

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
United States Patent and Trademark Office
Post Allowance and Refiling
OMB CONTROL NUMBER 0651-0033
(July 2012)

Background

The United States Patent and Trademark Office (USPTO) is submitting this request to update information collection 0651-0033, "Post Allowance and Refiling." The USPTO is submitting three new forms in this collection related to the inventor's oath or declaration for a reissue application:

- (1) Reissue Application Declaration by the Inventor (PTO/SB/AIA05);
- (2) Reissue Application Declaration by the Assignee (PTO/SB/AIA06); and
- (3) Substitute Statement in Lieu of an Oath or Declaration for Reissue Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64) (PTO/SB/AIA07)

Section 4 of the Leahy-Smith America Invents Act (AIA) amends 35 U.S.C. 115 to streamline the requirements for the inventor's oath or declaration, and permit a substitute statement in lieu of an oath or declaration in certain circumstances. The changes to 35 U.S.C. 115 in the AIA are effective on September 16, 2012, but apply only to patent applications filed on or after September 16, 2012.

The USPTO currently provides forms for the inventor's oath or declaration for a reissue application (PTO/SB/51, PTO/SB/52), which provide applicants with a simple way to make the averments and provide the inventorship information required by 35 U.S.C. 115 and 37 CFR 1.63. The USPTO has revised the inventor's oath or declaration requirements in view of the changes to 35 U.S.C. 115 in the AIA and in response to feedback from the public to: (1) require only the averments required by the AIA's 35 U.S.C. 115(b) and 251; and (2) permit applicants to provide inventorship information (the names of all of the inventors) on an application data sheet rather than the inventor's oath or declaration.

The averments required by 35 U.S.C. 115(b) are that: (1) the application was made or was authorized to be made by the affiant or declarant; and (2) the individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application. These averments differ somewhat from pre-AIA 35 U.S.C. 115, which requires that the applicant aver that he (or she) believes himself (or herself) to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he (or she) solicits a patent, and state of what country he (or she) is a citizen. These averments are pre-printed on the inventor's oath or declaration forms (and the substitute statement forms). A reissue oath or declaration must also identify at least one error being relied upon as the basis for reissue under 35 U.S.C. 251, state that the applicant believes the original patent to

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be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, and identify a claim that the application seeks to broaden if the reissue application seeks to enlarge the scope of the claims of the patent.

The USPTO is also providing applicants with the option to supply inventorship information via an application data sheet, rather than on the inventor's oath or declaration. This change does not affect the information that is required, but only how it is provided (formerly the USPTO required that it be provided in the inventor's oath or declaration, and the revised rules permit it to be provided either in the inventor's oath or declaration or on an application data sheet).

The USPTO is also providing substitute statement forms, which are applicable if the inventor is deceased, is legally incapacitated, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration. Under pre-AIA 35 U.S.C. 115, the applicant would make the oath or declaration required of an inventor in these situations. Under the AIA's 35 U.S.C. 115, the applicant provides a substitute statement rather than an oath or declaration with respect to an inventor in these situations. The information provided on the substitute statement was required by the pre-AIA regulations (37 CFR 1.47, 1.63 and 1.64) pertaining to an oath or declaration that is executed by an applicant who was not the inventor.

The changes to 35 U.S.C. 115 in the AIA do not apply to applications filed prior to September 16, 2012. Thus, the USPTO plans to provide new forms for use with applications filed on or after September 16, 2012, but still continue to make the existing inventor's oath or declaration forms (legacy forms) available until applications filed prior to September 16, 2012, are no longer pending before the USPTO.

Summary of Changes

In order to accommodate the revised procedure, the following forms are added to this information collection as follows:

- PTO/SB/AIA05: Reissue Application Declaration by the Inventor: The USPTO is providing this form for reissue patent applications in which the reissue oath or declaration is being executed by the inventor. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) and 251, with check boxes to indicate why the applicant believes the original patent to be wholly or partly inoperative or invalid, and a space to identify at least one error being relied upon as the basis for reissue, and to identify a claim that the application seeks to broaden if the reissue application seeks to enlarge the scope of the claims of the patent. Information concerning the error being corrected by reissue is required by pre-AIA 37 CFR 1.175 to be in an oath or declaration and is collected via the declaration forms currently included in this collection (PTO/SB/51).

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- PTO/SB/AIA06: Reissue Application Declaration by the Assignee: The USPTO is providing this form for reissue patent applications in which the reissue oath or declaration is being executed by the assignee. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) and 251 (with enough identifying information to ascertain who is executing the oath or declaration and the application to which it pertains), with check boxes to indicate why the applicant believes the original patent to be wholly or partly inoperative or invalid, and a space to identify at least one error being relied upon as the basis for reissue, and to identify a claim that the application seeks to broaden if the reissue application seeks to enlarge the scope of the claims of the patent. Information concerning the error being corrected by reissue is required by pre-AIA 37 CFR 1.175 to be in an oath or declaration and is collected via the declaration forms currently included in this collection (PTO/SB/52).

- PTO/SB/AIA07: Substitute Statement in Lieu of an Oath or Declaration for Reissue Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64): The USPTO is providing this form for reissue patent applications in which a substitute statement is being executed by the applicant. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) and 251 (with enough identifying information to ascertain who is executing the oath or declaration and the application to which it pertains), with check boxes to indicate why the applicant believes the original patent to be wholly or partly inoperative or invalid, and a space to identify at least one error being relied upon as the basis for reissue, and to identify a claim that the application seeks to broaden if the reissue application seeks to enlarge the scope of the claims of the patent. Information concerning the error being corrected by reissue is required by pre-AIA 37 CFR 1.175 to be in an oath or declaration and is collected via the declaration forms currently included in this collection (PTO/SB/52).

Changes in Burden

The proposed addition of these three forms will not result in a substantive change in the burden for this collection. A reissue patent application must contain an oath, declaration, or substitute statement by or with respect to each inventor under pre-AIA and AIA 35 U.S.C. 115, and the three new forms proposed to be added to this collection require only information that is collected via the declaration forms currently included in this collection (PTO/SB/51, PTO/SB/52).

Changes in Needs and Uses

The USPTO will provide demographic information collected on the forms associated with this information collection to the Census Bureau in order to receive from the Census Bureau generalized and non-applicant-specific statistics on the diversity of the USPTO's user community. Section 29 of the Leahy-Smith America Invents Act (Pub.L. 112-29 (2010)) empowers the USPTO to study the diversity of patent applicants.