
U.S. Patent Office Permits Patent Applications To Be Filed By Patent Assignee

Hartman Titus PLC
7114 E. Stetson Drive
Suite 205
Scottsdale, AZ 85251-3250

T: 480.659.0019
F: 480.659.3304
www.hartmantitus.com

John D. Titus

September 2012

A welcome change to U.S. patent law takes effect today. Going forward, the U.S. Patent Office will allow patent applications to be filed and prosecuted by the assignee of the invention rather than the named inventor.

This represents a significant departure from the prior rule, under which the inventor, and only the inventor, was considered the applicant, even if the inventor had assigned the invention to another, or was under an obligation to assign the invention to another (to an employer, for example).

The inventor is still required to complete a declaration. However, the declaration is no longer a required part of the initial application and, therefore, may be filed any time during prosecution, up to and including the date on which the issue fee is paid.

International applicants in particular are looking forward to these changes to U.S. patent practice. Outside the United States patent applications are typically filed in the name of the employer/assignee and not the inventor. For U.S. applications based on a first-filed foreign application, this means that the U.S. application may be filed - and a filing date granted - without the need to secure the signature of the inventor or the need to file a petition for acceptance of the application without the signature of an uncooperative inventor. This brings U.S. law into harmony with most of the rest of the world. The procedures for filing a declaration in lieu of an inventor's signature are also streamlined.

A link to the full announcement is here: <http://tinyurl.com/8s36sj9>.

Hartman Titus is a law firm focusing on intellectual property transactions and litigation, business matters, and commercial litigation. The firm has received recognition in the 2011-2012 U.S. News - Best Lawyers® "Best Law Firms" rankings in the areas of Trademark Law, Copyright Law, Litigation - Intellectual Property, and Litigation - Patent.