NEW USPTO INVENTOR’S APPLICATION DECLARATION AND RELATED FORMS EFFECTIVE SEPTEMBER 16, 2012

With last year’s passage of the “America Invents Act” (AIA), U.S. patent laws have been undergoing significant changes. While some of these changes were immediate, others are being implemented on a rolling basis. In particular, beginning September 16, 2012, new rules are in effect for (1) who can be the Applicant of a U.S. patent application, and (2) what is required of the Inventor Oath or Declaration (hereinafter “Declaration”).

“Applicant”

According to the new rules, for any new application filed on or after September 16, 2012, the Applicant can now be the inventor(s) or the assignee. A "new application" is defined as any U.S. patent application, excluding a reissue, but including any continuation (e.g., a "$111(a) bypass continuation"), divisional, continuation-in-part and any National Stage application based on an International Application having an international filing date of September 16, 2012 or later. An International Application filed on or after September 16, 2012 will not fall under the new rules until it enters the US National Stage, perhaps 30 months after the international filing date.

Inventor Declaration

Notwithstanding the ability of the assignee to be the Applicant, a Declaration must still be signed by each inventor, except in unusual circumstances, such as where the inventor is deceased, legally incapacitated, cannot be found, or refuses to execute an oath or declaration.

Traditionally, a single "Combined Declaration/Power of Attorney" identifying all of the inventors, identifying any priority claims, and providing a power of attorney, etc., was signed by all of the inventors.

For new applications, the USPTO now expects a separate Declaration to be signed by each inventor. Each separate Declaration must include a statement that the application was made or authorized to be made by the person executing the Declaration, and that the person executing the Declaration believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.
Application Data Sheet

While the new inventor Declaration is simple, starting September 16, 2012, the USPTO indicates that other relevant information about the application, such as listing all inventors, any priority claim, the identification of the Applicant (e.g., the assignee if the application is assigned), etc., should appear in a signed Application Data Sheet ("ADS"). The ADS for any new application can be signed by a patent practitioner or the Applicant.

Conclusion

The new USPTO AIA forms may be found on the USPTO’s website: http://www.uspto.gov/forms/aia_forms.jsp.

The information provided is based on the recently released rules to implement the Inventor’s Oath or Declaration provisions of the America Invents Act, and are subject to change based on any future rules or guidelines that may be issued by the USPTO.

Upon request, editable/writable AIA forms are available from Staas & Halsey LLP for use by its clients and prospective client.