

# **AIA Provisions: Inventor's Oath or Declaration, Certified Copies of Foreign Priority Documents and 35 U.S.C. 112 Identifiers**





# AIA Provisions and Effective Dates

**Day of Enactment**  
**Sept 16, 2011**

Reexamination transition for threshold

Tax strategies are deemed within prior art

Best mode

Human organism prohibition

OED statute of limitations

**10 Days**  
**Sept 26, 2011**

Prioritized Examination

15% transition Surcharge

**Oct 1, 2011**

Reserve Fund

**60 Days**  
**Nov 15, 2011**

Electronic filing incentive

**12 Months**  
**Sept 16, 2012**

Inventor's oath/declaration

Preissuance submission

Supplemental examination

Citation of prior art in a patent file

*Inter partes* review

Post-grant review

Covered business method review

**18 Months**  
**Mar 2013**

First-inventor-to-file

Derivation proceedings

Repeal of statutory invention registration

New patent fees

Micro entity discount

**Provisions are enacted**





# Overview

- Inventor's Oath or Declaration
  - Apply to all applications filed on or after September 16, 2012
- Certified Copies of Foreign Priority Documents
  - Applies to all applications filed on or after March 16, 2013
- New Identifiers of 35 U.S.C. 112, 1<sup>st</sup> through 6<sup>th</sup> paragraphs
  - Applies to all applications filed on or after September 16, 2012



# Inventor's Oath or Declaration



# Changes Affecting the Inventor's Oath or Declaration

- 1) Making foreign priority or domestic benefit claims
- 2) Who can be the applicant
- 3) Processing of the oath or declaration



## Foreign Priority and Domestic Benefit Claims Must Be on an Application Data Sheet (ADS)

- Claim for **foreign priority** must be set forth in an ADS for applications filed on or after September 16, 2012 (except national stage applications). See 37 CFR 1.55
  - Foreign priority claim in the oath/declaration is not sufficient and will not be recognized
- Claim for **domestic benefit** must be set forth in an ADS for applications filed on or after September 16, 2012. See 37 CFR 1.78
  - Domestic benefit claim in the first sentence(s) of the specification is not sufficient and will not be recognized



## Foreign Priority and Domestic Benefit Claims Must Be on an ADS (continued)

- For applications filed on or after September 16, 2012, examiners **should not amend** the first sentence(s) of the specification to include either a domestic benefit claim or a foreign priority claim.
  - Such an amendment will not be recognized by the Office (USPTO) and will not result in the applicant obtaining the domestic benefit or foreign priority claim.



## Foreign Priority and Domestic Benefit Claims Must Be on an ADS (continued)

- Domestic benefit claims and foreign priority claims must be made within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application (except in design applications).
- A petition to accept an unintentionally delayed benefit or priority claim is required after the 4/16 month time period (decided by the Office of Petitions).
- This practice has not been changed by the AIA.



# Who Can Be The Applicant?

- In addition to an inventor, an applicant may now also include other persons with interest in the application.  
See 35 U.S.C. 115 and 118
- This change applies to all applications filed on/after September 16, 2012.
- Applicants are no longer synonymous with inventors.



# Finding Inventor Information

- Despite the revised meaning of the term “applicant,” inventors are still required to submit an oath or declaration.
- Filing of an inventor’s oath or declaration may be delayed for up three months after the Notice of Allowability.
- Even if filing of an oath or declaration is delayed, the most up-to-date inventor information is located on the latest filing receipt.



# Locating Inventors and Applicants on a Filing Receipt

\*\* APP.FILE.REC (09/17/2012) ▼

 **UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLAIMS	IND CLAIMS
13/xxx.xxx	09/17/2012	56xx	57xx	xx40-x212US	24	4

**CONFIRMATION NO. xx62**

**FILING RECEIPT**

5x122  
ACME INC.  
21333 South Shore Drive  
Innovation, OH 99999

  
00000000xxxxxxx

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**Inventor(s)**  
Robert Marley, Jamaica, NY;  
William Nelson, Austin, TX

**Applicant(s)**  
Acme Inc., Innovation, OH  
Uptown Productions, Juno, AK

**Assignment For Published Patent Application**  
Acme Inc., Innovation, OH  
Uptown Productions, Juno, AK



# Processing of the Inventor's Oath or Declaration

- The Office of Patent Application Processing (OPAP, formerly OIPE) is now responsible for:
  - identifying inventor information from the application papers;
  - reviewing inventor's oaths or declarations (other than for reissue applications); and
  - processing requests under 37 CFR 1.48 (Rule 48) filed on or after September 16, 2012 to correct inventorship in a patent application.
- Examiners are still responsible for reviewing the inventor's oath or declaration for **reissue** applications.
- Examiners no longer act on requests under Rule 48 to correct inventorship in a patent application if the request was filed on or after September 16, 2012.



# Certified Copy of Foreign Priority Documents



## Certified Copy of Foreign Priority Document and Document Code

- A certified copy is an official (e.g. ribboned, sealed) priority document originating from foreign patent office.
- A document submitted by the International Bureau (IB) for applications filed under 35 U.S.C . 371 also meet the certified copy requirement.
- A certified copy is found in eDAN under document code (doc code) **FRPR**.

▲ Doc Code	Document Type
FRPR	Certified Copy of Foreign Priority Application



## Time Period for Filing a Certified Copy of a Foreign Priority Document

- For applications filed on or after March 16, 2013, an applicant must file a certified copy of a foreign priority application within the later of:
  - 4 months from the actual filing date of the later-filed application; or
  - 16 months from the filing date of the prior foreign application
- Time period does not apply to design applications



## Three Ways to Fulfill the Certified Copy Requirement

- Applicant files a certified copy of a foreign priority application with the Office (USPTO).
- The Office (USPTO) retrieves a copy of the foreign priority application through the Priority Document Exchange (PDX) Program.
- Applicant files an interim copy of the foreign priority application within the 4/16 month time period AND later files the certified copy.



## Certified Copy of Foreign Priority Documents via the Priority Document Exchange (PDX) Program

- The Priority Document Exchange (PDX) program allows participating countries to share foreign priority documents.
- When priority to a foreign application is claimed in an ADS and the foreign country participates in the program, the PDX team will retrieve an electronic copy of a foreign priority application.
- An electronic copy retrieved via PDX satisfies the certified copy requirement.
- If an electronic copy cannot be retrieved via the PDX program, an applicant is required to provide a certified copy.



# Document Codes for a PDX Copy of a Foreign Priority Document

PDX copies are found in eDAN under document codes (doc codes):

– **PD.FILED.E**

or

– **PD.FILED.F**

Doc Code	Document Type
PD.FILED.E	Priority Documents electronically retrieved by USPTO from a participating IP Office
PD.FILED.F	Priority Documents electronically retrieved requiring USPTO confirmation



# Interim Copy of a Foreign Priority Document

- Applicant may file an interim copy to meet the 4/16 month time period.
- An interim copy is **not** a certified copy and is **not** sufficient to perfect a claim for foreign priority. An interim copy is a duplicate of the original application as filed with the foreign office.
- To obtain foreign priority, an applicant must file a certified copy prior to patent grant.



## Requirements for Filing an Interim Copy of the Foreign Priority Document

An interim copy requires:

- a duplicate of the original foreign application clearly labeled as an “Interim Copy;” and
- a separate cover sheet that must:
  - (1) identify the foreign application by specifying the application number, country, and its filing date; and
  - (2) state that the duplicate filed in the Office (USPTO) is a true copy of the original application as filed in the foreign office.



## Interim Copy of the Foreign Priority Application Document Code

Interim copies are found in eDAN under the document code (doc code) **FRPR.IC**

▲ Doc Code	Document Type
FRPR.IC	Interim copy of the foreign priority doc



# Impact of Interim Copy on the Application under Examination

- An interim copy is not effective to establish an earlier effective filing date of the claimed invention.
- An interim copy of the foreign priority document cannot be used in overcoming a rejection based on an intervening reference.
- In order to overcome such a rejection, applicants must file a certified copy (and a translation if the priority document is not in English).



## Impact of Interim Copy When Using a Published Application as a Reference

- When you are using a published application claiming foreign priority as a prior art reference that has an interim copy in the file, the interim copy is useful to establish written description support for an earlier effectively filed date of the published application.



# **New Paragraph Identifiers for 35 U.S.C. 112**



# 35 U.S.C. 112: New Statutory Paragraph Identifications

- Paragraphs in 35 U.S.C. 112 are now identified by letters instead of numbers
- The AIA did not change the substantive requirements of 35 U.S.C. 112.

<b>Pre-AIA</b>	<b>AIA</b>	<b>Subject Matter</b>
35 U.S.C. 112, first paragraph	35 U.S.C. 112(a)	Written Description Enablement Best Mode
35 U.S.C. 112, second paragraph	35 U.S.C. 112(b)	Indefiniteness
35 U.S.C. 112, fourth paragraph	35 U.S.C. 112(d)	Improper Dependent Claim
35 U.S.C. 112, sixth paragraph	35 U.S.C. 112(f)	Means-plus-function



# 35 U.S.C. 112: Updated Form Paragraphs

- Updated form paragraphs in OACS refer to 35 U.S.C 112 statute paragraphs by both letters and numbers

## ***Form Paragraph 7.31.01***

Claim\*\*\* rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement.



# Resources

- Inventor's Oath or Declaration CBT (September 17, 2012), available at <http://uspto-aisd-315/revisedaia/>
- Hirshfeld/Faile Memorandum (October 25, 2012) (addressing examiner's review of inventor's oaths or declarations, requests to correct inventorship, and elimination of the Notice of Draftsperson's Patent Drawing review)
  - disseminated in Faile email dated November 6, 2012
- Reference Guide to Statutory Provisions and Final Rules Effective on September 16, 2012, available at [http://www.uspto.gov/aia\\_implementation/120910-aia-reference-guide-to-statutory-provisions-and-final-rules.pdf](http://www.uspto.gov/aia_implementation/120910-aia-reference-guide-to-statutory-provisions-and-final-rules.pdf)



# For Questions...

- Please contact a SPE or TQAS



# Time Code

- Time code = **ATRRAIN 0118 090101**

# Thank You!

