

Orich, Christine

From: Orich, Christine <Christine.Orich@btlaw.com>
Sent: Thursday, February 23, 2012 4:24 PM
To: fee.setting
Subject: Comments on Proposed Fees for Late Filing of Declaration

In my view, the proposed \$3000 fee for late filing of an oath or declaration is unconscionable, especially when one considers that we are moving to a first to file system in which any unnecessary delay in filing could result in the loss of rights. In many cases, coordinating signatures on a declaration is no small feat, with inventors being unavailable or located in different time zones and such. And since signatures can only be obtained once the patent application is in final draft, obtaining inventor signatures necessarily adds on to the time to filing if one wants to avoid the late-declaration surcharge.

In the Proposed Rules, the Patent Office has cited the additional processing that is needed if a Declaration is submitted late as justification for the surcharge. However, this argument holds no water if the application is submitted with a completed Application Data Sheet or a completed unsigned Declaration. When processing a newly filed application, it is my understanding that the Patent Office doesn't even look at the Declaration if the application is filed with an Application Data Sheet, unless there is an inconsistency between the two. In other words, the Patent Office takes the inventor information from the Application Data Sheet, not from the Declaration, unless there is an inconsistency between the two documents. This is set forth in MPEP 601.05:

"(2) The information in the application data sheet will govern when the inconsistent information is supplied at the same time by an amendment to the specification, a designation of correspondence address, or a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;
(3) The oath or declaration under § 1.63 or § 1.67 governs inconsistencies with the application data sheet in the naming of inventors (§ 1.41 (a)(1)) and setting forth their citizenship (35 U.S.C. 115);"

If the inventors are fully identified at the time of filing (e.g., on an Application Data Sheet or an unsigned Declaration), and the inventorship does not change during prosecution of the application, there is no additional processing required by the Patent Office once a signed declaration is submitted. Therefore, there should be no need for a surcharge under these circumstances.

I therefore propose modifying the current proposed fee for late filing of Declaration so that there is no surcharge for late filing of a signed Declaration (up to payment of the issue fee), as long as the application is filed with an Application Data Sheet containing the inventor

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information and the inventorship does not change during prosecution of the patent application.

Respectfully submitted,

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