

REPORT

UPDATED DECLARATIONS AND POWERS OF ATTORNEY

April 10, 2008

Over the last several years, the U.S. Patent and Trademark Office (USPTO) has changed various requirements and options for the Declaration that must be filed in patent applications. The USPTO has also announced that it will no longer accept some older versions of the Declaration as of June 1, 2008. Furthermore, certain advantages can be obtained by using newer versions of the Declaration. Thus, in order for our clients to remain current with the Declarations and Powers of Attorney for their patent applications filed in the USPTO, and to obtain the maximum benefits possible, we provide the following guidance, suggestions, and templates regarding current Declaration and Power of Attorney practice.

I. Background

As you know, the USPTO requires an Oath or Declaration, executed by all of the inventors, for each patent application (other than a provisional application). The USPTO also requires that we file a Power of Attorney in order to perform certain tasks (such as to conduct unfettered interviews and file Terminal Disclaimers, Powers to Inspect, Express Abandonments, and the like). When requested by our clients, Oliff & Berridge is pleased to provide the appropriate Declarations and Powers of Attorney for filing in the USPTO, based on the most current requirements and advantageous options for Declarations. At other times, our clients provide us with executed Declarations and Powers of Attorney based on copies of our forms that we have previously provided, which are in some instances many years old. We encourage our clients that provide the Declarations and Powers of Attorney to utilize our most current forms when preparing these documents in order to remain current with changes at the USPTO. Thus, we discuss below several recent USPTO and other changes that have caused us to modify and update our forms, and we provide blank copies of representative forms for your use. A more complete set of Declarations, Powers of Attorney,

and Assignments that are always current is available on our website, www.oliff.com, for our clients' use.

II. Recent Changes At The USPTO

A. Materiality Language

In the Declaration, the inventors must acknowledge their duty to disclose any known information that is "material to patentability." In some older versions of the Declaration, this acknowledgment was phrased as a duty to disclose information "material to the examination of the application." The USPTO has recently announced that on and after June 1, 2008, it will no longer accept Declarations that do not include the specific wording "material to patentability." If such an older Declaration is filed, the USPTO will object to the Declaration, and require that a newly executed Declaration be filed. (The older Declarations filed in currently pending applications, or in issued patents, will remain acceptable for those applications and patents.)

B. Priority Document Exchange Program

As described in several of our recent Special Reports, the USPTO is participating with the Japanese Patent Office (JPO) and the European Patent Office (EPO) in the electronic Priority Document Exchange program. See our January 26 and July 16, 2007, Special Reports. In this program, the USPTO obtains electronic copies of most priority applications that have been filed in the JPO or the EPO, and thus it is generally no longer necessary for our clients to provide and for us to file paper certified copies of such priority applications.¹ Similarly, for applications first

¹ At the present time, the JPO is not providing electronic copies of design applications and thus paper certified copies are still required.

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filed in the United States, the JPO and EPO can obtain electronic copies of most applications that have been filed in the USPTO. However, in order for the USPTO to provide the electronic copy, the Applicant must first submit a paper authorizing the USPTO to provide the electronic copy. In addition, we understand that the JPO in particular also requires information as to when such an authorization was filed in the USPTO, and the USPTO requires written authorization from the Applicants to release this additional information.

The USPTO now allows inventors to provide that authorization in the Declaration itself, rather than in a separate paper. This change was made to make it easier for Applicants to provide the authorization, while also providing the authorization at the earliest possible date. If the authorization is not provided in the Declaration, then an additional paper must be prepared and filed, which involves additional cost. As a result, we have updated our Declarations to include authorization for the USPTO to provide electronic copies of the U.S. application to any other participating offices in the Priority Document Exchange program and to provide the date on which that written authorization was provided. This change will provide a time and cost savings to our domestic clients and all of our other clients that sometimes file in the United States first. The presence of the authorization in a Declaration for an application that is first filed outside of the United States will have no negative effect.

C. Customer Number

In 1996, the USPTO established the use of Customer Numbers for designating the mailing address for patent application correspondence. Use of a Customer Number for correspondence address purposes helps to avoid clerical errors at the USPTO in entering our complete mailing address in new applications, and helps to keep our address updated with the USPTO when we must change our mailing address, as we recently did when our local post office moved. In 2004, the USPTO extended the use of the Customer Number, and allowed and encouraged that powers of attorney designate a firm's Customer Number, rather than a listing of specific attorneys by name and registration number. The USPTO further discouraged listing specific attorneys by name and registration number in powers of attorney, by limiting the number of specific attorneys that could be listed to ten or less.

We strongly encourage our clients to use Oliff & Berridge's appropriate USPTO Customer Number in Declarations and Powers of Attorney. The Customer Number can be used to designate Oliff & Berridge for the correspondence address for the application, and to designate the Members of the firm as the attorneys of record in the Power of Attorney. Furthermore, using the Customer Number helps to ensure that the application will be available to us through the USPTO Private PAIR database as soon as the new application filing has been processed by the USPTO.

The Customer Number is also a convenient way to provide the Power of Attorney to the Members of Oliff & Berridge, without having to provide a list of specific attorneys and their USPTO registration numbers. USPTO rules limit the number of individual attorneys that can be personally identified on a Power of Attorney to ten or fewer attorneys. Use of older Declarations and Powers of Attorney that identify more than ten specific attorneys require us to prepare and file an additional paper, limiting the list of attorneys to ten. However, the USPTO rules do not limit the number of individual attorneys that can be identified with a Customer Number. Therefore, by using the Customer Number, all of Oliff & Berridge's Members that can practice before the USPTO can be included in the Power of Attorney.² We maintain the roster of Members that are associated with Oliff & Berridge's Customer Number current to accommodate changes in the firm's membership when attorneys are promoted to Membership or when Members retire. Use of the Customer Number also eliminates the need for us to file a separate Designation of Ten Attorneys. A further discussion of the Power of Attorney changes is provided in our June 17, 2004, Special Report.

D. General Power Of Attorney

Also in 2004, the USPTO changed its practice regarding the use of Powers of Attorney, and began permitting use of General and Specific Powers of Attorney from the assignee that are separate from the Declaration executed by the inventors. Using a separate Power of Attorney establishes that our power to prosecute the application is from the assignee, and not from the inventor(s), eliminating conflict-of-interest issues in the

² Our Customer Numbers include only the Members (principals) of the firm, but not the firm's associates, patent agents, and "of counsel" attorneys.

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event of a dispute between the inventors(s) and the assignee. This change is also described in detail in our June 17, 2004, Special Report.

For our clients that do not already do so, we encourage using a Power of Attorney that is separate from the Declaration, specifically from the assignee(s) rather than from the inventor(s). We also encourage that the Power of Attorney be a General Power of Attorney. The General Power of Attorney minimizes the number of formal documents that need to be signed by corporate representatives. Only a single General Power of Attorney need be executed by a representative of each assignee; we can then file a copy of that General Power of Attorney in each application that we file for that assignee. Conversely, by filing a Specific Power of Attorney, a corporate representative must sign such a document for each patent application. In our opinion, the General Power of Attorney is the most cost-effective and efficient approach for assignees that file multiple patent applications through our firm.

For those clients that have already provided us with a General Power of Attorney, those papers conform with current USPTO practice, and no additional action is required.

E. Updated Forms

The enclosed sample Declarations include the above changes. The enclosed samples are of a Declaration, a General Power of Attorney, and a combined Declaration/Power of Attorney. The combined Declaration/Power of Attorney would be used only in those cases where our clients have not provided us with a General (or Specific) Power of Attorney for the particular assignee(s). A full selection of suitable forms, including ones for use with PCT applications, CIP applications, Design applications, and the like, is available on our website, as described below.

III. Forms Available On Our Website

Oloff & Berridge occasionally makes changes to Declarations in order to remain current with USPTO rules and practice. In view of such changes, we strongly encourage our clients to download the appropriate current and updated forms from our website. For your convenience, we have uploaded to our website a collection of Declaration, Power of Attorney, and Assignment forms. These forms can be accessed in the News and Events section of our website, at www.olliff.com, and are available in both Adobe Acrobat PDF and Microsoft Word format. Of course, we are always pleased to prepare a Declaration and Power of Attorney upon request, at no additional charge, for applications entrusted to our firm.

As always, we welcome any questions you may have.

* * * * *

Oloff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

For further information, please contact us by telephone at (703) 836-6400, facsimile at (703) 836-2787, e-mail at email@olliff.com or mail at 277 South Washington Street, Suite 500, Alexandria, Virginia 22314. Information about our firm can also be found on our web site, www.olliff.com.

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APPLICATION FOR UNITED STATES PATENT DECLARATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name; that

I verily believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural inventors are named below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: _____

described and claimed in the specification:

Check one

- *a. attached hereto.
 b. filed on _____ as Application No. _____ and amended on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

Authorization To Permit Access To Application by Participating Offices

The undersigned hereby grants the USPTO authority to provide the European Patent Office (EPO), the Japan Patent Office (JPO), and any other intellectual property offices in which a foreign application claiming priority to the above-identified application is filed access to the above-identified patent application. See 37 CFR 1.14(c) and (h).

In accordance with 37 CFR 1.14(h)(3), please provide access to a copy of the application-as-filed with respect to: 1) the above-identified application, 2) any foreign application to which the above-identified application claims priority under 35 USC 119(a)-(d) if a copy of the foreign application that satisfies the certified copy requirement of 37 CFR 1.55 has been filed in the above-identified US application, and 3) any U.S. application from which benefit is sought in the above-identified application.

In accordance with 37 CFR 1.14(c), access may be provided to information concerning the date of filing the Authorization to Permit Access to Application by Participating Offices.

Priority Benefit

Under Title 35, U.S. Code §119, the priority benefits of the following foreign application(s) and/or United States provisional application(s) filed by me or my legal representatives or assigns within one year prior to this application are hereby claimed:

The following application(s) for patent or inventor's certificate on this invention were filed in countries foreign to the United States of America either (a) more than one year prior to this application, or (b) before the filing date of the above-named foreign priority application(s) and/or United States provisional application(s):

ALL CORRESPONDENCE IN CONNECTION WITH THIS APPLICATION SHOULD BE SENT TO OLIFF & BERRIDGE, PLC, CUSTOMER NUMBER 25944, TELEPHONE (703) 836-6400.

I hereby declare that I have reviewed and understand the contents of this Declaration, and that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

PAGE 2 OF U.S.A. DECLARATION FORM

1 **Typewritten Full Name of First or Sole Inventor:**

Given Name Middle Initial Family Name

2 ****Inventor's Signature:**

3 ****Date of Signature:**

Month Day Year

Residence:

City State or Province Country

Citizenship:

Post Office Address:
(Insert complete mailing address, including country)

1 **Typewritten Full Name of Second Joint Inventor (if any):**

Given Name Middle Initial Family Name

2 ****Inventor's Signature:**

3 ****Date of Signature:**

Month Day Year

Residence:

City State or Province Country

Citizenship:

Post Office Address:
(Insert complete mailing address, including country)

1 **Typewritten Full Name of Third Joint Inventor (if any):**

Given Name Middle Initial Family Name

2 ****Inventor's Signature:**

3 ****Date of Signature:**

Month Day Year

Residence:

City State or Province Country

Citizenship:

Post Office Address:
(Insert complete mailing address, including country)

1 **Typewritten Full Name of Fourth Joint Inventor (if any):**

Given Name Middle Initial Family Name

2 ****Inventor's Signature:**

3 ****Date of Signature:**

Month Day Year

Residence:

City State or Province Country

Citizenship:

Post Office Address:
(Insert complete mailing address, including country)

*If Box (a.) is checked, this form may be executed only when attached to the specification (including claims).

**Note to Inventor: Please sign name exactly as it appears above and insert actual date of signing.

IF THERE ARE MORE THAN FOUR INVENTORS USE PAGE 3 AND PLACE AN "X" HERE

PAGE 3 OF U.S.A. DECLARATION FORM
(Discard this page if fewer than five inventors)

1 **Typewritten Full Name of Fifth Joint Inventor (if any):** _____
Given Name Middle Initial Family Name

2 ****Inventor's Signature:** _____

3 ****Date of Signature:** _____
Month Day Year

Residence: _____
City State or Province Country

Citizenship: _____

Post Office Address:
(Insert complete mailing address, including country) _____

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Given Name Middle Initial Family Name

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GENERAL POWER OF ATTORNEY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Owner Name: _____

hereby appoints the patent practitioners associated with Oliff & Berridge, PLC Customer No. 25944 as attorneys of record to prosecute any and all patents and patent applications in which this General Power of Attorney is filed, and all continuations and divisions thereof, owned in whole or in part by the above-named owner, and to transact all business in the Patent and Trademark Office.

The undersigned is authorized to execute this document as or on behalf of the owner.

**ALL CORRESPONDENCE SHOULD BE SENT TO OLIFF & BERRIDGE, PLC,
CUSTOMER NO. 25944, TELEPHONE (703) 836-6400.**

Date

Signature

Typed Name: _____

Title: _____
(if acting on behalf of an Owner)

APPLICATION FOR UNITED STATES PATENT DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name; that

I verily believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural inventors are named below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: _____

described and claimed in the specification:

Check one

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The following application(s) for patent or inventor's certificate on this invention were filed in countries foreign to the United States of America either (a) more than one year prior to this application, or (b) before the filing date of the above-named foreign priority application(s) and/or United States provisional application(s):

As a named inventor, I hereby appoint the patent practitioners associated with Oliff & Berridge, PLC Customer No. 25944 as attorneys of record to prosecute this application and all continuations and divisions thereof, and to transact all business in the Patent and Trademark Office.

ALL CORRESPONDENCE IN CONNECTION WITH THIS APPLICATION SHOULD BE SENT TO OLIFF & BERRIDGE, PLC, CUSTOMER NO. 25944. TELEPHONE: (703) 836-6400.

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