

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
United States Patent and Trademark Office
Patent Processing (Updating)
OMB CONTROL NUMBER 0651-0031
(September 2012)

Background

The United States Patent and Trademark Office (USPTO) is submitting this request to update information collection 0651-0031, "Patent Processing (Updating)." The USPTO is submitting the following new form in this collection: Statement Under 3.73(c) (PTO/AIA96).

Section 4 of the Leahy-Smith America Invents Act (AIA) amends 35 U.S.C. 118 to change the practice regarding the filing of an application by a person other than the inventor. First, 35 U.S.C. 118 is amended to provide that a person to whom the inventor has assigned, or is under an obligation to assign, the invention may make an application for patent. Second, 35 U.S.C. 118 is amended to provide that a person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

The changes to 35 U.S.C. 118 impact who is presumed to be the owner of an application for an original patent (the original applicant). As part of its implementation of the provisions of 35 U.S.C. 118, the USPTO revised 37 CFR 3.73. For consistency with the changes made to 37 CFR 3.73, the USPTO is providing new form PTO/AIA/96.

The changes to 35 U.S.C. 118 in the AIA and 37 CFR 3.73 do not apply to applications filed prior to September 16, 2012. Thus, the USPTO plans to provide new form PTO/AIA/96 for use with applications filed on or after September 16, 2012. The USPTO currently provides form PTO/SB/96 for when it is necessary to supply a statement under 37 CFR 3.73(b). The USPTO will continue to make existing form PTO/SB/96 (legacy form) 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 form is added to this information collection as follows:

PTO/AIA/96: Statement Under 37 CFR 3.73(c): This form is similar to the current PTO/SB/96 and may be used by an assignee to establish its ownership of a patent property in order to request or take action in a patent matter. References to "3.73(b)" in PTO/SB/96 have been changed to "3.73(c)" in PTO/AIA/96 for consistency with the change to 37 CFR 3.73, and the instructions for completion of the form by an assignee

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(continued)**

of less than the entire right, title and interest have been updated in PTO/AIA/96 for consistency with the changes made to 37 CFR 3.73(c)(2).

Changes in Burden

The proposed addition of new form PTO/AIA/96 will not result in a substantive change in the burden for this collection. New form PTO/AIA/96 proposed to be added to this collection requires only information that is currently collected via this collection (e.g., via form PTO/SB/96).