

March 6, 2012

oath_declaration@uspto.gov

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

Re: Proposed Changes To Implement The Inventor's Oath Or
Declaration Provisions Of The Leahy-Smith America Invents Act
77 Fed. Reg. 982-1003 (Jan. 6, 2012)

Foley & Lardner LLP is a national, full-service law firm with a vibrant intellectual property practice that includes over 200 intellectual property attorneys and professionals. We appreciate the opportunity to comment on the Proposed Changes To Implement The Inventor's Oath Or Declaration Provisions Of The Leahy-Smith America Invents Act, set forth in 77 Fed. Reg. 982-1003 (Jan. 6, 2012).

The proposed rules raise concerns with regard to the continuity of power of attorney from a parent application to a continuing application (§ 1.32(d), (e)) and with regard to the ability to use a copy of an oath or declaration from a parent application in a continuing application (§ 1.63(d)). These issues are addressed in turn below.

I. Power of Attorney

The proposed amendments to § 1.32 are set forth below:

§ 1.32 Power of attorney.

* * * * *

(d) A power of attorney from a prior application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if the inventorship of the continuing application is the same as the prior application or one or more inventors from the prior application have been

BOSTON
BRUSSELS
CHICAGO
DETROIT

JACKSONVILLE
LOS ANGELES
MADISON
MIAMI

MILWAUKEE
NEW YORK
ORLANDO
SACRAMENTO

SAN DIEGO
SAN DIEGO/DEL MAR
SAN FRANCISCO
SHANGHAI

SILICON VALLEY
TALLAHASSEE
TAMPA
TOKYO
WASHINGTON, D.C.

March 6, 2012

Page 2

deleted in the continuing application, and if a copy of the power of attorney from the prior application is filed in the continuing application.

(e) If a power of attorney has been granted by all of the inventors and not an assignee, the addition of an inventor pursuant to § 1.48 results in the loss of that power of attorney upon grant of the § 1.48 request, unless the added inventor provides a power of attorney consistent with the power of attorney provided by the other inventors. This provision does not preclude a practitioner from acting pursuant to § 1.34, if applicable.

In effect, proposed rule § 1.32(d) provides that a power of attorney from a prior application may be used in a continuing application if the continuing application names the same or fewer inventors as the prior application. Proposed rule § 1.32(e) notes that if power of attorney was obtained from the inventors (and not the assignee), the addition of an inventor results in a loss of power unless the added inventor provides a power of attorney.

The proposed rules do not provide for situations where power of attorney in the prior application was obtained from the assignee, and the new inventor has assigned his/her rights to the assignee. Under those circumstances, the power of attorney from the prior application should continue to have effect in the continuing application, notwithstanding the additional inventor. This is particularly true if the assignee has established its rights to request or take action in the continuing application in accordance with § 3.73(b).

Thus, a separate rule may be warranted when the power of attorney to be relied upon was granted by the assignee, such as the following:

(f) A power of attorney from a prior application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if the power of attorney was granted by an assignee who has established its right to request or take action in the continuing application pursuant to § 3.73(b) of this chapter, and if a copy of the power of attorney from the prior application is filed in the continuing application.

March 6, 2012

Page 3

Such an approach would be consistent with the commentary in the Federal Register Notice that the “power of attorney should be from the assignee where one exists.” 77 Fed. Reg. 986, col. 2.

II. Inventor’s Oath or Declaration

Excerpts of the proposed amendments to § 1.63 are set forth below:

(d)(1) A newly executed inventor oath or declaration under § 1.63 is not required under § 1.51(b)(2) and § 1.53(f) or § 1.497(a) in an application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed application, provided that:

- (i) An executed oath or declaration in compliance with this section was filed in the earlier-filed application;
 - (ii) A copy of such oath or declaration, showing the signature or an indication thereon that it was executed, is submitted in the continuing application; and
 - (iii) Any new inventors named in the continuing application provide an executed oath or declaration in compliance with this section.
- (2) If applicable, the copy of the executed oath or declaration submitted under this paragraph must be accompanied by a statement signed pursuant to § 1.33(b) requesting the deletion of the name or names of the person or persons who are not inventors in the continuing application.

The Federal Register Notice indicates that some of the proposed changes to § 1.63(d) are intended to make the provisions of § 1.63(d) available to continuation-in-part applications. However, some of the requirements may be inherently inconsistent with continuation-in-part applications. For example, commentary in the Federal Register Notice states that the use of an oath or declaration from a parent application only is proper “so long as the oath or declaration continues to be appropriate” for the continuing application, and that “it would not be proper to submit . . . a copy of a declaration . . . that contains misstatements relative to the continuing application.” 77 Fed. Reg. 991, col. 3.

One required statement that may be inherently inconsistent with a continuation-in-part application is found in proposed § 1.63(a)(6):

(6) State that the person making the oath or declaration has reviewed and understands the contents of the

March 6, 2012

Page 4

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

It is highly unlikely that the inventors could have “reviewed . . . the contents” of the continuation-in-part application at the time they executed the declaration for a parent application. If the USPTO intends to maintain this requirement, it should explain how an oath or declaration from a parent application ever could be used in a continuation-in-part application.

The proposed rules also appear to be internally inconsistent with regard to continuing applications that name different inventors than the prior application. On the one hand, proposed rule § 1.63(d)(1)(iii) appears to require a newly executed oath or declaration only from “[a]ny new inventors,” while proposed rule § 1.63(d)(2) appears to permit the deletion of an inventor by a separate paper, without requiring any newly executed oath or declaration from the remaining inventors. However, the same commentary cited above states that the statement in the oath or declaration regarding inventorship “must be true for the continuing application in order for an oath or declaration from a prior application to be properly submitted in the continuing application.” 77 Fed. Reg. 991, col. 3. This commentary appears to directly conflict with proposed rules § 1.63(d)(1)(iii) and § 1.63(d)(2), and appears to require a newly executed oath or declaration from all inventors if the continuing application names different inventors than the prior application.

As the proposed rules are consistent with current practice (at least with regard to the deletion of inventors), the USPTO should clarify that newly executed oaths or declarations are not required just because the continuing application names different inventors.

* * * * *

We appreciate the USPTO’s careful consideration of these comments.

Sincerely,

Courtenay C. Brinckerhoff