

The New PCT Request Form Promulgated for Use On and After September 16, 2012

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The International Bureau (IB) promulgated a new PCT request form, for use on and after 9/16/2012, in order to accommodate the changes to the US inventor declaration requirements effective on and after 9/16/2012 resulting from enactment of the Leahy-Smith America Invents Act (herein after the "AIA"). The new PCT request form includes a revised "Box No. VIII (iv) DECLARATION: INVENTORSHIP" which contains a revised inventor declaration form including the new magic language for an inventor declaration required by the AIA. The new PCT request form is "Form PCT/RO/101(16 September 2012)", which is currently available from WIPO at:

http://www.wipo.int/export/sites/www/pct/en/forms/Forms_16_September_2012/ro_12_e.pdf

I have a problem with the new PCT request form's new inventor declaration form. This new form properly contains locations to enter an inventor "residence" and also an inventor "Mailing Address". However, it does not provide the definition of the term inventor "mailing address", and therefore will result in the ongoing problem of foreign law firms and foreign corporations improperly listing the address of the law firm or corporate law department when that is an address that is not the inventor's mailing address (not where the inventor customarily receives any mail).

The USPTO inventor declaration rules promulgated in response to enactment of the AIA defines the inventor mailing address. The MPEP has in the past and continues to define the inventor mailing address.

See MPEP 605.03:

Each applicant's mailing or post office address is required to be supplied on the oath or declaration, if not stated in an application data sheet. Applicant's mailing address means that address at which he or *she customarily receives his or her mail*. Either applicant's home or business address is acceptable as the mailing address. The mailing address should include the ZIP Code designation. Since the term "post office address" as previously used in 37 CFR 1.63 may be confusing,

effective November 7, 2000, 37 CFR 1.63 was amended to use the term "mailing address" instead.

The object of requiring each applicant's mailing address is to ***enable the Office to communicate directly with the applicant if desired***; hence, the address of the attorney with instruction to send communications to applicant in care of the attorney is not sufficient.

See "Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act". 77 FR 48776 (August 14, 2012)(herein after the "final rules package"), 48789, left column:

The requirement for identification of a mailing address is clarified by noting that it is the address where the inventor “customarily receives mail,” which may encompass an address where the inventor works, a post office box, or other address where mail is received even if it is not the main mailing address of the inventor. ***The mailing address is for the benefit of the inventor in the event that the Office would need to contact the inventor directly.***

The practice of listing a corporate law department address as the inventor mailing address, may be a violation of the rule requirement that the inventor mailing address be an “address where the inventor 'customarily receives mail'". Most inventor's do not customarily receive any mail sent to their employer's law department. Certain foreign corporations desire to prevent the USPTO from being able to communicate with their employee inventors. That desire, however, conflicts with the USPTO's reason for requiring the inventor mailing address. As noted above, "[t]he mailing address is for the benefit of the inventor in the event that the Office would need to contact the inventor directly."

The corresponding new US short form declaration "(PTO/AIA/01 (06-12))" effective on and after 9/16/2012, does not have the same problem because this US short form does not include locations for entry of inventor “residence” or inventor “Mailing Address”. This lack of inclusion in the US short form declaration is because the US short form declaration must be accompanied by and ADS that does include the address information. (As noted in the US short form, below the signature block “Note: An application data sheet (PTO/SB/14 or equivalent), including naming the entire inventive entity, must accompany this form. Use an additional PTO/AIA/01 form for each additional inventor.”)

It is most likely that US counsel (or a US paralegal knowledgeable in the

requirements for declarations and ADSs) will prepare a US declaration and ADS and will know what information is required therein. Hopefully, such actors require accurate information from their clients to avoid the possibility of loss of client rights.

However, it is most likely that the person filling out a PCT request form's Box VIII (iv) declaration of inventorship on behalf of an entity residing outside the United States will not be US counsel (or a US paralegal knowledgeable in the requirements for declarations). I think it likely that such actors will fail to enter an address where the inventor "customarily receives mail" for the inventor mailing address, to the same extent they currently fail to provide accurate inventor mailing address information when instructing US counsel to file a US application or a US national stage entry of a PCT application. I find that failure in instructions occurs on a regular basis.

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