

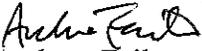


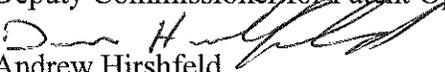
**UNITED STATES PATENT AND TRADEMARK OFFICE**

**MEMORANDUM**

DATE: October 25, 2012

TO: Patent Examining Corps

FROM:   
Andrew Faile  
Deputy Commissioner for Patent Operations

  
Andrew Hirshfeld  
Deputy Commissioner for Patent Examination Policy

SUBJECT: Changes in Examiner Review of Inventor's Oaths or Declarations, Requests to Correct Inventorship, and Elimination of the Notice of Draftsperson's Patent Drawing Review.

As you know, a number of provisions of the Leahy-Smith America Invents Act (AIA) became effective on September 16, 2012. You have already received the link to the AIA computer based training (CBT) (<http://uspto-aisd-315/revisedaia/>). This memorandum memorializes changes discussed in the CBT and supersedes MPEP sections 602 through 605. In addition, guidance is also provided on the elimination of the Notice of Draftsperson's Patent Drawing Review (PTO-948).

**Changes in Examiner Review of Inventor's Oaths or Declarations**

The USPTO published a final rule on August 14, 2012 to implement changes to the inventor's oath or declaration requirements as provided for in the AIA. Under the revised inventor's oath or declaration requirements for applications filed on or after September 16, 2012, the inventor's oath or declaration does not need to be filed until the application is in condition for allowance, and the information that must be provided in the inventor's oath or declaration is significantly reduced. For applications filed on or subsequent to September 16, 2012, Applicant must include information necessary for examination (e.g., name of each inventor, domestic benefit and foreign priority claims) in an application data sheet if the Applicant decides not to file the inventor's oath or declaration prior to docketing of the application for examination.

Effective immediately, Examiners are no longer required to review inventor's oaths or declarations that are filed in original applications (i.e. continuation and divisional applications, but not reissues), including plant and design applications. This responsibility will now be handled by the Office of Patent Application Processing (OPAP). Examiners, therefore, should no longer review any inventor's oath or declaration that has been filed in an original application for compliance with 37 CFR 1.63 or MPEP 602 through 605; should no longer require an inventor's oath or declaration or supplemental inventor's oath or declaration in an original

application; and should no longer object to application papers for containing undated and/or non-initialed interlineations, erasures, cancellations, or any other alterations. Additionally, examiners should no longer use any of the form paragraphs set out in MPEP 602 through 605. This applies to all applications, regardless of whether they were filed prior to, or after, September 16, 2012. The information necessary for examination, such as the name of each inventor and domestic benefit and foreign priority claims, will be available to examiners in PALM.

### **Oath and Declaration provisions effecting Reissue Applications**

The final rule published on August 14, 2012 to implement changes to the inventor's oath or declaration requirements also simplified the requirements for the inventor's oath or declaration for a reissue application. However, the inventor's oath or declaration for a reissue application must be provided before the application will be docketed for examination. The changes to reissue oath or declaration practice will be discussed in a separate memorandum.

### **Requests to Correct Inventorship**

Requests under 37 CFR 1.324 to correct inventorship in a patent (that is not involved in interference practice) will continue to be treated by the Supervisory Patent Examiner whose unit handles the subject matter of the patent.

Requests under 37 CFR 1.48 filed prior to September 16, 2012 to correct inventorship in a patent application will continue to be treated by the primary examiner. However, requests under 37 CFR 1.48 filed on or after September 16, 2012 will be handled by OPAP. Therefore, for requests filed on or after September 16, 2012, Examiners should no longer use any of the form paragraphs set out in MPEP 201.03.

### **Elimination of the Notice of Draftsperson's Patent Drawing Review**

Under current procedure, drawing formalities are evaluated by staff in the Office of Patent Application Processing (OPAP). These staff members determine if the submitted drawing can be adequately reproduced for publication purposes. **There is no separate draftsperson review of drawing formalities required apart from the review performed in OPAP.** If the drawings are not deemed acceptable by OPAP, they will be objected to during the pre-examination process and applicant will be notified of the deficiencies. This process occurs **before the Examiner begins examination of the application.**

Examiners are still responsible for reviewing the content of the drawings and should object to the drawings when they are determined not to conform with 37 C.F.R. § 1.83. Even though OPAP is responsible for reviewing drawing formalities, Examiners are not precluded from addressing any formalities they find under 37 C.F.R. § 1.84 within their Office Action.

### **Update of Forms**

The Notice of Allowability (PTOL-37) and the Notice of Allowability for a Design Application (PTOL-37D) have been revised to no longer include a check box for the examiner to object to the oath or declaration or require a substitute inventor's oath or declaration, or to require compliance with a Notice of Draftsperson's Patent Drawing Review (PTO-948). In addition, the Office Action Summary (PTOL-326), the First Action Interview Office Action Summary (PTOL-413FA), and the Office Action Summary for Applications Under Accelerated Examination (PTOL-326AE) have been revised to no longer include a check box for the examiner to object to the oath or declaration. If the inventor's oath or declaration has not been filed by the time the examiner has prepared a Notice of Allowability, the Technical Support Staff (TSS) will mail a separate notice with the Notice of Allowability that requires the inventor's oath or declaration.