

REPORT

**UPDATE REGARDING USPTO INVENTOR
DECLARATIONS IN NEW AND CONTINUING APPLICATIONS****August 27, 2012**

Further to our August 17, 2012 Special Report ("USPTO Issues Final Rules to Implement AIA Amendments to 35 U.S.C. §115 and §118"¹), a potential issue has recently arisen regarding whether certain language in our declarations as revised last November would satisfy the new rules that go into effect on September 16.

As summarized in Section III(A) of our August 17 Special Report, the new rules require that the inventor's Declaration include the following statements:

1. that the person executing the declaration (a named inventor or joint inventor) believes himself/herself to be the original inventor or an original joint inventor of a claimed invention in the application for which the Declaration is being submitted;
2. that the application was made or was authorized to be made by the person executing the declaration; and
3. that any willful false statement made in the declaration is punishable under 18 U.S.C. §1001 by fine or imprisonment *of not more than five (5) years*, or both.

In anticipating the various declaration form changes that were required by the AIA legislation, and as discussed in our November 28, 2011 Special Report ("Updated Inventor Declarations"), we previously updated our declaration forms to include the required statements (1) and (2) above, and maintained the longstanding conventional "acknowledgement of penalties" clause (statement (3) above) that was already in our forms without the above highlighted portion.

Our previously updated forms are fully acceptable in new national applications filed before September 16, 2012, and in PCT U.S. national phase applications having an international filing date before September 16, 2012. We have now revised our declaration forms to add the phrase "of not more than five (5) years." These most current forms are available in the "News and Events" section of our website, and may be used for any applications filed before, on or after September 16.

We are seeking clarification from the USPTO as to whether new declarations will have to be filed in continuing applications filed on or after September 16, 2012, that claim benefit of an earlier-filed application in which our previously revised declaration was filed (i.e., a declaration having all of the required statements (1)-(3) above, except that (3) did not include the phrase "of not more than five (5) years").

¹ Available in the "News and Events" section of our website (www.oliff.com).

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Meanwhile, we recommend that our clients use the following inventor declaration forms:

1. for new patent applications being filed before September 16, 2012, use our most current website declaration forms (which comply with both sets of rules);

2. for new PCT U.S. national phase applications having an international filing date before September 16, 2012, use our most current website declaration forms (which comply with both sets of rules); and

3. for applications to be filed on or after September 16, 2012, and PCT U.S. national phase applications having an international filing date on or after September 16, 2012, use either:

(a) our most current website declaration forms (which comply with both sets of rules), or

(b) our new "AIA-Only" declaration forms, which will be available on our website for download later this week and will only comply with the new rules.²

Our additional recommendations are provided in Section IX of our August 17, 2012 Special Report.

If you have any questions or concerns, please contact us. We sincerely apologize for not earlier anticipating the possible need for the specific phrase "of not more than 5 years" in our previous declaration forms.

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² The "new" declaration forms will differ from our current declaration forms by excluding information, or spaces for information, that is not required by the new rules. Therefore, the new declaration forms will not be suitable for use in applications filed before September 16, 2012, or for PCT U.S. national phase applications having an international filing date before September 16, 2012.