

The Limited Monopoly®

The Importance of Signatures During the Patent Process

by Robert Gunderman, PE and John Hammond, PE

Placing Your John Hancock on the Paper or Rearranging Those Electrons

While penning a large and flamboyant signature on a parchment as important as the Declaration of Independence may not be the rigor of the day, signatures are nonetheless very important to many aspects of the patent process. Now, however, instead of ink and animal skin, signatures are rendered electronically either after signing or during the signing process itself. The electronic signature is still evolving in the world of patents. Today, in the United States, an e-signature is common on many papers that are electronically filed with the US Patent and Trademark Office. An e-signature consists of a forward slash, followed by the name of the signer, followed by another forward slash. Most practitioners use an e-signature for many of the more common documents. Many other documents, such as title documents, are still signed in ink with a notary present to attest to the signature.

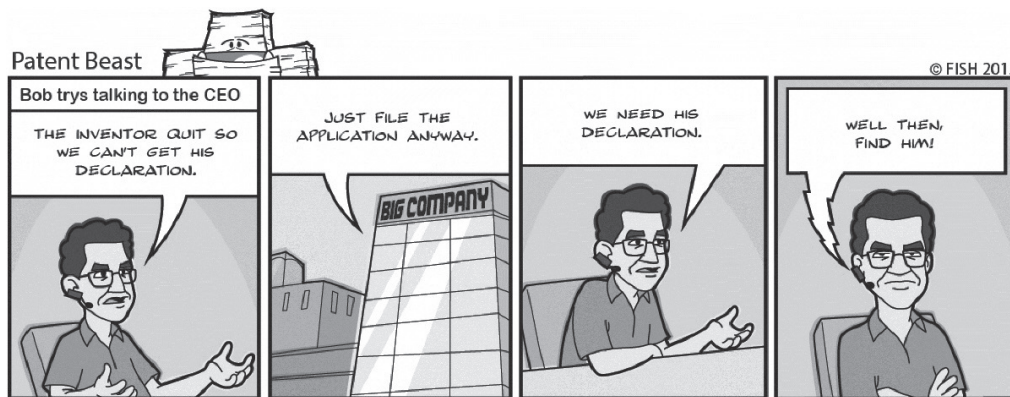
The Declaration

While not the Declaration of Independence, the Inventor's Oath or Declaration is an important document requiring a signature from each inventor. Under the new post-AIA rules, each inventor

may sign a separate Oath or Declaration. The Declaration acknowledges that the application was made or authorized to be made by the person executing the Declaration, that the individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application, and acknowledges the penalties of false statements being fines and/or imprisonment of five years or both. The Declaration is still best signed in ink and copies scanned as pdf for submission. If the Declaration is not submitted at the time of filing, it can be submitted at any time prior to the issuance of a Notice of Allowability by the Patent Office. However, the Office will issue a notice that the Declaration is missing, and the Applicant must pay a surcharge fee within two months of the mailing date of the Notice, even if the signed Declaration is submitted much later.

Power of Attorney

Under the new post-AIA rules, a Power of Attorney must be explicitly granted to the patent practitioner that is filing and will prosecute your application, otherwise he will not be able to take actions on your behalf before the USPTO. The Applicant for patent may give Power of Attorney by signing an appropriate



Power of Attorney form. If the Applicant is the assignee (typically a corporation), an officer of the assignee (e.g., the President of the corporation), may execute the Power of Attorney. If the assignee was not named as Applicant and wishes to appoint a patent practitioner, a statement under 37 CFR 3.73(c) must be prepared and submitted to accompany the Power of Attorney. It is good practice to name the assignee as Applicant when it is proper to do so, in order to avoid the need to obtain signatures from multiple inventors for various actions. Of course, in order to name the assignee as Applicant, an Assignment must be duly recorded.

The All Important Assignment

An Assignment is a transfer of ownership of a patent or patent application. This transfer may be required through an employment agreement, or may be a sale between two parties. Assignments are important legal documents. Absent an agreement to the contrary, the inventor owns his/her invention¹. With multiple inventors and no assignee, each is entitled to independently make, use, or sell the patented invention, or to license others to do so, without accounting to the other inventors.² With post-AIA rules, an applicant can now be the assignee, making an Assignment even more important for ongoing prosecution and related matters.

Combined Declaration and Assignment

The USPTO will also now accept a combined Declaration and Assignment with a single electronic filing entry. This can save untold frustration when inventors become scattered after the initial filing and it becomes difficult to obtain signatures on an assignment document at a later date. Essentially, one document and one signature from each inventor at the time of filing (or shortly thereafter with a surcharge) serves as both a Declaration and Assignment. Further, this combined document is filed in EPAS (the USPTO's electronic assignment system) and is transferred to EFS (the USPTO's electronic filing system) simply by checking an appropriately noted box on the electronic submission. A real time saver that simplifies the myriad of paperwork required to file a patent application.

The Application Data Sheet

The USPTO now views the Application Data Sheet (ADS) as a very important document that is submitted at the time of filing. The ADS identifies all inventors, identifies the practitioner of record, identifies the Applicant, of course identifies the application itself, and establishes any priority claims, domestic or foreign, that may be pertinent to the application being filed. The ADS is typically prepared and signed (e-signed) by the patent practitioner of record.

The Uncooperative Inventor

Of course every now and then an inventor becomes begrudged due to a dispute of some nature (most likely involving money), and refuses to sign the Oath or Declaration. This is problematic of course, and before the America Invents Act (AIA), the patent practitioner would then institute a rule 47 (37 CFR 1.47) procedure where statements were signed by individuals having knowledge of relevant facts; a petition was prepared, and all

documents were filed with payment of a fee. The USPTO then either granted the petition or asked for more information. An arduous process, to say the least. Now, after AIA, the practitioner simply fills out a new form PTO/AIA/02 and sends it in along with the signed Declarations from the other inventors. No fees, statements or petition. A much simpler solution to that uncooperative inventor. Of course ownership will still be an issue without an executed Assignment in place.

International Implications

Signature requirements vary with each country, so it is best to check signature requirements with a local patent agent for that country. For Patent Cooperation Treaty applications, it is important to remember that if you wish to name your company as Applicant, and not the individual inventors, an Assignment must be in place for your priority document. In many instances, that means your U.S. provisional patent application must be assigned prior to filing the PCT application. And don't forget that if a document is to be notarized in a foreign country, often an apostille is required. An apostille³ is an authentication of a document to ensure that the document will be recognized as valid in another country. These and other details are best left to a qualified patent practitioner in that country or a patent practitioner acting in a foreign liaison capacity.

In Closing...the Cooperative Inventor

So if you are named as an inventor on a patent application, be sure to understand what you are signing and promptly return any documents that require signature. Doing so will keep your patent application on track and keep expenses and stress levels down.

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1. See "The Limited Monopoly"™ March 2006.
 2. 35 USC §262
 3. Used by countries that participate in the Hague Convention of 1961.

Authors Robert D. Gunderman P.E. (Patent Technologies, LLC www.patenttechnologies.com) and John M. Hammond P.E. (Patent Innovations, LLC www.patent-innovations.com) are both registered patent agents and licensed professional engineers. They offer several courses that qualify for PDH credits. More information can be found at www.patenteducation.com. Copyright 2014 Robert Gunderman, Jr. and John Hammond



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