

# **AIA Inventor's Oath or Declaration Quick Reference Guide**

The following information is a guide to assist applicants in understanding the flexibilities available under the AIA with respect to the inventor's oath or declaration. For example, in addition to maintaining current practices, an assignment document can act as a declaration, and in applications with an application data sheet, each inventor can execute a separate declaration, and the filing of a declaration can be postponed until the application is in condition for allowance. These flexibilities are explained in further detail below.

## **I. Application Data Sheet (ADS):**

A nonprovisional application should be filed with a properly signed ADS (37 CFR 1.76) identifying the applicant.

An ADS must be filed:

1. To identify applicants who are not the inventor(s).
2. To set the inventorship where an inventor's oath or declaration is not being presented. This permits postponing the declaration until the application is otherwise in condition for allowance.
3. To set the inventorship where there are joint inventors and each joint inventor is executing a declaration that only names that inventor and not all of the inventors.
4. To make benefit claims under 37 CFR 1.78 and foreign priority claims under 37 CFR 1.55 (except applications entering the national stage under 35 U.S.C. 371).

Use newly-revised form PTO/AIA/14 (Revised 08/2012 – See Appendix for copy):

1. Submit the fillable form via EFS-Web with the application. Doing so will cause the bibliographic data to automatically load into USPTO electronic systems. Scanning or printing as a pdf will cause USPTO staff to have to manually enter the data. Note: Only an ADS that is submitted with the application via EFS-Web upon filing will automatically load into the Office's electronic systems. Use of the fillable ADS

subsequent to filing will not result in an automatic upload and will require USPTO staff to manually input the information.

2. The newly-revised ADS includes a new Applicant information section to identify non-inventor applicants. Note: Where the applicant is the assignee or a person to whom the inventor is under an obligation to assign the invention, documentary evidence of ownership should be recorded in the assignment records no later than payment of the issue fee. (37 CFR 1.46(b)(1))
3. Where the applicant is a juristic entity the ADS may only be signed by a patent practitioner. For other applicants, the ADS may be signed by either the applicant or a patent practitioner. (37 CFR 1.33(b))
4. All benefit claims under 37 CFR 1.78, and foreign priority claims under 37 CFR 1.55, must be set forth in an ADS. For applications entering the national stage under 35 U.S.C. 371, foreign priority claims are not required to be set forth in the ADS. Foreign priority claims in these applications must have been timely made in the international phase in the PCT request form or in a notice from applicant.
5. There is no longer a “supplemental” ADS. Information may be corrected or updated by filing a new ADS that contains only the sections containing changed or updated information. Changes must be shown by underlining for insertions and strikethrough or brackets for deletions. Each section containing changed or updated information must contain all of the information already of record with the changes shown by markings.

See Appendix for a copy of the ADS and helpful information for completing an ADS. The ADS (PTO/AIA/14) is available at: <http://www.uspto.gov/forms>

## II. The Inventor's Oath or Declaration:

Use the PTO/AIA/01, the declaration form for use with an Application Data Sheet which includes the new statutory statements:

1. The application was made or authorized to be made by the person executing the declaration,
2. The individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application, and
3. An acknowledgment of penalties clause referring to fine or imprisonment of not more than five years, or both.

Use of Office forms is not mandatory but is strongly recommended. When modifying an Office form, be sure to remove all indications that it is an Office form (*e.g.*, SB or AIA designation). See 37 CFR 1.4(d)(3).

Each declaration need only identify the inventor executing the declaration as long as an ADS is submitted identifying the entire inventive entity.

Inventors can continue to execute declarations that name the entire inventive entity.

Note: To avoid payment of a surcharge, an inventor's oath or declaration, including a substitute statement, executed by or with respect to each inventor must be submitted on the same day as the nonprovisional application is filed.

## III. Use of a Substitute Statement:

Where an inventor's signature cannot be obtained on a declaration, a substitute statement PTO/AIA/02 may be executed with respect to that inventor. (37 CFR 1.64)

An applicant under 37 CFR 1.46 (*i.e.*, assignee, obligated assignee or party who shows sufficient proprietary interest) may execute a substitute statement in the following circumstances:

1. The inventor is deceased or legally incapacitated
2. The inventor refuses to sign the declaration
3. The inventor cannot be found or reached after diligent effort

An applicant who is an assignee or obligated assignee does not need to file a petition or provide proof of the pertinent facts in order to be named as the applicant or execute a substitute statement. Though proof is not required to be submitted to the Office, proof of attempt to secure the inventor's signature should be kept in applicant's file. There is no change to what is considered a good faith attempt to contact an inventor and what constitutes a refusal to sign.

#### IV. Assignments containing the Inventor's Oath or Declaration:

An assignment that contains the information and statements in an oath or declaration ("assignment-statement") may be used as the inventor's oath or declaration.

The assignment must be recorded, and the best way to effect recordation is through use of the Electronic Patent Application System (EPAS).

1. File the application via EFS-Web and obtain an application number.
2. Submit the assignment-statement for recording in EPAS on the same day the application is filed to avoid a surcharge for delayed submission of the inventor's oath or declaration. Check the box in EPAS to notify the Office that the assignment-statement is being used as the inventor's oath or declaration. The Office will then place a copy of the assignment-statement into the application file.

#### V. Postponing submission of the Inventor's Oath or Declaration:

Submission of the inventor's oath or declaration may be postponed where an ADS is filed that identifies the entire inventive entity, including legal name, residence and mailing address for each inventor.

If neither an ADS nor the inventor's oath or declaration executed by all of the inventors is received on filing, then the Office will send a Notice to File Missing Parts and require (1) either an ADS or inventor's oath or declaration executed by all of the inventors; and (2) payment of a surcharge for the filing of the inventor's oath or declaration after the filing date of the application.

Note: If applicant submits on filing all required filing fees, including the surcharge, and an ADS, the Office will not send a Notice to File Missing Parts requiring the declaration.

If an inventor's oath or declaration executed by or with respect to each inventor has not been received by the time the application is in condition for allowance, a Notice of Allowability will be sent setting a three-month non-extendable time period within which applicant must file the inventor's oath or declaration.

## VI. Copies of Declarations from Prior Applications:

A copy of a declaration from a prior application may only be submitted in an application filed on or after September 16, 2012, if the declaration meets the requirements of amended 35 U.S.C. 115(a) which must include the required statements in 35 U.S.C. 115(b):

1. The application was made or authorized to be made by the person executing the declaration, and
2. The individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

The copy of the declaration must also include the acknowledgement of penalties clause in 35 U.S.C. 115(i) referring to fine or imprisonment of not more than five years, or both.

For applications entering the national stage under 35 U.S.C. 371 on or after September 16, 2012 where the International Application was filed prior to September 16, 2012, the declaration must comply with the pre-AIA provisions.

## VII. Power of Attorney:

The applicant for patent may give power of attorney. Use of form PTO/AIA/82 is recommended for use by applicants, including individual inventors.

For example, where the applicant is the assignee, the assignee (*e.g.*, the President of the company) may execute the power of attorney (PTO/AIA/82B or an equivalent) without need to resort to §§ 3.71 and 3.73. The patent practitioner may complete and sign the accompanying transmittal letter (PTO/AIA/82A) and submit a copy of the power of attorney into each respective application.

An assignee who was not named as the applicant who wishes to appoint a patent practitioner must proceed under §§ 3.71 and 3.73 and file a Statement under 37 CFR 3.73(c) (PTO/AIA/96) and a power of attorney (PTO/AIA/80).

*Pro se* inventors (*i.e.*, prosecuting the application without a patent practitioner) who are the applicant may give power of attorney to one or more of the joint inventors (PTO/AIA/81).

A copy of a power of attorney may not be used if a new applicant is being named in a continuing application, *e.g.*, in the prior application the power of attorney was given by the inventors and the continuing application is filed by a juristic entity.

A power of attorney given by inventors remains in effect where (1) a 37 CFR 1.48 request in a pending application or (2) a continuing application adds an inventor if the added inventor supplies a power consistent with the initial power and a copy of the power is supplied in the continuing application.

### VIII. § 1.46 Applicants at Allowance:

Where applicant is an assignee or obligated assignee and the real party in interest at the time of allowance has changed, the Office must be notified of the change so that the Office can issue the application to the real party in interest. (37 CFR 1.46(e))

### IX. Frequently Asked Questions:

Frequently asked questions are available on the Office's AIA microsite and will be updated on a regular basis. See: [http://www.uspto.gov/aia\\_implementation/faq.jsp#heading-10](http://www.uspto.gov/aia_implementation/faq.jsp#heading-10)

## **Appendix – Application Data Sheet**

The following are helpful suggestions concerning completion of the ADS, PTO/AIA/14 (see below). For more complete line by line instructions, see the updated “Instructions for Application Data Sheet 37 CFR 1.76” available on the patents form page.

1. Software requirements: Use the free Adobe Reader with the latest version to ensure the form’s full functionality.
2. Configure your web browser with an Adobe Reader plug-in to automatically open the file within your browser’s window.
3. For an application filed pro se by the inventors, all inventors must sign the ADS unless a power of attorney has been given.
4. The use of an ADS to supply information to the Office is not necessarily sufficient. For example:
  - a. Using an ADS to change the name of the inventors must be accompanied by a request under 37 CFR 1.48, and
  - b. Completing the representative information section must be accompanied by compliance with 37 CFR 1.32.



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<b>Application Data Sheet 37 CFR 1.76</b>	Attorney Docket Number	
	Application Number	
Title of Invention		
<p>The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the bibliographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76.                  This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.</p>		

### Secrecy Order 37 CFR 5.2

Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)

### Inventor Information:

Inventor		<input type="button" value="Remove"/>
Legal Name		
Prefix	Given Name	Middle Name
		Family Name
		Suffix
Residence Information (Select One) <input checked="" type="radio"/> US Residency <input type="radio"/> Non US Residency <input type="radio"/> Active US Military Service		
City	State/Province	Country of Residence
<b>Mailing Address of Inventor:</b>		
Address 1		
Address 2		
City	State/Province	
Postal Code	Country	
All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the <input type="button" value="Add"/> button.		

### Correspondence Information:

Enter either Customer Number or complete the Correspondence Information section below.  
 For further information see 37 CFR 1.33(a).

An Address is being provided for the correspondence information of this application.

Customer Number		
Email Address		<input type="button" value="Add Email"/> <input type="button" value="Remove Email"/>

### Application Information:

Title of the Invention			
Attorney Docket Number		Small Entity Status Claimed <input type="checkbox"/>	
Application Type			
Subject Matter			
Suggested Class (if any)		Sub Class (if any)	
Suggested Technology Center (if any)			
Total Number of Drawing Sheets (if any)		Suggested Figure for Publication (if any)	

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	Application Number	
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**Publication Information:**

<input type="checkbox"/> Request Early Publication (Fee required at time of Request 37 CFR 1.219)
<input type="checkbox"/> <b>Request Not to Publish.</b> I hereby request that the attached application not be published under 35 U.S.C. 122(b) and certify that the invention disclosed in the attached application <b>has not and will not be</b> the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

**Representative Information:**

Representative information should be provided for all practitioners having a power of attorney in the application. Providing this information in the Application Data Sheet does not constitute a power of attorney in the application (see 37 CFR 1.32). Either enter Customer Number or complete the Representative Name section below. If both sections are completed the customer Number will be used for the Representative Information during processing.			
Please Select One: <input checked="" type="radio"/> Customer Number <input type="radio"/> US Patent Practitioner <input type="radio"/> Limited Recognition (37 CFR 11.9)			
Customer Number			

**Domestic Benefit/National Stage Information:**

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.			
Prior Application Status			<input type="button" value="Remove"/>
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the <b>Add</b> button.			<input type="button" value="Add"/>

**Foreign Priority Information:**

This section allows for the applicant to claim benefit of foreign priority and to identify any prior foreign application for which priority is not claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55(a).			
			<input type="button" value="Remove"/>
Application Number	Country <sup>1</sup>	Filing Date (YYYY-MM-DD)	Priority Claimed
			<input checked="" type="radio"/> Yes <input type="radio"/> No
Additional Foreign Priority Data may be generated within this form by selecting the <b>Add</b> button.			<input type="button" value="Add"/>

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	Application Number	
Title of Invention		

**Authorization to Permit Access:**

<input type="checkbox"/> <b>Authorization to Permit Access to the Instant Application by the Participating Offices</b>
<p>If checked, the undersigned hereby grants the USPTO authority to provide the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the World Intellectual Property Office (WIPO), and any other intellectual property offices in which a foreign application claiming priority to the instant patent application is filed access to the instant patent application. See 37 CFR 1.14(c) and (h). This box should not be checked if the applicant does not wish the EPO, JPO, KIPO, WIPO, or other intellectual property office in which a foreign application claiming priority to the instant patent application is filed to have access to the instant patent application.</p> <p>In accordance with 37 CFR 1.14(h)(3), access will be provided to a copy of the instant patent application with respect to: 1) the instant patent application-as-filed; 2) any foreign application to which the instant patent application claims priority under 35 U.S.C. 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 instant patent application; and 3) any U.S. application-as-filed from which benefit is sought in the instant patent application.</p> <p>In accordance with 37 CFR 1.14(c), access may be provided to information concerning the date of filing this Authorization.</p>

**Applicant Information:**

Providing assignment information in this section does not substitute for compliance with any requirement of part 3 of Title 37 of CFR to have an assignment recorded by the Office.				
<b>Applicant 1</b>				
<p>If the applicant is the inventor (or the remaining joint inventor or inventors under 37 CFR 1.45), this section should not be completed. The information to be provided in this section is the name and address of the legal representative who is the applicant under 37 CFR 1.43; or the name and address of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under 37 CFR 1.46. If the applicant is an applicant under 37 CFR 1.46 (assignee, person to whom the inventor is obligated to assign, or person who otherwise shows sufficient proprietary interest) together with one or more joint inventors, then the joint inventor or inventors who are also the applicant should be identified in this section.</p>				
<input type="button" value="Remove"/>				
<input type="radio"/> Assignee	<input type="radio"/> Legal Representative under 35 U.S.C. 117			
<input type="radio"/> Person to whom the inventor is obligated to assign.	<input type="radio"/> Person who shows sufficient proprietary interest			
If applicant is the legal representative, indicate the authority to file the patent application, the inventor is:				
▼				
Name of the Deceased or Legally Incapacitated Inventor: <input type="text"/>				
If the Assignee is an Organization check here. <input type="checkbox"/>				
Prefix	Given Name	Middle Name	Family Name	Suffix
▼	<input type="text"/>	<input type="text"/>	<input type="text"/>	▼

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<b>Application Data Sheet 37 CFR 1.76</b>	Attorney Docket Number	
	Application Number	
Title of Invention		

<b>Mailing Address Information:</b>			
Address 1			
Address 2			
City		State/Province	
Country		Postal Code	
Phone Number		Fax Number	
Email Address			

Additional Applicant Data may be generated within this form by selecting the Add button.

**Signature:**

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications

<b>Signature</b>				Date (YYYY-MM-DD)	
First Name		Last Name		Registration Number	

Additional Signature may be generated within this form by selecting the Add button.

This collection of information is required by 37 CFR 1.76. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 23 minutes to complete, including gathering, preparing, and submitting the completed application data sheet form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**