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March 5, 2012

Via Electronic Mail

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The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments - Patents
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Attn: Hiram H. Bernstein, Senior Legal Advisor
Office of Patent Legal Administration, Office of the
Associate Commissioner for Patent Examination Policy

Re: Changes To Implement the Inventor's Oath or
Declaration Provisions of the Leahy-Smith America
Invents Act,
77 Fed. Reg. 982 (Jan. 6, 2012)

Dear Under Secretary Kappos:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to provide comments in response to the request of the United States Patent and Trademark Office ("the Office") published in the Federal Register on January 6, 2012 (PTO-P-2011-0074). In particular, the Section submits the following comments on the *Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 Fed. Reg. 982 (Jan. 6, 2012) (the "Oath and Declaration Notice"). These comments have not been approved by the American Bar Association's House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

The Leahy-Smith America Invents Act ("AIA") is historic legislation that was intended to greatly simplify the use of the U.S. patent system by inventors and their respective assignees. It was similarly intended to simplify and make more efficient the patent application processing and examination activities of the Office.

Among the major improvements in U.S. law contained in the AIA were provisions providing assignees a plenary right to make patent filings in their own names, as the “applicant for patent.” Of equal importance, the AIA eliminated essentially all of the complexity that existed in the former requirement under 35 U.S.C. §115 for an “inventor’s oath.” Under new §115, the only statutory mandate Congress imposed on the inventor was for a one-time inventor’s statement affirming its status as the inventor and authorizing the *initial* patent filing (the “inventor’s §115 required statement”).

Considering the complexity of the pre-AIA inventor’s oath requirements, the reforms to §115 were sweeping. Congress affirmatively eliminated any requirement for executing a further inventor’s statement in connection with the filing of any and all continuing applications (including continuation-in-part applications containing newly claimed subject matter). See §115(g)(1). Congress similarly eliminated any requirement for any “supplemental oath,” *e.g.*, rejecting the current practice of requiring a further inventor’s oath in situations where newly claimed subject matter was added to an application for patent. See §115(h)(2), “Supplemental statements not required.” Congress discouraged the filing of the inventor’s §115 required statement as a separate document, permitting the statement to be included in a patent assignment recorded with the Office. See §115(e). Finally, Congress provided plenary “safe harbor” provision under which any deficiency in the inventor’s §115 required statement could be remedied by filing a corrected statement in the Office, which Congress dictated can be done “at any time.” See §115(h)(1).

Collectively, these historic changes to U.S. patent law provide the Office a unique opportunity to harmonize patent filing requirements in the United States with the other member states of the Patent Cooperation Treaty (PCT). Each PCT member country has long permitted patent filings in the name of the assignee. Similarly, each PCT country, in any situation where an assignment from the inventor was filed in connection with an assignee-filed application, has historically imposed no inventor-related requirements beyond the naming of the inventor. Under the AIA, the Office now has the opportunity to follow exactly the same path in crafting the content and formalities associated with U.S. patent filings.

Indeed, one reason that the Section and other constituencies actively supported enactment of the AIA was that its implementation would accomplish substantial harmonization of patent application filing practices globally. It is in the context of this opportunity that the Section has considered and provides its comments on the Office’s proposed rules. In brief, the Section believes that the proposed rules fall far short of achieving the opportunity for simplifying patent filings for patent applicants, for simplifying the Office’s processing of patent applications, and for accomplishing greater international patent harmonization. In addition, the analysis undertaken by the Section suggests that the rules as proposed appear to conflict with provisions of the new law.

Accordingly, the Section raises the following concerns that it would request be addressed in the final rulemaking by the Office:

1. Patent filing by the assignee, as the applicant for patent, should not be limited: the proposed rules appear to contain unwarranted limitations on the circumstances under which an assignee may file the patent application.

The pre-AIA U.S. patent law contained an archaic requirement that, save for exceptional circumstances, restricted the ability of the non-inventor owner of an invention to apply for a patent on the invention. It requires the inventor be named as the applicant for patent, even in the situation where the inventor had no remaining proprietary interest in the patent application whatsoever.

The rule that the “applicant for patent” must be the inventor was unique to the United States. In particular, of the 144 members of the PCT, the United States is the only member country not to allow patent applications to be filed in the name of the assignee. This anomaly unnecessarily complicates the use of the PCT particularly to the disadvantage of U.S.-based applicants for patent.

Both 35 U.S.C. §115 and §118, as amended by the AIA, operate to eliminate in their entirety any limitations on assignee filing. In fully opening the U.S. patent system to assignee filing, Congress simultaneously imposed a new and explicit requirement that the applicant for patent must name the inventor. See §115(a).

Thus, for a *complete* patent filing under the AIA, Congress was clear – and any Office rulemaking should be equally clear – that the application for patent as filed should identify the applicant for patent (who is making the filing?) and the inventor (who is the individual or who are the individuals collectively constituting the inventive entity?).

By adopting the new inventor-naming requirement, Congress was able to effectively eliminate the requirement for a separate “inventor’s oath,” heretofore mandated under §115. Indeed, unlike the former §115 requirement for an inventor’s oath, which was required for a complete patent *filing*, the new §115 requirement for an inventor’s statement is a requirement imposed in connection with the *issuance* of the patent, not the patent filing. Congress was explicit that the applicant for patent, including assignee-applicants, need only provide the new inventor’s §115 required statement at some point in time prior to the notice of allowance.

Given this interpretation of the new statute, the proposed rules appear not to implement the new statutory scheme in a manner faithful to the statute itself. They can be construed to limit severely the circumstances under which an assignee may file for a patent as the applicant. Specifically, this appears possible only where a petition is filed, accompanied by a fee, showing “(1) The deceased or incapacitated inventor is under an obligation to assign the invention to the party; or (2) The party has sufficient proprietary interest in the matter to execute the oath or declaration pursuant to §1.63 on behalf of the deceased or incapacitated inventor and that such action is necessary to preserve the rights.” See proposed Rule 1.42(b).

This limitation would relegate the role of assignee-filed applications to that of a limited exception, rather than the norm, as dictated under the new statutory provisions in the AIA. It also

would burden applicants unnecessarily by maintaining the United States as the exception to the otherwise uniform rule of assignee filing internationally. It reflects, therefore, at best a lost opportunity for greater international patent harmonization.

The Federal Register notice provides, “The changes to 35 U.S.C. 115 and 118 do not mean that a person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent in all circumstances.” The Section’s view is that no fair reading of the new statute permits such a construction.

Moreover, even if it were possible to so construe the new statute, there is no conceivable policy justification for implementing the AIA’s remedial measures in such a restrictive manner. Indeed, to do so would negate the efforts at both transparency and simplification that are the hallmark of the private sector support for these legislative efforts.

Further, the Office does not offer any explanation of why assignee filing should be limited, even if the Congress had permitted it to do so. Indeed, it would appear that the Office’s proposed rules stand at odds with its advocacy for greater international patent harmonization. The rulemaking gainsays that advocacy by ignoring the opportunity to adopt international norms, specifically the practice among other PCT member states that do not limit filing applications in the name of the assignee.

Without some truly compelling justification, the Section submits that – even if the AIA could be read to somehow limit the right of an assignee to file for a patent – the Office should nonetheless proceed with rulemaking that does permit patent filing by the assignee, with the assignee being the applicant for patent, without limitation and in all circumstances.

2. The content of the inventor’s §115 required statement should be no more than the minimum mandated by the patent statute: The proposed rules include additional requirements at odds with efforts to achieve greater international consistency in patent filing requirements.

As noted above, under the new “assignee filing” regime, dictated by the AIA, there are two *identification* requirements for any assignee-filed application for patent to be considered a complete application: identification of the assignee (who is making the filing?) and identification of the inventor (who are the individuals constituting the “inventive entity”?). New §115(a) contains the latter requirement by unequivocally providing that every patent application must “include, or be amended to include, the name the inventor” of the application for patent.

These dual naming (or identification) requirements suggest a path forward for the Office to assure efficient filing, processing, and examination procedures for patent applications by the Office. Any possible concerns about the ability to efficiently process and examine assignee-filed applications for patent can be readily addressed if the Office imposes through rulemaking that every application, *as filed*, contain an express identification of both the applicant for patent and, if different, each individual constituting the “inventive entity.”

Imposing these dual identification requirements by rule would be fully consistent with the new statute. The Office could require by regulation not only the name of the individual or entity (inventor and applicant), but its residence, citizenship, correspondence address or other identifying information essential to the orderly processing of the application for patent. In addition, as under current practice for dealing with applications filed with “missing parts,” if such a complete identification of inventor and applicant were not provided at the time of filing, nothing in the AIA would prevent the Office from requiring the provision of such missing information within a specified period – and requiring a fee to be paid for its belated filing.

If the Office were to so proceed to implement new §115 and new §118, then the requirements for a complete patent filing in the United States would be largely harmonized with the formalities required outside the United States. Moreover, as of the time of patent filing, the Office would have all the information required to administratively process the patent application for immediate examination.

Given that these dual identification requirements were imposed on applicants for patent as part of filing a complete application for patent, the Section believes that the further implementation of the inventor’s §115 required statement could be accomplished in the simplest possible manner – consistent with the remedial intent in its enactment. This approach, in addition, would be consistent with the simplification intent of the AIA and the Office’s quest for greater international harmonization of patent filing requirements.

Simplification under rulemaking should commence with the most economic implementation of the requirements for the content of the inventor’s §115 statement. Under the AIA, new §115(b) mandates that the inventor need provide two and only two averments in connection with a patent application. As noted above, these are averments that the applicant has a statutory right to provide at any time up to the notice of allowance and ones that the applicant has the right to provide in a patent assignment document, rather than in the actual patent application file.

These two mandated statements are that (1) the application was made or was authorized to be made by the affiant or declarant, 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 Section believes that simplification, harmonization, and the public interest, are best served if the Office requires no more than this of the inventor under §115.

For an assignee-filed application for patent, there is clearly no policy or administrative reason to require anything more of the inventor – or require that the inventor’s statement be provided any sooner than the notice of allowance – or require that the statement be provided in the patent application file rather than in an assignment recorded elsewhere in the Office. For at least 99% of all patent filings, no issue (much less controversy) ever arises over the identification of the inventive entity or the owner of the patented invention.

In other words, any public interest in regulation by the Office of an inventor’s statement under §115 can be satisfied by providing in 37 C.F.R. that nothing more need be done in

connection with an assignee-filed application for patent than for the assignee to record, prior to the notice of allowance, an assignment containing the inventor's §115(b)(1) and (2) statements, in which the inventor asserts its status as an original inventor and authorizes the assignee's patent filing.

It was in part to effect this simplicity that Congress did not require that the inventor's §115 required statement be included in the patent application file, but instead expressly provided that the assignment document could be filed elsewhere in the Office. Thus, given that Congress did not require the statement be filed in the application file, it clearly did not envision that it would be necessary for the statement to be "examined" by a patent examiner in the course of deciding whether a patent should issue.

As a result, the combined impact of (1) allowing the inventor's §115 required statements to be made only once in the course of a series of related patent filings, (2) to then be placed in an assignment document separate from the patent application file, and (3) to be devoid of any actual substance other than verification of inventorship status and authorization of a patent filing, not only reflects a congressional intent for greater simplification of the patenting process, but reflects a congressional desire for greater international harmonization of patent formalities. The Section urges, therefore, that the Office's final rulemaking take the opposite tack from the proposed rules in the sense of maximizing the opportunity for U.S. patent filing requirements to be wholly consonant with practices outside the United States.

Thus, the Office's rulemaking should discourage the separate filing of an inventor's §115 required statement and instead encourage assignee-applicants routinely incorporate the inventor's §115 required statement in their assignment document recorded in the Office.

Accomplishing the foregoing would require rulemaking that would simplify the inventor's §115 required statement to the minimum necessary to effectuate its purpose under the new statute. This is also consistent with the corresponding PCT requirements under 35 U.S.C. 371(c)(4) in proposed Rule 1.497. Rule 1.497 provides that an international application entering the national stage under 35 U.S.C. 371 pursuant to §1.495 must also include the two statements set out above.

The Section, thus, requests the Office make significant changes to proposed 37 C.F.R. §1.63. As proposed, the rule includes additional requirements beyond what are mandated by statute. As examples, of what should not be required in the inventor's §115 required statement are provisions requiring that the inventor state that the person making the oath or declaration has reviewed and understands the contents of the application for which the oath or declaration is being submitted, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56.

As to these added requirements, no explanation of the need for these additional statements is provided and their presence is inconsistent with efforts at simplification and greater

international harmonization. Moreover, by their very nature, they appear to conflict with – or at least be inconsistent with – the prohibition placed on the Office against requiring additional §115 statements in continuing applications or requiring supplemental statements. See §115(g) and §115(h)(2) barring such further statements.

Not only does adding such non-mandatory requirements exceed what is necessary under the new statute, but extra requirements will create unnecessary complications with the PCT interface. It would be a bad policy outcome to have a circumstance where an inventor's required statement filed under §371 is subject to different requirements than those filed under §115.

The proposed rules also appear to require an applicant who files under §371/§1.497(b) to file a second statement complying with §1.63 and a supplemental application data sheet in accordance with § 1.67 – which appears flatly inconsistent with the congressional intent that an inventor need only make a one-time, two-part statement *authorizing* the initial patent filing and *confirming* its status as part of the inventive entity.

These differing requirements for inventor's statements create unnecessary complexity to applicants.¹ The Section submits that the more prudent way forward is to provide that an inventor's §115 required statement meeting the minimal statutory requirements be the only requirement imposed by regulation, irrespective of whether the application enters the national stage under §371 and an application filed under §115. Congress clearly could have mandated additional requirements – it crafted a very detailed statutory provision otherwise – but plainly chose not to do so. Before the Office exercises the discretion it was given to impose additional burdens on applicants (and, therefore, itself), it ought to offer a compelling justification.

Thus, although Congress did provide in §115(c) the authority for the Director to specify additional requirements for the inventor's statement, the Section believes that the Office should not do so unless such additional mandates would be consistent with the Congressional intent to modernize and simplify the patent system – and advance the objective of greater international patent harmonization. The Office will best serve the patenting community by keeping the patent filing process as simple (and inexpensive) and globally consistent as possible, which in this instance can be achieved by imposing only the minimal requirements mandated by statute.

While the best policy outcome for implementing §115 can be achieved by simplifying the §115 requirements imposed on the *inventive entity*, the Section is open to the possibility of rulemaking that would impose additional requirements on the *patent applicant*. Where *additional statements from the applicant* would assist the Office in the efficient processing of applications for patent, and would not impose undue or disproportionate burdens on applicants for patent, nothing in the AIA was intended to tie the hands of the Office in pursuit of such efforts.

¹ In addition, each requirement placed on an inventor's §115 statement creates a basis for a defective statement, requiring additional work on the part of patent owners to correct and additional work on the part of the Office to process. In contrast, streamlining requirements leads to fewer defective filings and lesser costs and burdens on applicants and the Office.

As one example, if the Office concludes that it is of continued importance for an acknowledgement in the application process that the applicant is under a duty to disclose to the Office all information known to be material to patentability as defined in § 1.56, a requirement for such an acknowledgement should be placed on the *applicant for patent*. The Section believes that this type of acknowledgement, however, should be placed in the application data sheet and made by the applicant's representative, since the duty and conduct by applicants more generally is governed by 18 U.S.C. §1001.

3. The inventor's §115 required statement should be permitted to be filed at any time before the notice of allowance: Requiring the statement earlier than this timing is inconsistent with the statute and unnecessary to assure efficient processing and examination of patent applications.

Under the AIA, the clear mandate in the statute is that the inventor's §115 required statement can be filed at any time before a notice of allowance is issued (see §115(f)). Nothing in §115 requires that the inventor's required statement be reviewed by the patent examiner as part of the patent examination process, or even included in the patent application file maintained by the Office. Thus, there is no purpose to be served in deciding to issue a patent by having the statement provided to the Office at any earlier time.

Indeed, the Section believes that the Office, in processing patent applications under the AIA for examination by a patent examiner, is not required for any statutory or policy reason to do anything more during the examination process than seek an affirmation from an assignee-applicant for patent that (1) the applicant has been authorized by the inventor to file for the patent and (2) the applicant has filed, or will file before receiving a notice of allowance, the inventor's §115 statement.

In contrast to the simpler approach of seeking the type of assignee-applicant affirmation described in the preceding paragraph, the notice of proposed rulemaking indicates that the Office considered it "better for the examination process and patent pendency to continue to require the oath and declaration pre-examination."

Respectfully, the Section submits that this unnecessarily retains the pre-AIA complexity in patent filing and costs to the applicant. It misses an opportunity for greater international harmonization of U.S. patenting practices. It creates more work for the Office than is required for any statutory or policy reason.

What the Section proposes that the Office consider, as an alternative to the proposed rules mandating the early filing of the inventor's §115 required statement, imposing a requirement, at the time of patent filing, that the applicant for patent provide the two-part statement outlined above: *first, a statement affirming that the applicant is either the inventor, or authorized by the inventor to file for a patent and, second, a statement affirming the applicant has filed with the application, or will file before receiving a notice of allowance, the inventor's §115 required statement.*

As noted above, the Section agrees that naming the inventors at the time of initial patent filing will facilitate the processing and examination of applications for patent. It is important that published patent applications contain inventor identification and such information is needed to efficiently identify what is and is not prior art. The least burdensome route to assure that the statutorily required inventor identification appears in a timely manner is to require applicants to fully identify the inventor at the time of filing – and to do so in the application data sheet or cover sheet. If rulemaking were to accomplish this result, it would obviate any need for the Office to require the filing of the inventor’s §115 required statement, not only at the time of filing, but at any time during the examination process. *It should suffice if the Office were to mandate the applicant provide the two-part statement described above, asserting authorization to file for the patent and acknowledging its obligation to file the §115 statement.*

The Section believes that the majority of assignee-applicants will file the inventor’s required §115 statement in the inventor’s assignment under §115(d) – particularly if the Office implements §115 in the most streamlined manner possible and does not require any duplicate filing or acknowledgement in the application for patent itself. Implementing §115 in this manner would be consistent with practices in universal use globally.

Moreover, assignment documents are typically executed early in the process of seeking patent protection. By requiring assignees to affirm at the time of filing that they are authorized to make the patent filing and will have filed the inventor’s §115 required statement before receipt of the notice of allowance, the Office – by requiring nothing more in connection with the patent filing – will encourage prompt filing of the assignment documents, since applicants will need to account for the possibility of a first-action allowance.

Moreover, if the Office is willing to implement the AIA’s requirements in this manner, the Section would support further rulemaking requiring applicants that have failed to file a required statement by the time the notice of allowance has issued to be required to petition to withdraw the application from issue (for the purpose of filing the required statement) and that such a petition be required to provide the missing statement under §115. By operating to shift responsibility to the applicant for compliance with the formality under §115, it both minimizes the effort required by the Office and encourages more prompt action on the part of applicants to complete to formality.

This approach would also obviate the concerns of the Office over the need for *Ex parte Quayle* actions to obtain the inventor’s §115 required statement. Moreover, it reduces the costs and complexity for an applicant and also the Office by not requiring a notice of missing parts or other communication when the required statement is not part of the original application filing.

Finally, the Section urges the Office to conform the regulations in title 37, Code of Federal Regulations, to the new statutory definition of the term “inventor,” as well as assure that the use of the term “applicant” fully reflects the reality that most patent applicants will be filed by assignees, not inventors. In addition, the provisions in title 37 relating to the inventor’s §115 statement in continuing applications should be removed, consistent with the new authority of the

The Honorable David J. Kappos

March 5, 2012

Page 10

Office to do so. The same observation applies with equal force to all provisions relating to supplemental statements under §115, which have been affirmatively eliminated by statute.

In closing, the Section recognizes and appreciates the Office's efforts to solicit public opinions regarding rules proposed in the Oath and Declaration Notice and offers the foregoing comments in an effort to help the Office implement rules that best serve the interests of the users of the patent system and the public. If you have any questions on our comments or would wish for us to further explain any of our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,

A handwritten signature in cursive script that reads "Bob Armitage".

Robert A. Armitage
Section Chairperson
American Bar Association
Section of Intellectual Property Law