

March 26, 2013

The America Invents Act (AIA) has changed certain procedures concerning inventors and applicants for patent applications. A brief summary of some of these changes is provided in the table below. The majority of these new procedures are applicable only to applications with filing dates on or after September 16, 2012 (*i.e.* "AIA applications"). However, there are some new procedures that apply to all applications regardless of filing date. Cooley's patent practitioners will help you navigate these changes, but some common questions are addressed here.

Is an Application Data Sheet now required for all applications?

No, but given the limited circumstances in which an application data sheet (ADS) is not required,¹ it is best to file an ADS with all applications. Pre-AIA provisions permitted priority claims to be present in an ADS or in the first sentence of the application. Under AIA, each claim for domestic priority or foreign priority (except foreign priority claims in a national stage application) must be present in an ADS for applications filed on or after September 16, 2012. However, it is still good practice to also include priority claims in the first sentence of the specification with language to incorporate by reference any prior application.

Do the new regulations make it easier to correct inventorship? To which applications do the new inventorship regulations apply?

Yes. All that is required under the new procedures to correct inventorship is the submission of an updated ADS with a request and processing fee. An applicant no longer need file a statement from each person being added or deleted that the error occurred without deceptive intent, an oath or declaration by the actual inventors, or written consent of any assignees. However, if a new inventor is being added, a signed declaration for that inventor will need to be filed. This procedure to change inventorship applies to all applications, whether filed before, on, or after September 16, 2012.

How does a declaration that complies with pre-AIA law differ from a declaration that complies with AIA law?

One change you may notice with the AIA compliant declaration is that an inventor no longer has to state that they are the first inventor. This is consistent with the change from a first-to-invent to a first-to-file patent system. The new AIA compliant declaration must also state that the application was made or authorized to be made by the declarant. Another change is that the acknowledgement of penalties for any willful false statement made in the declaration must now also include reference to a fine, imprisonment *of not more than five years*, or both. In the pre-AIA compliant declaration, the acknowledgement of penalties clause only must refer to a fine, imprisonment, or both. The AIA compliant declaration also no longer requires the listing of co-inventors, if this information is included in an Application Data Sheet (ADS).

If we have pending patent applications that were filed prior to September 16, 2012, but have not yet filed any continuing applications, should we ask the inventors to sign a new AIA compliant declaration in anticipation of future continuing applications?

Yes. An AIA-compliant declaration will be required for continuation or divisional applications filed on or after September 16, 2012. If

the declaration in the parent application only complied with pre-AIA provisions, it cannot be used for post-AIA continuing applications. You can, however, have the inventors sign a second declaration for the parent application that is compliant with both pre-AIA and AIA requirements. This executed pre-AIA and AIA compliant declaration can be submitted in the parent application and can then be used for subsequent continuation or divisional applications. This will prove particularly useful if an inventor leaves your company before any future continuation or divisional applications are filed.

What happens if we are unable to have an inventor sign a declaration?

Under the AIA, if the inventor is deceased, under legal incapacity, refuses to execute, or cannot be found or reached after diligent effort, a "Substitute Statement" executed by the inventor's legal representative, the assignee of the inventor, the party to whom the inventor is obligated to assign, or a party showing sufficient proprietary interest can be used. Unlike pre-AIA law, proof of inventor refusal or unavailability does not need to be submitted with the Substitute Statement. However, there is no change under the AIA as to what is considered a good faith attempt to contact an inventor and what constitutes a refusal to sign. A good record of these efforts should be kept.

Under pre-AIA law, we could delay filing a declaration until after an application had been filed and we had received a notice of missing parts. Under the AIA, can we still file a declaration after an application has been filed? Will we receive a notice of missing parts?

Under pre-AIA law, if you filed an application without a declaration, the U.S. Patent and Trademark Office issued a notice of missing parts giving you two months, extendable up to a maximum of seven months, to file the declaration and pay a surcharge. Substantive examination of the application was delayed until the declaration was filed. As a result, many applicants used this delay before substantive examination to replace or amend the claims that were originally filed with the application.

Under the AIA, you actually have more time to file a declaration. The declaration can be filed any time before the application is allowed, and a failure to file a declaration with the originally filed application will not result in a notice of missing parts. However, a surcharge will continue to be applied for declarations filed after the original filing date, and a notice of missing parts will be issued if the surcharge is not paid when the application is filed. If the surcharge is paid, substantive examination of the application will begin even if the application has been filed without a declaration. As a result, if you wish to strategically delay substantive examination through a notice of missing parts, you may now do so by failing to file a declaration and not paying the missing declaration surcharge when the application is filed.

The table and questions in this *Alert* summarize certain procedural changes under AIA. Your Cooley patent practitioner can address any questions or concerns about these changes.

	PRE-AIA	AIA
Applicant²	Inventor(s)	Inventor(s), Assignee (i.e. inventors have assigned or have obligation to assign), or another entity with a sufficient proprietary interest in the invention.

	PRE-AIA	AIA
	Entity with sufficient proprietary interest permitted to make an application for the inventor upon proof that the inventor refused to execute an application or could not be found or reached after diligent effort, and showing that such action is <i>necessary to preserve the rights of the parties or to prevent irreparable damage</i> .	Entity with sufficient proprietary interest: requires showing that such action is appropriate to preserve the rights of the parties.
		Applicant that is juristic person (entity that is not an actual person) must be represented by an attorney or agent admitted to practice before the PTO.
Priority Info³	Application Data Sheet (ADS) or first sentence of the specification	ADS (for applications entering national stage under 35 USC 371, foreign priority does not have to be entered into ADS.)
Inventor Information Requirements⁴	Residence and citizenship.	Mailing address is acceptable. No citizenship info needed.
Correct Inventorship⁵ (patent application)	Needs to be "without deceptive intent" on the part of the omitted inventor and indicate whether correction necessitated by original inventorship being in error or by amendment to the claims.	<p>Do not need to state "without deceptive intent" or what necessitated correction; just correct ADS and pay a processing fee. (Must file a declaration for any added inventor).</p> <p>To correct an ADS, file a new ADS that contains only the sections containing changed or updated information. Changes must be shown by underlining for insertions and strikethrough or brackets for deletions.</p> <p><i>This change applies to all applications regardless of filing date.</i></p>

	PRE-AIA	AIA
Declaration⁶	Believe to be the first and original inventor(s).	Believe to be an original inventor or an original joint inventor.
	Include names of any other co-inventors.	Does not need to list other co-inventors if inventor information included in an ADS.
	Requires language stating that the inventor: "has reviewed and understands the contents of the application" and "is aware of the duty to disclose to the office all information known to the person to be material to patentability as defined in 37 CFR 1.56."	Though not required, permissible to include this language in the declaration as applicants are still required to review and understand the contents of the application and be aware of the duty of disclosure.
	Acknowledgement of penalties clause must refer to fine or imprisonment, or both.	Acknowledgement of penalties clause must refer to fine or imprisonment of not more than 5 years, or both.
		State that the application was made or was authorized to be made by person executing declaration
	Form PTO/SB/01A	Form AIA/01

	PRE-AIA	AIA
	<p>Must be filed before the application will be examined.</p>	<p>Filing not required until application is in condition for allowance (i.e. receive Notice of Allowance). Must be filed before or with issue fee and by deadline indicated on Notice of Allowance.</p> <p>Applicant can file an assignment in lieu of a declaration if it fulfills the declaration requirements. Must indicate on the assignment cover sheet in a conspicuous manner the intent to utilize the assignment as the required oath or declaration under Rule 63.</p> <p>An assignment must be submitted to the Assignment Recordation Branch via EPAS, not via EFS-WEB, in order to comply with § 1.63(e)(1)(ii). The Office will scan the assignment into the Image File Wrapper (IFW) file for the application before forwarding it to the Assignment Recordation Branch.⁷</p>
<p>Inventor Unavailable or Refuses to Sign Declaration⁸</p>	<p>Rule 47 practice required a petition, fee, proof, and affidavits.</p>	<p>Submit a "Substitute Statement" executed by the inventor's legal representative, assignee, party to whom inventor is obligated to assign, or party showing sufficient proprietary interest if the inventor is deceased, under legal incapacity, refuses to execute, or cannot be found or reached after diligent effort.</p> <p>Though proof does not need to be submitted to the USPTO with the Substitute Statement, there is no change to what is considered a good faith attempt to contact an inventor and what constitutes a refusal to sign. Applicant should keep a record of these efforts.</p>

1. For applications filed on or after September 16, 2012, an ADS must be filed with an application where: (i) submission of the inventor's oath or declaration is to be postponed; (ii) each inventor's oath or declaration identifies only the inventor (or person) executing that particular oath or declaration and not all of the inventors; (iii) there is a claim for domestic benefit (37 C.F.R. 1.78), or foreign priority claim (37 C.F.R. 1.55) (except foreign priority for national stage applications); or (iv) there is an identification of applicants other than the inventors under 37 C.F.R. 1.46 (except for national stage applications, where the applicant is the person identified in the international stage).
2. AIA Sec. 4; 35 U.S.C. 118; 37 C.F.R. 1.31, 1.42, 1.46.
3. 37 C.F.R. 1.55, 1.76, 1.78
4. AIA Sec. 4; 35 U.S.C. 115; 37 C.F.R. 1.63
5. AIA Sec. 20; 35 U.S.C. 116; 37 C.F.R. 1.48.
6. AIA Sec. 4; 35 U.S.C. 115; 37 C.F.R. 1.63
7. 77 Fed. Reg. 48,789–90.
8. AIA Sec. 4; 35 U.S.C. 115; 37 C.F.R. 1.64.

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