



## America Invents Act (AIA) - Changes to Inventor's Oath or Declaration

### Brief Summary

- Inventor(s) can authorize an application to be made before it is prepared.
- Oath/declaration can be combined with assignment.
- Oath/declaration can be submitted any time if Application Data Sheet submitted prior to examination. (However, surcharges and reduced patent term (for PCT applications) may apply.)
- If an Application Data Sheet is filed, you do not have to list the entire inventive entity in the oath/declaration (i.e., a separate oath/declaration can be prepared and filed for each inventor).
- Application Data Sheets must be submitted to claim priority to prior-filed applications.
- Be careful during transition period!
  - Applications filed before September 16, 2012 (including 371 national stage applications with an international filing date before September 16, 2012) must comply with the old requirements.
  - Applications filed on or after September 16, 2012 need to comply with the new requirements.

### Oath/Declaration

**Effective date:** Applications filed, or proceedings commenced, on or after September 16, 2012

- Applies to all new applications (provisionals, non-provisionals, continuations, divisionals, new by-pass applications).
- Does not apply to RCE's unless parent application filed after September 16, 2012.
- Applies to 371 National Stage filings only if International Filing date is September 16, 2012 or later.

**Form of Oath or Declaration:**

- (1) a traditional oath/declaration by inventor,
- (2) as part of assignment document by inventor, or
- (3) by a substitute statement on behalf of inventor

**Must include:** (1) inventor's name (if joint inventors, each signs their own oath/declaration) (2) identify application, (3) statement that application was made or authorized to be made by the declarant, (4) statement that declarant believes himself/herself to be the original inventor/joint inventor (5) acknowledgement that willful false statement punishable under 18 U.S.C. § 1001 by fine or imprisonment of not more than 5 years, or both.

**No longer need:** (1) citizenship (2) “first” inventor statement, (3) priority information, (4) all inventors’ names, (5) reviewed application statement (6) duty to disclose relevant information to PTO statement; and (7) statement that false statements may jeopardize.

**Separate Oaths/Declarations for Each Inventor:** Since you no longer need to list all inventors’ names on the oath/declaration, as long as an Application Data Sheet is filed, separate oaths can be prepared and submitted for each inventor. (Note, however, that oaths/declarations that name the entire inventive entity can still be used.)

**Timing:** Can file oath/declaration any time before allowance (and up to 3 months after receiving a Notice of Allowability). No more Notice of Missing Parts for lack of signed declaration. However, if declaration is delayed:

- Before examination, you must provide an Application Data Sheet with name/ mailing address/residence of inventors
- Must pay the late declaration filing surcharge up front
- **WARNING, for PCT applications** there are patent term adjustment (PTA) consequences in delaying submission of executed declaration. The requirements of Section 371 are not met until the inventor’s oath or declaration are filed and therefore the patent term guarantees of Section 154(b)(1) do not apply until the oath or declaration is filed.

**Substitute Statement:** Use as an alternative to a traditional oath/declaration if individual is (1) dead, (2) under legal incapacity, (3) missing after diligent effort, or (4) under an obligation to assign but refuses to make oath/declaration

- **Requires:** (1) identify individual to whom statement applies, (2) circumstances/basis for filing, (3) identify person executing the substitute statement and their relationship to the nonsigning inventor, and (5) the last known address of the nonsigning inventor
- Evidence of ownership (*e.g.*, assignment, employment agreement) should be recorded no later than date issue fee paid

**Assignment containing declaration:**

- “Must include” oath/declaration items listed above in the assignment
- “Conspicuous” indication that docs are combined *e.g.* checkbox on recordal transmittal
- Filing with application will NOT record assignment,
  - BUT assignment recording with the checkbox will place copy in application file.
- Declarations have heightened rules regarding misstatements that can trigger inequitable conduct/imprisonment for misstatements. Consider whether efficiencies outweigh concerns about merging the documents.

**Edits:** OK to edit application after signed oath/declaration obtained, if statements in oath/declaration remain applicable to application papers.

**Transition Period:** During the transition period, make sure the oath/declaration meets the requirements for the application in question.

- Applications filed on or after September 16, 2012 must comply with the new requirements. Therefore, an oath/declaration from a prior application can only be submitted in an application filed on or after September 16, 2012, if the declaration meets the requirements of amended

Section 115.

- Applications before September 16, 2012 must comply with the old requirements. This includes 371 national stage applications that have an international filing date before September 16, 2012.

## Application Data Sheet

- **Mandatory for priority claims** (and to identify inventive entity if oath/declaration not filed with application)
- **Must be signed** (if not, ineffective to provide inventor names or to make a priority claim)
  - Can be signed by any party listed in 37 CFR 1.33(b) (e.g., patent practitioner of record or acting in a representative capacity, assignee, all of the inventors)
- **Include**: each inventor's (1) legal name; (2) mailing address; and (3) residence (if inventor residence differs from where the inventor customarily receives mail)
- If application papers (e.g., inventor's oath) from a prior application are used in a continuing application and correspondence address changed during the prosecution of the prior application, must submit an Application Data Sheet or separate paper identifying the new correspondence address

## Correction of Inventorship

- Change inventorship (including order of inventors) by filing a new signed Application Data Sheet + fee.
- For §371 national stage entry, can correct inventorship by filing Application Data Sheet with application.
  - If no Application Data Sheet, then national stage inventors will be those on the PCT.
  - If adding an inventor, need to submit their oath/declaration as described above.
- No longer require "without deceptive intention" statement or written consent of assignee.
- No longer need to indicate whether correction of inventorship is necessitated by the original inventorship being in error or by an amendment to the claims.

## Power of Attorney

- **Combined declaration/POA** no longer recommended by the PTO.
- **POA must**: (1) be in writing; (2) name one or more representatives; (3) give the representative power to act on behalf of the principal; and (4) be signed by the applicant or the patent owner.
- **Continuing applications** must be filed with copies of old POA (even if unchanged), to avoid ambiguity.
- **Non-inventor owners** (including corporations) must now act via a registered practitioner -- *pro se* representation for businesses and other non-inventor owners no longer allowed.

## **Reissue Applications**

- No longer need supplemental reissue declaration (unless broadening or assigned)
- Assignee can file if original patent was filed by assignee (even for broadening reissue)
- Reissue declaration required before examination will proceed (but no longer need statement about lack of deceptive intent)
- Broadening reissue declaration now must identify the broadened claim(s)

## **Change in Address of Practitioner**

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.