

Advance Notice of Change to MPEP 605.04(b), (c) and (f) - Application Data Sheets Are Strongly Recommended When Inventor Information is Changed

Effective immediately, in addition to the oath or declaration executed by the patent applicant, the Office shall use a contemporaneously or later submitted Application Data Sheet (ADS) per 37 CFR 1.76 as a data source for inventor information when preparing for issuing a patent. The data source for inventor information for patent application publications is the data used to generate a filing receipt, and no change in this process is being made at this time.

Correcting Office Data for a Patent When There is an Error in Spelling of an Inventor's Name and/or Inventor Name Change:

The Office strongly encourages the filing of an ADS whenever a change to, or correction of, the inventorship data is requested. This will enable the Office to capture the correct inventorship data during the patent printing process. Accordingly, if the spelling of an inventor's name is incorrect in the executed oath or declaration, an ADS showing the correct spelling is strongly encouraged to be filed with any request to correct the spelling of an inventor's name, Manual of Patent Examining Procedure (MPEP) § 605.04(b) (8th ed. 2001, revision 1, Feb. 2003). If an ADS is filed after the filing date of an oath or declaration, the spelling of the inventor's name on the ADS will be used for the spelling of an inventor's name. If the inventor changes his or her name after execution of an oath or declaration, while a petition under 37 CFR 1.182 and the required petition fee are required, it is also strongly suggested that an ADS be submitted so the corrected data can be captured by the Office.

37 CFR 1.76(d) sets forth whether an ADS or the oath/declaration controls when there are inconsistencies between the documents, with the general rule being that the ADS will

control, except for the naming of inventors and citizenship. See the provisions in 37 CFR 1.76(d)(1) – (4) for specific situations. For patent printing purposes, however, the names of the inventors will be taken from the ADS. Thus, if an ADS is filed with names other than those on the oath/declaration, since the oath/declaration controls but the patent will be printed with data from the ADS, a certificate of correction should be filed to correct the naming of the inventors on the patent to correspond to the oath/declaration, or any granted request to correct inventorship under 37 CFR 1.48(b).

37 CFR 1.76 also sets forth the proper format for an ADS (see also MPEP § 601.05). Information about ADS is also available on the Office's Internet Web site (<http://www.uspto.gov>). (In the site index, look under "Application Data Sheet Format.")

Correcting Office Data for a Patent involving the Order of Names of Inventors:

Office computer records are relied upon for the order of names of inventors and the number of inventors. For example, if the oath/declaration signed by the inventors shows inventors in XYZ order but latest filing receipt or Private PAIR show inventors in ZXY order (because a petition under 37 CFR 1.182 was granted to change the order of the inventor names, see MPEP 605.04(f)), the front page of the patent should show ZXY order. If the declaration shows inventors A & B & C but latest filing receipt or Private PAIR shows inventors A and C (e.g., because there was a request under 37 CFR 1.48(b) to delete inventor B), then the front page of the patent should show inventors A & C. The accuracy of the Office computer records for the inventor's names and their order is dependent, however, upon the Office capturing the data correctly. The most reliable way for the Office to capture changes of this type is to capture the data changes from an ADS. Thus, to ensure that a patent will include the correct inventors'

names, and in the desired order, applicants are strongly encouraged to provide an ADS in addition to the filing of a petition under 37 CFR 1.182 or a request under 37 CFR 1.48(b) as noted above.

Questions regarding this notice should be directed to the Office of Patent Legal Administration, at (703)308-6906, or to PatentPractice@uspto.gov.

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/s/
Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy