



Greenblum & Bernstein, P.L.C.  
**CLIENT ADVISORY**  
Recent Changes in Rules and Procedures

August 21, 2012

**AMERICA INVENTS ACT FINAL RULE  
REGARDING INVENTOR'S DECLARATION**

Dear Clients:

The U.S. Patent and Trademark Office has published the Final Rules regarding inventor's Declarations. These new rules will be in effect for applications filed on or after September 16, 2012.

According to the Final Rules, an assignee, an entity to whom the inventor(s) are obligated to assign, or an entity showing a sufficient proprietary interest in the matter may make an application as the applicant. Notwithstanding this designation as applicant, each inventor must still execute an oath or Declaration. However, in cases where an applicant/inventor is deceased, under legal incapacity, cannot be found or reached after diligent efforts or refuses to sign the Declaration, a joint inventor, the assignee or someone showing a sufficient proprietary interest can sign a Substitute Statement instead of the Declaration.

Another significant change under the new rules is that an executed declaration does not have to be filed until the application is otherwise in condition for allowance as long as an Application Data sheet had been filed before examination.

The requirements of the Declaration have also been simplified. That is, the citizenship of the inventors is no longer required. The residence and mailing address of the inventors and the priority information need only be listed in an Application Data Sheet. Also, a combination Declaration/Assignment may be filed. We are currently revising our Declaration forms and preparing a combination Declaration/Assignment form. They will be available when they are revised.

An Applicant may file a Substitute Statement upon the indication of the application being otherwise in condition for allowance instead of a Declaration. The Substitute Statement would indicate the "circumstances" of the non-signing inventor (the inventor being deceased, under legal incapacity, cannot be found or reached after diligent efforts, or refuses to sign the Declaration), the relationship to the inventor of person executing the declaration, and the last known address of the non-signing inventor.

Should you have any questions or comments regarding this matter, please do not hesitate to contact us.

Best regards,

GREENBLUM & BERNSTEIN, P.L.C.

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