

FREQUENTLY ASKED AMERICA INVENTS ACT (AIA) QUESTIONS

I. Naming an Applicant

A. **Who should be named the applicant in applications filed after September 16, 2012?**

✚ An applicant may any person or “juristic entity,” e.g., a corporation or other legally created organization, (1) to whom the inventor has assigned, (2) to whom the inventor is under an obligation to assign, or (3) who otherwise shows sufficient proprietary interest in the matter. If there is no assignee or if the assignee has opted not to file the application and not to take over prosecution to the exclusion of the inventor, then the applicant may be the inventor.

✚ If the application is assigned to an assignee or is under an obligation to assign to an assignee, the assignee should be identified as the applicant. If you wish for the inventor to be identified as the applicant because the assignee has opted not to file the application or has opted not to take over prosecution, you should notify us in your new application order letter. If you do not indicate who the applicant of your application is, we will identify the assignee as the applicant at the time of filing the application.

B. **When entering National Stage, who is considered the applicant?**

✚ Whomever is listed on the Request form in the International Application is considered the applicant. If this information will differ at the national phase stage, then a Request for Recording of a Change (PCT Rule 92bis) must be filed in the international application.

II. Identifying the Assignee as Applicant

A. **Can an assignee file a patent application on behalf of the company, instead of the inventor?**

✚ Yes. The applicant can be an assignee, a person to whom there is an obligation to assign, or a person who otherwise shows sufficient proprietary interest in the matter. The inventor(s) must still execute an oath/declaration.

B. **Is the assignee required to execute any documents as the applicant?**

✚ Yes. An Assignee must be represented by a patent practitioner. Therefore, a Power of Attorney should be executed.

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C. **Is the assignee required to establish ownership of the application to grant Power of Attorney?**

- ✚ No. When the assignee is the applicant, the assignee may grant power of attorney without complying with 37 C.F.R. 3.71 and 3.73.
- ✚ However, when the assignee does not become the applicant or the applicant is changed, it is necessary to comply with 37 C.F.R. 3.71 and 3.73.

III. **Changing an Applicant**

A. **Can we change the applicant under the new rules?**

- ✚ Yes. To request a change of applicant after an original applicant has been established, an Application Data Sheet (ADS) may be filed specifying the new applicant under the “Applicant” section. This should be completed prior to the payment of the Issue Fee.
- ✚ If changing the applicant from the inventor to an assignee, evidence of chain of title and/or ownership (e.g., by an executed assignment to the entire right, title, and interest in the application) is necessary for compliance with 37 C.F.R. 3.71 and 3.73.

IV. **Oath/Declaration**

A. **Are we able to use the oath/declaration that was executed prior to September 16, 2012, when filing an application after September 16, 2012?**

- ✚ No, because the “old” oath/declaration does not contain the new wording required by the AIA. For National Stage applications, the “old” oath/declaration should be used when the international filing date is prior to September 16, 2012. When the international filing date is after September 16, 2012, a new oath/declaration containing AIA mandated language must be used.
- ✚ If you are using the 4.17 declaration when filing a PCT application, please be sure the correct wording for declarations filed on or after September 16, 2012 is included in the declaration.

B. **What is the AIA mandated language that must be included in the inventor oath/declaration?**

- ✚ A statement that “the application was made or authorized to be made by the affiant or declarant”; and in the penalties clause, sufficient language acknowledging “imprisonment of not more than 5 years”.

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C. If the assignee is the applicant, does the assignee need to execute an oath/declaration?

✚ No. Only the inventor(s) are required to execute an oath/declaration.

D. Can the inventor sign a combined declaration/power of attorney form, when the application is subject to assignment?

✚ The power of attorney should be signed by the applicant. When the application is assigned or is subject to assignment to an assignee, the applicant should be the assignee. Therefore, the applicant assignee should sign the power of attorney, and the inventor should sign the declaration without the power of attorney.

E. What is the due date for filing an oath/declaration?

✚ Provided that the applicant has already filed a signed ADS identifying the inventive entity, the oath/declaration will be required prior to the payment of the Issue Fee. The USPTO will issue a Notice of Allowability (PTOL-37) requiring the oath/declaration be submitted. There is a 3-month **non-extendible** due date for submitting the oath/declaration.

✚ The USPTO will no longer issue a Notice to File Missing Parts requiring a oath/declaration. However, a signed ADS must be submitted identifying the inventive entity. If an oath/declaration is not submitted at the time of filing the application, a USPTO surcharge fee of \$130.00 is now required to be paid at the time of filing the application.

F. When late filing the oath/declaration, will I incur any Patent Term Adjustment (PTA)?

✚ Yes. A delay in filing of an oath/declaration may reduce any potential PTA.

V. Continuing Applications

A. For applications filed before September 16, 2012, can I reuse the oath/declaration from the parent application in the continuation/divisional application?

✚ For all continuing applications filed on or after September 16, 2012 and based on a parent application filed before September 16, 2012, the declaration from the parent application is no longer effective. Applicants must execute a new oath/declaration (see our website, www.whda.com) for applications filed on or after September 16, 2012, which may be submitted after the filing of the continuing application with payment of the USPTO surcharge fee.

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B. Is a new Declaration required when filing a Request for Continued Examination (RCE)?

✚ No. An RCE does not require a new Declaration.

C. When filing a By-Pass Continuation, is a new Declaration required?

✚ Yes. Since a by-pass continuation application is treated as a regular U.S. application, a new declaration is required.

D. If there is a new additional inventor for a continuing application, is a new Declaration and Power of Attorney required?

✚ If the applicant is the assignee, a declaration is needed only from the new inventor. A copy of the POA executed on behalf of the assignee in the parent application, can be refiled in the continuing application.

✚ If the applicant is the inventor, although a declaration is needed from just the new inventor, a new POA is needed from all the inventors for the continuing application. Therefore, we recommend all the inventors execute a new combined declaration and power of attorney.

VI. Power of Attorney

A. Who is able to execute a Power of Attorney?

✚ It depends on who is applicant. If the inventor is identified to be the applicant, a power of attorney should be executed by the inventor. If the assignee is identified to be the applicant (which is expected to be the case when the application is assigned or is subject to assignment to an assignee), a power of attorney should be executed by a representative authorized to act on behalf of the assignee. An assignee must be represented by a patent practitioner, thus, when an assignee is the applicant, a power of attorney must be executed on behalf of the assignee.

B. What is the difference between the Power of Attorney forms PTO/AIA/82A and PTO/AIA/82B?

✚ Form PTO/AIA/82A identifies the specific application to which the general power of attorney form PTO/AIA/82B applies. The Patent Practitioner will sign the PTO/AIA/82A form at the time of filing the general power of attorney PTO/AIA/82B form. Form PTO/AIA/82B will, as a standard, be used as a general power of attorney form.

✚ To grant a power of attorney to a specific application, use the limited power of attorney form provided on our website, www.whda.com.

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VII. Non-Signing Inventors

A. **What steps should be taken when an inventor refuses to sign or cannot be located?**

- ✚ The USPTO has simplified this process by removing the necessity of a Petition, fee and statements. Now, a Substitute Statement can be signed by the person with “knowledge of the facts.” However, the company is still required to do everything that they did before and keep the same records. If the application is litigated in the future, the records/evidence establishing an inventor’s refusal to sign, etc. must be produced.