Changes to Inventor’s Oath or Declaration

The America Invents Act (AIA), passed in 2011, significantly changes who may file for patent applications and the inventor’s oath or declaration filed with an application. Historically, only inventors could apply for patents in the United States. Beginning September 16, 2012, however, the AIA enabled anyone who owns invention rights including corporate entities to apply for patents. This change harmonizes U.S. patent practice with most other countries.

Under the new provisions, a patent applicant need only be one “to whom the inventor has assigned or is under an obligation to assign, or is acting with the intent to assign the inventorship rights including corporate entities to apply for patents. This change harmonizes U.S. patent practice with most other countries.

Changes to the Invention Declaration or Oath

The new statute and implementing rules still require submission of an executed oath or declaration by each inventor. In circumstances where an inventor is unable or unwilling to execute a declaration, however, a patent applicant may file a “substitute statement” in lieu of the executed declaration. Such exceptions arise when: (1) the inventor is deceased; (2) the inventor is legally incapacitated; (3) the inventor refuses to execute an oath or declaration; or (4) the inventor cannot be found or reached after diligent effort.

Submission of the executed oath or declaration or substitute statement may be postponed up until a notice of allowability, provided that inventorship information was set forth in an application data sheet (ADS) at the time of initial filing or within the period for filing a response to a Notice to File Missing Parts.

An ADS submitted with the initial patent filing must list the legal name of each inventor and identify a mailing and residence address for each inventor. Unlike prior declaration practice, the citizenship of each inventor need not be provided.

The new statutory requirements for the declaration require three statements:

- That the application was made or was authorized to be made by the inventor
- That the declarant believes himself or herself to be the original inventor
- Acknowledgement that any willful false statement is punishable by fine or imprisonment of not more than 5 years, or both

In view of these new statutory requirements, such as the first statement above, any continuing application including continuation, divisional, continuation-in-part and §371 bypass applications filed on or after September 16, 2012, must include a new declaration complying with the AIA statutory requirements. Declarations complying with the former statute must be used for §371 national stage applications filed from a Patent Cooperation Treaty (PCT) application which was filed before September 16, 2012. The former statute required the declaration to recite that the inventor is the “original, first” inventor or joint inventor. The new statute requires declarations reciting that the inventor is the “original” Inventor but omits the term “first.” Thus, when nationalizing a PCT application filed before September 16, 2012, it is important that the executed declaration use the statutory language now being omitted.

The former statutory requirements also required inventors to acknowledge their duty of candor under 37 CFR §1.56 and to verify the accuracy of statements in the application. While these statements are no longer required, the rules were amended to simply state that a person may not execute an oath or declaration for an application unless that person has reviewed and understood the contents of the application, and is aware of the duty to disclose all information known to the person to be material to patentability.

The new rules also permit inventor declarations to be combined with assignment documents. In such documents the joint assignment and declaration will not be effective as a declaration unless the three statutory requirements identified above are carefully included. In addition, where applicants intend to use a recorded assignment for the dual purpose of a declaration in an application, the cover sheet accompanying a request to record an assignment using the Electronic Patent Assignment System (EPAS) must include a conspicuous statement indicating the intention for dual use.
Changes in Inventorship

Procedures for changing inventorship have been simplified and are carried out using a supplemental ADS. Petitions to correct inventorship will no longer be necessary for applications filed on or after September 16, 2012. Instead, applicants wishing to change identification of inventorship will submit (1) a supplemental ADS listing the correct inventors, (2) a processing fee set forth in 37 CFR §1.17 and (3) where appropriate an executed declaration for any added inventors.

The USPTO has proposed an additional fee of $1,000 ($500 for a small entity and $250 for a micro entity) for requests to correct inventorship after a 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 patent office prior to examination.

The law no longer requires that a single, executed declaration identify all of the inventors. Thus, a declaration identifying a single inventor instead of all inventors may be filed. This change obviates the need for all inventors to execute a new declaration when correcting inventorship.

Priority Claims

Under the new rules, priority claims to earlier filed applications, whether to a provisional or nonprovisional application, now must be identified in an ADS. Failure to make a priority claim in an ADS, even if the beginning of the specification contains or is amended to contain a statement asserting the priority claim, will not entitle an applicant to the benefit of the priority claim.

Best Practices

The following are best practices that you should consider:

• When filing a patent application, always use an ADS.
• Employment, consulting, or other forms of agreements should be executed prior to development of inventions with clear statements controlling ownership of patent rights.
• Taking advantage of the new option to delay filing of an inventor’s declaration in a §371 (national stage application) could prevent accrual of patent term adjustment (PTA) since §371(c)(4) requires an executed inventor’s oath or declaration. Also, the USPTO still requires a surcharge for any declaration not included in the original filing.
• In applications sought by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter, when an issue is to be paid, it will be important to verify the current ownership interest and notify the USPTO of any change.

More information may be found at: http://www.uspto.gov/aia_reform/index.jsp.

If you have any questions or wish to discuss how various aspects of the AIA legislation may affect your organization, please contact your attorney at Brinks Hofer Gilson & Lione.