

Patent Office Professional Association

Box 25287, Alexandria, VA 22313

March 6, 2012

David J. Kappos
Under Secretary of Commerce for Intellectual Property
And Director,
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act. RIN 0651-AC68.

Dear Mr. Kappos,

This letter sets forth the formal Comments of the Patent Office Professional Association (POPA) in response to Notice of Proposed Rulemaking, RIN 0651-AC68, regarding the inventor's oath or declaration provisions of the Leahy-Smith America Invents Act. Comments are due on or before March 6, 2012. Therefore, these Comments are timely filed.

POPA is the exclusive representative of the more than 7,000 patent examiners and other patent professionals at the U.S. Patent and Trademark Office (USPTO). Patent examiners examine patent applications within the constraints of a very rigorous performance appraisal system that measures examiners' production in six-minute increments. Because of these rigorous constraints, examiners have a vested interest in any changes that would result in additional work for examiners, such as delaying the submission of the inventor's oath or declaration until such time as an application is in condition for allowance.

POPA concurs with the agency's position in the Notice of Proposed Rule Making that it is "better for the examination process and patent pendency to continue to require the oath or declaration during pre-examination." See 77 FR 982 (January 6, 2012) at 984. POPA agrees with the agency that any substantial delay in requiring the oath or declaration would negatively impact the quality of examination and add to overall pendency.

For many years, the agency, its examiners and the agency's external stakeholders have strived to achieve timely and compact prosecution of patent applications. Compact prosecution is achieved when the examiner is able to set forth all objections and rejections relevant to a particular patent application in a first Office Action so that the patent applicant can then respond to the first Office Action with any necessary amendments, evidence and/or arguments to overcome the objections and rejections and place the application in condition for allowance. Getting a patent application

in condition for allowance at the earliest opportunity is in the best interest of the patent applicant, the U.S. patent system and the American people.

To properly examine a patent application, the examiner must know the inventor(s) of the claimed invention prior to examination. Inventorship is relevant in determining the applicability of prior art and in identifying any double patenting situations involving the inventor(s). Delay in establishing inventorship via an inventor oath or declaration or by some other means such as a “substitute statement” submitted by an assignee, would likely result in additional new rejections being made in an application late in prosecution when the inventorship is finally determined and new relevant prior art or double patenting issues become apparent. Such situations would necessarily result in further delays in prosecution and increased overall pendency of the patent application.

If the agency elects to allow delay in the filing of the inventor oath or declaration, then the agency should provide some alternative means of obtaining the name(s) of the inventor(s) and making this information readily available to the examiner prior to examination. Only when the examiner has this critical information in front of him/her prior to examination, will the examiner be able to provide a quality examination of the patent application. Any delay in getting this information in front of the examiner will result in decreased quality of examination and increased patent pendency.

Finally, if the agency elects to allow delays in submitting inventor information, examiners should be properly compensated for any additional work required due to those delays.

Thank you for this opportunity to provide POPA’s comments on this issue. If you have further questions or wish to discuss our position further, please contact me and I will be happy to talk with you.

Sincerely,

/Robert D. Budens/

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