also be filed within the period specified in paragraph (f)(1) or (f)(2) of this section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in paragraphs (f)(3)(i) and (f)(3)(ii) of this section.

(i) The application must be an original (non-reissue) application that contains an application data sheet in accordance with § 1.76 identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file an oath or declaration in compliance with § 1.63, or a substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor no later than the expiration of the time period set in the "Notice of Allowability" to avoid abandonment, when the applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance. The time period set in a "Notice of Allowability" is not extendable. See § 1.136(c). The Office may dispense with the notice provided for in paragraph (f)(1) of this section if an oath or declaration under § 1.63, or a substitute statement under § 1.64, executed by or with respect to each actual inventor has been filed before the application is in condition for allowance.

(4) If the excess claims fees required by § 1.16(h) and (i) and multiple dependent claim fee required by § 1.16(j) are not paid on filing or on later presentation of the claims for which the excess claims or multiple dependent claim fees are due, the fees required by § 1.16(h), (i) and (j) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency. If the application size fee required by § 1.16(s) (if any) is not paid on filing or on later presentation of the amendment necessitating a fee or additional fee under § 1.16(s), the fee required by § 1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(5) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part

applications under paragraph (b) of this section. See § 1.63(d) concerning the submission of a copy of the inventor's oath or declaration from the prior application for a continuing application under paragraph (b) of this section.

(6) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

\* \* \* \* \*

(h) *Subsequent treatment of application—Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that the inventor's oath or declaration may be filed when the application is otherwise in condition for allowance pursuant to paragraph (f)(3) of this section and minor informalities may be waived subject to subsequent correction whenever required.

\* \* \* \* \*

■ 25. Section 1.55 is amended by revising the introductory text of paragraph (a)(1)(i), the introductory text of paragraph (c), and paragraph (d)(1)(ii) to read as follows:

**§ 1.55 Claim for foreign priority.**

(a) \* \* \*

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for foreign priority must be presented in an application data sheet (§ 1.76(b)(6)) during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

\* \* \* \* \*

(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a)–(d) or 365(a) not presented in an application data sheet (§ 1.76(b)(6)) within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C.

119(a)–(d) or 365(a) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)–(d) or 365(a) must be accompanied by:

\* \* \* \* \*

(d)(1) \* \* \*

(ii) The foreign application is identified in an application data sheet (§ 1.76(b)(6)); and

\* \* \* \* \*

■ 26. Section 1.56 is amended by revising paragraph (c)(3) to read as follows:

**§ 1.56 Duty to disclose information material to patentability.**

\* \* \* \* \*

(c) \* \* \*

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application.

\* \* \* \* \*

■ 27. Section 1.59 is amended by revising paragraph (a)(2) to read as follows:

**§ 1.59 Expungement of information or copy of papers in application file.**

(a) \* \* \*

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment present on the filing date of the application) will not be expunged from the application file.

\* \* \* \* \*

■ 28. Section 1.63 is revised to read as follows:

**§ 1.63 Inventor's oath or declaration.**

(a) The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration directed to the application, except as provided for in § 1.64. An oath or declaration under this section must:

- (1) Identify the inventor or joint inventor executing the oath or declaration by his or her legal name;
- (2) Identify the application to which it is directed;
- (3) Include a statement that the person executing the oath or declaration believes the named inventor or joint

inventor to be the original inventor or an original joint inventor of a claimed invention in the application for which the oath or declaration is being submitted; and

(4) State that the application was made or was authorized to be made by the person executing the oath or declaration.

(b) Unless the following information is supplied in an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

(1) Each inventor by his or her legal name; and

(2) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(c) A person may not execute an oath or declaration for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56. There is no minimum age for a person to be qualified to execute an oath or declaration, but the person must be competent to execute, *i.e.*, understand, the document that the person is executing.

(d)(1) A newly executed oath or declaration under § 1.63, or substitute statement under § 1.64, is not required under § 1.51(b)(2) and § 1.53(f) or § 1.497 for an inventor in a continuing application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed application, provided that an oath or declaration in compliance with this section, or substitute statement under § 1.64, was executed by or with respect to such inventor and was filed in the earlier-filed application, and a copy of such oath, declaration, or substitute statement showing the signature or an indication thereon that it was executed, is submitted in the continuing application.

(2) The inventorship of a continuing application filed under 35 U.S.C. 111(a) is the inventor or joint inventors specified in the application data sheet filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application. If an application data sheet is not filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application, the inventorship is the inventorship set forth in the copy of the inventor's oath or declaration from the earlier-filed application, unless it is

accompanied by a statement signed pursuant to § 1.33(b) stating the name of each inventor in the continuing application.

(3) Any new joint inventor named in the continuing application must provide an oath or declaration in compliance with this section, except as provided for in § 1.64.

(e)(1) An assignment may also serve as an oath or declaration required by this section if the assignment as executed:

(i) Includes the information and statements required under paragraphs (a) and (b) of this section; and

(ii) A copy of the assignment is recorded as provided for in part 3 of this chapter.

(2) Any reference to an oath or declaration under this section includes an assignment as provided for in this paragraph.

(f) With respect to an application naming only one inventor, any reference to the inventor's oath or declaration in this chapter includes a substitute statement executed under § 1.64. With respect to an application naming more than one inventor, any reference to the inventor's oath or declaration in this chapter means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors, unless otherwise clear from the context.

(g) An oath or declaration under this section, including the statement provided for in paragraph (e) of this section, must be executed (*i.e.*, signed) in accordance either with § 1.66 or with an acknowledgment that any willful false statement made in such declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

(h) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1) will be placed in the file record of the application or patent, but may not necessarily be reviewed by the Office. Any request for correction of the named inventorship must comply with § 1.48 in an application and § 1.324 in a patent.

■ 29. Section 1.64 is revised to read as follows:

**§ 1.64 Substitute statement in lieu of an oath or declaration.**

(a) An applicant under § 1.43, 1.45 or 1.46 may execute a substitute statement in lieu of an oath or declaration under § 1.63 if the inventor is deceased, is under a legal incapacity, has refused to execute the oath or declaration under § 1.63, or cannot be found or reached after diligent effort.

(b) A substitute statement under this section must:

(1) Comply with the requirements of § 1.63(a), identifying the inventor or joint inventor with respect to whom a substitute statement in lieu of an oath or declaration is executed, and stating upon information and belief the facts which such inventor is required to state;

(2) Identify the person executing the substitute statement and the relationship of such person to the inventor or joint inventor with respect to whom the substitute statement is executed, and unless such information is supplied in an application data sheet in accordance with § 1.76, the residence and mailing address of the person signing the substitute statement;

(3) Identify the circumstances permitting the person to execute the substitute statement in lieu of an oath or declaration under § 1.63, namely whether the inventor is deceased, is under a legal incapacity, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration under § 1.63; and

(4) Unless the following information is supplied in an application data sheet in accordance with § 1.76, also identify:

(i) Each inventor by his or her legal name; and

(ii) The last known mailing address where the inventor customarily receives mail, and last known residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor who is not deceased or under a legal incapacity.

(c) A person may not execute a substitute statement provided for in this section for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(d) Any reference to an inventor's oath or declaration includes a substitute statement provided for in this section.

(e) A substitute statement under this section must contain an acknowledgment that any willful false statement made in such statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

(f) A nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under § 1.63. The submission of an oath or declaration by a nonsigning inventor or legal representative in an application filed under § 1.43, 1.45 or 1.46 will not

permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

■ 30. Section 1.66 is revised to read as follows:

**§ 1.66 Statements under oath.**

An oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

■ 31. Section 1.67 is revised to read as follows:

**§ 1.67 Supplemental oath or declaration.**

(a) The applicant may submit an inventor's oath or declaration meeting the requirements of § 1.63, § 1.64, or § 1.162 to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(b) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76, except that any correction of inventorship must be pursuant to § 1.48.

(b) A supplemental inventor's oath or declaration under this section must be executed by the person whose inventor's oath or declaration is being withdrawn, replaced, or otherwise corrected.

(c) The Office will not require a person who has executed an oath or declaration in compliance with 35 U.S.C. 115 and § 1.63 or 1.162 for an application to provide an additional inventor's oath or declaration for the application.

(d) No new matter may be introduced into a nonprovisional application after its filing date even if an inventor's oath or declaration is filed to correct deficiencies or inaccuracies present in the earlier-filed inventor's oath or declaration.

■ 32. Section 1.76 is amended by revising paragraphs (a), (b)(1), (b)(3), (b)(5), (b)(7), (c), and (d), and adding new paragraph (e) to read as follows:

§ 1.76 Application data sheet.

(a) Application data sheet: An application data sheet is a sheet or sheets, that may be submitted in a provisional application under 35 U.S.C. 111(b), a nonprovisional application under 35 U.S.C. 111(a), or a national stage application under 35 U.S.C. 371, and must be submitted when required by § 1.55 or 1.78 to claim priority to or the benefit of a prior-filed application under 35 U.S.C. 119, 120, 121, or 365. An application data sheet must be titled "Application Data Sheet." An application data sheet must contain all of the section headings listed in paragraph (b) of this section, except as provided in paragraph (c)(2) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the application for which it has been submitted.

(b) \* \* \*

(1) Inventor information. This information includes the legal name, residence, and mailing address of the inventor or each joint inventor.

\* \* \* \* \*

(3) Application information. This information includes the title of the invention, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (e.g., utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination.

\* \* \* \* \*

(5) Domestic benefit information. This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the

specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(5).

\* \* \* \* \*

(7) Applicant information: This information includes the name (either natural person or juristic entity) and address of the legal representative, assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under § 1.43 or § 1.46. Providing assignment information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) Correcting and updating an application data sheet. (1) Information in a previously submitted application data sheet, inventor's oath or declaration under § 1.63, § 1.64 or § 1.67, or otherwise of record, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, except that inventorship changes must comply with the requirements of § 1.48, foreign priority and domestic benefit information changes must comply with §§ 1.55 and 1.78, and correspondence address changes are governed by § 1.33(a).

(2) An application data sheet providing corrected or updated information may include all of the sections listed in paragraph (b) of this section or only those sections containing changed or updated information. The application data sheet must include the section headings listed in paragraph (b) of this section for each section included in the application data sheet, and must identify the information that is being changed, with underlining for insertions, and strike-through or brackets for text removed, except that identification of information being changed is not required for an application data sheet included with an initial submission under 35 U.S.C. 371.

(d) Inconsistencies between application data sheet and other documents. For inconsistencies between information that is supplied by both an application data sheet under this section and other documents:

(1) The most recent submission will govern with respect to inconsistencies as between the information provided in an application data sheet, a designation of a correspondence address, or by the inventor's oath or declaration, except that:

(i) The most recent application data sheet will govern with respect to foreign

priority (§ 1.55) or domestic benefit (§ 1.78) claims; and

(ii) The naming of the inventorship is governed by § 1.41 and changes to inventorship or the names of the inventors is governed by § 1.48.

(2) The information in the application data sheet will govern when the inconsistent information is supplied at the same time by a designation of correspondence address or the inventor's oath or declaration.

(3) The Office will capture bibliographic information from the application data sheet. The Office will generally not review the inventor's oath or declaration to determine if the bibliographic information contained therein is consistent with the bibliographic information provided in an application data sheet. Incorrect bibliographic information contained in an application data sheet may be corrected as provided in paragraph (c)(1) of this section.

(e) Signature requirement. An application data sheet must be signed in compliance with § 1.33(b). An unsigned application data sheet will be treated only as a transmittal letter.

■ 33. Section 1.77 is amended by revising paragraph (a)(6) to read as follows:

§ 1.77 Arrangement of application elements.

(a) \* \* \*

(6) The inventor's oath or declaration.

\* \* \* \* \*

■ 34. Section 1.78 is amended by revising paragraphs (a)(2)(iii), (a)(5)(iii), (a)(5)(iv), and (c) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) \* \* \*

(2) \* \* \*

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)).

\* \* \* \* \*

(5) \* \* \*

(iii) If the later filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)).

(iv) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, applicant will be notified and given a period of time

within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet eliminating the reference under this paragraph to the prior-filed provisional application, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.

\* \* \* \* \*

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the applicant to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made, the conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

■ 35. Section 1.81 is amended by revising paragraph (a) to read as follows:

**§ 1.81 Drawings required in patent application.**

(a) The applicant for a patent is required to furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

\* \* \* \* \*

■ 36. Section 1.105 is amended by removing paragraph (a)(2), and redesignating paragraphs (a)(3) and (a)(4) as paragraphs (a)(2) and (a)(3), respectively.

■ 37. Section 1.131 is amended by revising the introductory text of paragraph (a) to read as follows:

**§ 1.131 Affidavit or declaration of prior invention.**

(a) When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

\* \* \* \* \*

■ 38. Section 1.136 is amended by revising paragraph (c)(1) to read as follows:

**§ 1.136 Extensions of time.**

\* \* \* \* \*

(c) \* \* \*

(1) The period for submitting the inventor's oath or declaration;

\* \* \* \* \*

■ 39. Section 1.153 is amended by revising paragraph (b) to read as follows:

**§ 1.153 Title, description and claim, oath or declaration.**

\* \* \* \* \*

(b) The inventor's oath or declaration must comply with the requirements of § 1.63, or comply with the requirements of § 1.64 for a substitute statement.

■ 40. Section 1.154 is amended by revising paragraph (a)(6) to read as follows:

**§ 1.154 Arrangement of application elements in a design application.**

(a) \* \* \*

(6) The inventor's oath or declaration (see § 1.153(b)).

\* \* \* \* \*

■ 41. Section 1.162 is revised to read as follows:

**§ 1.162 Applicant, oath or declaration.**

The inventor named for a plant patent application must be the person who has

invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought. The inventor's oath or declaration, in addition to the averments required by § 1.63 or § 1.64, must state that the inventor has asexually reproduced the plant. Where the plant is a newly found plant, the inventor's oath or declaration must also state that it was found in a cultivated area.

■ 42. Section 1.163 is amended by revising paragraph (b)(6) to read as follows:

**§ 1.163 Specification and arrangement of application elements in a plant application.**

\* \* \* \* \*

(b) \* \* \*

(6) The inventor's oath or declaration (§ 1.162).

\* \* \* \* \*

■ 43. Section 1.172 is revised to read as follows:

**§ 1.172 Reissue applicant.**

(a) The reissue applicant is the original patentee, or the current patent owner if there has been an assignment. A reissue application must be accompanied by the written consent of all assignees, if any, currently owning an undivided interest in the patent. All assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(c) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

■ 44. Section 1.175 is revised to read as follows:

**§ 1.175 Inventor's oath or declaration for a reissue application.**

(a) The inventor's oath or declaration for a reissue application, in addition to complying with the requirements of § 1.63, § 1.64, or § 1.67, must also specifically identify at least one error pursuant to 35 U.S.C. 251 being relied upon as the basis for reissue and state that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent.

(b) If the reissue application seeks to enlarge the scope of the claims of the patent (a basis for the reissue is the patentee claiming less than the patentee had the right to claim in the patent), the inventor's oath or declaration for a reissue application must identify a claim that the application seeks to

broaden. A claim is a broadened claim if the claim is broadened in any respect.

(c) The inventor, or each individual who is a joint inventor of a claimed invention, in a reissue application must execute an oath or declaration for the reissue application, except as provided for in § 1.64, and except that the inventor's oath or declaration for a reissue application may be signed by the assignee of the entire interest if:

(1) The application does not seek to enlarge the scope of the claims of the original patent; or

(2) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(d) If errors previously identified in the inventor's oath or declaration for a reissue application pursuant to paragraph (a) of this section are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(e) The inventor's oath or declaration for a reissue application required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f), except that the provisions of § 1.53(f)(3) do not apply to a reissue application.

(f)(1) The requirement for the inventor's oath or declaration for a continuing reissue application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed reissue application may be satisfied by a copy of the inventor's oath or declaration from the earlier-filed reissue application, provided that:

(i) The inventor, or each individual who is a joint inventor of a claimed invention, in the reissue application executed an inventor's oath or declaration for the earlier-filed reissue application, except as provided for in § 1.64;

(ii) The continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or

(iii) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(2) If all errors identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(g) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1), will be placed in the file record of the reissue application, but may not necessarily be reviewed by the Office.

■ 45. Section 1.211 is amended by revising paragraph (c) to read as follows:

§ 1.211 Publication of applications.

\* \* \* \* \*

(c) An application filed under 35 U.S.C. 111(a) will not be published until it includes the basic filing fee (§ 1.16(a) or § 1.16(c)) and any English translation required by § 1.52(d). The Office may delay publishing any application until it includes any application size fee required by the Office under § 1.16(s) or § 1.492(j), a specification having papers in compliance with § 1.52 and an abstract (§ 1.72(b)), drawings in compliance with § 1.84, a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), and the inventor's oath or declaration or application data sheet containing the information specified in § 1.63(b).

\* \* \* \* \*

■ 46. Section 1.215 is amended by revising paragraphs (a) through (c) to read as follows:

§ 1.215 Patent application publication.

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the application data sheet and/or the inventor's oath or declaration. The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under § 1.125(b), amendments to the abstract under § 1.121(b), amendments to the claims that are reflected in a complete claim listing under § 1.121(c), and amendments to the drawings under § 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. The patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage. See paragraph (c) of this section for publication of an application based upon a copy of the application submitted via the Office electronic filing system.

(b) The patent application publication will include the name of the assignee,

person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter if that information is provided in the application data sheet in an application filed under § 1.46. Assignee information may be included on the patent application publication in other applications if the assignee information is provided in an application data sheet submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Providing assignee information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and the application data sheet and/or the inventor's oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

\* \* \* \* \*

■ 47. Section 1.321 is amended by revising paragraph (b) to read as follows:

§ 1.321 Statutory disclaimers, including terminal disclaimers.

\* \* \* \* \*

(b) An applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the applicant or an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in § 1.20(d).

\* \* \* \* \*

■ 48. Section 1.324 is revised to read as follows:



**§ 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.**

(a) Whenever through error a person is named in an issued patent as the inventor, or an inventor is not named in an issued patent, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) A statement from each person who is being added as an inventor and each person who is currently named as an inventor either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change;

(2) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(c) of this chapter; and

(3) The fee set forth in § 1.20(b).

(c) For correction of inventorship in an application, *see* § 1.48.

(d) In an interference under part 41, subpart D, of this title, a request for correction of inventorship in a patent must be in the form of a motion under § 41.121(a)(2) of this title. In a contested case under part 42, subpart D, of this title, a request for correction of inventorship in a patent must be in the form of a motion under § 42.22 of this title. The motion under § 41.121(a)(2) or § 42.22 of this title must comply with the requirements of this section.

■ 49. Section 1.414 is amended by revising paragraph (c)(2) to read as follows:

**§ 1.414 The United States Patent and Trademark Office as a Designated Office or Elected Office.**

\* \* \* \* \*

(c) \* \* \*

(2) National stage processing for international applications entering the national stage under 35 U.S.C. 371.

■ 50. Section 1.421 is revised to read as follows:

**§ 1.421 Applicant for international application.**

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office. If an international application does not include an applicant who is indicated as being a resident or national of the

United States of America, and at least one applicant:

(1) Has indicated a residence or nationality in a PCT Contracting State, or

(2) Has no residence or nationality indicated, applicant will be so notified and, if the international application includes a fee amount equivalent to that required by § 1.445(a)(4), the international application will be forwarded for processing to the International Bureau acting as a Receiving Office (*see also* § 1.412(c)(6)).

(b) Although the United States Receiving Office will accept international applications filed by any applicant who is a resident or national of the United States of America for international processing, for the purposes of the designation of the United States, an international application will be accepted by the Patent and Trademark Office for the national stage only if the applicant is the inventor or other person as provided in § 1.422 or § 1.424. Joint inventors must jointly apply for an international application.

(c) A registered attorney or agent of the applicant may sign the international application Request and file the international application for the applicant. A separate power of attorney from each applicant may be required.

(d) Any indication of different applicants for the purpose of different Designated Offices must be shown on the Request portion of the international application.

(e) Requests for changes in the indications concerning the applicant, agent, or common representative of an international application shall be made in accordance with PCT Rule 92*bis* and may be required to be signed by all applicants.

(f) Requests for withdrawals of the international application, designations, priority claims, the Demand, or elections shall be made in accordance with PCT Rule 90*bis* and must be signed by all applicants. A separate power of attorney from the applicants will be required for the purposes of any request for a withdrawal in accordance with PCT Rule 90*bis* which is not signed by all applicants.

■ 51. Section 1.422 is revised to read as follows:

**§ 1.422 Legal representative as applicant in an international application.**

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may be an applicant in an international application which designates the United States of America.

**§ 1.423 [Removed and Reserved]**

■ 52. Section 1.423 is removed and reserved.

■ 53. Section 1.424 is added to read as follows:

**§ 1.424 Assignee, obligated assignee, or person having sufficient proprietary interest as applicant in an international application.**

(a) A person to whom the inventor has assigned or is under an obligation to assign the invention may be an applicant in an international application which designates the United States of America. A person who otherwise shows sufficient proprietary interest in the matter may be an applicant in an international application which designates the United States of America on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

(b) Neither any showing required under paragraph (a) of this section nor documentary evidence of ownership or proprietary interest will be required or considered by the Office in the international stage, but will be required in the national stage in accordance with the conditions and requirements of § 1.46.

■ 54. Section 1.431 is amended by revising paragraph (b)(3)(iii) to read as follows:

**§ 1.431 International application requirements.**

\* \* \* \* \*

(b) \* \* \*

(3) \* \* \*

(iii) The name of the applicant, as prescribed (note §§ 1.421, 1.422, and 1.424);

\* \* \* \* \*

■ 55. Section 1.491 is amended by revising the section heading and paragraph (b), and adding a new paragraph (c), to read as follows:

**§ 1.491 National stage commencement, entry, and fulfillment.**

\* \* \* \* \*

(b) An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c)(1) and (c)(2) within the period set in § 1.495.

(c) An international application fulfills the requirements of 35 U.S.C. 371 when the national stage has commenced under 35 U.S.C. 371(b) or (f) and all applicable requirements of 35 U.S.C. 371 have been satisfied.

■ 56. Section 1.492 is amended by revising paragraph (h) to read as follows:

**§ 1.492 National stage fees.**

\* \* \* \* \*

(h) Surcharge for filing any of the search fee, the examination fee, or the inventor's oath or declaration after the date of the commencement of the national stage (§ 1.491(a)) pursuant to § 1.495(c)

By a small entity (§ 1.27(a)) ..... \$65.00  
 By other than a small entity ..... \$130.00

\* \* \* \* \*

■ 57. Section 1.495 is amended by revising paragraphs (a), (c), (g), and (h) to read as follows:

**§ 1.495 Entering the national stage in the United States of America.**

(a) The applicant in an international application must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. The thirty-month time period set forth in paragraphs (b), (c), (d), (e) and (h) of this section may not be extended.

\* \* \* \* \*

(c)(1) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date, the Office will notify the applicant if he or she has omitted any of:

(i) A translation of the international application, as filed, into the English language, if it was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2));

(ii) The inventor's oath or declaration (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1;

(iii) The search fee set forth in § 1.492(b);

(iv) The examination fee set forth in § 1.492(c); and

(v) Any application size fee required by § 1.492(j).

(2) A notice under paragraph (c)(1) of this section will set a time period within which applicant must provide any omitted translation, search fee set forth in § 1.492(b), examination fee set forth in § 1.492(c), and any application size fee required by § 1.492(j) in order to avoid abandonment of the application.

(3) The inventor's oath or declaration must also be filed within the period specified in paragraph (c)(2) of this

section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in paragraphs (c)(3)(i) through (c)(3)(iii) of this section.

(i) The application contains an application data sheet in accordance with § 1.76 filed prior to the expiration of the time period set in any notice under paragraph (c)(1) identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor no later than the expiration of the time period set in the "Notice of Allowability" to avoid abandonment, when the applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance. The time period set in a "Notice of Allowability" is not extendable. See § 1.136(c). The Office may dispense with the notice provided for in paragraph (c)(1) of this section if an oath or declaration under § 1.63, or substitute statement under § 1.64, executed by or with respect to each actual inventor has been filed before the application is in condition for allowance.

(iii) An international application in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid and for which an application data sheet in accordance with § 1.76 has been filed may be treated as complying with 35 U.S.C. 371 for purposes of eighteen-month publication under 35 U.S.C. 122(b) and § 1.211 *et seq.*

(4) The payment of the processing fee set forth in § 1.492(i) is required for acceptance of an English translation later than the expiration of thirty months after the priority date. The payment of the surcharge set forth in § 1.492(h) is required for acceptance of any of the search fee, the examination fee, or the inventor's oath or declaration after the date of the commencement of the national stage (§ 1.491(a)).

(5) A "Sequence Listing" need not be translated if the "Sequence Listing" complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).

\* \* \* \* \*

(g) The documents and fees submitted under paragraphs (b) and (c) of this

section must be identified as a submission to enter the national stage under 35 U.S.C. 371. If the documents and fees contain conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371, the documents and fees will be treated as a submission to enter the national stage under 35 U.S.C. 371.

(h) An international application becomes abandoned as to the United States thirty months from the priority date if the requirements of paragraph (b) of this section have not been complied with within thirty months from the priority date.

■ 58. Section 1.496 is revised to read as follows:

**§ 1.496 Examination of international applications in the national stage.**

National stage applications having paid therein the search fee as set forth in § 1.492(b)(1) and examination fee as set forth in § 1.492(c)(1) may be amended subsequent to the date of commencement of national stage processing only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications will be advanced out of turn for examination.

■ 59. Section 1.497 is revised to read as follows:

**§ 1.497 Inventor's oath or declaration under 35 U.S.C. 371(c)(4).**

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with § 1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1, the applicant must file the inventor's oath or declaration. The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration in accordance with the conditions and requirements of § 1.63, except as provided for in § 1.64.

(b) An oath or declaration under § 1.63 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§ 1.63(a), (c) and (g). A substitute statement under § 1.64 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§ 1.64(b)(1), (c) and (e) and identifies the person executing the substitute statement. If a newly executed inventor's oath or declaration under § 1.63 or substitute statement under § 1.64 is not required pursuant to § 1.63(d), submission of the

copy of the previously executed oath, declaration, or substitute statement under § 1.63(d)(1) is required to comply with 35 U.S.C. 371(c)(4).

(c) If an oath or declaration under § 1.63, or substitute statement under § 1.64, meeting the requirements of § 1.497(b) does not also meet the requirements of § 1.63 or § 1.64, an oath, declaration, substitute statement, or application data sheet in accordance with § 1.76 to comply with § 1.63 or § 1.64 will be required.

■ 60. Section 1.530 is amended by revising paragraph (l)(1) to read as follows:

**§ 1.530 Statement by patent owner in *ex parte* reexamination; amendment by patent owner in *ex parte* or *inter partes* reexamination; inventorship change in *ex parte* or *inter partes* reexamination.**

\* \* \* \* \*

(l) \* \* \*

(1) When it appears in a patent being reexamined that the correct inventor or inventors were not named, the Director may, on petition of all the parties set forth in § 1.324(b)(1) and (b)(2), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.997 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

\* \* \* \* \*

■ 61. Section 1.730 is amended by revising paragraph (b)(1) to read as follows:

**§ 1.730 Applicant for extension of patent term; signature requirements.**

\* \* \* \* \*

(b) \* \* \*

(1) The patent owner in compliance with § 3.73(c) of this chapter; or

\* \* \* \* \*

**PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE**

■ 62. The authority citation for part 3 continues to read as follows:

**Authority:** 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

■ 63. Section 3.31 is amended by adding new paragraph (h) to read as follows:

**§ 3.31 Cover sheet content.**

\* \* \* \* \*

(h) The assignment cover sheet required by § 3.28 must contain a

conspicuous indication of an intent to utilize the assignment as the required oath or declaration under § 1.63 of this chapter.

■ 64. Section 3.71 is amended by revising paragraphs (a), (b), and (c) to read as follows:

**§ 3.71 Prosecution by assignee.**

(a) *Patents—conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may conduct prosecution of a national patent application as the applicant under § 1.46 of this title, or conduct prosecution of a supplemental examination or reexamination proceeding, to the exclusion of the inventor or previous applicant or patent owner. Conflicts between purported assignees are handled in accordance with § 3.73(c)(3).

(b) *Patents—assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecution of a national application for patent as the applicant under § 1.46 of this title or a supplemental examination or reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent, or

(2) *Partial assignee(s) together or with inventor(s).* All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent, who together own the entire right, title and interest in the application or patent. A partial assignee is any assignee having less than the entire right, title and interest in the application or patent. The word “assignee” as used in this chapter means with respect to patent matters the single assignee of the entire right, title and interest in the application or patent if there is such a single assignee, or all of the partial assignees, or all of the partial assignee and inventors who have not assigned their interest in the application or patent, who together own the entire right, title and interest in the application or patent.

(c) *Patents—Becoming of record.* An assignee becomes of record as the applicant in a national patent application under § 1.46 of this title, and in a supplemental examination or reexamination proceeding, by filing a statement in compliance with § 3.73(c) that is signed by a party who is authorized to act on behalf of the assignee.

\* \* \* \* \*

■ 65. Section 3.73 is revised to read as follows:

**§ 3.73 Establishing right of assignee to take action.**

(a) The original applicant is presumed to be the owner of an application for an original patent, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b) In order to request or take action in a trademark matter, the assignee must establish its ownership of the trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(1) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(2) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(c)(1) In order to request or take action in a patent matter, an assignee who is not the original applicant must establish its ownership of the patent property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) If the submission is by an assignee of less than the entire right, title and interest (*e.g.*, more than one assignee

exists) the Office may refuse to accept the submission as an establishment of ownership unless:

(i) Each assignee establishes the extent (by percentage) of its ownership interest, so as to account for the entire right, title and interest in the application or patent by all parties including inventors; or

(ii) Each assignee submits a statement identifying the parties including inventors who together own the entire right, title and interest and stating that all the identified parties own the entire right, title and interest.

(3) If two or more purported assignees file conflicting statements under paragraph (c)(1) of this section, the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application.

(d) The submission establishing ownership under paragraph (b) or (c) of this section must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(1) Including a statement that the person signing the submission is authorized to act on behalf of the assignee;

(2) Being signed by a person having apparent authority to sign on behalf of the assignee; or

(3) For patent matters only, being signed by a practitioner of record.

**PART 5—SECURITY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES**

■ 66. The authority citation for 37 CFR part 5 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2), 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; the Nuclear Non Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Director (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

■ 67. Section 5.25 is amended by revising paragraphs (a)(3)(iii) and (b) to read as follows:

**§ 5.25 Petition for retroactive license.**

(a) \* \* \*

(3) \* \* \*

(iii) An explanation of why the material was filed abroad through error without the required license under § 5.11 first having been obtained, and

\* \* \* \* \*

(b) The explanation in paragraph (a) of this section must include a showing of facts rather than a mere allegation of action through error. The showing of facts as to the nature of the error should include statements by those persons having personal knowledge of the acts regarding filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error should cover the period leading up to and including each of the proscribed foreign filings.

\* \* \* \* \*

**PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE**

■ 68. The authority citation for 37 CFR part 10 continues to read as follows:

**Authority:** 5 U.S.C. 500, 15 U.S.C. 1123; 35 U.S.C. 2(b)(2), 31, 32, 41.

■ 69. Section 10.23 is amended by removing and reserving paragraph (c)(11).

**§ 10.23 Misconduct.**

\* \* \* \* \*

(c) \* \* \*

(11) [Reserved]

\* \* \* \* \*

**PART 41—PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

■ 70. The authority citation for 37 CFR part 41 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 41, 132, 133, 134, 135, 306, and 315.

■ 71. Section 41.9 is amended by revising paragraph (a) to read as follows:

**§ 41.9 Action by owner.**

(a) *Entire interest.* An owner of the entire interest in an application or patent involved in a Board proceeding may act in the proceeding to the exclusion of the inventor (*see* §§ 3.71 and 3.73 of this title).

\* \* \* \* \*

Dated: July 17, 2012.

**David J. Kappos,**

*Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

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