

From: Orich, Christine <Christine.Orich@btlaw.com>
Sent: Monday, February 27, 2012 10:59 AM
To: fee.setting
Subject: RE: Comments on Proposed Fees for Late Filing of Declaration

Noting the Patent Office's further concerns as to the need to establish inventorship prior to examination (to determine prior art, or double patenting, for example), I respectfully submit the following alternative to my earlier-submitted proposal (reproduced below):

Modified proposal:

that the Patent Office treat the late filing of a signed Declaration similarly to Information Disclosure Statements. In both cases, the Patent Office wants to have the information prior to examination. So, for example, if an application is filed with a completed Application Data Sheet identifying the inventor(s) and a signed Declaration is filed within 3 months of the filing date or before the first Office Action, there is no surcharge for the late filing of the signed Declaration. Then, similar to "late" IDS's, surcharges could apply the later the signed Declaration is filed.

This approach would not penalize those who correctly identify inventorship at the outset but due to logistical issues and/or potential loss of rights, need to file the application before they have all signatures on the Declaration. It would also not penalize applicants who submit signed Declarations upon filing. It would place the burden squarely on those applicants for whom the Patent Office's administrative burden is the greatest: those who do not correctly identify inventorship on filing or within a reasonable time thereafter.

This approach would also make it easier for applicants to use the proposed combined assignment and declaration. Because assignments need to be notarized or witnessed, there can often be a delay in getting these documents properly executed, particularly when inventors are in different locations. As a result, with the FITF system, applicants will be unlikely to take advantage of this option due to the fact that it would delay filing of the application (if one wants to avoid the late-declaration fee). On the other hand, being able to combine the declaration and assignment would be very beneficial to both applicants and the PTO by eliminating the need for multiple documents to be executed.

Respectfully submitted,

Christine Orich
Barnes & Thornburg LLP
Office: (317) 231-6486
Mobile: (317) 796-7732
Fax: (317) 231-7433
corich@btlaw.com
www.btlaw.com

From: Orich, Christine
Sent: Thursday, February 23, 2012 4:24 PM
To: fee.setting@uspto.gov
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 information and the inventorship does not change during prosecution of the patent application.**

Respectfully submitted,

Christine Orich
Barnes & Thornburg LLP
Office: (317) 231-6486
Mobile: (317) 796-7732
Fax: (317) 231-7433
corich@btlaw.com
www.btlaw.com

CONFIDENTIALITY NOTICE: This email and any attachments are for the exclusive and confidential use of the intended recipient. If you are not the intended recipient, please do not read, distribute or take action in reliance upon this message. If you have received this in error, please notify us immediately by return email and promptly delete this message and its attachments from your computer system. We do not waive attorney-client or work product privilege by the transmission of this message. TAX ADVICE NOTICE: Tax advice, if any, contained in this e-mail does not constitute a "reliance opinion" as defined in IRS Circular 230 and may not be used to establish reasonable reliance on the opinion of counsel for the purpose of avoiding the penalty imposed by Section 6662A of the Internal Revenue Code. The firm provides reliance opinions only in formal opinion letters containing the signature of a partner.