

From: Sundby, Suzannah [mailto:XXX@Ygg.fYXUVWXYX]
Sent: Saturday, March 03, 2012 11:15 PM
To: oath_declaration
Subject: Inventor's Oath/Declaration (Response to Proposed Rules)

ATTN: Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner for Patent Examination Policy

Dear Mr. Bernstein:

1. With regard to the proposed rule requiring Application Data Sheets (ADSs) to be used for foreign priority and domestic benefit claims, I respectfully recommend that the ADS rules be simplified if the only way to properly claim foreign priority or the benefit of an earlier filed application is by way of an ADS.

The reason why I do not submit ADSs with new application filings is that I prefer to use the USPTO Adobe fillable form SB14 as a possible means to correct certain information later if needed, e.g. to correct an inventor's address or when the application has been allowed, and there is an error which USPTO Publications Branch needs to be fixed immediately. The rules for ADSs are extensive and overly burdensome. In fact, the guidance materials dated 15 April 2003 (which is the 5th revision), is 68 pages long! Although SB14 is generally an easy form to use by attorneys, paralegals and secretaries, the Supplemental ADS rules are not so easily implemented in every day practice. In particular, the ADS rules require a certain format for each particular piece of information submitted. For example, each line of information has a different maximum length of characters, e.g. Title = 500 characters, Attorney docket number = 25 characters, Given name = 50 characters, Assignee mailing address = 2 lines, each not more than 50 characters, etc. On top of this, the Supplemental ADS rules require strike-through and underline to show the changes being made to the original ADS along with an indication that the Supplemental ADS is a "supplemental ADS". The Adobe fillable form SB14 does not allow one to use underline and strike-through fonts and it also prevents one from typing more than the allotted characters (including the struck-through and underlined characters).

Thus, in order correct certain information using a Supplemental ADS, one is required to use unconventional and cumbersome means, e.g. an archaic typewriter or the "text box tool" in Adobe to modify the initial ADS and show the marked-up changes. Alternatively, one is required implement their own software program to generate the initial ADS so that it can be saved and readily modified (strike-through and underline) to make minors changes later, e.g. at the last minute before grant. In these situations where one is using a Word document program/ADS as a template, it is ridiculous (and not economical) for an attorney to go through the ADS and Supplemental ADS and count the number of characters for each line.

Therefore, I recommend that the same form, SB14, can be used for the "initial" and subsequent ADS. In particular, if an initial ADS was submitted and an Supplemental ADS later becomes necessary, I recommend that the same form, i.e. SB14, be used to show only the changes requested to be made without the strike-through and underlining. For example, if one submits an initial ADS that provides the inventor's information including foreign priority information and for some reason the ADS has an incorrect address for the inventor, I recommend that the Applicant/Assignee be able to submit an SB14 form which only shows the inventor's correct address (without underline or strike-through or the indication that it is a "supplemental" ADS). Surely, the USPTO employees processing such a supplemental ADS will readily understand what information is to be changed and what information is to remain the same in such a circumstance.

Additionally, what happens if on the same day (e.g. application filing) an Applicant provides a priority claim in the ADS and recites such in the first paragraph of the specification, but the information between the two varies, e.g. one has a typographical error in the priority date or priority document number?

2. With regard to the proposed rules which must be complied with in order for an assignee to take action, I note that many patent practitioners are significantly disappointed in the overly burdensome rules. Therefore, I recommend that the proposed rules are relaxed to the point that after one attempt of contacting an inventor to sign a declaration/oath at either the inventor's last known work address or the inventor's last known residential address, that the inventor is automatically deemed to be a non-signing inventor or an inventor who cannot be found after diligent effort.

3. I also recommend that when the original declaration provides a Power of Attorney (POA) to a given individual or entity by the inventors, that the POA automatically "transfers" as being by the POA by the assignee, in the case where the inventors have or are obligated to assign their portion to the assignee. Where a "new" assignee/applicant does not wish the original attorney to have POA, the "new" assignee/applicant should then prepare and file the appropriate revocation and new POA and correspondence forms.

4. With regard to the necessity for an original handwritten signature related to credit card payments, I recommend that when paying by credit card using EFS-Web that the filer need only submit the usual information, e.g. name, credit card number, expiration date, billing address, etc., along with the credit card security code (on the back of the credit card) in place of a form which has the credit card holder's signature. This is consistent with online commercial transactions. It is also noted that many firms use a single credit card for all USPTO filing payments and to request the person who is the holder of the credit card to sign and date a multitude of credit card forms, i.e. PTO 2038 forms, every day, including for the last minute 11th hour filings, would be unduly burdensome and logistically impractical for the

majority of large law firms and in-house patent departments.

5. With regard to the proposed Power of Attorney (POA) rules, many practitioners and clients feel that even the current POA rules are "form over substance" and result in needless paper pushing. In view of the various state bar rules, and the OED's power and scope, I recommend a relaxation in the POA rules. In particular, the USPTO should leave it to the attorneys and law firms to obtain the requisite paperwork granting them POA which is to be retained in the attorney's/law firm's records. Then if and when an issue arises which raises the question of whether or not the attorney acted appropriately in a given situation, the USPTO requests a copy of the requisite POA form and acts accordingly.

6. 3.73(b) Statements - I recommend that the USPTO take the position that when an Applicant/Assignee executes a POA, the attorney of record automatically has the right to act on behalf of the Applicant/Assignee, including executing a 3.73(b) Statement.

7. In the proposed rules, there are various rules which seem to require an original signature. It is respectfully requested that the USPTO clarify that such "original signatures" include "e-signatures".

8. In order to ensure prompt processing of correspondence addresses, I recommend that a practitioner using private PAIR have the ability to input a new/correct correspondence address which becomes effective immediately upon submission (and under penalty of fine and imprisonment). It is noted that practitioners are subject to certain state bar ethical rules and duties as well as those of OED. Thus, the restrictions imposed by private PAIR access and ethical duties will likely prevent unintended, purposeful, and malicious changes to another's correspondence address.

9. I respectfully request that the USPTO comment on proposed rule 1.41(a)(4). In particular, whether such change may or will have an impact on the right of priority and the joint research agreement exception. In other words, what, if any, impact with the proposed rule have on the identity of "assignee" and "applicant"?

10. The comments to the proposed rules mention changes to 37 CFR 1.48 Correction of Inventorship. The proposed rules, however, do not contain any such changes. Clarification is respectfully requested.

11. With regard to abbreviations in the inventor's name, I recommend that the first name of an inventor may be abbreviated as often inventor's are known by their middle name and merely abbreviate their first name.

12. With regard to the combined assignment/declaration format, what result if one portion is determined to be void or voidable? For example, if the assignment portion is found to be void or invalid, does that make the declaration part also void or invalid? Thus, I recommend that the USPTO clearly indicate that the legality (or invalidity) of one part not to have any impact on the other part.

Thank you for this opportunity to comment on the proposed oath/declaration rules.

Best regards,
Suzannah K. Sundby, Esq.
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The views expressed herein are mine and are not to be attributed to any other person or entity including Smith, Gambrell & Russell, LLP or any client of the firm.

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