

Summary of the Final Rules Oath/Declaration going into effect on September 16, 2012

Oaths/Declarations filed after September 16, 2012, will have different substantive and timing requirements based on the USPTO Final Rules. New forms for the oath/declaration are already available on the USPTO website for use after September 16, 2012. However, we note that the changes should not greatly alter existing filing procedures for the reasons set forth below and that the differences between the forms will not render ineffective the oath/declaration that was previously available.

The substantive differences between the old form and new form involve removal of statements that are no longer required based on implementation of the AIA. Accordingly, while we recommend transitioning to using the new form in due course, it is still permissible to file an oath/declaration in the old form after September 16, 2012. Thus, for example, in any case in which formal papers were generated using the old form, regardless of whether those documents were generated or signed by the inventors prior to September 16, 2012, the signed oath/declaration that is ultimately obtained can be submitted and will be effective after September 16, 2012.

Regarding the timing for submission of a signed oath/declaration, after September 16, 2012, the signed oath/declaration must be filed together with a new application (same as before) or, for the same \$130 fee as before, submission may be delayed until the application is otherwise in condition for allowance. Thus, the filing procedure for any application being filed without “missing parts” will remain the same. Also, while a longer delay will be allowed in applications filed with the “missing part” of an oath/declaration, we recommend continuing to obtain signatures from inventor(s) as soon as possible after filing. Even though the rules will permit the

delay of such documents until the application is otherwise in condition for allowance, such a long delay in obtaining the documents will likely cause them to become more difficult to obtain, which will likely increase cost.

After September 16, 2012, substitute statements are permitted in cases where an oath/declaration cannot be obtained. However, that does not mean that a substitute statement can always be used. Also, the substitute statement in no way changes the requirement to obtain an oath/declaration in normal situations where one can be obtained. An oath/declaration must still be signed by the inventors in every case in which doing so is possible. The permissible bases for filing a substitute statement in lieu of an oath/declaration are (1) if the inventor is deceased, (2) if the inventor is under a legal incapacity, (3) if the inventor has refused to execute the oath/declaration, or (4) if the inventor cannot be found or reached after diligent effort.

After September 16, 2012, Assignees (and those showing an obligation of assignment or other proprietary interest) may be listed as the Applicant on applications filed. However, that does not relieve the requirement to supply the names of the inventors at the time of filing an application. In such cases, the Assignee is merely the party making the application and, in the event that the filing of an oath/declaration is being deferred, the inventors must be listed on an appropriate Application Data Sheet (ADS). Further, the statements required by the oath/declaration can be made in an assignment, thereby allowing a single document to act as both an assignment and oath/declaration. The declaration for reissue applications filed after September 16, 2012, in the name of an Assignee Applicant is also changing.