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March 6, 2012

Hon. David J. Kappos  
 Under Secretary of Commerce for Intellectual Property  
 and Director of the U.S. Patent and Trademark Office  
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*Submitted via:* oath\_declaration@uspto.gov

**Re: Comments on Proposed Rules: “Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act” 77 Fed. Reg. 982 (January 6, 2012)**

Dear Under Secretary Kappos:

Intellectual Property Owners Association (IPO) appreciates the opportunity to provide comments to the U.S. Patent and Trademark Office in response to the proposed Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act published in the Federal Register on January 6, 2012.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO’s membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members.

IPO supports rules that will streamline and simplify the patent process, allowing owners of intellectual property to avoid unnecessary filing costs and delays in protecting their rights. The following comments are organized into four sections: (1) time for filing an oath or declaration; (2) streamlining documents and procedures; (3) applicant filing and prosecution; and (4) proposed amendments.

IPO thanks the USPTO for considering these comments and would welcome any further dialogue or opportunity to support the USPTO in implementing the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act.

Sincerely,

Richard F. Phillips  
 President

**COMMENTS**

1. Time for Filing an Oath or Declaration

The Leahy-Smith America Invents Act (AIA) amended 35 U.S.C. §115 by adding subsection (f) to require an oath or declaration<sup>1</sup> to be filed before the notice of allowance. In the Notice of Proposed Rulemaking (Notice), however, the USPTO proposed requiring the oath or declaration prior to examination, with penalties imposed for providing it after the application filing date. The USPTO justified its proposal based on statutory authority, the need for early identification of inventors during examination, application pendency concerns, and costs associated with processing the documents. None of these justifications supports the proposed departure from the statute.

*a. Statutory Authority*

First, in support of requiring the oath or declaration prior to examination, the USPTO cited authority from other provisions of the Patent Act:

[T]he change to 35 U.S.C. 115 does not alter the statutory authorization in 35 U.S.C. 111(a) and 371 requiring the oath or declaration to be submitted prior to examination of the application, and requiring a surcharge for the submission of an oath or declaration after the filing date of the application under 35 U.S.C. 111(a) or by the date of commencement of the national stage in an international application entering the national stage under 35 U.S.C. 371 (emphasis added).

Sections 111(a) and 371 neither require the oath or declaration to be submitted prior to examination nor require a surcharge for submitting these documents after the filing date. Section 111(a)(2)(C) requires an “oath by the applicant as prescribed by section 115.” As noted above, amended section 115(f) prescribes that the oath be filed prior to the notice of allowance not prior to examination.

Further, section 111(a)(3) permits submitting the oath after the specification and drawings are filed, i.e., the filing date<sup>2</sup>, and “within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.” Thus, this provision expressly permits submission of the oath after the filing date and does not *require* a surcharge for doing so. The corresponding provisions of section 371 are in accord.

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<sup>1</sup> A substitute statement may be filed in lieu of an oath or declaration in certain circumstance per section 115(d). The oath or declaration may be included in the same document as an assignment per section 115(e). The comments herein directed to the timing of filing oaths or declarations and streamlining documents and procedures apply equally to such substitute statements and assignment documents.

<sup>2</sup> Section 111(a)(4) provides that the filing date is the date the USPTO receives the specification and drawings.

*b. Identification of Inventors*

Second, in support of requiring the oath or declaration prior to examination, the Notice emphasized the importance of identifying inventorship early in prosecution:

The Office needs to know who the inventors are to prepare patent application publications and publish applications at eighteen months from their earliest filing date. The Office also needs to know who the inventors are to conduct examination (under conditions of patentability in effect today as well as in effect under the Leahy-Smith America Invents Act). For instance, the Office must know the identity of the inventors to determine what prior art may be applied against the claimed invention or whether to issue a double patenting rejection.

This justification actually underscores that it is not the oath or declaration that is important prior to examination but the identification of the inventor(s).

Moreover, the practical reality of new section 115(h), which permits an oath or declaration to be withdrawn, replaced, or corrected at any time, weakens the USPTO's inventorship justification. The USPTO overlooked section 115(h):

While the Office recognizes the ability of any person making a statement under 35 U.S.C. 115 to correct the statement at any time, including after issuance of the patent, as provided in 35 U.S.C. 115(h), the Office will not review the submission of such a document if it is not timely presented during prosecution of the application.

Section 115(h) actually recognizes that true inventorship is more readily ascertainable toward the end of prosecution after the scope of the claimed invention has been more fully defined.

In keeping with the AIA's purpose of streamlining the oath or declaration process to make it easier to file applications and the USPTO's need for early identification of inventorship, IPO suggests that such early identification can be accomplished through the simple submission of an Application Data Sheet (ADS).

*c. Application Pendency*

Third, in support of requiring the oath or declaration prior to examination, the Notice suggested that permitting submission the oath or declaration up to the notice of allowance would significantly increase the application pendency. One solution would be to have the examiner issue a notice of "allowability" if she is ready to issue a notice of allowance, but finds that an oath or declaration is missing. In this new notice of allowability, the examiner would indicate the requirement to pay the issue fee within three months as is currently required. She would also indicate that the applicant has a non-extendable period in which to submit the missing oath. Upon

failure to submit the document within that period, the application would go abandoned and the applicant would have to petition to revive it.

*d. Proposed Fees*

In support of requiring the oath or declaration at the time of filing, the USPTO indicated in the Notice that applications filed without an oath or declaration “require special processing on the part of the Office.”

Presently the USPTO charges a fee of \$130 to file an oath or declaration in response to a Notice to File Missing Parts, giving the applicant a two month non-extendable deadline. In the preliminary Proposed Patent Fee Schedule published February 7, 2012, that fee would be increased to \$140. Notably, the USPTO indicated that no actual unit cost associated with this fee was provided in the Proposed Fee Schedule because there was no specific activity supporting it other than collecting and depositing the fee. This contradicts the USPTO’s statement in the Notice regarding “special processing.”

Further, if there is no specific activity supporting the fee other than collecting and depositing it, this calls into question the proposed fee of \$3000 for filing the oath or declaration up to the notice of allowance.<sup>3</sup> A fee this large effectively deters the very actions authorized by section 115(f). Therefore, to the extent that the USPTO determines that a fee is required to process the submission of an oath or declaration submitted after the filing date but prior to the notice of allowance, that fee should represent no more than the cost associated with processing the submission.

2. Streamlining Documents and Procedures

The AIA provides an opportunity to facilitate faster and simpler filings, reduce costs associated with duplicative submissions, and reduce overall prosecution time. The proposed rules, however, do not fully embrace this opportunity. In particular, the proposed rules appear to maintain the prior practice of requiring one oath or declaration per application. This practice creates considerable delay, complexity, and cost associated with coordinating inventors’ signatures. These problems only increase when subsequent filings necessitate re-execution of the document.

IPO therefore suggests that the USPTO discontinue the practice of requiring one comprehensive oath or declaration per application. Instead, the USPTO should permit one oath or declaration per inventor. Further, per new section 115(g) once an oath or declaration is made, that same document should be effective for any subsequent filings.

3. Applicant Filing and Prosecution

The amendments to sections 115 and 118 redefine what is meant by “applicant” for a patent. Prior to these amendments, “applicant” was synonymous with “inventor.” Per amended sections

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<sup>3</sup> Similarly, the proposed fee for correcting inventorship is \$130 if the oath or declaration was filed prior to examination, but \$1700 if the oath or declaration was filed after examination.

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115 and 118, “applicant” means not only the inventor, but alternatively the assignee, the entity to which the inventor is obligated to assign the application, or the person with a sufficient proprietary interest in the invention. The Notice recognized this to some extent by defining the term “person” as used in section 118 to include juristic persons so that a juristic person may “make an application for patent” and would therefore be an “applicant for patent.” Many of the proposed rules, however, do not fully implement the provisions of the amendments to sections 115 and 118 designed to accomplish filing and prosecution by other than the inventor.

Of particular concern, the USPTO retained the wording of 37 C.F.R. §1.41(a) that the applicant is the actual inventor. IPO urges the USPTO to amend all relevant rules to ensure that the term “applicant” means not only an inventor, but also an assignee, an entity to which the inventor is obligated to assign the application, or a person with a sufficient proprietary interest in the invention. The USPTO should also be consistent with its interpretation of the phrase “applicant for patent” as including a juristic person throughout the rules.

In addition, the proposed rules confuse the matter by omitting any reference to a substitute statement. Instead, the proposed rules use the language “oath or declaration” throughout. The Notice attempted to explain that “an assignee or a person whom the inventor is obligated to assign can execute the oath or declaration” and that such oath or declaration “constitutes the substitute statement.” Per section 115(d), however, such an applicant provides a substitute statement *in lieu of* an oath or declaration. The USPTO should amend the proposed rules to clarify that when an entity other than the inventor is the applicant, it is a substitute statement, not an oath or declaration, that is required prior to the notice allowance.

#### 4. Proposed Amendments

The following proposed amendments will clarify the meaning of “applicant,” facilitate faster and simpler filings by applicants, reduce costs associated with duplicative submissions, reduce overall prosecution time by removing the need to coordinate the signing of original oaths or declarations by inventors, and allow greater flexibility in the pursuit of continuing applications.

**Existing Rule §1.41(a)** should be amended to read: “A patent is applied for ~~in~~ by the applicant and shall include the name or names of the actual inventor or inventors.”

**Proposed rules §§1.41(a)(3), 1.41(a)(4), 1.42, 1.47, 1.48, 1.63** should be amended to provide for the filing of a substitute statement under section 115(d) and in lieu of an oath or declaration.

**Existing Rule §1.48** needs to be significantly amended as it is predicated on the principle of one comprehensive oath or declaration.

**Proposed §1.63:** Subsection (a) of the proposed rule should be amended to clarify that pursuant to section 115(e), an assignment which includes the statements required by sections 115(b) and (c) may be filed “in lieu of filing such statements separately.”

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**Proposed rule §1.63(a)(2)** should be amended to require that the oath or declaration must identify ~~each inventor~~ the signing inventor by his or her full name. . .

**Proposed rule §1.63(a)(4)** should be amended to require that the oath or declaration must include a statement that the person executing the oath or declaration believes ~~the named inventors or joint inventors to be the original inventor or original joint inventors~~ he or she to be the original inventor or an original joint inventor of the claimed invention in the application for which the oath or declaration is being ~~submitted~~ signed.

**Proposed rule §1.63(a)(6)** should be deleted. Alternatively, proposed rule §1.63(a)(6) should be amended to require that the oath or declaration must state that the person making the oath or declaration has reviewed and understands the contents of the application for which the oath or declaration is being ~~submitted~~ signed including the claims, as amended by any amendment specifically referenced in the oath or declaration. §1.63(a)(6).

**Proposed Rule §1.63(2)** should be deleted as there would be no need to request the removal of inventors to an earlier-filed application, since the naming of the inventive entity is established by the ADS for the continuing application.

IPO has not proposed specific language for amending the rules to fully implement the provisions relating to filing the oath or declaration up until the notice of allowance without any surcharge in excess of the actual cost, if any, for processing the submission after the filing date. These changes will require global amendments to existing and proposed rules.