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Application Data Sheets

Question IOD100: Is the use of an application data sheet (ADS) a best practice or is it now mandatory?

Submission of an application data sheet (ADS) should be routine for all applications but is required where: (i) submission of the inventor's oath or declaration is to be delayed; (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 CFR 1.78), or foreign priority claim (37 CFR 1.55)(except foreign priority for national stage applications); or (iv) there is an identification of applicants other than the inventors under 37 CFR 1.46 (except for national stage applications, where the applicant is the person identified in the international stage).

Question IOD200: The amended rules require that each claim for domestic benefit under 37 C.F.R. 1.78 or each claim for foreign priority under 37 C.F.R. 1.55 (except foreign priority claims in a national stage application) be present in an application data sheet (ADS). Will the use of an ADS for these benefit and priority claims also be considered as an incorporation by reference of the prior applications into the subject application?

No, although an ADS submitted with an application is part of the application, the use of an ADS to make a claim for domestic benefit or foreign priority is not an express incorporation by reference of the prior application into the subject application. An express incorporation by reference must be set forth in the specification of the subject application as filed.

Question IOD210: Are there any plans to have an EFS fillable corrected Application Data Sheet (ADS) form so that changes can be shown with markings (i.e., strike through or underlining)?

Yes, the Office is working on an EFS-Web ADS that would be fillable and generated through EFS-Web. Once the EFS-Web ADS is available, the Office plans to work on creating an EFS-Web corrected ADS. We envision that the EFS-Web corrected ADS will auto-populate with the application information from USPTO systems so applicant can make changes to the existing information.

For applications filed on or after September 16, 2012, a corrected ADS may contain only the section that includes the information being changed. Applicants do not have to use USPTO form AIA/14 to submit a corrected ADS and may instead create a corrected

ADS in word processing software. For example, if filing a request to correct the spelling of an inventor's name, an applicant could create a corrected ADS in word processing software that identifies the application at the top and includes only the "Inventor Information" section, with the incorrectly spelled name stricken and the corrected name underlined.

Question IOD250: When a domestic benefit claim is submitted only in the specification of a new application and is not mentioned in the ADS, is a petition required to submit a corrected ADS after the four-month window with the domestic benefit claim?

Yes, for applications filed on or after September 16, 2012, a domestic benefit claim(s) must be made in an ADS within four months from filing or sixteen months from the filing date of the prior-filed application, whichever is later. If a corrected ADS containing a domestic benefit claim(s) is presented outside of the four/sixteen month time period, then a petition to add an unintentionally delayed domestic benefit claim and fee must be filed to add the claim(s).

Question IOD255: If a second ADS is filed to correct or amend information presented in a previously filed ADS, is the second ADS required to include underlines and cross-outs to reflect the changes?

Yes, an ADS that is provided to correct or update information (relative to the information submitted in a previously submitted ADS) must identify the information that is being changed via underlining for insertions and strike-through or brackets for text removed.

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Assignee Filing

Question IOD300: Can a company, as the assignee, file a patent application for an invention on behalf of the company rather than on behalf of the inventor?

Yes, the assignee can be the applicant. However, the inventor must still execute an oath/declaration. The assignee may only execute a substitute statement in lieu of an oath/declaration where the inventor refuses to execute an oath/ declaration, cannot be found or reached after diligent effort, is deceased, or is legally incapacitated.

Question IOD400: Prior to September 16, 2012, an assignee was required to proceed via 37 C.F.R. §§ 3.71 and 3.73 to establish ownership of the application to be able to grant a power of attorney to prosecute the application. Is this still the case for a new application filed on or after September 16, 2012, where the assignee files the application as the applicant?

No, where the assignee is the applicant, the assignee may appoint a power of attorney to prosecute the application without having to comply with §§ 3.71 and 3.73.

Question IOD500: If an assignee-applicant files a continuation-in-part (CIP) application after September 16, 2012, what steps should the assignee-applicant take for execution of the declaration?

For an application filed on or after September 16, 2012 with an assignee as the applicant, the assignee-applicant must file an application data sheet identifying the assignee as the applicant. Additionally, the assignee-applicant must submit an executed inventor's oath or declaration no later than in response to a Notice of Allowability. For the inventor's oath or declaration, a copy of the oath or declaration from a prior application in the benefit chain may be used in the CIP application only where the prior declaration is compliant with 35 U.S.C. 115 as amended by the AIA. If the oath or declaration from a prior application in the benefit chain is not compliant with 35 U.S.C. 115 as amended by the AIA, then the inventor must execute a new oath or declaration that satisfies the AIA requirements.

Question IOD600: If an assignee-applicant files an application on or after September 16, 2012, who should sign a power of attorney?

If the assignee is named as the applicant, then the assignee-applicant must give the power of attorney. See 37 CFR 1.32. A power of attorney from an assignee may be executed by a person having apparent authority to do so, such as the President of the assignee, or by including a statement of authorization. See MPEP § 324.

Question IOD700: Can an assignee be the applicant for a provisional application?

Yes, 37 CFR 1.46(b) relating to assignee-applicants refers to 35 U.S.C. 111 broadly thereby covering 35 U.S.C. 111(b) provisional applications.

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Assignment with Statements

Question IOD800: Can an assignment document contain the statements required to be included in an inventor's oath/declaration?

Yes, an assignment may include the statements required in an oath/declaration. In such case, the applicant may file a combined inventor's oath/declaration and assignment document in the Office.

Question IOD900: Does the Office intend to provide forms for the submission of a combination assignment-statement as the inventor's declaration?

No, the Office does not plan to provide an assignment form that may also be used to meet the inventor's oath or declaration requirement because assignments are a matter of local law. If an applicant wants to file a combination assignment-statement, the Office suggests that the applicant re-draft his/her normally-used assignment to meet the requirements of new 37 CFR 1.63, including the required statements in 35 U.S.C. 115 as amended by the AIA. For ease of reference, the required statements are set forth in the USPTO declaration forms PTO/AIA/01 ("Declaration (37 CFR 1.63) For Utility or Design Application Using an Application Data Sheet (37 CFR 1.76)") and the PTO/AIA/08 ("Declaration for Utility or Design Patent Application (37 CFR 1.63)"). The declaration forms for Plant Applications are USPTO forms PTO/AIA/03 and PTO/AIA/09. Additionally, where an applicant considers merely attaching declaration page(s) to the end of the assignment document, the applicant should ensure that any signature is applicable to both the declaration pages and the assignment.

Question IOD1000: Does the Office have an explicit preference to receive a combined assignment-statement where an invention has been assigned?

No, the Office has no preference as to the type of inventor's oath or declaration to be filed for an application. The Office considers that the public interest is best served where an assignment, if one exists, is publicly recorded.

Question IOD1100: If an applicant files an application via EFS-Web and then files a combination assignment-statement for recording against the application via EPAS on the same day as the application filing, will the applicant be required to pay a surcharge since the declaration did not physically accompany the application filing?

No, while an assignment cannot be recorded against an application via EPAS until an application number is provided, the applicant will immediately receive the application number when the application is filed in EFS-Web. The applicant may then file the

assignment-statement for recordation against the designated application number on the same day as the application filing through EPAS and avoid the surcharge for a delayed declaration.

Question IOD1200: If an applicant files an application via EFS-Web and then on the same day files the assignment-statement via EPAS, how can the applicant provide the application number with the assignment-statement (as required by EPAS) given that the inventor(s) will have executed the assignment-statement before the application number is known?

For purposes of recording an assignment-statement, the applicant is required to provide the application number only on the cover sheet of the EPAS submission; the applicant is not required to place the application number on the executed assignment-statement. However, the executed assignment-statement must identify the application in some way (e.g., name of inventors, title of invention on the specification as filed, and attorney docket number on the specification as filed).

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Changing/Correcting Inventorship or Inventor Name Changes

Question IOD1300: If an applicant needs to change the inventorship in a nonprovisional application, what is the applicant required to submit?

To change inventorship, an applicant must file a request under 37 CFR 1.48(a), an application data sheet listing the correct inventors, and a \$130 fee. Additionally, the applicant must submit an inventor's oath or declaration for each added inventor.

Question IOD1400: An inventor filed a non-provisional application before September 16, 2012, with a declaration executed in her maiden name. After September 16, 2012, the inventor married and changed her last name. The inventor wishes to have the application record reflect her new name. Should the inventor request a change in inventor name under the practice employed before September 16, 2012 (i.e., a petition under 37 C.F.R. 1.182 with a \$400 fee as specified in MPEP § 605.04(c)) or under amended 37 C.F.R. 1.48(f) that became effective on September 16, 2012 (i.e., a signed request to correct the name submitted with an application data sheet and the \$130 processing fee specified in 37 C.F.R. 1.17(i))?

The inventor should file a request to change the inventor name under amended 37 C.F.R. 1.48(f), since the inventor seeks to correct her name after September 16, 2012.

Question IOD 1500: If an applicant does not submit the inventor's oath or declaration on filing of a nonprovisional application (other than a reissue application) because applicant plans to postpone submission of the inventor's oath or declaration until a Notice of Allowability issues, is a surcharge required and, if so, when must the surcharge be paid?

Yes, the surcharge under 37 CFR 1.16(f) is required if the inventor's oath or declaration (executed by or with respect to each inventor) is not submitted on filing of the application. If the surcharge is not paid at the time the application is filed, the Office will send a Notice to File Missing Parts requiring the surcharge. If, however, a general authorization to charge any required fees to a deposit account (that covers fees under 37 CFR 1.16) is submitted on filing of the application, the Office will charge the surcharge in accordance with the deposit account authorization. Payment of the surcharge cannot be postponed until a Notice of Allowability issues.

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Effective Date

Question IOD1600: What is the effective date for the inventor's oath/declaration provision in the AIA?

The effective date for the inventor's oath/declaration provision in the AIA is September 16, 2012.

Question IOD1700: If an applicant filed an application prior to September 16, 2012, without an executed declaration, and is submitting an inventor's oath or declaration after September 16, 2012, must the inventor's oath or declaration comply with pre-AIA law?

Yes, the inventor's declaration is not subject to the AIA rule changes because the application was filed before the inventor's oath or declaration provision of the AIA became effective on September 16, 2012.

Question IOD1800: If an applicant filed an international application before September 16, 2012, and intends to submit national stage application under 35 U.S.C. 371 after September 16, 2012, must the inventor's declaration for the national stage application comply with the AIA rule changes to the inventor's declaration?

No, the inventor's declaration is not subject to the AIA rule changes. The submission of a national stage application is not the filing of an application but instead relates to entry of the international application into the national stage. The filing date of a national stage application is the filing date of the international application. See MPEP § 1893.03(b).

Question IOD1900: If an applicant files a continuation application after September 16, 2012, claiming the benefit of an application filed before September 16, 2012, can the inventor's declaration filed in the parent application be re-submitted in the continuation application?

Probably not. To re-submit an inventor's declaration from the parent application in the child application, the declaration from the parent application must comply with the requirements of 35 U.S.C. 115 as amended by the AIA. Specifically, the inventor's declaration must state that the inventor (i) is an original inventor of the claimed invention; and (ii) authorized the filing of the patent application for the claimed invention. The inventor's declaration also must contain an acknowledgement that any willful false statement made in such declaration is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both. It is unlikely that the declaration from the parent application contains these statements since they were not required by pre-AIA law.

Question IOD2000: If a continuation-in-part (CIP) application is filed after September 16, 2012, containing new matter relative to the parent application also filed after September 16, 2012, is the inventor required to review and understand the new matter in the CIP application and thus to be aware of the duty to disclose material information to the Office relating to the new matter?

Yes, an inventor is under a duty of disclosure to the Office under 37 CFR 1.56 for all filings made at the Office, even though an inventor is not required under 35 U.S.C. 115 as amended by the AIA to acknowledge that duty of disclosure in writing in an inventor's oath or declaration. Because of the inventor's duty of disclosure, it is appropriate to have the inventor review a CIP application containing new matter before the CIP application is filed at the Office, even though the inventor need not execute a new oath or declaration.

Question IOD2100: Does the inventor's oath or declaration provision of the AIA apply to plant applications under 35 U.S.C. 161, design applications under 35 U.S.C. 171, and reissue applications under 35 U.S.C. 251?

Yes, the changes to inventor's oaths or declarations introduced by the AIA apply to plant, design, and reissue applications as these are applications considered to fall under 35 U.S.C. 111(a).

Question IOD2200: For an application filed on or after September 16, 2012, but before March 16, 2013, that is still subject to the first-to-invent provisions of 35 U.S.C. 102 and 103, should the inventor's oath or declaration filed in that application continue to include the language that the inventor is the first inventor?

No, an inventor's oath or declaration for an application filed on or after September 16, 2012, is subject to the requirements of 35 U.S.C. 115 as amended by the AIA and does not need to state that the inventor is the "first" inventor, even though the application may be subject to the first-to-invent provisions of 35 U.S.C. 102 that the inventor be the "first" inventor.

Question IOD2300: An applicant filed a PCT application before September 16, 2012. After September 16, 2012, the applicant plans to file a continuation application of the PCT application under 35 U.S.C. 111(a) (i.e., "bypass application"), rather than a national stage of the PCT application under 35 U.S.C. 371. Is the applicant required to submit in the bypass application an inventor's oath or declaration that complies with the AIA or with pre-AIA law?

Where an applicant files a bypass application on or after September 16, 2012, the applicant must submit an inventor's oath or declaration that complies with the AIA.

Question IOD2400: Our company has several pending applications that were filed prior to September 16, 2012, containing properly executed declarations pursuant to pre-AIA requirements. Although new declarations are not required, as the inventors are still available, can we have them execute new declarations compliant with the pre-AIA and post-AIA requirements and submit them so that copies can be used in any subsequent continuing applications?

Yes, the inventors may execute new declarations compliant with pre-AIA and post-AIA requirements and submit them for use in any subsequent continuing applications if filed.

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Forms

Question IOD2500: What forms has the Office made available related to the inventor's oath/declaration provision?

The Office has made a variety of new forms related to the inventor's oath/declaration provision available on the Office's AIA microsite as well as on the Office's form site, including an inventor declaration for an original (non-reissue) application, inventor declaration for a reissue application, substitute statement, and Application Data Sheet (ADS).

Question IOD2600: Can I continue to use the same inventor declaration form after the effective date of the inventor's oath/declaration provision on September 16, 2012?

No. There is new statutorily-mandated language that must be included in the inventor oath/declaration after September 16, 2012, that is not included on the inventor oath/declaration form available before that date. The new statutorily mandated language includes: (1) a statement that "the application was made or authorized to be made by the affiant or declarant," and (2) the acknowledgement of penalties clause must refer to "imprisonment of not more than 5 years." The Office has made a new oath/declaration form containing the necessary statutorily-mandated language available on the Office's AIA microsite as well as on the Office's form site.

Question IOD2700: Why does the USPTO form PTO/AIA/01 state that the date of execution is optional?

The Office has listed the date of execution on PTO/AIA/01 as optional because the Office does not check the date of execution and will not require a newly executed oath or declaration where the date of execution has been omitted. If an applicant prefers, he/she is welcome to include the date of execution.

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Inventor's Oath or Declaration

Question IOD2800: Under the inventor's oath/declaration provision, what information must an inventor supply in his/her oath/declaration to be filed in the Office for a patent application?

An inventor must state in his/her oath/declaration that (i) he/she is an original inventor of the claimed invention; and (ii) he/she authorized the filing of the patent application for the claimed invention. An inventor is no longer required to (i) state that he/she is the first inventor of the claimed invention; (ii) state that the application filing is made without deceptive intent; or (iii) provide his/her country of citizenship.

Question IOD2900: If an applicant files a continuation-in-part (CIP) application after September 16, 2012, naming inventors X and Y, and the parent application named only inventor X, can the applicant use in the CIP application a copy of the declaration signed by inventor X that was filed in the parent application?

Yes, an applicant can use the declaration filed in the parent application if that declaration complies with new 35 U.S.C. 115 and a signed Application Data Sheet (ADS) is filed in the CIP application (either before or with the copy of the parent declaration) naming the inventive entity (X and Y). An oath or declaration signed by the additional inventor Y in the CIP application would also be required. But as long as a signed ADS was filed naming the inventive entity (X and Y) in the CIP application, the oath or declaration executed by the additional inventor Y in the CIP application would not need to identify inventor X.

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Juristic Entity

Question IOD3000: Given that an application data sheet is required to be signed and given that a juristic entity must be represented by a patent practitioner, who should sign an application data sheet when the applicant is an assignee that is a juristic entity?

A patent practitioner must sign the application data sheet for an assignee-applicant that is a juristic entity.

Question IOD3100: Section 1.33(b)(3) states that, unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner. What papers may be signed by the juristic entity?

A juristic entity may sign substitute statements, small entity assertions, terminal disclaimers, powers of attorney, and submissions under 37 CFR 3.73(c) for an assignee to establish ownership of patent property if the assignee is not the original applicant.

Question IOD3200: If an applicant does not submit the inventor's oath or declaration on filing of a nonprovisional application (other than a reissue application) because applicant plans to postpone submission of the inventor's oath or declaration until a Notice of Allowability issues, is a surcharge required and, if so, when must the surcharge be paid?

Yes, the surcharge under 37 CFR 1.16(f) is required if the inventor's oath or declaration (executed by or with respect to each inventor) is not submitted on filing of the application. If the surcharge is not paid at the time the application is filed, the Office will send a Notice to File Missing Parts requiring the surcharge. If, however, a general authorization to charge any required fees to a

deposit account (that covers fees under 37 CFR 1.16) is submitted on filing of the application, the Office will charge the surcharge in accordance with the deposit account authorization. Payment of the surcharge cannot be postponed until a Notice of Allowability issues.

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Naming the Applicant

Question IOD3300: An application filed after September 16, 2012, mistakenly identified the assignee as the applicant in the "Applicant Information" section of the ADS. How can this error be corrected in order to identify the inventors as the applicant?

Once the assignee is misidentified as the applicant, a request to correct or update the name of the applicant would need to be accompanied by a new ADS and a statement under 37 C.F.R. 3.73 that shows ownership by the inventors.

Question IOD3400: An applicant files an application naming two inventors. One of the inventors has assigned his rights to the invention to an assignee, but the second inventor has not assigned his rights and is under no obligation to assign. Who should be listed as the applicant in the "Applicant Information" section of the ADS?

The assignee and the second inventor should be listed in the "Applicant Information" section of the ADS as the applicant.

Question IOD3500: Can assignee information be included on the U.S. patent application publication where the inventors are the applicant and there is an assignee who is not the applicant, and if so, can the non-applicant assignee information be provided on the ADS?

Yes, assignee information can be included on the patent application publication even where the assignee is not the applicant. The current ADS form, PTO/AIA/14, does not have a field for providing non-applicant assignee information. The Office is in the process of revising the ADS form to provide an additional field for non-applicant assignee information for assignees who are not the applicant, but who want assignee information printed on the patent application publication. Until the revised ADS form is available, non-applicant assignee information may be provided on the application transmittal letter for the purpose of having the information printed on the patent application publication.

Question IOD3600: A person alleging sufficient proprietary interest, in order to be the applicant, must file a petition under 37 CFR 1.46(b)(2), which requires a showing that such person has sufficient proprietary interest in the matter. When must the petition under 37 CFR 1.46(b)(2) be filed?

The petition under 37 CFR 1.46(b)(2) should be filed with the application. If the petition is not filed with the application, then the person who is alleging sufficient proprietary interest may not be considered the applicant. Instead, where no applicant is identified, the Office will, by default, consider the inventor to be the applicant (*e.g.*, to complete processing of the application so it can be forwarded for examination). 37 CFR 1.46(c) provides that a request to change the applicant after an original applicant has been specified requires compliance with 37 CFR 3.71 and 3.73. A person alleging sufficient proprietary interest who later wants to become the applicant would not be able to comply with 37 CFR 3.71 and 3.73. In addition, any power of attorney must be signed by the applicant. If a petition has not been filed, then a person who allegedly has sufficient proprietary interest would not be able to sign a power of attorney.

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Power of Attorney

Question IOD3700: Who is permitted to sign a power of attorney for a patent application?

For an application filed on or after September 16, 2012, a power of attorney must be signed by the applicant. A “patent owner” may sign a power of attorney when a patent has issued, such as for a reissue application, reexamination proceeding, or a supplemental examination proceeding.

Question IOD3710: Can an assignee who is not the applicant revoke or appoint a power of attorney in a patent application filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012?

No, an assignee who is not an applicant must become the applicant under 37 C.F.R. 1.46(c) in order to revoke or appoint power of attorney.

Question IOD3800: An inventor-applicant filed an application after September 16, 2012, and gave a power of attorney. The assignee now wants to become the applicant, but does not wish to change the power of attorney given by the inventor. Is it necessary for the assignee to file a power of attorney that is consistent with the one provided by the inventor?

No, the assignee-applicant would not need to file a new power of attorney so long as the power of attorney granted by the inventor-applicant remained. A new power of attorney from the assignee-applicant would need to be filed only if the power of attorney from the inventor was revoked.

Question IOD3810: An applicant plans to file a new application after September 16, 2012, and wishes to give power of attorney to a patent practitioner using USPTO form PTO/AIA/82. Since the application number is not yet known, may that field be left blank on the first page of the form (PTO/AIA/82A)?

Yes, the application number is required to be identified only where the paper is being submitted for a previously-filed application for a patent. The application information fields on the PTO/AIA/82A should be completed to the extent possible to clearly identify the application to which the form is being directed.

Question IOD3820: In an application in which the assignee is named as the applicant, is a statement under 37 C.F.R. 3.73 required along with the Power of Attorney, when the Power of Attorney is signed by the assignee-applicant?

No, assignees and obligated assignees who are named as the applicant in the ADS (e.g., on filing) may give power of attorney without resort to 37 CFR 3.71 and 3.73. PTO form AIA/82 should be used to give the power of attorney.

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Substitute Statement

Question IOD4000: Does the inventor’s oath/declaration provision permit a substitute statement in lieu of an inventor’s oath/declaration?

Yes, the inventor’s oath declaration provision permits a substitute statement to be filed in an application when the inventor is: (i) deceased; (ii) legally incapacitated; (iii) unable to be found or reached after diligent effort; or (iv) refuses to sign an oath/declaration.

Question IOD4100: Who may file a substitute statement in lieu of an inventor’s oath/declaration if such a statement is permitted in a patent application?

The following applicant entities may sign a substitute statement on behalf of an inventor when such a statement is permitted in a patent application:

- (i) the inventor's legal representative under 37 CFR 1.43, where the inventor is deceased or legally incapacitated;
- (ii) the other joint inventors under 37 CFR 1.45, where the inventor refuses to sign the declaration or cannot be reached or located after diligent effort;
- (iii) the assignee or party to whom the inventor is under an obligation to assign under 37 CFR 1.46, where the inventor is deceased, legally incapacitated, refuses to sign the declaration or cannot be reached or located after diligent effort; or
- (iv) a party who otherwise shows a sufficient proprietary interest in the claimed invention under 37 CFR 1.46(b), where the inventor is deceased, legally incapacitated, refuses to sign the declaration or cannot be reached or located after diligent effort.

Question IOD4200: Where an assignee is executing a substitute statement under one of the permitted circumstances, does the requirement for residence and mailing address also apply to the person signing the statement?

Yes, where an assignee executes a substitute statement, the assignee must supply his/her residence and mailing address. If the assignee is a juristic entity, the residence and mailing address of the juristic entity should be used.

Question IOD4210: What evidentiary showing is an applicant required to make when filing a substitute statement?

An applicant may sign and file a substitute statement (AIA/02 or equivalent) where an inventor refuses to sign a declaration, cannot be reached or located after diligent effort, is legally incapacitated, or is deceased. Proof of the circumstances (e.g., attempts to contact the inventor) is no longer required, but such information should be retained in an applicant's records.

Question IOD4300: If an inventor who no longer works for the company insists on being paid before signing a declaration for an application filed after September 16, 2012, can this be considered a sufficient inventor refusal to support the use of a substitute statement?

The AIA does not change the standard for an inventor's refusal to execute a declaration. An initial refusal to sign based on some precondition may or may not amount to an outright refusal, depending on the specific facts.

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Timing

Question IOD4400: Does the inventor's oath/declaration provision contain any timing restriction for filing an inventor's oath/declaration?

Yes, the inventor's oath/declaration provision permits the Office to issue a Notice of Allowance in an application only if: (i) the inventor's oath/declaration is filed; (ii) a substitute statement filed in lieu of the inventor's oath/declaration; or (iii) an assignment containing the statements required for an inventor's oath/declaration is recorded in the Office for the patent application.

Question IOD4500: When is an applicant required to submit an inventor's oath/declaration?

An applicant (i) may submit the inventor's oath/declaration on filing of the application; or (ii) may postpone until the Office issues a Notice of Allowability, provided that the applicant files a signed Application Data Sheet identifying the inventive entity.

Question IOD4600: If an applicant does not submit the inventor's oath or declaration on filing of a nonprovisional application (other than a reissue application) because applicant plans to postpone submission of the inventor's oath or declaration until a Notice of Allowability issues, is a surcharge required and, if so, when must the surcharge be paid?

Yes, the surcharge under 37 CFR 1.16(f) is required if the inventor's oath or declaration (executed by or with respect to each inventor) is not submitted on filing of the application. If the surcharge is not paid at the time the application is filed, the Office will send a Notice to File Missing Parts requiring the surcharge. If, however, a general authorization to charge any required fees to a deposit account (that covers fees under 37 CFR 1.16) is submitted on filing of the application, the Office will charge the surcharge in accordance with the deposit account authorization. Payment of the surcharge cannot be postponed until a Notice of Allowability issues.

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Miscellaneous

Question IOD4700: According to 37 CFR 1.63(b)(2), an inventor's mailing address is where the inventor customarily receives mail. Can an inventor's mailing address be the corporation where an inventor works, for example, the address of the corporate legal department?

Yes, if an inventor customarily receives mail at a corporate mail address, then the inventor may provide that address for his mailing address.

Question IOD4800: Since the AIA has eliminated the requirement for statements of lack of deceptive intent, what will be the impact on reissue practice?

The inventor's oath/ declaration filed in the reissue proceeding need not contain a statement that the error(s) being corrected occurred without deceptive intention, and a supplemental oath or declaration is no longer required due to the filing of an amendment.

Question IOD4900: An applicant files a request for prioritized examination (Track I) with a new application filed on or after September 16, 2012. Is an executed inventor's oath or declaration required to be filed with the new application, even where a proper application data sheet (ADS) is filed that lists the legal name, residence, and mailing address for each inventor?

Yes, a request for prioritized examination for an application filed after September 16, 2012, must be accompanied by an inventor's oath or declaration executed by or with respect to each named inventor. In other words, an inventor's oath or declaration cannot be postponed until the Office issues a Notice of Allowability for applications subject to prioritized examination (Track I).

Question IOD5000: Where a practitioner who represents the inventor makes an alteration to the specification, for example, an amendment to the claims, after the inventor has executed the declaration and before the application is filed, should the inventor re-execute a new declaration after reviewing the amended application?

An inventor is not required to re-execute a new inventor's oath or declaration provided that the changes are minor, for example, correction of typographical errors, grammatical problems, and clarifying sentences. 37 CFR 1.52(c). If the changes would amount to the introduction of new matter had the change been made to a filed application, however, then the inventor should execute a new oath or declaration after reviewing the amended application. The amended rules permit alterations to the specification without the inventor re-executing an oath or declaration only where the statements in the executed declaration remain applicable. Additionally,

an inventor must before executing the oath or declaration (i) review and understand the contents of the application; and (ii) be aware of his or her duty of disclosure. 37 CFR 1.63(c). If the changes made to the specification before an application is filed result in substantial alterations to the application, then an inventor may not understand the contents of the application or be aware of his/her duty to disclose information relating to the substantial alteration.