

Untitled

From: G Glass [e-mail address redacted]
Sent: Wednesday, January 18, 2012 8:35 AM
To: oath_declaration
Subject: AIA Oath or Declaration Implementation

Dear Sir

I observe that:

35 U.S.C. 115(h)(2) provides that if an individual has executed an oath or declaration meeting the requirements of 35 U.S.C. 115(a) or an assignment meeting the requirements of 35 U.S.C. 115(e), then the Director cannot require that individual to subsequently make any additional oath, declaration, or other equivalent statement in connection with the application or any patent issuing thereon. 35 U.S.C. 115(h)(3) provides that a patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under 35 U.S.C. 115(h)(1).

An examiner can allow a patent that extends beyond the statements of invention and independent claims in the "as filed" assigned application. Indeed it is not uncommon for words and phrases to appear in claims that are not found in the description of the invention. Under these conditions the current interpretation of the rules is given by MPEP 603 "Supplemental Oath or Declaration - 600 Parts, Form, and Content of Application" which currently says:

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with § 1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

Such a declaration is commonly required when re-issue applications broaden an invention.

One of the problems I see is a previous employer and owner interpreting an invention I previously made in a way that is far broader than what I envisaged and far broader in terms of how I understand the words in the description of the invention. In such a case the requirement for a supplemental declaration gives an inventor an opportunity to object to an interpretation of his invention - indeed the inventor can explain the limiting features in his declaration. If you are going to remove the requirement for a supplemental oath, I would appreciate it if you would allow inventors to request a post grant review to clarify potential new matter issues that may arise from differences of interpretation so that there is no gap between these two mechanisms available to an inventor to protect himself when he finds himself in the position where he has lost his job in a cost cutting exercise and his previous employer may the sell his invention on to a third party that then tries to take control of the inventors future inventions years down the line using the re-issue patent application mechanism.

Thank you for your time.
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