

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
United States Patent and Trademark Office
Initial Patent Applications
OMB CONTROL NUMBER 0651-0032
(July 2012)

Background

The United States Patent and Trademark Office (USPTO) is submitting this request to update information collection 0651-0032, "Initial Patent Applications." The USPTO is submitting eight new forms in this collection related to the inventor's oath or declaration:

- (1) Declaration (37 CFR 1.63) for Utility or Design Patent Application using an Application Data Sheet (37 CFR 1.76) (PTO/SB/AIA01)
- (2) Substitute Statement in Lieu of an Oath or Declaration for Utility or Design Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64) (PTO/SB/AIA02)
- (3) Declaration (37 CFR 1.63) for Plant Patent Application using an Application Data Sheet (37 CFR 1.76) (PTO/SB/AIA03)
- (4) Substitute Statement in Lieu of an Oath or Declaration for Plant Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64) (PTO/SB/AIA04)
- (5) Declaration for Utility or Design Patent Application (37 CFR 1.63) (PTO/SB/AIA08)
- (6) Plant Patent Application (35 U.S.C. 161) Declaration (37 CFR 1.162) (PTO/SB/AIA09)
- (7) Declaration (supplemental sheet for PTO/SB/AIA08 or PTO/SB/AIA09) (PTO/SB/AIA10)
- (8) Substitute Statement Supplemental Sheet (supplemental sheet for PTO/SB/AIA02 or PTO/SB/AIA04) (PTO/SB/AIA11)

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 (PTO/SB/01, PTO/SB/02, PTO/SB/03), 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 averments required by the AIA's 35 U.S.C. 115(b); 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.

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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).

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/AIA01: Declaration (37 CFR 1.63) for Utility or Design Patent Application using an Application Data Sheet (37 CFR 1.76): The USPTO is providing this form for utility and design patent applications. This form is for applicants who wish to supply inventorship information via an application data sheet, rather than on the inventor's oath or declaration. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) (with enough identifying information to ascertain who is executing the oath or declaration and the application to which it pertains).

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- PTO/SB/AIA02: Substitute Statement in Lieu of an Oath or Declaration for Utility or Design Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64): The USPTO is providing this form for utility and design patent applications. This form permits the applicant to either supply inventorship information via an application data sheet, or use the Substitute Statement Supplemental Sheet (PTO/SB/AIA11) to supply inventorship information. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) and the statements required by 35 U.S.C. 115(d) for a substitute statement (again with enough identifying information to ascertain with respect to whom the substitute statement is executed and the application to which it pertains).
- PTO/SB/AIA03: Declaration (37 CFR 1.63) for Plant Patent Application using an Application Data Sheet (37 CFR 1.76): The USPTO is providing this form for plant patent applications. This form is for applicants who wish to supply inventorship information via an application data sheet, rather than on the inventor's oath or declaration. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) (with enough identifying information to ascertain who is executing the oath or declaration and the application to which it pertains).
- PTO/SB/AIA04: Substitute Statement in Lieu of an Oath or Declaration for Plant Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64): The USPTO is providing this form for plant patent applications. This form permits the applicant to either supply inventorship information via an application data sheet, or use the Substitute Statement Supplemental Sheet (PTO/SB/AIA11) to supply inventorship information. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) and the statements required by 35 U.S.C. 115(d) for a substitute statement (again with enough identifying information to ascertain with respect to whom the substitute statement is executed and the application to which it pertains).
- PTO/SB/AIA08: Declaration for Utility or Design Patent Application (37 CFR 1.63): The USPTO is providing this form for utility and design patent applications. This form is for applicants who wish to supply inventorship information via the inventor's oath or declaration. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) and the inventorship information that is required by the pre-AIA 37 CFR 1.63 to be in an oath or declaration and that is collected via the declaration forms currently included in this collection (PTO/SB/01, PTO/SB/02).
- PTO/SB/AIA09: Plant Patent Application (35 U.S.C. 161) Declaration (37 CFR 1.162): The USPTO is providing this form for plant patent applications. This form is for applicants who wish to supply inventorship information via the inventor's oath or declaration. The form contains the inventor's oath or declaration averments required by 35 U.S.C 115(b) and the inventorship information that is required by the pre-AIA 37 CFR 1.63 to be in an oath or declaration and that is collected via the declaration forms currently included in this collection (PTO/SB/03).
- PTO/SB/AIA10: Declaration. The USPTO is providing this form as a supplement to either the Declaration for Utility or Design Patent Application (37 CFR 1.63)

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(PTO/SB/AIA08) for utility and design patent applications or the Plant Patent Application (35 U.S.C. 161) Declaration (37 CFR 1.162) (PTO/SB/AIA09) for plant applications for applicants who wish to supply inventorship information via the inventor's oath or declaration when there is more than one inventor.

- PTO/SB/AIA11: Substitute Statement Supplemental Sheet (supplemental sheet for PTO/SB/AIA02). The USPTO is providing this form as an optional supplement to the Substitute Statement in Lieu of an Oath or Declaration for Utility or Design Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64) (PTO/SB/AIA02) or the Substitute Statement in Lieu of an Oath or Declaration for Plant Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64) (PTO/SB/AIA04) for applicants who wish to supply inventorship information via the substitute statement rather than via an application data sheet.

Changes in Burden

The proposed addition of these eight forms will not result in a substantive change in the burden for this collection. A 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 eight 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/01, PTO/SB/02, PTO/SB/03).

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.