

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

RIN 0651-AC68

For: **Notice of Proposed Rulemaking:
Changes to Implement the Inventor's
Oath or Declaration Provisions of the
Leahy-Smith America Invents Act**

**77 Fed. Reg. 982
(January 6, 2012)**

**Comments In Reply To the Notice of Proposed Rulemaking Entitled
"Changes to Implement the Inventor's Oath or Declaration Provisions of the
Leahy-Smith America Invents Act"**

Via Internet to: oath_declaration@uspto.gov

Mail Stop Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Due: March 6, 2012

Attention: Mr. Hiram H. Bernstein, Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner for Patent Examination Policy

Dear Mr. Bernstein:

In reply to the Notice of Proposed Rulemaking published January 6, 2012, at 77 Fed. Reg. 982, the PTO Practice Committee at STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. submits the following comments.

1. 37 C.F.R. §1.4(e)

The Office proposes to amend 37 C.F.R. §1.4(e) to require that correspondence requiring a person's signature and relating to "payment by credit card in patent cases . . ." must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent by that person.

(a) If implemented, does this mean that EFS-Web will no longer accept credit card payments for prosecution or other patent-related fees?

(b) If implemented, will patentees not be able to pay maintenance fees online with a credit card?

(c) If implemented, will patentees not be able to pay patent assignment recordation fees online with a credit card?

In the comments for this proposed rule (77 Fed. Reg. 986), the Office states the change is proposed to avoid possible controversies regarding use of an S-signature instead of a handwritten signature for credit card payments such as when a request for a refund is based on use of an S-signature rather than a handwritten signature. However, the proposed change seems to be overly broad and capture all electronic payments.

Payment by credit card is a convenience and complements use of the deposit account. Even though payment with a deposit account is possible, if payments for patent fees cannot be made by credit cards, then applicants may begin to use payment by check, which requires filing by methods other than use of EFS-Web, to avoid possibly overdrawing the deposit account.

If there is a concern about requests for refunds, it seems simpler to require that requests for refund must have an original signature than to block payment by credit cards for all fees due for patent cases.

2. 37 C.F.R. §1.32(d)

The Office proposes to add new 37 C.F.R. §1.32(d) to allow a power of attorney from a prior application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application, to have effect in the continuing application, if inventorship of the later application is the same as the earlier application or if one or more inventors from the earlier application have been deleted in the continuing application, and if a copy of the power of attorney is filed in the continuing application.

(a) If the power of attorney in the earlier application is from an assignee, then it should not be required that inventorship of the continuing application be the same as the application or less than that of the earlier application, if the newly added inventors have also assigned, or are under an obligation to assign, to the same assignee, and such assignment is recorded at the USPTO prior to, or concurrent with the filing of the power of attorney.

(b) Proposed new rule 32(d) should be broadened to include powers of attorney that had been filed in provisional applications to which a later application claims benefit under 35 U.S.C. 119(e). That is, a power of attorney that was filed in a provisional application should have effect in a non-provisional application that claims the benefit of the provisional application if submitted in the non-provisional application, whether or not inventorship remains the same, as discussed above.

3. 37 C.F.R. §1.33(f)

The Office proposes to add new 37 C.F.R. §1.33(f) that requires that "unless otherwise specified," all papers submitted on behalf of a juristic entity must be signed by a patent practitioner. However, in the comments the Office states, "Thus, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner." (page 987, column 1, second full paragraph; emphasis added).

The statement in the comments is more restrictive than the proposed rule. The proposed rule recites "unless otherwise specified," which seems to allow a juristic entity to sign documents such as terminal disclaimers and Statements under 37 C.F.R. § 3.73(b). Clarification is requested.

4. 37 C.F.R. §1.48(k)

37 C.F.R. §1.48(k) is confusing because it refers to national stage applications "prior to becoming nonprovisional applications (which would include applications for which no declaration has been filed) "and" to correct an error in the inventive entity set forth in an executed declaration submitted under PCT Rule 4.17(iv). It isn't immediately clear from reading Rule 48(k) that the language after the "and" is a requirement (i.e., that this section only applies if an executed declaration submitted under PCT Rule 4.71(iv) has been filed). A second sentence should be added to refer the reader to 37 C.F.R. §1.41(a)(4) for correction of inventorship of an international application entering the national stage under 35 U.S.C. 371 in which no oath or declaration has been filed.

5. 37 C.F.R. §1.48

(a) In the comments at page 989 last column, first full paragraph, the Office states: "Section 1.48 is also proposed to be amended to eliminate the "without deceptive intention" requirement (as this requirement has been eliminated from 35 U.S.C. 116), and delete the reference to §1.43 (as §1.42 is proposed to be amended to include the subject matter of 1.43)."

However, the proposed rule as printed at the end of the NPRM is missing this amendment to Rule 48. That is, the language "without any deceptive intention" has not been removed from, for example, 37 C.F.R. §1.48(a).

(b) Similarly, Section 1.48 is also proposed to be amended to delete the reference to §1.43 (as §1.42 is proposed to be amended to include the subject matter of 1.43). However, the proposed rule as printed at the end of the NPRM is missing this amendment to, for example, Rule 48(a)(3).

6. 37 C.F.R. §1.55 and 37 C.F.R. §1.78 (priority and benefit claims)

Is there any grandfathering for applications filed prior to September 16, 2012, with regard to how a claim to foreign priority or domestic benefit is made? For example, if an application is filed prior to September 16, 2012, but the priority or benefit claim is timely made, but, is not made until on/after September 16, 2012, may the foreign priority claim be in the oath/declaration or must it be in a supplemental Application Data Sheet? That is, does the requirement that all priority and benefit claims be in an ADS or Supplemental ADS depend on the date of filing of the application or on the date on filing of the claim?

7. 37 C.F.R. §1.78

(a) The Office proposes to amend 37 C.F.R. §1.78 to require that all Application Data Sheets filed after the filing date of an application be called a "Supplemental" ADS.

Is the ADS filed with national stage entry a "supplemental ADS" even though it is filed after the 'legal' filing date of the application, i.e., after the PCT filing date. If it was intended that the document filed with a national stage entry under 35 U.S.C. 371 be termed simply an "Application Data Sheet," then proposed rule 76(c) should be amended to recite that a Supplemental application data sheet:

". . . (a) May be supplied only after filing of the application, or after payment of the basic national fee for a national stage entry under 35 U.S.C. 371, regardless of whether . . ."

(b) Current rules for supplemental ADS' require that all changed information in a supplemental ADS be indicated by line-through or underline for deleted and new text, accordingly. For a supplemental ADS that is the first filed ADS, must the entire document be underlined or only that information that is different from the information that the Office currently has in its records?

8. 37 C.F.R. §1.63

(a) If an application is filed prior to September 16, 2012, but the oath/declaration is filed on/after September 16, 2012, should the oath/declaration be prepared under the new rules or the old rules?

(b) Are oaths or declarations filed for continuing applications filed on/after September 16, 2012 grandfathered under the old declaration rules? That is, may applicants continue to use an oath/declaration that was filed prior to September 16, 2012 for continuation and divisional applications that are filed after September 16, 2012? Can a declaration first filed prior to September 16, 2012, be filed for a CIP application filed on/after September 16, 2012?

(c) If the oath/declaration filed for a continuation or divisional application relies on a copy of an oath/declaration that was included in an assignment in the parent application, must the assignment be recorded in the continuation or divisional application?

(d) If the oath/declaration filed for a continuation or divisional application relies on a copy of an oath/declaration that was included in an assignment in the parent application, must the assignee listed on the assignment still be the owner when submitting the oath/declaration in the continuation or divisional application?

(e) If the oath/declaration is prepared using the language of the new rules, so that it can be filed with a new application on, for example, September 16, 2012, is it still compliant if it was executed prior to September 16, 2012?

9. 37 C.F.R. §1.63(d)(1)(iii)

The Office proposes to amend 37 C.F.R. §1.63(d)(1)(iii) to recite that any new inventors named in the continuing application provide an executed oath or declaration in compliance with this section. However, if the earlier application contains a declaration executed by 3 inventors, and a CIP application is filed naming 4 inventors, wouldn't a new declaration be required from all inventors? For the CIP application, the declaration naming only 3 inventors would not contain correct statements when it states that "The person executing the oath/declaration believes the named inventor(s) to be the original inventor/joint inventors" since it was missing inventor 4. Therefore, wouldn't a new declaration be needed if inventorship was changed?

10. 37 C.F.R. §3.73(c)(3)

The Office proposes to add new 37 C.F.R. §3.73(c)(3) which recites that a statement under paragraph (b) of this section from a prior application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if the inventorship of the continuing application is the same as the prior application or one or more inventors from the prior application have been deleted in the continuing application, and a copy of the statement under paragraph (b) of this section from the prior application is filed in the continuing application.

The rules should allow applicants to also file a copy of a 37 C.F.R. §3.73(b) statement that was originally filed in a provisional application in a nonprovisional application that claims the benefit of the provisional application.

Also, as mentioned above with regard to changes to the rules related to powers of attorney, If the 3.73(b) statement in the earlier application is from an assignee, then it should not be required that inventorship of the continuing application be the same as the application or less than that of the earlier application, if the newly added inventors have also

assigned, or are under an obligation to assign, to the same assignee, and such assignment is recorded at the USPTO prior to, or concurrent with the filing of the 3.73(b) statement.

Conclusion

Consideration of the above comments is respectfully requested.

Respectfully submitted,

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