

Topic	Question	Answer
<b>Application Data Sheet (ADS)</b>	Will the USPTO revise their ADS?	Yes, the new ADS should be available around September 16, 2012.
<b>Assignee as Applicant</b>	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, under the new rules the USPTO has moved from an "inventor-applicant" system to an "assignee-applicant" system. 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. However, the inventor must still execute an oath/declaration.
	Does an applicant who is a legal entity need to execute any documents as the applicant?	Yes, 37 C.F.R. §1.31 requires that a juristic entity be represented by a patent practitioner. Therefore, a Power of Attorney must be executed.
	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 37 C.F.R. §§ 3.71 and 3.73. However in situations where the assignee does not become the applicant or the applicant changes, it will be necessary to comply with 37 C.F.R. §§ 3.71 and 3.73.
<b>Changing an Applicant</b>	How can we change an applicant under the new Rules?	37 C.F.R. § 1.46(c) indicates that a request to change the applicant after an original applicant has been established must include an ADS specifying the new applicant in the "applicant" field and must comply with 37 C.F.R. §§ 3.71 and 3.73. This should be done before payment of the Issue Fee.
<b>Naming an Applicant</b>	What is the best practice for naming applicants (inventor, assignee, etc.) when filing applications on or after September 16, 2012.	The best practice, if the assignee is to be named as applicant is to provide this information in your new case order letter. We will then be able to prepare and file an Application Data Sheet (ADS) with this information.
	May we file an application in the United States with the assignee as the applicant, even though the Request Form of the PCT application specifies the Inventors as the applicants for the US?	The applicant will be whoever is listed on the Request form in the International Application. You will need to correct the applicant during the international phase by filing a Request for Recording of a Change under PCT Rule 92bis. Please contact us if you have specific case questions/scenarios.  Also, if you are going to use a 4.17 inventor's declaration when filing an International PCT application, please be sure it has the correct wording for declarations filed on or after September 16, 2012.

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<b>Declaration</b>	If an "old" declaration was executed prior to September 16, 2012, may we still file that declaration on or after September 16, 2012 in a regular U.S. application?	<p>No, unless the "old" declaration contains the proper wording.</p> <p>The new statutorily-mandated language that must be included in the inventor oath/declaration on or after September 16, 2012, which includes among other things: (1) a statement that "the application was made or authorized to be made by the affiant or declarant," and (2) sufficient language in the penalties clause that acknowledges "imprisonment of not more than 5 years." If the signed declaration does not have this wording, it cannot be used on or after September 16, 2012.</p> <p>However, please note that "old" declarations should be used in U.S. National Stage Applications where the international filing date is before September 16, 2012.</p>
	When the legal entity is the applicant, does a representative of the legal entity have to execute an oath/declaration?	No, only the Inventors need to execute an oath/declaration.
	Can we file a Combined Declaration (and Assignment) up until payment of the Issue Fee?	<p>Yes, provided that the applicant has already filed a signed Application Data Sheet (ADS) identifying the inventive entity. Note that if a declaration is not filed with the new application, a USPTO surcharge will be accrued.</p> <p>The USPTO will not send a Notice to File Missing Parts requiring an inventor's oath/declaration if a signed ADS has been filed naming each inventor by his or her legal name and identifying a mailing address and residence for each inventor. Where the inventor's oath/declaration has not been submitted at the time that the application is otherwise in condition for allowance, the USPTO will send a Notice of Allowability (but not a Notice of Allowance and Fee(s) Due) requiring the inventor's oath/declaration.</p> <p>The USPTO does warn that taking advantage of the delay to file the oath/declaration in a U.S. national stage application could preclude the application from accruing Patent Term Adjustment (PTA) if the USPTO does not issue a first Office Action or Notice of Allowance in a timely manner.</p>
	What are the consequences if we do not file the executed declaration documents on time?	Absent some other action, the application will go abandoned.

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	For cases filed before September 16, 2012 with an "old" declaration, is it possible to reuse the "old" declaration if a continuation/divisional is filed on or after September 16, 2012?	No, because it most likely does not contain the proper wording.
	For cases filed before September 16, 2012 with an "old" declaration, to file a Request for Continued Examination (RCE) without obtaining a new declaration?	Yes, because an RCE does not require a declaration.
	If a PCT application was filed before September 16, 2012 and a bypass continuation is filed on or after September 16, should the new declaration form be used?	Yes. A new declaration should be filed because a bypass continuation is treated as a "regular" U.S. application.
<b>Execution Date of Documents</b>	Are there any problems if the execution date of a Declaration and Assignment is after the filing date of an application?	No. However, a USPTO surcharge will apply for the late filing of a declaration.
<b>Non-Signing Inventors</b>	What must a company do before checking the box indicating, for example, that the inventor refuses to sign thereby permitting the company to sign for the inventor? What records must be kept? Will there ever be a need to produce the records/evidence establishing the company's right to sign?	The company is still required to do everything that they did before and keep the same records as they did before. The difference is that only one form is required now for the USPTO, instead of the Petition, the statements and the fee. There may be a need in the future (possible litigation) to produce the records/evidence establishing an inventor's refusal to sign.
<b>Power of Attorney</b>	Given the new rules, who is able to execute a Power of Attorney?	<p>If the invention has been assigned, the power of attorney should be executed on behalf of the assignee, not by the inventors. Moreover, new 37 C.F.R. §1.31 requires "a juristic entity (e.g., organizational assignee)" to be represented by a patent practitioner. Thus, when an assignee is the applicant, a power of attorney executed on behalf of the assignee should be filed.</p> <p>New 37 C.F.R. §1.32(d) provides that a power of attorney filed in a parent application can be used in a continuing application if a copy is filed in the continuing application, unless the power of attorney was executed by the inventors and the continuing application names an additional inventor, in which case a new power of attorney will be required.</p>
	If a company/assignee would like to sign a general Power of Attorney, which form should we use?	The general Power of Attorney form PTO/AIA/80 should be used in situations where the Assignee is not the Applicant. The general Power of Attorney form PTO/AIA/82B should be used in situations where the Assignee is to be named as the applicant.