

From: Brad Pedersen [H PDLO DGGUHW UHGDFWIG]  
Sent: Monday, March 05, 2012 5:37 PM  
To: oath\_declaration  
Subject: Comments on Changes to Implement Inventor's Oath and Declaration

March 5, 2012

MAIL STOP – Comments Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

ATTENTION – Hiram H. Bernstein  
Senior Legal Advisor, OPLA

Re: Comments on Oath and Declaration Proposed Rules

The Minnesota Intellectual Property Law Association (MIPLA) is grateful for the opportunity to provide input with respect to the Notice of Proposed Rulemaking (NPR) entitled "Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act" – Vol. 77, No. 4, January 6, 2012, pp. 982-1003.

MIPLA is an independent organization of nearly 500 members in and around the Minnesota area representing all aspects of private and corporate intellectual property practice, as well as the academic community. MIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent law before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of the Board of MIPLA after consultation and input from the IP Law, Patent Practice and Patent Litigation Committees, and do not necessarily reflect the view of opinions of any individual members or firms of the committees or MIPLA, or any of their clients. MIPLA understands that the USPTO will not directly respond to these suggestions, and MIPLA reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to fee setting.

In general, MIPLA supports the opportunity for third parties to submit relevant prior art references during patent prosecution so long as the submissions are legitimate and the rules for the submission process protect patent applicants from frivolous or harassing uses of the process.

MIPLA has the following overall comments/suggestions.

1. Oath/Declaration Rules Should Implement Intent of AIA – MIPLA urges the USPTO to review and reconsider the Proposed Rules to insure that these rules fully implement the intention of the changes made by the AIA to the oath and declaration requirements. As commented on by others, including Samson Helfgott, the Proposed Rules currently seem to continue many of the existing requirements based on the existing requirements that applications be filed by an inventor; instead of updating the rules to reflect Congressional intent that (i) such paperwork may be filed up to an allowance of an application, and (ii) an assignee may file and prosecute an application upon a reasonable showing of an obligation to assign the claimed invention being presented in an application.
2. Use the Application Data Sheet (ADS) to provide information necessary to prosecute an application – MIPLA urges the USPTO to utilize the ADS, instead of the oath and declaration, as the primary basis for providing information relating to inventors and assignees that may need to be utilized during the prosecution of an application. In the vast majority of applications, issues related to inventorship or assignment are not at issue and the obligation of complying with the formalities of these requirements can be easily deferred until an indication of allowable subject matter.
3. Allow for Certification by Assignee that Inventorship/Ownership are "Usual" for Employee/Consultant Inventor Scenarios – Inventorship and ownership issues typically do not arise in situations where the employee-made inventions are subject to and within the scope of a proper employment agreement and where all of the employee-inventors are under a common obligation of assignment at the time of invention/filing. MIPLA urges the USPTO to consider expanding the ADS to allow an assignee applicant to certify that (i) all of the named inventors were employees or consultants under a valid agreement at the time of invention/filing that required assignment of inventions rights to the assignee applicant as a common assignee, and (ii) the claimed inventions in the application are within the proper scope of the obligation of assignment in such employment/consulting agreements and also in situations in which the US application claims priority to an application originally filed by the assignee outside the US.

MIPLA has the following specific comments/suggestions.

- A. Proposed Rule 1.33(a) and 1.33(g) – MIPLA recommends that the USPTO revise Proposed Rule 1.33(a) to indicate that the Office will use the correspondence address associated with a Customer Number, instead of that the Office may use that correspondence address. Similarly, Proposed Rule 1.33(g) should be revised to indicate that changes in the correspondence address for a Customer Number will be recognized without any update to the correspondence address. Some MIPLA members have recently received USPTO correspondence where the Office is electing to use an address other than the correspondence address associated with a Customer Number even though the Customer Number has been properly presented in the filings associated with an application. This practice has caused unneeded confusion and unnecessary extra efforts to correct correspondence addresses due, for example, to typographical errors in a

correspondence address indicated on a filing. Once a Customer Number has been associated with an application, the Office and the practitioner should exclusively reference the information for that Customer Number until such time as the Power of Attorney is revoked or changed.

Submitted on behalf of MIPLA by:

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