



# Vidas, Arrett & Steinkraus, P.A.

## **AIA Declaration Changes**

As of September 16, 2012, the U.S. Patent Laws pertaining to Declarations & Oaths have changed such that all old Declaration forms should be discarded as non-compliant with the new laws. We will provide you with the new Declaration forms. Short listings of some of the provisions that may affect you include:

### **Assignee can file as Applicant**

The AIA (America Invents Act) amends 35 USC §118 to permit filing and prosecution of U.S. patent applications by a “person to whom the inventor has assigned or is under an obligation to assign the invention,” or by a “person who otherwise shows *sufficient proprietary interest* in the matter.” Like Europe, the Applicant need not be an inventor and can file and prosecute the application. However, in most cases, the inventors must still execute declarations. An assignee filing the application as applicant must provide documentary evidence of ownership like an assignment or employment agreement and record the same no later than the payment of the issue fee.

### **An Applicant can sometimes use a Substitute Statement instead of a Declaration**

If an inventor is deceased, under legal incapacity or cannot be found or reached after diligent effort, or is under an obligation to assign the invention, but refused to execute the declaration, a “substitute statement” in lieu of a declaration may be filed. This is much easier than allowed previously. Remember that a substitute statement merely allows the application to

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proceed, it does not dispense with the need to have paperwork to prove ownership. All evidence of ownership such as employment agreements should be collected and maintained.

### **MUST use new Declarations – old are non-compliant**

The old declarations do not include some provisions now required, and all old United States Patent Office forms regarding Oaths and Declarations should no longer be used. Care should be taken that documents which include Declarations have been changed to meet the new laws and rules.

Declarations no longer require a listing of citizenship. They are all for a single inventor only, such that each inventor signs their own form. An inventor only needs to state they believe they are an inventor of a claimed invention in the application. An inventor no longer must state that they reviewed and understand the application before signing. In fact, changes may be made after executing the declaration so long as their statements remain applicable. No address is listed on the model U.S. Patent Office Declaration form, which is included on the required Application Data Sheet (ADS) instead. A statement is required in Declarations that acknowledge that willful false statements are punishable by fine or imprisonment under 18 U.S.C. Section 1001.

### **Generally MUST use Application Data Sheets (ADS)**

Foreign priority claims and domestic benefit claims must be made in an ADS. With the new declarations, an ADS is where the name of each inventor, residence and mailing address is given for each inventor. If an inventor's declaration is filed before the ADS, the inventorship in the declaration controls.

### **May be able to postpone filing Declaration until allowed**

If an ADS is filed before examination, you may postpone filing a declaration by the inventors until the application is in condition for allowance. However, in a national stage entry, delaying filing the declaration could limit its ability to get a patent term adjustment since the

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USPTO provides 14 months from the time the application is complete with an signed declaration. However, we still highly recommend filing signed Declarations as soon as possible.

### **Inventorship easier and cheaper to change until 1<sup>st</sup> Office Action**

It is expensive to seek to change inventorship after a first Office action on the merits - \$1,000 for large entities based on a proposed rule and fee. An applicant in an international application can change inventorship as to the U.S. on national stage entry simply by filing an ADS.

### **Declaration defects may be correctable and not make patent invalid**

Under 35 U.S.C. §115(h)(3) a patent shall not be invalid for failure to comply with §115 if the failure is remedied under §115(h)(1).

### **Corporations must be represented by patent practitioners**

Juristic entities such as corporations had occasionally represented themselves in patent prosecution. It caused enough problems that now all such entities must be represented by a registered practitioner. §1.31.

### **Consequences for PCT filers**

If the Applicant filing the case is only the assignee-applicant, it may reduce the range of ISAs available. For example, an Argentinian corporation as the sole Applicant could prevent use of the PCT so it might be preferable in some cases to have the inventors appear as the Applicant.

New PCT Rule 4.17 Declarations will be published soon by WIPO and should be used.

If a PCT International Filing Date is before September 16, 2012, our “old” U.S. declarations should be used. If possible, we should be granted an e-handshake to your PCT cases so we can use ePCT data on entering the national phase in the United States.

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