

From: Helfgott, Samson [e-mail address redacted]
Sent: Thursday, January 12, 2012 08:30 AM
To: Kappos, David
Subject: Oath or Declaration

Dear Dave:

First let me apologize for bothering you. You may recall that previously I had mentioned to you that the proposed rules to implement the AIA will either be a great opportunity to move USPTO into a more streamlined, modern, up-to-date, and more harmonized system similar to other patent systems, or the proposed rules will simply maintain as much as possible of the current "unique" old USPTO system. You indicated you were interested in "writing on a clean slate", and I applauded that approach and looked forward to proposed rules along that approach.

I have been working on the Oath and Declaration issues and it appears clear to me that the AIA section 4 differentiated between the "applicant" and the "inventor". The applicant could be an assignee, or an inventor, and the oath or declaration was simply in there for "naming the inventor". This was the meaning of Assignee Filing.

I further felt that the ADS was the appropriate place to list all the information "naming the inventors", and for each listed inventor the AIA required a "piece of paper" which could either be an oath signed by the inventor, a "substitute statement", or a combined oath/assignment.

I believe the proposed rules unfortunately keep just about every rule previously required and every detail unique to USPTO practice that was previously needed. In fact, I believe these proposals have "distorted" the AIA language to "shoehorn it" into the old existing rules.

By way of example:

1. Assignee filing - The AIA in the first sentence of section 118 makes it absolutely clear that an assignee can make an application for a patent. The proposed rules however recites that the AIA does not mean that an assignee can make application for patent in all circumstances, and instead the only time it permits an assignee to file is under two rules (basically the old rules) where the inventor is deceased (Rule 1.42) or when the inventor refuses to sign (Rule 1.47). Those existed in the past and really do not constitute any assignee filing. In fact, the proposed rules specifically retain Rules 1.41(a) and (b) specifying that the "inventor" is the "applicant".

THIS IS NOT ASSIGNEE FILING.

2. AIA Rule 115 (h)(2) states that no supplemental statements are required after an original oath or declaration is submitted. The proposed rules indicate the USPTO won't request any more "supplemental oaths" but what they will request is oaths "in compliance". So they have replaced the word "supplemental" wherever it exists in the rules with "in compliance" and thereby kept everyone of the old requirement supplemental oaths or declarations, just calling them by a different name.

THAT IS NOT WHAT THE AIA STATES.

3. The AIA makes it clear that you don't need supplemental oaths for reissues. The rules indicate that the "elimination of supplemental reissue oaths" will only be directed to "lack of deceptive intent". However, supplemental reissue oaths will still be required for identification of the errors as the applicants continuously go along on the reissue.

THIS IS NOT WHAT THE AIA STATES.

4. The AIA in section 115(d) introduces a "substitute statement" which is "in lieu of the oath or declaration" and just requires explaining reasons why the inventor is not able to file the oath. It says nothing about filing a petition, it says nothing

about an oath or declaration.

The proposed rules define the "supplemental statement" as a third party signing an "oath or declaration" and the filing of a "petition".

THIS IS NOT WHAT THE AIA STATES.

5. The AIA in section 115(f) specifically states that the document supporting the naming of the inventor must be filed before the notice of allowance. It specifically identified that time and did not make any requirements for filing earlier than that time. Nevertheless, the proposed rules insist on following the old rules, requiring filing the oath or declaration at the time of the filing of the application, and even penalizing the applicant for filing later than that. If a new rule would instead simply require "naming the inventors" in the ADS at the time of filing, all of the issues raised by the USPTO could be resolved without the necessity of filing the actual document until prior to notice of allowance.

It is interesting that the ADS is now being used for claiming all priorities and the ADS is now being used for many other purposes but the proposed rules do permit the use of the ADS for "naming the inventors". Instead, it supports its need for an "oath and declaration to identify inventorship" because of a previously existing rule 1.41(a)(1). However, the entire purpose is to come up with new rules. It appears that the old rules are more important than the new AIA.

I could go on and on. However, it seems to me that the USPTO is not interested in "writing on a clean slate". They appear to rather be interested in "shoehorning" AIA into the existing rules and procedures .

The USPTO has been praising the AIA saying that the USPTO will now have Assignee Filing similar the rest of the world. This is not the case based upon the proposed rules. It is embarrassing for us to stand up in international arenas and indicate how the AIA harmonized US laws with the rest of the world, when we won't even be able to fill out a PCT application form and indicate that the "assignee" is the applicant, like in the rest of the world. We will still have to indicate that the "inventor" is the "applicant" for "US only".

Sorry to complain, but I find this quite aggravating and embarrassing to my foreign clients, colleagues and patent offices, and I wonder how the rest of the proposed rules will be.

Samson Helfgott
Director of Patents
KattenMuchinRosenman LLP
575 Madison Avenue
New York, NY 10022-2585
[phone redacted]
[e-mail address redacted]