

Philips Intellectual Property and Standards

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March 2, 2012

By Electronic mail
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**Subject: Comments re Changes to implement then
Inventor's Oath or Declaration Provisions of the
Leahy-Smith America Invents Act**

Philips Intellectual Property and Standards submits these comments on behalf of Koninklijke Philips Electronics NV and its associated companies ("Philips"). Philips is one of the largest global users of the patent system. The vast majority of the patent applications that Philips files are filed in multiple jurisdictions, typically under the provisions of the Patent Cooperation Treaty.

We note that the rule changes proposed in this section and the commentary related thereto depend upon the definition of the term "Applicant"; but that the current language in 37 C.F.R. 1.41(a) and (b) is inconsistent with amended section 35 U.S.C. 118 as mandated by the AIA which unequivocally states

"A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent."

The amendments to section 118 which authorize applications by assignees (both "formal" assignees and those entities who are beneficiaries of inventor's obligations to assign) are critical elements of the congressionally mandated protocols to simplify and harmonize international filing procedures. Philips has a vital economic interest to see them fully implemented.

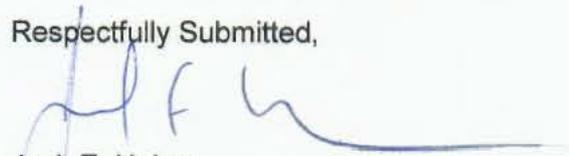
This proposed rulemaking leaves the first sentences of 37 C.F.R. 1.41 subsections (a) and (b) unchanged¹.

If the Office intends to amend those rule sections to be consistent with the AIA; then, in Philips' opinion, it's inappropriate for the Office to require comments based upon a partial submission of rule sections which are so intimately intertwined. We therefore suggest that the

¹ As far as we are able to determine, at this time there is no other pending proposal to amend these rule sections

period for comments to this proposal be extended until the Office has proposed other corresponding changes in subsection 1.41(a) and (b) and that it should expire concurrently with those proposals. If the Office is unable to extend the adaption of these rules until the time that a complete set of consistent provisions is available, we propose that these rules must contain a clear acknowledgement that the assignee of a patent application, or a person to whom the inventor is under an obligation to assign an application is entitled to act, in the first instance, as an applicant in their own right.

Respectfully Submitted,



Jack E. Haken
Vice President
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