

Untitled

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Subject: Inventor's Oath/Declaration (Response to Proposed Rules)

NON-PROHIBITIVE IMPLEMENTATION OF 35 U.S.C. 115(D)(2) (A)(iii) FOR SUBSTITUTE STATEMENTS

Title 35, § 115(d)(2)(A) (iii) permits an applicant to submit a substitute statement in lieu of a declaration when the inventor cannot be found or reached after diligent effort. The PTO should take notice of the difficulties in locating inventors who have left the employment of the entity to whom the application has been assigned. In many instances, inventors have left their last known address and relocated to a different state or even a different country without notice.

Currently the USPTO has imposed prohibitive requirements before an applicant can submit a petition under 37 C.F.R. § 1.47. To have a petition granted under 37 C.F.R. § 1.47, the USPTO currently requires the applicant make multiple attempts to contact the inventor using a variety of document delivery techniques. Evidence of non-delivery using these techniques must be supplemented by the efforts of the applicant to "skip trace" the inventor using the Google® database or the like, as well as inquiries to every last known associate of the inventor.

A reasonable inquiry as to the inventor's whereabouts by the applicant, together with a single delivery attempt to a last known address should suffice for purposes of showing "diligent effort" under 35 § 115(d)(2)(A) (iii).

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