

# REPORT

## USPTO ISSUES FINAL RULES TO IMPLEMENT AIA AMENDMENTS TO 35 U.S.C. §115 AND §118

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On August 14, the U.S. Patent and Trademark Office (USPTO) issued final rules to implement various changes to 35 U.S.C. §115 and §118 under the America Invents Act (AIA). Except as otherwise noted herein, the new requirements discussed below apply to any U.S. national patent applications (including continuing applications) that are filed on or after September 16, 2012 and to the U.S. national phase of PCT international applications that have an international filing date on or after September 16, 2012.

As summarized in Section III(C) of our November 22, 2011 Special Report, "Updated Analysis of America Invents Act (AIA)," amended §115 primarily changes the content requirements of Declarations, as well as the requirements for when one or more inventors cannot or will not execute a Declaration.<sup>1</sup> Amended §118 expands upon who, other than the inventor, may be the "applicant" for a patent.

### I. Background

As you know, the USPTO requires a Declaration for each patent application (other than a provisional application). The USPTO previously required that the Declaration be executed by all of the inventors, except in special

permitted circumstances in which someone other than an inventor could execute the Declaration on behalf of an inventor. Additionally, it has always been the practice of the USPTO to equate the named inventor(s) in an application with the applicant(s) for patent. The AIA changed those practices, as well as changing the content requirements for Declarations.

In view of the changes to 35 U.S.C. §115, we previously modified our firm's Declarations to include the new required statements, as discussed in our November 28, 2011 Special Report, "Updated Inventor Declarations." We confirm that those updated Declarations will satisfy the final rules.

We are pleased to note that the final rules are a drastic shift from the USPTO's previously proposed rules. It is evident from the USPTO's commentary regarding the final rules, as well as from the final rules themselves, that the USPTO's welcome shift from the initially proposed, very burdensome rules was heavily influenced by public comments, including our firm's detailed comments (available on the USPTO website).

In summary, the final rules incorporate provisions that provide options for patent applicants to be entities other than the inventor(s), simplify the content requirements of Declarations, streamline procedures for correcting

<sup>1</sup> Our Special Reports are available in the News and Events section of our website ([www.oliff.com](http://www.oliff.com)).

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inventorship, and also heighten the importance of Application Data Sheets in patent applications.

We discuss below the key provisions of the USPTO's final rules. Our previously updated forms are available in the News and Events section of our website ([www.oliff.com](http://www.oliff.com)). We will provide a complete set of newly revised forms on our website over the next two weeks.

## II. Applicants

The AIA's changes to §115 and §118 make clear that the terms "applicant" and "inventor" are no longer interchangeable, and that the inventor is no longer automatically the applicant. This change will finally bring the United States more in line with the use of these terms in other patent offices around the world. Importantly, the changes facilitate the process by which an assignee or an entity to which the inventor has an obligation to assign ("obligated assignee") may file an application for a patent as an "applicant."

The new rules permit the filing of patent applications by assignees, obligated assignees, and persons who otherwise show sufficient proprietary interest in the matter. The "applicant" must be identified in the Application Data Sheet under the new heading "Applicant Information," which replaces the currently required heading "Assignee Information."

Thus, we anticipate that most corporate assignees will designate themselves as "applicant" in their U.S. patent applications. However, please keep in mind that this will not be possible in the U.S. national phase of PCT applications with an international filing date before September 16, 2012. Thus, PCT filers should continue to distinguish between the U.S. inventor/applicants and applicants for other designations in their PCT international filings until September 16. To establish an assignee as the applicant in the U.S. counterpart of a PCT international application with an international

filing date before September 16, 2012, it will be necessary to file a continuation of the international application rather than a national stage of the international application, on or after September 16, 2012.

Irrespective of who is the "applicant" for patent, a Declaration by each inventor (which may be in the form of an Assignment meeting the Declaration requirements) or a Substitute Statement by the applicant in lieu of an inventor's Declaration, must be filed in every patent application.

### A. Proof Of Assignee/Applicant Status

If the "applicant" is an assignee or obligated assignee, no further proof or showing is required at the filing date other than the identification of the applicant in the Application Data Sheet. However, documentary evidence of ownership (*e.g.*, a copy of an Assignment or employment agreement) must be recorded no later than the date the Issue Fee is paid in the application.

### B. Filing By Others

The new rules also permit a person (including a corporate "person") having sufficient proprietary interest in the patent application that is not the assignee or obligated assignee to apply for a patent on behalf of and as an agent for the inventor. The USPTO treats such a person as the "applicant," although the statute is not clear that this is proper.

To be considered the "applicant," such a person must provide a showing, including documentary evidence, of the party's "sufficient proprietary interest" (which evidence will be publicly available in the file record). The showing must be submitted by way of a petition, along with payment of a petition fee (\$200.00), and a statement that making the application by such a person is appropriate to preserve the rights of the parties.

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### C. Change Of Ownership

If an assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in the matter is the "applicant," as permitted by the new rules, such applicant must notify the USPTO of any change in ownership of the application no later than the date of payment of the Issue Fee. Otherwise, the USPTO will assume that there has been no change in ownership and will issue the patent to the applicant. A change of applicant must be supported by a signed statement establishing the new ownership in accordance with rule 3.73(c), in addition to filing of an assignment for recordation.

### III. Declarations And Substitute Statements

The changes to Declaration practice apply to any U.S. national application filed on or after September 16, 2012, and any U.S. national phase application having an international filing date on or after September 16, 2012. For applications filed (or having an international filing date for PCT national phase applications) prior to September 16, 2012, any Declaration (whether the Declaration itself is filed before, on or after September 16) must still comply with the current rules that remain in effect through September 15.

Therefore, we recommend using our previously revised Declaration forms (which satisfy the requirements of both sets of rules) for all new applications filed before September 16 and for the national phase of all PCT international applications having an international filing date before September 16. They may also be used for applications filed on or after September 16. Our new further revised Declaration, Assignment/Declaration, and Substitute Statement forms should thus not be used for U.S. national phase applications for some time to come, and should not be used for any U.S. national applications filed before September 16.

### A. Content Of Declaration

Under the final rules, each inventor must execute a Declaration, which must identify the application to which it is directed and the inventor's legal name, and must include three required statements. The required statements are:

1. that the person executing the declaration (the 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 for not more than five (5) years, or both.

These statements are included in our previously revised forms.

The new rules also require that "a person may not execute an oath or declaration for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56." *See* 37 CFR 1.63(c). Although the new rules no longer require that the statements averring to the above be included in the inventor's Declaration, we will continue to include them in our Declarations to ensure that signing inventors are aware of the requirement to review the application and the duty of disclosure.

Aside from the above required statements, the USPTO has simplified the content requirements of an inventor's Declaration. Specifically, the Declaration no longer has to provide the country of citizenship for each

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inventor or a claim for foreign priority. Additionally, as long as the information is provided in an Application Data Sheet (filed concurrently with or before the Declaration), a Declaration no longer has to include the names of all the inventors, or the mailing address and residence city and country of any inventor, and does not need to be signed by all of the inventors.<sup>2</sup> Each inventor may sign a Declaration that only names that inventor.

As discussed in our November 28, 2011 Special Report, we previously revised our Declaration forms to include the statements required by amended §115. In our previously revised forms, in order to comply with the USPTO rules that are still in effect through September 15, 2012 (and thereafter for applications with earlier U.S. or international filing dates), we maintained spaces for listing the names of all inventors and for providing the country of citizenship, residence city and country, and mailing address for each inventor. Even though the previously revised forms include additional information and spaces for information that is no longer required under the new rules, please rest assured that those forms meet all USPTO requirements for applications filed before, on or after September 16, 2012.

In view of the simplified content requirements of a Declaration, we are further

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<sup>2</sup> In our comments to the USPTO regarding the USPTO's proposed rulemaking, we urged the USPTO to remove the "residence" requirement (which is not required by §115) because it is unnecessary, burdensome, and vague, many inventors would prefer to keep their "residence" private, and some countries' laws prohibit employers from requiring public disclosure of such information. In response to our concern, the USPTO's commentary merely defines "residence" as "a city and either a state or foreign country," and the "mailing address" as "where one customarily receives mail." A work address (e.g., c/o the assignee at its address) or post office box may be used as the mailing address. However, the final rules still require that the city and country of residence of each inventor must be identified in an Application Data Sheet.

revising our firm's Declarations to simplify them. The newly revised forms will be available on our website over the next two weeks.

#### **B. Declaration Statements May Be Made In An Assignment**

An inventor who is under an obligation to assign his or her rights in a patent application may make the required Declaration statements in an Assignment, in lieu of making such statements in a separate Declaration. This option permits the assignee owner of an application to have the inventor execute a single document, rather than two separate documents, if the Assignment includes the required Declaration statements.

Assignments filed for the purpose of satisfying the Declaration requirements must be filed with an Assignment Cover Sheet that indicates to the USPTO the intended dual use of the Assignment document. The USPTO will then scan the Assignment into the Image File Wrapper for the application, in addition to recording the Assignment in the Assignment Recordation Branch.

We are creating new "combined" Assignment/Declaration forms, which include the required Declaration statements to comply with the Declaration requirements. Those forms may only be used to satisfy the Declaration requirements for U.S. national applications 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. We will provide those forms on our website over the next two weeks.

#### **C. "Substitute Statement" In Lieu Of A Declaration**

The new rules provide that, under specific permitted circumstances where an inventor is unable to sign or refuses to sign a Declaration, an "applicant" may make a "Substitute Statement," in lieu of that inventor executing a Declaration.

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## 1. Permitted Circumstances

The permitted circumstances for an applicant to file a Substitute Statement in lieu of the inventor's Declaration are:

1. the inventor is deceased;
2. the inventor is legally incapacitated;
3. the inventor cannot be found or reached after diligent effort; or
4. the inventor refuses to sign the Declaration, *and is under an obligation to assign the invention.*

In addition, amended §115 gives the USPTO authority to specify additional circumstances under which an applicant for patent may provide a Substitute Statement in lieu of an inventor's Declaration. The USPTO has exercised that authority by permitting joint inventors to file a Substitute Statement when one joint inventor refuses to execute the Declaration, even though the refusing inventor is not under an obligation to assign.

## 2. Content Requirements

A Substitute Statement must include the following information:

1. Identification of the inventor or joint inventor with respect to whom the Substitute Statement is being executed.
2. The "required statements" of an inventor, made upon information and belief with respect to that inventor (*see below*).
3. Identification of the person (e.g., co-inventor, individual applicant, or authorized representative of a corporate applicant) executing the Substitute Statement, and the relationship of such person to the inventor with respect to whom the Substitute Statement is being executed, and, unless such information is supplied in an Application Data Sheet, the mailing address and

residence city and country of the person signing the Substitute Statement.<sup>3</sup>

4. Identification of the above-listed "permitted circumstance" that allows the Substitute Statement to be filed in lieu of an inventor's Declaration. Contrary to the currently burdensome proof requirements for when an inventor cannot or refuses to sign a Declaration, no proof regarding the exact circumstances (*e.g.*, attempts to contact the inventor) has to be provided in the Substitute Statement.

5. Unless the information is supplied in an Application Data Sheet, for an inventor who is not deceased or under legal incapacity, the last known mailing address where that inventor customarily received mail and that inventor's last known residence city and country.

6. The acknowledgment of penalties clause regarding making willful false statements.

The "required statements" to be made in the Substitute Statement under information and belief are that:

1. the person signing the Substitute Statement believes that the inventor to whom the Substitute Statement applies is the original inventor or an original joint inventor of a claimed invention in the application for which the Substitute Statement is being submitted; and
2. the person signing the Substitute Statement made the application or authorized the application to be made.<sup>4</sup>

<sup>3</sup> For a corporate applicant executing a Substitute Statement, we recommend that such information be provided as to the applicant and as to the person signing the Substitute Statement.

<sup>4</sup> The USPTO's proposed form for a Substitute Statement has the latter statement made by the person signing the Substitute Statement, rather than on information and belief about the subject inventor. This is logical in view of the fact that one of the grounds for filing a Substitute Statement is that an inventor refuses to sign a Declaration, but does not comply with final rule 1.64(b)(1). We will try to obtain clarification of this discrepancy from the USPTO.

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### 3. Signature Requirements

Amended §115 requires that the Substitute Statement be executed by the applicant. The new rules, however, employ the words "an applicant," implying that, where there are multiple applicants (*e.g.*, joint inventors) only one applicant needs to execute the Substitute Statement on behalf of the inventor. We will try to obtain clarification of this inconsistency with the USPTO. Meanwhile, we recommend that all joint applicants (if there are multiple applicants) sign each Substitute Statement.

Signature on behalf of a corporate applicant can be made by an authorized representative of the applicant under rule 3.73. That rule is changed in the final rules to permit signature by a registered patent practitioner, if the practitioner is the attorney of record in the application.

#### D. Timing For Declaration Or Substitute Statement Filing

Under current practice, the USPTO requires that the Declaration be filed with the application or in response to a Notice to File Missing Parts mailed shortly after the filing date. Under the final rules, however, the USPTO will permit applicants to postpone filing the inventor's Declaration until the application is otherwise in condition for allowance, as long as the applicant provides a signed Application Data Sheet before examination that includes the name, residence city and country, and mailing address of each inventor.

If an application is in condition for allowance but does not include the inventor's Declaration (or a Substitute Statement), the USPTO will issue a Notice of Allowability giving the applicant three months to satisfy the Declaration requirements. That time period is not extendible.

The USPTO will continue to require a surcharge (\$130.00 for a large entity; \$65.00 for a

small entity) for filing the inventor's Declaration later than the filing date of the application. Thus, if an application is filed with the necessary fees, including the surcharge, and a signed Application Data Sheet, but not the inventor's Declaration or Substitute Statement, the USPTO will not issue a Notice to File Missing Parts. However, the USPTO will issue a Notice to File Missing Parts if the application that does not contain the inventor's Declaration or Substitute Statement also does not include the surcharge or a signed Application Data Sheet.

To avoid incurring the surcharge, we recommend filing the inventor's Declaration (or Substitute Statement) at the time of filing the application. However, there might be advantages to delaying the filing of the Declaration or Substitute Statement in a U.S. national application in exchange for longer patent term extension in some rare cases.<sup>5</sup>

Assignments should be filed as early as possible to obtain the protections of 35 U.S.C. §261. For an inventor's Declaration that is included in an Assignment, therefore, the Declaration should be filed as early as possible.

The permissible delay in filing the inventor's Declaration could result in adverse patent term adjustment consequences in PCT U.S. national phase applications. Specifically, the fourteen-month time frame for calculating USPTO delay in issuing a first Office Action/Notice of Allowance is calculated from the date on which an international application fulfills the requirements for entering the national

<sup>5</sup> For patents with anticipated high daily end-of-term royalty income, the additional pendency created by the three-month period for filing a Declaration may create a useful patent term extension. The USPTO is cognizant of the potential unintended patent term adjustment advantage that could result from delaying the issuance of the Letters Patent. The USPTO is considering proposing (in a separate rulemaking) changes to patent term adjustment provisions to eliminate that advantage.

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phase, which include the filing of the inventor's Declaration. Therefore, in PCT national phase applications, we recommend that the inventor's Declaration be signed at the time the international application is filed, and filed with the initial national phase papers, or otherwise filed as early as possible.

#### **E. Declaration Requirements For Continuing Applications**

No newly executed Declaration is required for an individual named as the inventor or joint inventor in a continuing application filed on or after September 16, 2012 that claims benefit under 35 U.S.C. § 120, 121, or 365(c) of an earlier-filed application, provided that an inventor's Declaration or a Substitute Statement, in compliance with the new rules, was filed with respect to that individual in the earlier-filed application. Such continuing applications include Continuation, Divisional and Continuation-In-Part (CIP) applications. A copy of the earlier-filed inventor's Declaration or Substitute Statement must be filed in the continuing application.

As noted in our November 22, 2011 Special Report, the above exception to requiring a newly executed inventor's Declaration only applies to a continuing application if the inventor's Declaration from the earlier-filed application is in compliance with the requirements of §115 as amended by the AIA. Therefore, the earlier-filed inventor's Declaration must include the required statements discussed above (Content of Declaration).

Particularly for new continuing applications claiming benefit to applications filed before September 16, 2012, newly executed Declarations will be necessary if the earlier-filed Declarations did not include the required Declaration statements. It will not be necessary to file a new Declaration in a continuing application filed on or after September 16, 2012, that claims benefit to

an earlier-filed application in which our previously revised Declaration or our newly revised Declaration was filed.

#### **IV. Correction Of Inventorship**

The new rules streamline the requirements for correcting inventorship in a patent application other than a reissue application. In addition, it is no longer necessary to distinguish between correcting the name of an inventor or the order of names of the inventors. This change applies as of September 16, 2012 to all pending patent applications other than reissue applications.

Under the new rules, the applicant may establish the inventorship of a nonprovisional application, including a U.S. national phase application, in the Application Data sheet or the inventor's Declaration.<sup>6</sup> If a signed Application Data Sheet is filed before or concurrently with the inventor's Declaration, the inventorship is that provided in the Application Data Sheet. However, if an Application Data Sheet is not filed before or concurrently with the inventor's Declaration, the inventorship as set forth in the inventor's Declaration controls. Because it is our firm's standard practice to file all new applications with Application Data Sheets, the new rules should allow us to avoid the issuance of Notices to File Missing Parts for many patent applications.

To correct the name of an inventor, remove an inventor, or change the order of names of joint inventors in a nonprovisional application where the inventorship has already been established (by an Application Data Sheet or inventor's Declaration), a Request to Correct Inventorship must be filed that includes an Application Data Sheet identifying the correct name or order of

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<sup>6</sup> Applicants can thus change the inventorship between a PCT international application and its U.S. national phase simply by filing an Application Data Sheet identifying the corrected inventors with the initial national phase filings.

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names of the inventors, along with the required processing fee (\$130.00).

To correct the inventorship to include an additional inventor, a Request to Correct Inventorship must be filed with an inventor's Declaration (or Substitute Statement) with respect to that inventor, an Application Data Sheet, and the required processing fee (\$130.00).

In its commentary regarding the new rules, the USPTO states that it may propose (through separate rulemaking) requiring an additional fee of \$1,000 (\$500 for a small entity, \$250 for a micro entity) for filing a request to correct inventorship in an application after the first Office Action on the merits has issued, to encourage "reasonable diligence and a bona fide effort in ascertaining the actual inventorship and providing that information to the Office prior to examination."

## **V. Application Data Sheets**

The new rules place heightened importance on the Application Data Sheet. Under the new rules, the Application Data Sheet is considered a part of the application. The Application Data Sheet is the mechanism for designating the applicant, for listing the inventor(s) (if an inventor's Declaration was not previously filed), for correcting inventorship, and for making both priority and continuing application benefit claims.

### **A. Priority And Benefit Claims Made In Application Data Sheets**

The Application Data Sheet must include all domestic and foreign priority claims, as well as all domestic benefit claims. This requirement supplants the current requirements of including foreign priority claims in the inventor's Declaration, and domestic benefit claims in the specification, by requiring both claims to be set out in the Application Data Sheet. However, incorporation by reference of the contents of

priority or benefit applications should still be included in the specification.

### **B. Inventor Information In Application Data Sheets**

While the inventor's Declaration no longer has to include the names of all inventors, or the mailing address and residence city and country of all of the inventors, such information must be provided in an Application Data Sheet.

### **C. Supplemental Filing Of Application Data Sheets**

Information in a previously submitted Application Data Sheet may be corrected until payment of the Issue Fee by simply providing a new Application Data Sheet with the corrected information, with the exception of correcting inventorship (which must include the Request to Correct Inventorship, Application Data Sheet, and processing fee). The information being changed in the Application Data Sheet must be identified with underlining for insertions and strike-through for deletions.

## **VI. Alteration Of Application Papers**

Under the current rules, patent practitioners are not permitted to file an application containing any material alteration made in the application papers after the signing of the inventor's Declaration without identifying the alteration at the time of filing. However, as exemplified by the new rules allowing post-execution creation of the Application Data Sheet, which is a part of the application, the new rules also permit certain (no new matter) alterations to application papers to be made even after the signing of the inventor's Declaration.

Specifically, §1.52 no longer includes the requirements that any alterations of the application papers be made before the signing of the accompanying Declaration and be initialed by the applicant. Instead, new rule 1.52(c) states:



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Interlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor's oath or declaration referring to those application papers, provided that the statements in the inventor's oath or declaration pursuant to §1.63 remain applicable to those application papers.

In view of the above provision, alterations to application papers (which now also include the Application Data Sheet) may be made even after the signing of the inventor's Declaration, provided that the required Declaration statements remain applicable. Specifically, any alterations to application papers must not result in the Declaration statements (1) that the inventor believes himself to be the original inventor or an original joint inventor of a claimed invention in the application, and (2) that the application was made or was authorized to be made by the inventor, no longer being applicable with respect to the application to which the alterations are made.

Therefore, an Application Data Sheet signed after the execution of the inventor's Declaration is a permitted alteration to the application papers where the information in the Application Data Sheet does not alter the applicability of the statements made in the inventor's Declaration. The Application Data Sheet need not be signed by the inventor, but may be signed by a patent practitioner.

Aside from the Application Data Sheet, the new rules will thus eliminate the need to file Preliminary Amendments to correct typographical errors, informalities, or to make minor editorial non-new matter edits after the Declaration has been signed.

## VII. Power Of Attorney

The USPTO no longer provides combined Declaration/Power of Attorney forms, and

continues to strongly discourage use of such forms. The new rules make clear that the Power of Attorney must be from a "principal." The term "principal" is defined to mean the applicant (for an application for patent) and the patent owner (for a patent). The USPTO will no longer accept a Power of Attorney from an inventor where another person/entity is the "applicant."

The emphasis on having a Power of Attorney from the assignee is in line with the USPTO's previous changes regarding the use of Powers of Attorney, which are discussed in more detail in our April 10, 2008 Special Report, "Updated Declarations and Powers of Attorney" and in our June 17, 2004 Special Report, "USPTO Rule Changes Regarding Declarations, Powers of Attorney and Assignments." An underlying premise is to avoid conflict-of-interest issues that may arise in the event of a dispute between the inventor(s) and the assignee(s).

Therefore, the new rules require that a Power of Attorney be from the "applicant" for patent or the "patent owner." Where an assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in the matter is the "applicant" (as identified in the Application Data Sheet), the inventor is not the "applicant" or "patent owner" and, thus, is not permitted to grant the Power of Attorney.

The new Power of Attorney requirements apply to patent applications having a direct or international filing date on or after September 16, 2012, including new patent applications filed on or after September 16 that claim benefit of a provisional or non-provisional application filed prior to September 16. In such applications, it will be necessary to file a new Power of Attorney from the patent owner if the earlier-filed Power of Attorney was from the inventor(s) (*e.g.*, a combined Declaration/Power of Attorney), but the application was assigned.

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Although the USPTO will likely continue to accept combined Declaration/Power of Attorney forms where the inventor is also the applicant, we strongly encourage our clients to file a Power of Attorney from the assignee (where one exists), separate from the inventor's Declaration. We further recommend that the Power of Attorney be a General Power of Attorney to minimize the number of formal documents that need to be signed by corporate representatives. In our opinion, the General Power of Attorney is the most cost-effective approach for assignees that file multiple patent applications through our firm, because a copy of that same document can be filed in each such application.

### VIII. Reissue Declarations

The new rules concerning reissue Declarations are effective on September 16, 2012, regardless of the filing date of the subject application.<sup>7</sup> The changes primarily (1) clarify that a reissue application presenting a single claim containing both a broadening and a narrowing of the previously claimed invention is to be treated as a broadening reissue, (2) require the inventor's Declaration to identify a specific claim that the application seeks to broaden, if the reissue application seeks to enlarge the scope of the claims, (3) permit an assignee of the entire interest who was the original applicant to sign the reissue Declaration even if the reissue application is a broadening reissue, and (4) reduce the need for supplemental reissue declarations.

### IX. Recommendations

In view of the new rules, we make the following general recommendations to our clients.

1. For our clients that provide us with executed Declarations, use our previously updated Declarations for new patent applications being filed before September 16, 2012, and PCT U.S. national phase applications having an international filing date before September 16, 2012, and either those Declarations or our most current Declarations for applications to be filed on or after September 16.

2. For U.S. national applications filed on or after September 16, 2012, take advantage of the new mechanism for satisfying the Declaration requirements by making the required Declaration statements in an Assignment in most applications.

3. In most circumstances, file the inventor's Declaration at the time of filing any new application to avoid the surcharge for providing the inventor's Declaration at the later permitted time.

4. For the rare U.S. national patent application in which daily end-of-term royalty income is expected to be significant, consider delaying filing the inventor's Declaration to obtain up to three months patent term extension.

5. For PCT U.S. national phase applications, have the Declaration signed as soon as possible after the international application is filed, using our previously revised Declaration for all such applications having an international filing date before September 16, 2012.

6. When providing us with new application papers, provide us with complete inventor information, including the legal name, residence city and country, and mailing address of each inventor.

7. When providing us with new application papers for filing, let us know what entity should be identified as the "applicant."

8. In unassigned applications, the inventor(s) should continue to provide us with a

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<sup>7</sup> The revised reissue rules refer to other rules that have different applicability dates from those of the revised reissue rules. We hope to obtain clarification of the effect of this discrepancy from the USPTO.

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Power of Attorney (which can be a General or a Specific Power of Attorney).

9. In assigned applications, provide us with a Power of Attorney from the assignee. We recommend that the Power of Attorney be a General Power of Attorney, which we will use only in applications that have been entrusted to our firm. We only need one such General Power of Attorney for any given applicant, not one for each new application.

10. As discussed above, newly executed inventor's Declarations will have to be filed in any continuing applications filed on or after September 16, that claim benefit to earlier-filed applications in which Declarations were filed that do not include the new Declaration statements. Therefore, we recommend promptly obtaining newly executed Declarations (that include the required Declaration statements) from the inventor(s) for any such currently pending applications for which continuing applications are anticipated, in order to avoid a surcharge in the continuing application.

11. File continuing applications before September 16, 2012, if possible, to avoid any need for a newly executed Declaration.

12. For new applications in which execution of a Declaration is expected to be difficult to obtain, consider waiting until on or

after September 16 to file the application to take advantage of the new streamlined Substitute Statement procedures. If the application is based on a PCT international application, consider filing the U.S. application as a continuation, rather than national phase, of the international application, to obtain the benefit of the streamlined procedures.

13. PCT filers should continue to distinguish between U.S. inventor/applicants and applicants for other designations in their PCT international filings until September 16, 2012.

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*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.*

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